



## FISH & RICHARDSON



### Brian D. Coggio

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#### Services

Litigation  
Patent Litigation  
Hatch-Waxman

#### Sectors

Chemicals  
Biotech/Pharma  
Medical Devices

Mr. Coggio is Senior Counsel in the New York office of Fish & Richardson. He has extensive law firm experience as a senior trial attorney and counselor and has litigated disputes across a wide range of technologies with a particular focus in chemical, pharmaceutical, and biotechnology. He has also been involved in cases before the International Trade Commission and in various foreign countries including Germany, Great Britain, Switzerland, Italy, and the Netherlands. In addition, Mr. Coggio has also represented clients in numerous cases under the Hatch-Waxman Act and has written and lectured extensively on this topic in this country, Europe, Canada and Japan.

#### Experience

##### Litigation examples

Hoffman-La Roche. He is lead counsel for Roche in three Hatch-Waxman actions involving the drug XELODA® against Mylan, Teva and Roxanne, respectively. The cases are pending in the District of New Jersey.

Boehringer Ingelheim. In *Novartis v. Ben Venue*, a Hatch-Waxman action he was lead counsel representing Ben Venue, a subsidiary of Boehringer Ingelheim. He secured a summary judgment of non-infringement, later affirmed by the Federal Circuit.

Bristol-Myers Squibb. He was lead counsel representing Bristol-Myers in *Zenith v. Bristol-Myers Squibb*, a declaratory action judgment involving the pharmaceutical cefadroxil and related to the Hatch-Waxman Act. The case established the principle of infringement by *in vivo* conversion of a non-patented product into patented pharmaceutical after ingestion.

Alcon Laboratories. He was part of a team representing Alcon in two Hatch-Waxman actions against Allergan involving drugs for intraocular administration. Both litigations were successfully resolved on summary judgment in Alcon's favor.

Marion Merrill Dow. In *Marion Merrill Dow v. Geneva* and *Marion Merrill Dow v. Par Pharmaceuticals*, both

Hatch-Waxman actions, he was lead counsel asserting infringement of the client's patent covering a metabolite of the antihistamine terfenadine (Seldane®). In the course of both litigations, various motions for summary judgment of invalidity and/or non-infringement were overcome. He was also involved in related litigations in the Supreme Court of Germany and in the House of Lords.

Bruker Daltonics. In *Extrel v. Bruker*, he was retained to prosecute the appeal from a decision in which Bruker had been found liable for infringement. Sales of the alleged infringing product, FTICR mass spectrometers, were enjoined, and awards of increased damages and attorney fees had been entered. On appeal, the Federal Circuit reversed the finding of infringement and vacated the injunction and all monetary awards against the client.

Hoechst Marion Roussel. In actions before the International Trade Commission and various district courts, he was lead counsel and led a large team that asserted that methods of producing diltiazem (Cardizem® CD) used by various defendants infringed a patent licensed to Hoechst by Tanaka Seiyaku. The lengthy trial before ITC involved examination and cross-examination of witnesses who spoke Japanese, Finnish, Italian, German, or Hebrew.

Hoffmann-La Roche. He was lead counsel for Roche in a patent infringement action instituted by Chiron involving the latter's patents covering various aspects of the gene encoding the hepatitis C virus. In addition, he coordinated related litigations in the Netherlands, France, Germany, Switzerland, Italy and Japan. He and his team were instrumental in obtaining a favorable worldwide settlement of all the litigations.

Hewlett-Packard. In two district court trials and related appeals to the Federal Circuit in disputes between Hewlett-Packard and Bausch & Lomb involving X-Y plotters, he was part of a team that successfully represented Hewlett-Packard against accusations of patent infringement. Moreover, the team established willful infringement by Bausch & Lomb of Hewlett-Packard's own patent. As a result, Hewlett-Packard recouped all attorney fees from its adversary.

Hoffmann-La Roche. Throughout his career, he has been counsel to Roche and its foreign subsidiaries, including Nippon Roche and Roche GmbH, in various patent infringement litigations in which Roche has asserted patents covering alpha interferon. Recently, he was involved in related worldwide litigation involving a modified form of interferon (pegylated interferon) marketed by Roche as Pegsys®. Most recently, in *ICN Pharmaceuticals v. Hoffmann-La Roche*, he was lead counsel representing Roche in a Hatch-Waxman action involving the pharmaceutical product ribavarin. That litigation was eventually settled. He was also lead counsel to Roche in a multi-defendant litigation instituted by Housey Pharmaceuticals against numerous pharmaceutical companies involving so-called research tool patents. After a successful result at a *Markman* hearing, the patentee conceded both invalidity and non-infringement. The ruling was affirmed by the Federal Circuit.

U.S. Biochemical. In *Harvard Medical School and U.S. Biochemical v. Pharmacia*, he was lead counsel representing plaintiffs in a patent infringement action asserting infringement of a patent covering T7 DNA polymerase used in DNA sequencing. The successful result included the entry of a worldwide license agreement.

Bruker Daltonics. He was lead counsel representing Bruker and Agilent in *Finnigan v. Bruker* before the International Trade Commission. After a three-week trial, the Administrative Trial Judge held for Bruker. This decision was affirmed by the full commission and by the Federal Circuit. He also coordinated related litigations in U.S. district court and in Germany and Switzerland.

American Cyanamid. In *Ethicon v. American Cyanamid*, he was part of a team that represented the defendant-patentee who sued Ethicon (a division of Johnson & Johnson) for infringement of a patent covering synthetic absorbable sutures. After 72 days of trial, the case was settled in favor of Cyanamid. He also coordinated related litigations in England, France, and Germany, all of which were successfully resolved.

National Starch. In a patent/trade secret litigation instituted by Air Products, he was lead counsel for National Starch in the trade secret action and defeated claims that the client had misappropriated 13 separate trade secrets.

