

Gilead Gets PTAB To Wipe Out University's Antiviral IP Claims

By Adam Lidgett

Law360 (May 24, 2021, 6:08 PM EDT) -- The Patent Trial and Appeal Board has thrown out more than two dozen claims in a University of Minnesota patent covering a compound with antiviral and anti-cancer properties, handing a win to Gilead in a sprawling patent fight.

The PTAB on Friday found that numerous claims in the university's U.S. Patent No. 8,815,830 were not patentable, agreeing with Gilead's argument that the patent was anticipated by an earlier patent application publication known as Sofia.

The board said the case partially turned on whether Sofia was considered prior art, and ultimately the PTAB found that it was.

"We determine that petitioner has demonstrated by a preponderance of the evidence that Sofia anticipates claims 1-9, 11-21, and 23-28 of the '830 patent," the board wrote.

The PTAB instituted inter partes review in the case about a year ago, after finding that Gilead showed it was likely that one of the disputed claims was invalid over Sofia, which discloses a compound for treating viral infections.

The board's Friday decision is the latest in a patent fight between Gilead and the University of Minnesota, which filed a lawsuit in 2016 over allegations that the drugmaker's blockbuster hepatitis C drugs infringed a patent issued to one of its top scientists.

The lawsuit, originally filed in Minnesota, was shipped to California in October 2017 after a Minnesota federal judge found that Gilead doesn't "ride" or have a "regular and established physical place of business" in the district, rendering the venue improper.

Gilead had also filed three other challenges to the patent-in-suit at the PTAB, but those had been denied earlier.

"We are pleased with Friday's decision from the U.S. Patent Office which found the University's patent to be invalid," Gilead said in a statement to Law360. "The University of Minnesota did not invent [hepatitis C treatment] sofosbuvir, nor did it contribute to its development. We believe the university's patent is invalid, unenforceable and not infringed by the sale of Gilead's HCV therapies."

Counsel for the university declined to comment to Law360 on Monday.

The patent-in-suit is U.S. Patent No. 8,815,830.

Gilead is represented by Alicia Russo, Robert Schwartz, Justin Oliver and Stephen Yam of Venable LLP, and J. Scott McBride, Nevin Gewertz, Faye Teller, Rebecca Horwitz and Meg Fasulo of Bartlit Beck LLP.

The university is represented by Edward R. Gates, Richard F. Giunta, Gerald B. Hrycyszyn and Charles T. Steenburg of Wolf Greenfield & Sacks PC.

The case is Gilead Sciences Inc. v. Regents of the University of Minnesota, case number IPR2017-01712, before the Patent Trial and Appeal Board.

--Additional reporting by Melissa Daniels and Tiffany Hu. Editing by Rich Mills.