

SANOFI-AVENTIS DEUTSCHLAND GMBH v. GLENMARK PHARMACEUTICALS INC.,  
Appeal No. 2012-1489 (April 21, 2014). Before Newman, Linn and Wallach. Appealed from  
D.N.J. (Judge Cavanaugh).

Background:

Aventis sued Glenmark who had filed an Abbreviated New Drug Application (ANDA) for Aventis's patented hypertension drug, which includes a double-ring ACE inhibitor and a calcium antagonist. At the time of Aventis's patent filing, the prior art had studied primarily single-ring ACE inhibitors combined with calcium antagonists. However, Aventis's hypertension drug had longer duration of effect, as well as improved kidney function and improved blood vessel structure, more than previously known treatments. After a jury found that the claims of Aventis's patent had not been proved invalid on the ground of obviousness, the district court denied Glenmark's motion for judgment as a matter of law. Glenmark appealed.

Issue/Holding:

Did the district court err in not holding Aventis's patent invalid? No, affirmed.

Discussion:

Glenmark argued that the district court erred in finding Aventis's patent non-obvious because benefits discovered after the filing of the patent application (i.e., the improved kidney and blood vessel function) should not be considered in an obviousness analysis. Glenmark also argued that the fact that no double-ring ACE inhibitors had been previously evaluated or suggested for combination with calcium antagonists should be considered. Instead, because the single-ring ACE inhibitors had been tested with calcium antagonists, it was "obvious to try" every combination of effective ACE inhibitors and calcium antagonists, including a double-ring ACE inhibitor, despite any later-discovered "synergy."

The Federal Circuit found that later-discovered benefits are relevant to non-obviousness. Further, the Federal Circuit determined that there was no prior knowledge that the combination of a double-ring ACE inhibitor with calcium antagonists would be longer lasting than hypertension treatments at the time of filing. Thus, the Federal Circuit held that the jury could have reasonably relied on testimony that persons skilled in the art could not have predicted the longer-lasting hypertension control demonstrated by a double-ring ACE inhibitor combined with a calcium antagonist. Accordingly, the Federal Circuit agreed with the district court's holding that the claims of Aventis's patent are not invalid.