

KEVIN NOONAN

Defending Biotech Companies Is In His Genes

by Melissa Birks

Why must biotech companies patent human genes, iconic *60 Minutes* reporter Morley Safer wondered on air. The camera cut to Chicago patent lawyer Kevin Noonan for an answer, and Noonan had one.

Noonan, bespectacled, with silver hair and goatee, was the only voice for biotech companies in that April 4 episode. Pegged off a recent federal lawsuit against the manufacturer of tests for breast and ovarian cancers, the episode questioned the legality, cost, and, indeed, the morality of companies “owning” human genes. When a company patents genes, Safer told the audience, no one else “can look at them, or test for them, or develop therapies based on them, without their consent.”

A partner at **McDonnell Boehnen Hulbert & Berghoff LLP**, Noonan does not represent the defendants named in the suit. Still, he explained to Safer that patents reward companies for the steep financial risks they take inventing tests like those at the heart of that case.

“But they’re not selling cars. They’re selling health,” Safer complained.

“Whether it’s cars or health,” Noonan responded, “there has to be a profit for investors to invest. If you want to eliminate profit, I think we’re talking about a different economic system.” Left out of the piece was Noonan’s explanation that no one “owns” genes, and that Safer had wildly overstated the rights conferred by patents on genes.

Dr. Noonan’s practice serves pharmaceutical companies, biotechnology firms, and universities. Safer introduced him on *60 Minutes* as a lawyer who often defends biotech companies and argues that, without patents, “you don’t have the things that give you better health in the first place.”

Unlike scientific research, which involves at least as many negative results as positive ones, Dr. Noonan enjoys patent law because he gets to review the positive data and see the experiments that worked. His role involves a unique blend of legal skill and using a lawyer’s vocabulary to explain complex scientific processes. In his view, patent law is great for those who have a “geek” persuasion because of the emphasis on technology, but he warns, there are many “traps for the unwary.” Unlike other areas of law where people can get away with being creative with the facts, science and experimental results are more concrete (although the trick can be in their interpretation).

While his background in molecular biology is invaluable to understanding the nature of the patents and clients he serves, ultimately, his position is that patent law is “a job for lawyers; knowing the science is like being in France—it helps if you know French.”



Mice in NJ, Law in Chicago

And it helps, in a practice focusing on biotechnology and chemical arts, that Dr. Noonan knows his molecular biology. As an undergraduate, he attended Stony Brook University in New York, then worked for three years thereafter as a technician in a biology lab at Yale before heading to Princeton for graduate studies.

His Ph.D. research focused on cancer genes in mice and, through a set of fortuitous circumstances, led to his arrival in Chicago. His advisor at Princeton University left Princeton to work here in Chicago; Dr. Noonan followed him, concluding his Ph.D. studies here.

However, upon completing his Ph.D. and an NIH-funded post-doc studying multi-drug resistance in cancer, Dr. Noonan found that the academic job market offered no positions that suited him. A colleague suggested that he investigate patent law, where he could continue to use the knowledge and experience obtained in his Ph.D. studies. Dr. Noonan joined a firm as a law clerk and enrolled in John Marshall Law School, where he earned his J.D. in 1993.

While at John Marshall Law School, Dr. Noonan worked as a patent agent during the day and studied law at night. While studying the required course offerings in other areas of law, his experience in patent law led him to take LL.M. courses in that subject. He found the LL.M. classes especially interesting because many of his colleagues were established lawyers, and the focused discussion of patent law cases complemented his work at his firm during the day (and helped him represent clients).

‘Competitiveness in All of Us’

McDonnell Boehnen Hulbert & Berghoff

LLP was founded in 1996 by a group of partners and associates who departed a local patent firm. Dr. Noonan was part of the original founding group and has remained with the firm since its inception; he recalls he was employee number 13. He remembers when the firm first opened its doors and many of the day-to-day necessities were bought on partners’ personal credit cards. Those early days were difficult but rewarding, he says, and the practice grew rapidly in the ensuing years. But those early, start-up years had an effect: like many of the firm’s clients, “we try to be entrepreneurial in everything we do,” Noonan says.

The firm’s practice has an important component: an active tech advisor and patent agent program in which new professionals learn under the tutelage of experienced patent professionals. This approach has allowed MBHB to build a savvy practice as a smaller, growing firm and cultivate quality professionals.

What is immediately clear from meeting Dr. Noonan is that he truly enjoys his practice and regularly finds new challenges and victories. Asked about one of his favorite moments in practice, he thought of one readily. One of his clients was attempting to gain approval for a patent for a groundbreaking invention. But the United States Patent and Trademark Office had assigned a particularly recalcitrant examiner to the case. The client’s application lingered interminably, and it seemed that no movement was possible. Eventually, Dr. Noonan and his team were able to shepherd the case through and obtain a patent. Simply put, he says, “Clients tend to be happy and grateful. You enjoy that.”

What makes the difference for him in a victory like that case is that “there is

competitiveness in all of us. Being able to explain things in a way that prevails is great.”

Of Blogs, Twitters, Snippets, and Cats

Dr. Noonan took an innovative step with the 2006 launch of the weblog, *Patent Docs*, which he co-authors with another MBHB partner. *Patent Docs* features coverage on intellectual property law issues, reviews of new and pending cases relevant to the pharmaceutical and biotechnology industries, and contains commentary on and review of various intellectual property topics. His articles are generally quite lengthy and are tightly written.

Patent Docs quickly entered into the debate about genes and patents that have received major national, and international, attention. Dr. Noonan’s blog has helped to make him a nationally-recognized expert on genes and other issues. In trying to keep it modern, Dr. Noonan’s blog has a Twitter feed, but he also hands out old-fashioned buttons to help spread the word.

Dr. Noonan is also an adjunct professor at John Marshall Law School and at DePaul University’s law school, teaching biotechnology patent law. He publishes regularly in his firm’s journal, *snippets*, and contributes articles on patent law to various legal publications.

Outside of work, Dr. Noonan and his wife of twenty years, Cheryl enjoy the company of their two cats, Foucault and Lillie. He admits that he didn’t have a cat until he was 40 years old, but Foucault’s addition to the family and Lillie’s subsequent arrival were wonderful. He is an avid reader as well and has a densely-populated bookshelf in his office that runs the gamut from literature to history, and includes, of course, texts on patents. ■