

Regeneron defeated in GM mouse patent row

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A US court has ruled that biotechnology company Regeneron engaged in “inequitable conduct” after finding that it withheld information from a patent application for a genetically modified mouse.

The ruling, handed down on Thursday August 6, at the US District Court for the Southern District of New York, stems from a 2014 patent infringement claim that Regeneron had filed against Netherlands-based biotech company Merus.

In February this year, the district court threw out Regeneron’s infringement claim, which centred on US patent number 8,502,018, and declared the patent invalid.

Despite this, Merus went on to pursue a counterclaim of inequitable conduct against Regeneron and said it withheld material information from patent examiners during the prosecution stage for the ‘018 patent.

The patent was issued in 2013 and is called “Methods of modifying eukaryotic cells” — which covers a genetically modified mouse.

Judge Katherine Forrest, presiding over the case, said the contradictions between the documents submitted to the US Patent and Trademark Office and Regeneron’s witness testimony in the 2014 infringement case led her to believe that the biotech company had misled examiners.

She said the “failure to make full and adequate production of the documents ... alone warrants serious sanctions” before concluding that Regeneron “engaged in inequitable conduct in connection with the prosecution of the ‘018 patent.”

Ton Logtenberg, chief executive of Merus, said: “We are very pleased with the court’s decision in our favour. From the outset Merus maintained that the ‘018 patent is invalid, not infringed and was procured by inequitable conduct.

“Merus felt compelled to press its inequitable conduct claim because, as a US patent owner itself, Merus does not believe that Regeneron’s patent should have been permitted to issue and interfere with any company’s legitimate business,” he added.

A spokesperson for Regeneron told *LSIPR* that it “disagrees completely” with the ruling and has confirmed it will appeal against it.

Patricia Carson, partner at law firm Kirkland & Ellis and representing Merus, said: “It brings to a close Merus’s third successful counterclaim against Regeneron, and has provided a sound resolution for our client, who has been embroiled in litigation for over a year.” Peter Silverman, also representing Merus, described the ruling as “significant” because it reaffirms the importance of candor before the USPTO and in litigation.”