



Partner

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Services

Intellectual Property > Life Sciences > Patent Counseling and Prosecution >
Patent Litigation >

Samuel B. Abrams is a partner in the intellectual property group. Mr. Abrams focuses on strategic patent counseling and prosecution and has extensive experience handling interference proceedings and European oppositions on behalf of companies in the biotechnology, chemical, pharmaceutical, drug delivery, and immunology sectors. With respect to drug delivery, Mr. Abrams has represented The Liposome Company, wherein he was engaged to opine on various patents assigned to the company and several third party patents. He also handles the full range of validity, freedom-to-operate and infringement opinions, as well as the strategic planning of patent portfolios, working with his clients on novel ways to monetize their intellectual property.

Mr. Abrams was recommended for biotechnology law in the 2018 edition of The Best Lawyers in America. As a “recommended expert” in *IAM Patent 1000's* New York rankings, he was recognized as having “uncommon experience handling administrative contentious proceedings in Europe and is in hot demand as US IP stakeholders take a greater interest in the run-up to the United Patent Court’s establishment.” Prior to going into private practice, Mr. Abrams was a member of the Merck patent department wherein he was responsible for Merck’s antibiotic patent portfolio.

EXPERIENCE

- *Kroczek v. Tamatani*. Represented **Millennium Pharmaceuticals** in an interference against Japan Tobacco Inc. relating to the T-cell costimulatory molecule ICOS. The interference was settled favorably for Millennium.
- *Gissman v. Lowy et al.* Represented the **German Cancer Research Institute (GCRI)**, assignee of the Gissman patent application, in an interference against the National Institutes of Health relating to a vaccine to prevent cervical cancer. The vaccine is currently being marketed by Merck under the trade name Gardasil®. The interference settled favorably for the GCRI.
- *Kishore v. Burrell*. Represented **British American Tobacco** in an interference against Monsanto relating to genetically-modified potatoes. The interference was settled after the preliminary motions were filed.
- *University of New Mexico v. Fordham University*. Represented **Fordham** in an interference against the University of New Mexico relating to heat shock proteins. Fordham prevailed on priority.
- *Lomedico v. Yamada*. Represented **Roche** in a three-party interference against Immunex Corporation and Dainippon Pharmaceutical Co., Ltd. involving recombinant DNA technologies for producing interleukin-1 alpha (IL-1 alpha) and an additional interference against Dainippon for methods of treating diseases using IL-1 alpha. The interferences were settled after a decision on motions and exchange of priority evidence.
- *Bloembergen et al. v. Rimsa et al.* Represented **Japan Corn Starch** against National Starch in the appeal from the adverse decision in the interference under 35 U.S.C. § 146. The case was favorably settled.
- *Martek Biosciences Corporation v. Nutrinova Inc. et al.* Representing plaintiff **Martek** in a patent litigation suit against Nutrinova and Lonza over omega-3 fatty acids; obtained a jury verdict in favor of Martek on all counts, finding that the defendants had infringed all of Martek's patents at issue in the trial. On appeal, a Federal Circuit five-judge panel fully sustained the judgment for Martek, rejecting Lonza's appeal. The remainder of the case is on remand to the trial court for further proceedings.
- *Incyte Pharmaceuticals, Inc. v. Falb and Gimbrone*. Represented **Millennium Pharmaceuticals** in an interference against Incyte relating to a novel gene. Millennium prevailed on priority.
- *Dodds v. Hulshoff*. Represented **Sepracor, Inc.** in an interference against Andeno (and Tanabe) involving the synthesis of a compound that is useful for making Dilutiazem. Sepracor prevailed on priority. Sepracor also prevailed in the subsequent appeal under 35 U.S.C. § 146.
- *Tempesta v. Cariel and Jean*. Represented **Shaman Pharmaceuticals** in an interference against Cariel. Cariel conceded priority after Shaman demonstrated that Cariel engaged in inequitable conduct.
- *Bolognesi v. Shafferman*. Represented **Trimeris Corp.** in an interference against the NIH relating to the peptide T20, which is currently marketed to treat HIV. Trimeris successfully dissolved the interference by demonstrating that there was no interference in fact.
- *Wertz et al. v. Rose*. Represented **Yale University** in an interference against University of Alabama relating to a recombinant VSV virus that can be utilized in a vaccine against HIV. Yale prevailed on priority.
- *Furman v. Cheng*. Represented **Yale University** in an interference against Glaxo relating to a compound to treat HIV. Yale prevailed on priority.

EDUCATION

- Rensselaer Polytechnic Institute, B.S., Biomedical Engineering, 1978
- Case Western Reserve University School of Law, J.D., 1981

ADMISSIONS

- New York
- United States Patent and Trademark Office

MEMBERSHIPS

- American Intellectual Property Association
- New York Patent, Trademark and Copyright Law Association

SPEAKING ENGAGEMENTS

- **IP Issues to Consider When Launching a New Product** — NJCCA 9th Annual In-House Counsel Conference with Sponsorship by Dechert LLP, Whippany, NJ (September 23, 2011)

Speaker, "IP Issues to Consider When Launching a New Product" program explored the various different types of intellectual property rights that can be used to protect new products, the types of rights conferred and their geographic reach, and best practices for minimizing risks of infringement of third party rights.

- **Tips For Successful Claim Drafting** — Law Seminars International's Current Patent Claim Construction Practice, Philadelphia, PA (October 10, 2007)
- **The Fine Art of Interference Practice: Structures, Concepts, and Pitfalls** — Biotech Patents Conference, San Francisco, CA (December 6, 2004)
- **Freedom-to-Operate and Interferences: Structures, Concepts and Pitfalls** — Freedom-To-Operate Conference, New York, NY (November 10, 2003)