

Federal Court Issues Favorable Decision For Sheppard Mullin Client, American Bioscience

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Sheppard, Mullin, Richter & Hampton is proud to announce that Joe Coyne and Phil Davis, both partners in the Firm's Business Trial Practice Group, obtained a favorable decision from the U.S. Court of Appeals for the Federal Circuit on behalf of its client, Los Angeles-based American Bioscience (ABI), in *The Board of Education v. American Bioscience, Inc. et al.* The Court overturned a lower court ruling involving ABI's patent on a chemical analog to the billion-dollar anti-cancer drug Taxol.

Florida State University (FSU) claimed that the compound is worth over \$200 million. FSU alleged that two of its professors should have been named as inventors in the patent and that three ABI researchers should not have been named as inventors. FSU therefore claimed rights to the patented Taxol analog.

ABI demonstrated that the compound is one of a number of new anti-cancer drugs it is developing and that FSU's researchers did not contribute to the invention. The Federal Circuit decided that the FSU researchers did not conceive the specific invention claimed. Judge Alan D. Lourie of the U.S. Court of Appeals for the Federal Circuit stated in the Court's decision, "...invention does require conception, and there is no evidence that FSU's inventors conceived of any of the claimed compounds. Having in mind specific portions of a claimed compound is not the same as conceiving the compound with all of its components. One must have a conception of the specific compounds being claimed, with all of their component substituents..." The Federal Circuit found that ABI invented the patented compound and rewarded ownership of the patent entirely to ABI.

Mr. Coyne, lead defense attorney, commented, "Sheppard Mullin and ABI are incredibly pleased that the Federal Circuit took the time to learn the science, the organic chemistry, as well as the facts of the case. The results of a two-week trial clearly demonstrated that ABI was the inventor of this innovative compound. ABI will now have undisputed ownership of the potentially valuable analog." He added, "The Court's ruling was a sweeping victory for our client."

Mr. Davis, also ABI's defense attorney, said, "This is the right result. FSU and Dr. Holton have an arrogant view regarding the creation of taxol analogs. Our clients invented three new analogs that FSU had never thought of, but FSU claimed inventorship of solely because one of ABI's scientists once worked in Dr. Holton's lab. The Federal Circuit found that ABI's researchers were the true inventors. The devil for FSU was in the details, the organic chemistry, and the proof. We prevailed because of the evidence and a great team effort."

Sheppard Mullin has more than **370 attorneys** among its **eight offices** in Los Angeles, San Francisco, Orange County, San Diego, Santa Barbara, West Los Angeles, Del Mar Heights, and Washington, D.C. The **full-service** firm provides counsel in Antitrust and Trade Regulation; White Collar and Civil Fraud Defense; Business Litigation; Construction, Environmental, Real Estate and Land Use Litigation; Corporate; Entertainment and

Media; Finance and Bankruptcy; Financial Institutions; Government Contracts and Regulated Industries; Healthcare; Intellectual Property; Labor and Employment; Real Estate, Land Use, Natural Resources and Environment; and Tax, Employee Benefits, Trusts and Estates. **The Firm celebrated its 75th anniversary in 2002.**

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