

ADDITIONAL DEVELOPMENTS—PATENT

BIOGEN IDEC MA INC. V. TRUSTEES OF COLUMBIA UNIVERSITY

2004 WL 1839726 (D. Mass. Aug. 13, 2004)

The district court denied Biogen Idec MA's motion for a preliminary injunction to prevent the Trustees of Columbia University's from terminating their license agreements, holding that while Biogen was likely to prove that Columbia's patents are invalid and unenforceable, Biogen failed to prove it would be irreparably harmed by the denial of the injunction.

In the early 1990s, plaintiff drug companies Biogen and Genzyme Corporation licensed from Columbia University all patents deriving from a 1980 patent on a recombinant DNA technology known as cotransformation (the "Axel patents"). In August 2002, Biogen, believing the patents had expired and its license terminated, stopped royalty payments to Columbia. The university informed Biogen and Genzyme that they were obligated to continue royalty payments because a new patent had issued which derived from the Axel patents, U.S. Patent No. 6,455,275 ("the '275 patent").

Biogen and other drug companies brought suit against Columbia in July 2003, challenging the validity and enforceability of the '275 patent. The plaintiffs argued that the '275 patent covers essentially the same technology as the earlier patents, and is therefore invalid under the doctrine of non-statutory double-patenting or, in the alternative, is unenforceable because of prosecution laches. In March 2004, as a result of the non-payment of royalties, Columbia notified plaintiffs it was terminating their licenses. Plaintiffs sought a preliminary injunction to prevent Columbia's termination.

On the invalidity claim, plaintiffs presented expert testimony explaining why the claims of the '275 patent are not patently distinct over claims of an earlier patent and therefore, are invalid for obviousness type double patenting. The court noted that Columbia offered no evidence to rebut the testimony, relying instead solely on the presumption of the patent's validity. On the laches claim, the court found that the 22-year interval between application and issuance of the patent and other delays in prosecution strongly suggested deliberate delay for the purpose of increasing commercial value of the patents; Columbia failed to offer explanations for this delay.

However, the district court denied the motion for a preliminary injunction, holding that although the plaintiffs established a likelihood of success on the merits, they failed to show they would suffer irreparable harm if the request was denied, largely because there was "no threat that [the drug companies would] be restrained from manufacturing or distributing their respective drugs during the pendency of this case."