



How strong is the IP in light of recent Federal Circuit and Supreme Court activity?

Are the patents valid?

- Obviousness standard in a state of flux
 - *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007)
 - *Ex parte Kubin* (BPAI 2007) (Precedential)
 - *Takeda Chem. Indus., Ltd. v. Alphapharm Pty. Ltd.*, 492 F.3d 1350 (Fed. Cir. 2007)
 - *Forest Labs., Inc. v. Ivax Pharm. Inc.*, 501 F.3d 1263 (Fed. Cir. 2007)
 - *Aventis Pharma Deutschland GmbH v. Lupin Ltd.*, 499 F.3d 1293 (Fed. Cir. 2007)

Are the patents valid?

- Likelihood of survival of second generation invention patents
 - *Pfizer v. Apotex*, 480 F.3d 1348 (Fed. Cir. 2007)
- Research Tools
 - *Integra v. Merck* saga
- Licensed versus owned
 - *MedImmune v. Genentech, Inc.*, 127 S. Ct. 764 (2007)

Will the patent application issue?

- Laws and rules in flux
- Increased inconsistency with USPTO
 - High turnover with Examiners
 - Training/Mentoring Issues
- Will a broad claim issue?
- What is the value of a narrow claim?

Other considerations

- Proposed New Rules at the PTO
 - Continuation and Claims Rules
 - *Tafas v. Dudas* and the consolidated *GSK v. Dudas* hearing set for February 15, 2007
 - Briefing by Industry and Bar Associations due December 20, 2007
 - Markush Rules
- Patent Reform

Summary Considerations

- Premium on issued patents versus pending applications
- Premium on first generation inventions versus second generation inventions
- Premium on ownership versus licensed rights
- Premium on product-focused issued claims versus broad and “overreaching” claims