

# Daily Journal

APRIL 17, 2013

## Intellectual Property 2013

One of the striking things about picking the list of top intellectual property attorneys, aside from the difficulty of choosing among hundreds of highly qualified nominees, is the diversity of their achievements. The litigators chosen travel the country to do battle for their clients.

While these attorneys' work has stretched worldwide, some of the biggest cases of the past year took place in California. To qualify for the list, an attorney must be based in California even if much of his or her work is done elsewhere, such as the U.S. International Trade Commission in Washington, D.C., the U.S. Patent and Trademark Office in Virginia, and district courts in Texas, Delaware, Illinois and elsewhere. And their focus must be on intellectual property, as opposed to general litigators who sometimes handle such work.

### Top 25 Portfolio Managers/ Patent Prosecutors

#### Jeffrey S. Mann

Morgan, Lewis & Bockius LLP | San Francisco

Biotechnology, life sciences



A highlight for Mann and his team last year was the clear win on each of three inter partes reexaminations for their client Biosearch Technologies Inc.

The company designs and manufactures products that accelerate the discovery and application of genomic information.

A larger biotech company had sued Biosearch for patent infringement.

"The patents placed in reexamination covered an important product line of the client," Mann said, "and we were able to bring the patents out of reexamination with all claims confirmed."

While statistically it's rare to have one patent emerge from an inter partes reexamination with all claims confirmed, Mann said. "Clearly, it's even more unusual to achieve this result with three related patents all in reexamination at the same time."

He added, "Working closely with our client we were able to construct compelling arguments on scientific, commercial and legal grounds, conclusively supporting the patentability of the claims for all three patents."

Among Mann's other significant matters, he counseled biotech company Prosetta Antiviral Inc. on the intellectual

property aspects of its strategic alliance with Bristol-Myers Squibb Co.

The deal has helped to advance the discovery and development of drug candidates representing new classes of antiviral drugs, with a particular focus on AIDS, he said.

Mann also counseled Lumiphore Inc. about the intellectual property related to a global agreement with Algeta ASA, a cancer therapeutics company.

"A very satisfying aspect of what we do is to be able to work with our clients to turn the IP that we have worked on with them into an essential component of a deal that generates revenue for our clients and allows them to continue innovating and building their business," Mann said.

An inventor of two of his own U.S. patents related to polymeric drug delivery, and holding a Ph.D in synthetic organic chemistry, Mann leads Morgan Lewis' intellectual property practice in San Francisco.

"My team all have advanced degrees in technology, biology or chemistry," Mann said. "As IP attorneys, we use that background on a daily basis in counseling clients and creating value through IP for them."

— Pat Broderick