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## University of Minn Waived Its Sovereign Immunity in Inter Partes Review of its Patents

Though this matter does not fall in the medtech or life science areas, it is noteworthy in view of our prior newsletters describing Allergan's attempt at sovereign immunity by transferring its patents to a native tribe.

The University of Minn (UM) owned several patents in the telecomm area and were the subject of inter partes review initiated by Ericsson in the USPTO to invalidate the patents.

The Patent Trial and Appeal Board (PTAB) noted that it had previously determined that, under the Eleventh Amendment to the US Constitution, immunity is available to States as a defense in inter partes review. However, the issue in this case was whether UM had waived its immunity defense.

The PTAB pointed out that UM had filed in district court patent infringement lawsuits against Ericsson's customers, and UM consented to Ericsson intervening in those lawsuits.

UM argued that any waiver of immunity should be limited to the venues where UM filed its lawsuits.

The PTAB disagreed, explaining that Ericsson could not seek inter partes review in the district courts. Therefore, according to the PTAB, it would be unfair to allow UM to assert immunity in this inter partes review.

### COMMENTS:

The PTAB did not address the ability of Ericsson to raise invalidity defenses in UM's district court lawsuits and whether that should factor into whether it was unfair to Ericsson to be precluded from raising the same or similar invalidity issues in inter partes review.

## Pfizer to Pay \$94M to Settle Class Action Over Celebrex Claims

Purchasers of the anti-inflammatory drug Celebrex sued Pfizer claiming that Pfizer abused the patent office process to extend its patent rights to the drug.

Previously, the Federal Circuit invalidated a Pfizer patent for the drug. Pfizer then sought in the patent office a re-issue of the patent to correct "unintentional" errors. The patent office eventually re-issued the patent.

Using the re-issued patent, Pfizer sued generic drug makers. A federal court found the re-issued patent invalid. Nevertheless, the generic companies settled upon an agreement to not sell their generics for a time period that extended beyond the term of the original patent.

The class action alleged that Pfizer violated antitrust laws by delaying competition by the generics.

### COMMENTS:

\$94M would seem to pale in comparison to the total sales revenue from Celebrex.

## Boehringer's Trademark for "Breathless" is Not Merely Descriptive and Can Be Registered

Boehringer sought federal registration of its trademark BREATHLESS for "promoting public awareness of" and "providing medical information about" idiopathic pulmonary fibrosis (IPF).

A term is "merely descriptive" and therefore unregistrable if it conveys an "immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the services for which it is used."

The Trademark Trial and Appeal Board (TTAB) noted that a dictionary defined "breathless" as "breathing with difficulty, gasping."

According to the TTAB, breathlessness is a symptom of IPF. However, the evidence did not show that "breathless" merely described providing consumers with information about IPF or raising public awareness about it.

Therefore, the TTAB concluded that BREATHLESS did not identify a feature of Boehringer's services and is therefore registrable.

### COMMENTS:

The distinction here was that the trademark may have described something about the subject matter to which the services pertained, but not the services themselves.

## What is an "Extended Release Coating" of a Drug?

Aptalis owned patents to an extended release, skeletal muscle relaxant drug that provided 24 hour relief with a single dose. They sued Apotex for a generic version.

The parties disputed the patent meaning of "an extended release coating comprising a water insoluble polymer membrane surrounding core."

The Federal Circuit referred to a dictionary in noting that "surround" means "to enclose on all sides." The parties, however, disagreed over whether the coating must be "continuous".

Aptalis argued that the word "continuous" did not appear in the patents. It did not persuade the Federal Circuit.

According to the Federal Circuit, the patents pointed out that the prior art described coatings having apertures that exposed 5-75% of the core surface. And, according to the Federal Circuit, the patents did NOT claim a coating with a certain percentage of exposed surface. Rather, the patents claimed a coating "surrounding" the core.

Therefore, the coating had to be all around the core, not just around a part of the core.

### COMMENTS:

This is another example of why the inventor needs to be careful in how the prior art is described in the inventor's patent. It can be used to interpret and limit the scope of the invention.

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