

Jorge A. Goldstein, Ph.D., Authors Fourth Edition of U.S. Biotechnology Patent Law

Washington D.C. (November 1, 2019) - Sterne, Kessler, Goldstein & Fox is pleased to announce the publication, by *Thomson Reuters*, of director [Jorge A. Goldstein, Ph.D.](#)'s fourth edition of *U.S. Biotechnology Patent Law, 2019-2020*. This book is a highly readable and well-organized desktop companion for practicing attorneys, patent agents, novice prosecutors, litigators, and students seeking effortless entry into U.S. case law dealing with patents in modern biotechnology.

The focus of this book is on biotechnology cases decided by the Court of Appeals for the Federal Circuit, its predecessor, the Court of Customs and Patent Appeals, the U.S. Supreme Court, and the U.S. Patent & Trademark Office Appeal Boards.

Each important biotech case is prominently highlighted in the book and includes, in order:

1. A summary and relevance of the holding;
2. Separate patent claims (Since the holdings in patent law can only be understood in reference to the claims—Are they methods? Products? What are the exact words and limitations? — the author has separated the involved claims for immediate access.);
3. Technology drawings or other facts needed for a clearer understanding; and
4. Verbatim citations and quotes from the tribunal.

Among the numerous revisions in this updated 2019-2020 edition are the following:

Chapter 3 Eligibility: Continued discussion of the guidance provided by the courts in the area. Updates include discussion of the following cases: *Roche v. Cepheid (2018)*, *Natural Alternatives v. Creative Compounds (2019)*, *Athena Diagnostics v. Mayo (2019)*, and *Endo Pharma v. Teva (2019)*. The author has also added commentary on the emerging rules on the eligibility of biotechnology method claims.

Chapter 6 Written Description: In light of the Supreme Court's denial of certiorari, the author has reorganized and added new sections on the written description of antibody genres.

Chapter 9 Novelty: A new Comment has been included to explain the recently-decided *Helsinn v. Teva* (Fed. Cir. 2019), which, held that, post the AIA of 2012-2013, a secret sale of a claimed product is still a statutory bar to patentability.

Chapter 10 Obviousness: A new introduction to the general analysis of obviousness of biotechnology claims has been added. Also, discussion of *UC v. Broad Institute* (Fed. Cir. 2018) has been incorporated into the chapter.

Chapter 11 Inventorship: The author has expanded the Comment at 11:4 to clarify the law on the simultaneous conception and reduction to practice of inventions in unpredictable technologies like biotechnology.

Chapter 12 Infringement: Additional case law has been incorporated for discussion of the impact (or not) of an attorney's mistakes in prosecution, experimental use exception and claim construction of a claimed biological deposit number.

U.S. Biotechnology Patent Law, 2019-2020 is available for purchase from [Thomson Reuters](#).

About the Author

A pioneer in biotechnology patent law and founding partner of Sterne Kessler, [Jorge A. Goldstein, Ph.D.](#), has almost forty years' experience in preparing, prosecuting, licensing, enforcing, and litigating biotech patents before the U.S. and foreign patent offices and tribunals. Dr. Goldstein is also the founder of the firm's unique *pro bono* practice dedicated to integrating intellectual property law concepts with economic, social, and cultural rights to empower disenfranchised and impoverished communities' economic and social development. Dr. Goldstein received his J.D. from The George Washington University *with high honors*, his Ph.D. in chemistry from Harvard, and his B.S. in chemistry from Rensselaer Polytechnic Institute.

About Sterne Kessler

Based in Washington, D.C. and renowned for more than four decades for dedication to the protection, transfer, and enforcement of intellectual property rights, Sterne Kessler is one of the most highly regarded intellectual property specialty law firms in the world. Its team of attorneys, registered patent agents, students, and technical specialists include some of the country's most respected practitioners of IP law tackling innovations across a broad spectrum of industries. The firm's practitioners hold over 50 masters and over 50 doctorate degrees in science or engineering and represent Fortune 500 companies, entrepreneurs, start-ups, inventors, venture capital firms, and universities in a client service driven environment that is welcoming, inclusive, and intellectually stimulating. Visit the firm online at [sternekessler.com](#).

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