

PHILIP GRUBB

Philip Grubb (British) studied organic chemistry at Oxford University (D.Phil. 1964). After a year's post-doctoral study at the University of Wisconsin, he worked as a research chemist first for du Pont in the USA, then for ICI in England, before entering the patent department of ICI in 1970. He qualified as a British Chartered Patent Agent in 1974 and in the same year moved to Sandoz in Basle, Switzerland, where he became a European Patent Attorney in 1978. He was deputy head of the pharmaceutical group of the patents and trademarks department of Sandoz and was active in patents and licensing in the fields of pharmaceuticals and biotechnology. Since the merger of Sandoz with Ciba-Geigy, he is now Intellectual Property Counsel in Corporate Intellectual Property, Novartis International AG. Since 1999 he has been closely involved with the Genomics Institute of the Novartis Research Foundation in La Jolla, CA.

Philip is the author of "Patents for Chemists" (OUP, 1982), "Patents in Chemistry and Biotechnology" (OUP, 1986), and "Patents for Chemicals, Pharmaceuticals and Biotechnology" (OUP, 1999). He has acted as a tutor for the qualifying examination for European Patent Attorneys in seminars in Strasbourg and elsewhere since 1990, and has lectured at several conferences, mainly on the subject of the TRIPs agreement, the Convention on Biological Diversity and related matters.

HOW REAL ARE PATENT THICKETS, REACH-THROUGH RIGHTS, ROYALTY STACKING AND DEPENDENCY AND FREEDOM-TO-OPERATE RESTRICTIONS?

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The annual number of patent filings is rising exponentially, so that there are always more and more third party patents that have to be considered in determining whether or not one is free to operate. This is true in all fields, but particularly so for gene and research tool patents. For a large research-based pharmaceutical company this may give rise to more problems than opportunities, whereas the reverse may be true for small biotech companies. Nevertheless, the problems are no different in kind from those which the industry and market forces have coped successfully for a long time. Dependency situations arise in the patenting of NCEs, and are normally dealt with by licensing or cross licensing. Royalty stacking can occur in many areas, and can be tackled by contractual provisions.

There is no need to change the patent law to make special provisions for research tool and gene patents. A gene is no more than a chemical compound, and for example to restrict the scope of gene patents to the disclosed utility would be a serious mistake, which could have adverse consequences on patent protection for all new compounds. Some excesses may however need to be curbed, not by legislation but by the interpretation of existing law by the courts. Thus in the absence of valid reach-through claims there is no justification for the patentee to ask for a royalty on products found using a research tool, but not covered by the claims. And in my opinion, most reach-through claims are invalid and should not be upheld by the courts.