

Genentech Presses For Cancer Drug Patent's Invalidation

By **Dorothy Atkins**

Law360, San Francisco (January 5, 2017, 6:55 PM EST) -- Genentech Inc. urged a California federal judge on Thursday to invalidate a patent at the center of Phigenix Inc.'s infringement suit targeting Genentech's breast cancer treatment Kadcyla, arguing the patent's claims were anticipated by earlier clinical trials and are "infinitely broad."

Genentech's attorney Michael A. Jacobs of Morrison & Foerster LLP argued during a hearing in San Jose that the asserted claims are invalid because they are not supported by the patent's specifications. The patent's claims broadly include any molecule that indirectly inhibits certain genes and does not specify that the patent applies exclusively to breast cancer treatments, he said.

"It doesn't have any experimental information whatsoever of treating a breast condition," Jacobs said.

Phigenix, a biomedical research company, had sued Genentech for patent infringement in January 2014, targeting the company's Kadcyla drug, which was approved about a year earlier by the U.S. Food and Drug Administration to treat metastatic breast cancer. The asserted claims in Phigenix's patent describe methods of treating conditions, like breast cancer, by administering a drug that alters the combination of two specific genes.

During Thursday's hearing, Jacobs argued that even if the patent's specifications supported the patent's claims, publicly disclosed uses of Kadcyla as a breast cancer treatment inherently anticipate the asserted claims, making the patent invalid.

Phigenix's attorney Paul D. Ackerman of Andrews Kurth Kenyon LLP rebuffed Jacob's argument, saying there are genuine disputes of material fact as to whether the 2005 patent application contains an adequate written description of a claimed invention.

Ackerman argued that the patent application includes breast cancer, along with some dozens of other conditions, as a possible use for the patented method. Additionally, Ackerman said that patients in the clinical trials predating Phigenix's patent were given a "much different cocktail" from the method asserted in the patent.

U.S. District Judge Beth L. Freeman took the arguments under submission, but said her decision will "rise and fall" on the adequacy of the 2005 patent application.

Genentech had urged the court in May to throw out the case, arguing in a sanctions motion that the

infringement claims are “scientifically unsupportable” and that there is nothing to suggest Kadcyła alters the expression of either of those genes. Additionally, Genentech argued that the asserted claims are invalid and that the claims are anticipated by a patent application filed years earlier describing a breast cancer treatment.

But in October, Judge Freeman denied Genentech’s motion, finding that although Genentech exposed “significant weaknesses” in Phigenix’s infringement claims, they are not entirely baseless.

The patent-in-suit is U.S. Patent Number 8,080,534.

Phigenix is represented by Robert A. Gutkin, John Murray, Gregory L. Porter and Paul D. Ackerman of Andrews Kurth Kenyon LLP and Edward Vincent King Jr. of King & Kelleher LLP.

Genentech is represented by Michael A. Jacobs, George C. Harris and Matthew I. Kreeger of Morrison & Foerster LLP.

The case is Phigenix Inc. v. Genentech Inc., case number 5:15-cv-01238, in the U.S. District Court for the Northern District of California.

--Additional reporting by Matthew Bultman. Editing by Edrienne Su.