



WILLIAM R. BOUDREAUX **SHAREHOLDER**

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EDUCATION

J.D.,
Louisiana State University Paul M. Hebert Law Center, 1991
B.S., Biochemistry
Louisiana State University, 1987

BAR ADMISSIONS

Indiana
Ohio
Michigan
Supreme Court of the United States
U.S. Patent & Trademark Office
U.S. Court of Appeals, Fed. Cir.

Bill Boudreaux is an experienced pharmaceutical patent lawyer, bringing more than 20 years of experience from both in-house and private practice settings. Bill's extensive in-house experience at major pharmaceutical companies gives him a unique perspective, allowing him to provide clients with practical, business-focused advice. He is known for his thoughtful, thorough approach and ability to anticipate client needs.

Bill represents a broad range of biotech and pharma clients ranging from Global Fortune 50 Companies to start-ups. While at Eli Lilly and Pfizer, he was primary patent counsel for several late-stage and post-launch drug products, including four blockbuster drugs. He has extensive experience in global patent portfolio creation and management, pharmaceutical patent life-cycle planning and IP due diligence. Bill's experience also includes freedom-to-operate studies, due diligence reviews, infringement/validity studies, and strategy and support for Hatch-Waxman litigation.

Whether providing advice to in-house counsel or business associates, Bill understands the importance of delivering legal advice in a distilled, business-focused way. In-house counsel appreciate that Bill has stood in their shoes. One lead lawyer at a global pharmaceutical company commented that it is rare to find someone like Bill who understands all aspects of her job—the legal issues, the pressures and relational dynamics.

A recognized leader in the life sciences space, Bill co-chairs Brinks Gilson & Lioné's Patent Prosecution and Biotechnology and Pharmaceutical practice groups and served on the firm's Board of Directors and Executive Committee. He has been named a "Life Science Star" by *Managing Intellectual Property* magazine and a "Leading Intellectual Property Lawyer" by *Leading Lawyers Network*.

EXPERIENCE | OVERVIEW

- Served as primary patent counsel for blockbuster osteoporosis drug from launch of drug to Hatch-Waxman challenge. Managed global portfolio of over 140 patent families supporting this drug. Counseled internal product team regarding patent strategy, prepared for litigation and patent issues regarding product label language. Devised patent reissue strategy on key patents that survived challenge through appeal to the Federal Circuit extending loss of exclusivity by two years.
- Provided IP diligence for mid-size pharmaceutical client's multi-million dollar acquisition of another pharmaceutical company. Included review of several patent portfolios and multi-party license agreements.
- Counseled small pharmaceutical company regarding patent life-cycle management issues resulting in successful licensing of drug and eventual FDA approval. Provided business-focused guidance regarding drug

label language, patent listing in FDA's Orange Book and drafted and filed Hatch-Waxman patent term extension applications.

EXPERIENCE | LEGAL

- **Brinks Gilson & Lione**, Ann Arbor, Michigan
Shareholder, January 2009-Present
Counsel, June 2007-December 2008
- **Pfizer Inc.**, Ann Arbor, Michigan
Senior Corporate Counsel, January 2005-June 2007
- **Eli Lilly and Co.**, Indianapolis, Indiana
Patent Counsel, July 1999-January 2005
Patent Attorney, July 1997-July 1999
- **Hoechst Marion Roussel Inc.**, Cincinnati, Ohio
Senior Patent Attorney, June 1994-July 1997
Patent Attorney, September 1992-July 1997
- **Ethyl Corp.**, Baton Rouge, Louisiana
Patent Engineer, May 1990-September 1992

PRACTICE GROUPS

Post-Grant Patent
Patent Prosecution
Licensing
Litigation
Appellate

AREA OF FOCUS

Biotechnology & Pharmaceutical

FORWARD THINKING

Alerts

- The Federal Circuit Deals Another Setback to Medical Diagnostic Patents, June 15, 2015
- U.S. Supreme Court to Review the Judicial Doctrine of Patent Exhaustion, December 07, 2016
- Janssen Biotech Unable To Rewrite History and Save Remicade Patent, January 25, 2018
- The Carvedilol District Court Case, April 12, 2018

Presentations

- "Patent Prosecution and the Newly Implemented USPTO (AIA) Regulations" Midwest Intellectual Property Symposium, Indianapolis, Indiana, November 15, 2012
- "An Industry Perspective on Implementation of the AIA, New PTO Proceedings, and Their Collective Impact on Life Cycle Management," American Conference Institute's Maximizing Pharmaceutical Patent Life Cycles, New York City, October 10, 2012
- "The post-AIA World: Factoring the Impact of Patent Reform into Biosimilars Prosecution and Litigation Strategies," American Conference Institute's 3rd Advanced Forum on Biosimilars, New York City, May 23, 2012
- "Pharmaceutical Patent Life Cycle Management – a US Perspective," D. Young & Co. Life Sciences Patent Seminar, Copenhagen, Denmark, October 4, 2010

HONORS

- Leading Intellectual Property Lawyer, Leading Lawyers Network, 2014-2016

- "Life Science Star," Intellectual Property Law, *LMG Life Sciences*, 2012-2015

AFFILIATIONS

- Intellectual Property Owners Association
Patent Law (U.S.) Committee, 2010-2012
Pharmaceutical Issues Committee, 2006-2007 and 2013-present
Hatch Waxman Committee, 2006-2007
Patent Office Practice (U.S.) Committee, 2007
- American Intellectual Property Law Association

TECHNICAL BACKGROUND

- Biopharma

REPRESENTATIVE MATTERS

- **Patent Portfolio Creation and Management**
- Strategic counseling, patent portfolio development, and pharmaceutical life-cycle planning. As in-house counsel, supported cross-functional product teams from preclinical phase through post-launch of drug.
- Drafting and prosecuting hundreds of patent families in the pharmaceutical space including small molecule pharmaceuticals, pharmaceutical formulations, therapeutic methods, dosing regimens, second medicinal uses, and the like.
- Conducting pre-litigation reviews of patent portfolios; filing of Hatch-Waxman patent term extension applications; corrective actions such as patent reissue filings.
- **Appeals**
- *Integra Lifesciences I, Ltd. v. Merck KGaA*, 496 F.3d 1334 (Fed. Cir. 2007). Counsel of record for Eli Lilly and Company as amicus curiae.
- *Merck KGaA v. Integra Lifesciences I, Ltd.*, 545 U.S. 193 (2005). Supporting reversal of Federal Circuit's holding that pre-clinical pharmaceutical research and development activity does not fall under the infringement exemption of 35 U.S.C. §271(e)(1). Counsel of record for Eli Lilly and Company as amicus curiae at the petition for certiorari stage.
- **Patent Reviews**
- Due diligence reviews prior to entering licensing, joint venture or financing agreements
- Freedom to operate opinions and pre-marketing patent audits
- Patent infringement and validity studies
- **Intellectual Property Agreements**
- Negotiating and drafting new agreements related to joint research and licensing
- Interpretation and counseling regarding existing agreements