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## Education

BS, Manhattan College 1971  
Chemical Engineering

LLM, New York University School of Law 1980  
Trade Regulations

JD, Fordham University School of Law 1974  
*cum laude*  
Editor, *Fordham Law Review*

## Admissions

New York 1975  
United States Patent and Trademark Office 1975  
United States District Court for the Southern District of New York  
United States District Court for the Eastern District of New York  
United States Court of Appeals for the Federal Circuit

## Other Distinctions

### Representative Publications and Presentations

Co-Chair, "ACI's 12th Advanced Forum on Biotech Patents: Comprehensive and Practical Biotech Patent Prosecution and Litigation Strategies for a Rapidly Evolving Legal Climate (Boston, November 30 - December 1, 2010)

Speaker, "Learning to Navigate the New Limits and Boundaries of The Safe Harbor," 11th Annual Maximizing Pharmaceutical Patent Life Cycles (New York, October 6-7, 2010)

"The Patentability of Drug Enantiomers," 190 N.J.L.J. 51 (October 1, 2007)

"Scope of the Safe Harbor Exemption of the Hatch-Waxman Act After *Merck v. Integra Lifesciences*," 15 Fordham Intellectual Prop. L.J. (2005)

"Overview of Patent Litigation," 11(1) IP Litigator 1 (2005)

"'CREATE' Act of 2004 Extends 'Safe Harbor' Aspects of Patent Laws," N.Y.L.J. 4 (Feb. 3, 2005)

"The Right to a Jury Trial in Actions for Patent Infringement and Suits for Declaratory Judgment," 13 Fordham Intellectual Prop. L.J. 205 (2002), reprinted as Chapter 21, "Survey of Developments of Intellectual Property and Technology Law" (WebCredenza, Inc. 2004)

"New Horizons in Patent Litigation: 'Discovering' Electronic Information," N.Y.L.J. S4 (October 12, 2004)

"Recent Federal Circuit Decisions of Significance to Biotech/Pharmaceutical Practitioners", appearing in "Biotechnology & Pharmaceutical Law 2004" (Practising Law Institute, October 2004)

"Electronic Discovery: Where We Are and Where We are Headed," 16 Int'l Prop. & Tech. L.J. 16 (March 2004)

"Recent Developments Regarding The Hatch-Waxman Act," N.Y.L.J. S2 (Jan. 26, 2004)

"Can the Seventh Amendment Ever Require That the Defense of Inequitable Conduct be Presented to a Jury?," 9 (7) IP Litigator 1 (2003)

"The Period of Liability for Patent Infringement," 10(7) IP Today 36 (2003)

"Overview Of Patent Litigation" appearing in "What Every Litigator Must Know About Intellectual Property 2003" (Practising Law Institute, July 2003), updated July 2004

Contributor: "Patent Disputes: Litigation Forms and Analysis," Battersby & Grimes (Aspen Pub. 2003)

Contributor: "Trademark & Copyright Disputes: Litigation Forms and Analysis," Battersby & Grimes (Aspen Pub. 2003)

"Disqualification of Opinion Counsel as Trial Counsel When an Advice of Counsel Defense is Asserted," 9(2) IP Litigator 11 (2003)

"*Integra Life Sciences I Ltd. v. Merck KGaA*: Exemptions For Research Tool Patents," 9(3) IP Strategist 6 (2002)

"Court is Taking a Dim View of Best-Mode Defense," 25(12) Nat'l L.J., Sec. C. (Nov. 11, 2002)

"The Safe Harbor Provision of the Hatch - Waxman Act: Present Scope, New Possibilities, and International Considerations," 57 Food Drug L.J. 161 (2002)

"The Right to a Jury Trial Under the Waxman-Hatch Act - The Question Revisited and Resolved," 57 Food Drug L. J. 1 (2002)

"The Identification and Selection of Expert Witnesses," 6(3) IP Litigator 1 (2000)

"Adequate Notice: The Key to Obtaining Pre-Suit Damages in Patent Infringement Actions," 6(2) Met. Corp. Counsel 20 (1998)

"Arbitration of Patent Infringement Disputes," 6(3) Metropolitan Corp. Counsel 13 (1998)

"Avoiding Patent Infringement During the Drug Approval Process," N.Y.L.J. S4 (Mar. 9, 1998)

"The Application of the Patent Laws to the Drug Approval Process," 52 Food Drug L.J. 345 (1997)

"The Right to a Jury Trial in Actions Under the Hatch-Waxman Act," 52 Food Drug L.J. 259 (1997)

"Developing Pharmaceutical Products Without Fear of Patent Infringement," 5(6) Met. Corp. Counsel (1997)

"Are Clinical Trials Conducted to Obtain FDA Approval Fatal to Patent Validity?" 5(4) Met. Corp. Counsel (1997)

"The Utilization of U.S. Patents to Prevent the Importation and Sale of Gray Goods," 83 Trademark Rptr. 481 (1993)

"The Exercise of Patent Rights Through Multiple Exclusive Field-of-Use Licensing," 4 Rutgers Comp. & Tech. L.J. 383 (1985)

"History and Present Status of Gray Goods," 75 Trademark Rptr. 433 (1985), reprinted in Hawk, B., United States, Common Market and International Antitrust: A Comparative Guide (Prentiss Hall 1986)

## News

[Ariad Decision Underlines Importance of Fully Describing Patented Biotech Inventions](#)

[Brian Coggio Joins Fish](#)

[Revisiting Ariad v. Eli Lilly](#)

[Strategies to strengthen your patent](#)

## Speaking Engagements

[25th Annual Pharmaceutical/Chemical Patent Practice Update](#)

[13th Advanced Forum on Biotech Patents](#)

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