Orange Book Listable?

When submitting a new drug application ("NDA") with the FDA, an applicant (or branded company) is required to file a list of patents that cover the drug product. These patents will be listed in the FDA's Orange Book upon approval of the drug for commercial sale. Patents that are eligible to be listed in the Orange Book are patents that have claims that cover the drug substance (active ingredient), the drug product (formulation and composition), or the approved method of use.

What patents can't be listed in the Orange Book?

Patents that have claims directed to the process or manufacture of the drug substance, to the packaging of the drug product, or to metabolites or intermediates of the drug substance are not eligible to be listed in the Orange Book.

Why pursue patents that are Orange Book listable?

Competitors seeking to market a generic version of the drug must certify for each patent claiming the drug or the approved use of the drug that (i) such patent information has not been filed; (ii) the patent has expired; (iii) the date the patent will expire; or *(iv) the patent is invalid or will not be infringed by the manufacture, use, or sale of the new drug for which the application is submitted.* Filing a paragraph IV certification can constitute an act of patent infringement and the generic company can be sued before even selling the generic version of the drug. If the branded company files the suit within 45 days of the notice of filing the certification, the FDA will postpone the generic drug approval for 30 months. During this 30 month period, the branded company and the generic competitor can litigate the patent dispute while the generic drug is barred from entering the market. If all patents are held invalid or not infringed, the FDA can proceed to approve the generic drug even if the 30 month period has not yet concluded.