

Stephen B. Maebius



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Stephen (Steve) B. Maebius is a partner and intellectual property lawyer with Foley & Lardner LLP. He has led teams within Foley handling a variety of different kinds of IP work, including IP due diligence reviews, infringement and validity opinions, international portfolio management, licensing, litigation with parallel inter partes reviews, reexaminations and interferences, and pharmaceutical patent term extensions. Two IP transactions in which Mr. Maebius has participated were awarded "Deal of Distinction" status by the Licensing Executives Society. He is a former member of the firm's Management Committee and former chair of the Intellectual Property Department. Prior to becoming a lawyer, he was a patent examiner in the Biotechnology Group of the U.S. Patent & Trademark Office.

Representative Matters

- Lead counsel in successful defense of 6 Inter Partes Reviews filed by generic petitioners against a family of Orange Book-listed pharmaceutical patents covering a \$1B controlled release product with parallel Hatch-Waxman litigation (IPR2013-00368, IPR2013-00371, and IPR2013-00372 - instituted but all claims found patentable in final written decision; IPR2015-01777, IPR2015-01778, and IPR2015-01782 - not instituted)
- Prosecuted product-by-process patent listed in Orange Book that was upheld as valid and infringed in *United Therapeutics v. Sandoz*, 2014 U.S. Dist. LEXIS 121573 (D.N.J. Aug. 29, 2014)
- Co-counsel for successful petitioner in Inter Partes Review filed against patent asserted in litigation against LED client (IPR2012-00005; decision affirmed on appeal)
- *Takeda Pharmaceutical Co. Ltd. v. John Doll* (Fed. Cir. 2009) – co-counsel in precedential 2-1 decision remanding a double patenting rejection arising from patent reexamination (all claims confirmed to be patentable upon remand to the Patent Office)
- *Goldenberg & Immunomedics v. Cytogen & C.R. Bard* (Fed. Cir. 2004) – co-counsel on appeal in reversal of summary judgment in client's favor in precedential 2-1 decision on

- doctrines of equivalents issue
- Reexamination of 2 patents in parallel litigation covering pharmaceutical product with \$1.5B in sales per year - obtained decision confirming patentability of all claims in under a year
- Licensing of biotechnology drug with up-front payment of \$100M - represented acquiring company in IP diligence and drafting transaction agreements

Thought Leadership

Mr. Maebius is the principal author of the book "Due Diligence for Intellectual Property: Valuing Assets in a Transaction," published by Law Journal Press. He has been active as both a teacher and author in the intellectual property field, including serving as a visiting associate professor of intellectual property law at Tokyo University's Research Center for Advanced Science and Technology and serving as a faculty adjunct professor at George Washington University Law School, where he taught comparative and international patent law. In addition, he testified about post-grant patent proceedings during the FTC/DOJ hearings on the "Implications of Competition and Patent Law and Policy," which preceded the landmark patent legislation known as the America Invents Act.

In the area of nanotechnology, Mr. Maebius helped start the NanoBusiness Commercialization Association and the *Nanotechnology Law & Business* journal and he continues to serve as an associate editor of the *Nanotechnology Law & Business* journal.

Recognition

- *IAM Patent 1000 – The World's Leading Patent Practitioners*, recognized for post-grant patent procedures (2012-2013) and prosecution and transactions (2014-2016)
- *Chambers Global Intellectual Property – USA and Japan* (2012 - 2015)
- *Chambers USA* for the District of Columbia in intellectual property and patent prosecution (2012 - 2014)
- *Washington, D.C. Super Lawyers®* for intellectual property (2014 - 2016)
- *The Legal 500* for patent licensing and patent prosecution (2010 - 2013), for patent licensing and transactional (2014 and 2015), for intellectual property – patent prosecution – utility and design patents (2015 and 2016), and for healthcare – life sciences (2015 and 2016)
- *The Best Lawyers in America®* in the areas of biotechnology law, patent litigation, and patent law (since 2007) and intellectual property (since 2009)
- *Washingtonian's Best Lawyers in Washington for Intellectual Property* (2013 - 2014)
- Peer Review Rated as AV® Preeminent™, the highest performance rating in Martindale-Hubbell's peer review rating system
- *Managing Intellectual Property - IP Star* (2015)

Education

Mr. Maebius graduated from Cornell University (B.S. biology, 1989) and the George Washington University Law School (J.D., 1994).

Admissions

Mr. Maebius is admitted to practice in the District of Columbia, the state of Virginia, before the Court of Appeals for the Federal Circuit, the U.S. Supreme Court and before the U.S. Patent and Trademark Office.

Publications

- "CAFC Partially Relaxes Idle Free Requirements for Amendments During IPR", *PTAB Trial Insights Blog* (<https://www.ptabtrialinsights.com/2016/02/cafc-partially-relaxes-idlefree-requirements-for-amendments-during-ipr/>), 2016
- "Lessons Learned From the 1st Successful Pharmaceutical IPR Defense of Orange Book Listed Patents", *PTAB Trial Insights Blog* (<https://www.ptabtrialinsights.com/2015/08/lessons-learned-from-the-1st-successful-pharmaceutical-ipr-defense-of-orange-book-listed-patents/>), 2015
- "Does Spike in IPR Settlements Signify Petitioner Success?" *PTAB Trial Insights Blog* (<http://www.ptabtrialinsights.com/2015/08/does-spike-in-ipr-settlements-signify-petitioner-success/>), 2015
- "Patenting Risk Evaluation & Mitigation Strategies for Pharmaceuticals: A New Life Cycle Management Target for Patents?" *Pharmaceutical Law & Industry*, 7(1): 1-3, 2009 (co-author)
- "Bayer Highlights Debate on Research Method Use (Patent Won't Cover Fruit of Offshore Research Not Made with the Method)," *National Law Journal*, 2001 (co-author)
- "Extending Process Claims From Intermediate to Final Product: Avoiding the Trap of *Eli Lilly v. American Cyanamid*," *Journal of the Patent & Trademark Office Society*, 1998