

Joseph M. Bennett-Paris, Ph.D.

Partner

Office: Chicago

Address: 111 East Wacker Suite 2800 / Chicago / Illinois 60601

Email: jbennettparis@taftlaw.com

Telephone: (312) 836-4033

Fax: (678) 550-9853

JOSEPH (Joe) M. BENNETT-PARIS, Ph.D, joined Taft's Pharmaceutical and Life Sciences Litigation practice in 2014 and practices in Atlanta and Chicago. For 15 years, Joe has counseled clients in all areas of patent law, including patent prosecution, non-infringement, patentability, freedom-to-operate, invalidity and licensing. His practice primarily focuses on biotechnology, pharmaceutical, chemistry, and most recently, biosimilars.

Notably, for 10 years, Joe represented Pharmasset, Inc., which was acquired by Gilead Inc. in 2011 for \$11 billion. While representing Pharmasset, Joe directed the prosecution and strategy of the patents covering the recently approved drug SOVALDI® (sofosbuvir), a 2'-methyl nucleoside compound — the first in a new class of nucleotide polymerase inhibitors — that is the first all oral treatment to bring about a near eradication of hepatitis C in patients infected with the virus.

For several years, Joe's practice has focused on the generic drug industry. Prior to entering law, he served on the faculty of the Wake Forest University School of Medicine, and because of this intimate knowledge of academia, he has been able to provide unique contributions to several Hatch-Waxman cases, particularly in finding and working with expert witnesses and inventors.

Following is a list of representative matters:

- *Abbott Laboratories et al. v. Sandoz Inc.*, Case No. 11-424 (GMS). Patent infringement action regarding Sandoz's ANDA to make a generic version of Abbott's ZEMPLAR® (paricalcitol).



Practice Groups:

Intellectual Property,
Pharmaceutical & Life Sciences
Litigation, Intellectual Property
Litigation, Patent Prosecution,
Trademark, Copyright & Trade
Secret, Litigation

Bar/Court Admissions:

Federal
United States Patent and
Trademark Office

State
Georgia

Year First Admitted to Practice Law:

1999

Education:

University of North Carolina
Chapel Hill School of Law (1999),
Loyola University of Chicago
(Ph.D., Pharmacology) (1988),
University of Southern California
(B.S., Biological Sciences) (1983)

Certifications / Registrations:

Registered Patent Attorney, U.S.
Patent and Trademark Office

Professional Affiliations / Recognitions:

Federal Bar Association, Georgia
State Bar Association, Atlanta Bar
Association, Georgia Bio Life
Sciences Partnership

- *Aventis Pharma S.A. and Sanofi-Aventis U.S. LLC v. Apotex Inc. and Apotex Corp.*, Case No. 08-496-GMS (D. Del. 2010). Patent infringement action regarding Apotex's ANDA to make a generic version of Sanofi-Aventis' anticancer product TAXOTERE®, the active ingredient of which is docetaxel. Following a two-week trial, obtained an order for Apotex striking down the patents-in-issue as invalid as obvious and unenforceable due to Sanofi-Aventis' inequitable conduct in procuring the patents. Successfully argued on appeal with the Federal Circuit affirming trial court decision. Of importance is that inequitable conduct defense remains viable in ANDA litigations because of this ruling.
- *Ferring v. Apotex*, Case No. 3:11-cv-0481-RCJ-VPC (D. Nev.). Patent infringement action regarding Apotex's ANDA to make a generic version of LYSTEDA® (tranexamic acid).
- *Allergan v. Apotex*, Case No. 2:12-cv-178 (E.D. TX). Patent infringement action regarding Apotex's ANDA to make a generic version of ACULAR LS® (0.4% ketorolac tromethamine).
- *Wyeth v. Apotex Inc. and Apotex Corp.*, Case No. 08-022308 (S.D. Fla.). Patent infringement action regarding Apotex's ANDA to make a generic version of Wyeth's anti-depressant product EFFEXOR XR® (venlafaxine hydrochloride).
- *Pfizer v. Apotex Inc.*, Case No. 1:12-cv-00809-SLR (D. Dela). Patent infringement action regarding Apotex's ANDA to make a generic version of PRISTIQ® (desvenlafaxine).
- *Shire LLC, et al. v. Sandoz Inc.*, Case No. 11-01110-RBJ-KMT (D. Col.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Shire's ADHD product INTUNIV® (guanfacine hydrochloride).
- *Genentech, et al. v. Sandoz*, Case No. 11-1925-JSW (N.D.Cal.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Roche's VALCYTE® (valganciclovir hydrochloride).
- *Helsinn Healthcare S.A. et al. v. Sandoz Inc. et al.*, Case No. 3:11-03962-MLC (D.N.J.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Helsinn's anti-nausea product ALOXI® (palonosetron hydrochloride injection).

- *Abbott Laboratories et al. v. Sandoz Inc.*, Case No. 10-538-SLR (D.Del.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Abbott's cholesterol product NIASPAN® (niacin).
- *Abbott Laboratories et al. v. Sandoz Inc.*, Case No. 11-424-GMS. Patent infringement action regarding Sandoz's ANDA to make a generic version of Abbott's ZEMPLAR® (paricalcitol).
- *Allergan, Inc. v. Sandoz Inc.*, Case No. 09-097-TJW (ED. Tex). Patent infringement action regarding Sandoz's ANDA to make a generic version of Allergan's glaucoma drops COMBIGAN® (brimonidine tartrate/timolol maleate).
- *Medicis Pharmaceutical Corp. v. Sandoz Inc., et al.*, Case No. 09-033-JJF (D.Del.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Medicis' acne product SOLODYN® (minocycline hydrochloride).
- *Alcon Research, Ltd. et al. v. Sandoz Inc.*, Case No. 09-0103-RLY-JMS (S.D. Ind.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Alcon's eye allergy product PATANOL® (olopatadine hydrochloride).
- *Merck & Co., Inc. v. Sandoz Inc.*, Case No. 09-890-MLC-JJH (D. N.J.). Patent infringement action regarding Sandoz's ANDA to make a generic version of Merck's anti-nausea product EMEND® (aprepitant).

Joe is a frequent lecturer and author on intellectual property-related topics. He recently co-authored a chapter with Richard Ruzich titled "Pre-Clinical R&D" in *ANDA Litigation: Strategies & Tactics for Pharmaceutical Patent Litigators*, 2nd ed. (in press).

Joe's practice also includes copyright matters and entertainment law, particularly with regard to the music and publishing industries. He devotes a significant amount of pro bono work to the arts community through the Georgia Lawyers for the Arts. In addition, he sits on the board of several non-profit organizations, including A5 Volleyball Club, the premier junior club volleyball organization in the Southeast for both girls and boys volleyball.

Joe is a graduate of the University of North Carolina School of Law and a graduate of Loyola University Chicago (Ph.D., Pharmacology) and the University of



Taft Stettinius & Hollister LLP
<http://www.taftlaw.com>

Ann Arbor / Chicago / Cincinnati / Cleveland / Columbus / Dayton / Delaware / Indianapolis / Northern Kentucky / Phoenix

Southern California (B.S., Biological Sciences). While at the University of Southern California, he had the good fortune to study undergraduate chemistry from Arieh Warchel, 2013 Nobel Prize recipient in Chemistry.