

MedImmune Inc vs. Genentech Inc.

In a decision by the US Supreme Court in *MedImmune, Inc. v. Genentech, Inc.*, No. 05-608, ___ U.S. ___ (2007) (Scalia, J.), the Court issued a narrow reversal of the Federal Circuit's denial of a justiciable controversy, setting aside the intermediate court's controversial standard in *Gen-Probe Inc. v. Vysis, Inc.*, 359 F. 3d 1376 (2004). The Court also disapproved the "evolved form [of *Gen-Probe* of] the 'reasonable apprehension of imminent suit' test [of] *Teva Pharm. USA, Inc. v. Pfizer, Inc.*, 395 F. 3d 1324, 1333 (2005)." (original emphasis by the Court). See *A Narrow Holding on the Scope of the Declaratory Judgment Act* (page 2).

In *dicta*, the Court (1) suggests a far broader application of the declaratory judgment statute for patent challenges than heretofore permitted by the Federal Circuit; see *Broad Dicta on the Application of the Declaratory Judgment Statute* (page 3), and (2) leaves *Lear, Inc. v. Adkins*, 395 U. S. 653, 673 (1969), unscathed, providing guidance to the lower courts for resolving licensee disputes; see *Dicta Continuing the Policies of Lear* (page 4).

Justice Scalia spoke for eight justices; only Justice Thomas issued a dissent.

This analysis benefits from discussions and views of George Best and Stephen B. Maebius of Foley & Lardner LLP as well as Lynn E. Eccleston of McGuire Woods LLP.

A great deal of electronic traffic has entered computers around the world over the past 24 hours that provide often greatly differing interpretations of *MedImmune*, including much nonsense about what the case "holds". But, the *holding* in the *MedImmune* case is quite narrow, dealing with the question of whether there is a justiciable controversy.

There will, of course, be great debates about the *practical* implications that can be drawn from *MedImmune*, and also speculation about what the Federal Circuit will do with its own decisional law in the wake of *MedImmune*.

For a concise *legal* understanding of the issues involved, see Lynn E. Eccleston, "*MedImmune: The Practical Implications*", that particularly focuses upon Orange Book litigation consequences. A summary of the Supreme Court *MedImmune* decision can be found [here](#).

Prof. Harold Wegner, Washington, DC, January 9, 2007