

Emer Simic

Partner | Intellectual Property

OVERVIEW

Emer Simic is a partner in the Intellectual Property Practice Group and focuses her practice on patent litigation and counseling in the pharmaceutical and biotech space. Emer has substantial experience successfully representing pharmaceutical and biotech companies in Hatch-Waxman and patent infringement disputes before the U.S. District Court and before the Patent Trial and Appeal Board (PTAB). A strategic advisor and compelling advocate, Emer partners with her clients to achieve their goals at all phases of litigation, from pre-litigation counseling and opinions through FDA filings, discovery, trial and appeal.

Emer's ability to harmonize scientific knowledge with her legal acumen outside the courtroom enables her to effectively counsel her clients on complex IP matters throughout the product lifecycle, from advising on patent prosecution strategy and portfolio management to providing opinions on validity and FTO. Emer also assists with due diligence investigations for pharmaceutical mergers and acquisitions. Building and maintaining robust client relationships is a cornerstone of her practice, aiding businesses through informed decision-making that aligns with her client's strategic objectives.

Originally from Ireland, Emer also holds the distinction of being a qualified barrister. Within the legal community, she is highly lauded for her accomplishments: listed in *Intellectual Asset Management's (IAM) Patent 1000* for Litigation, named among the top "40 Under 40 Illinois Attorneys to Watch" by the *Chicago Daily Law Bulletin*, honored as one of "Chicago's Notable Women Lawyers" by *Crain's Custom Media*, and designated an "IP Star" by *Managing IP*.



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EDUCATION

Chicago-Kent College of Law (J.D., 2008)

Honorable Society of King's Inns
(Barrister-At-Law, 2006)

University of Cambridge (M.Phil., 2002)

University of Cambridge (B.A.,
Natural Sciences, 2001)

ADMISSIONS

Illinois

EXPERIENCE

Representative Matters

- *Pfizer Inc. et al. v. Zenara Pharma Private Limited* – counsel for Defendant, Zenara Pharma Private Limited in Hatch-Waxman litigation involving Zenara’s Abbreviated New Drug Application for tafamadis (61 mg) capsules.
- *Actelion Pharmaceuticals Ltd. v. Gland Pharma Limited* – counsel for Defendant, Gland Pharma Limited in Hatch-Waxman litigation involving Gland’s Abbreviated New Drug Application for epoprostenol sodium for injection (1.5 mg/vial and 0.5 mg/vial)
- *InfoRLife SA and WG Critical Care, LLC v. Hikma Pharmaceuticals USA, Inc.* – counsel for Hikma in Hatch-Waxman litigation concerning Hikma’s Abbreviated New Drug Application for midazolam 0.9% sodium chloride (50 mg/50 ml and 100mg/100 ml) solution, for intravenous use. InforRLife’s case was dismissed with prejudice, and Hikma launched its product.
- Represented NDA holder and patent owner in Hatch-Waxman litigation concerning Cambia® (diclofenac potassium powder for oral solution). Obtained favorable settlement.
- Represented 503B outsourced compounding manufacturer in a trade secret action brought in federal district court regarding vasopressin for injection. That litigation was successfully settled.
- Successfully defended private pharmaceutical company at trial against alleged infringement of Orange Book-listed patents for lansoprazole delayed-released orally disintegrating tablets (ODT). As a result of this ruling, the first lansoprazole ODT product was sold Over-The-Counter (“OTC”) in the U.S. market.
- Counsel for innovator company in multiple Hatch-Waxman litigations filed against generic drug companies concerning RAVICTI® for the treatment of UCD in patients two months of age and older. Those litigations were successfully settled.
- Counsel for innovator company in Hatch-Waxman litigation filed against generic drug companies concerning Rayos®. That litigation was successfully settled.
- Represented multinational pharmaceutical company in litigation arising from its Abbreviated New Drug Application seeking approval to market a generic desvenlafaxine product. That litigation was successfully settled.
- Represented multinational pharmaceutical company in litigation related to its generic quinapril product. That litigation was successfully settled.

- Represented pharmaceutical company in litigation arising from its Abbreviated New Drug Application seeking approval to market generic oxycodone extended release products.
- Represented pharmaceutical company in litigation arising from its Abbreviated New Drug Application seeking approval to market a generic posaconazole product.
- Represented multinational pharmaceutical company in litigation arising from its Abbreviated New Drug Application seeking approval to market a generic choline fenofibrate product. That litigation was successfully settled.
- Represented pharmaceutical company at trial in litigation arising from its Abbreviated New Drug Application seeking approval to market a generic pemetrexed product.

PTAB

- Lead counsel for Fonterra Cooperative Group Limited and Fonterra (USA) Inc. in IPRs challenging U.S. Patent Nos. 10,709,146 and 10,729,150 assigned to Arla Foods AMBA concerning whey protein products.
- Successfully defended a pharmaceutical company's Orange Book-listed patent for its RAVICTI® product in an IPR proceeding against competitor. Competitor appealed PTAB's decision to the Federal Circuit. The Federal Circuit affirmed per curiam PTAB's decision upholding the patentability of client's '012 patent.
- Successfully defended a pharmaceutical company in multiple IPR proceedings filed by competitor against client's patents relating to its RAVICTI®. Pursuant to a settlement agreement reached between the parties, the IPRs were terminated.
- Represented pharmaceutical company in defending IPR proceedings filed by multinational pharmaceutical competitor against client's patents relating to its RAVICTI® product. Pursuant to a settlement agreement reached between the parties, the IPRs were terminated.
- Represented pharmaceutical company in defending IPR proceedings filed by competitor against client's patents relating to its RAVICTI® product. Client appealed PTAB's final written decision to the Federal Circuit. Pursuant to a settlement agreement reached between the parties, competitor withdrew as Appellees from the Federal Circuit Appeal.

RECOGNITIONS

- Selected as one of the top "40 Under 40 Illinois Attorneys to Watch" by the *Chicago Daily Law Bulletin* in 2020
- Honored in "Chicago's Notable Women Lawyers" by *Crain's Custom Media*, 2020
- Listed in *Intellectual Asset Management's (IAM) Patent 1000* in Litigation, 2020-2024: Silver – Illinois.



- Named an “IP Star – Patent,” *Managing Intellectual Property*, 2020, 2022-2023
- Named in the *Illinois Rising Stars* list, as published in *Illinois Super Lawyers*, 2012-2021
- Named in the *Illinois Rising Stars* list, recommended in “Intellectual Property” since 2023
- Selected by peers as a Leading Lawyer in Intellectual Property Law and Patent Law—*Leading Lawyers Network*, 2016–2022
- *The Best Lawyers in America*, recommended in “Litigation – Patent” since 2023

NEWS & INSIGHTS

January 24, 2025 Firm News

Twenty-Two Neal Gerber Eisenberg Attorneys Recognized on 2025 Illinois Super Lawyers List

January 2, 2025 In The Media

Emer Simic Quoted in *Law360* Article “Patent Litigation Trends To Watch In 2025”

October 16, 2024 Event

NGE Attends American Conference Institute’s 10th Annual Paragraph IV Disputes Conference

October 10, 2024 Event

Emer Simic and Jeff Ward Attend the ACI’s 10th Annual Paragraph IV Disputes Conference

September 23, 2024 Event

NGE Participates in WIPL’s 2024 Annual Conference

September 13, 2024 Publication

Federal Circuit Weighs in Again on Obviousness-Type Double Patenting to Limit *In re Collect* and Preserve PTA for First-Filed, First-Issued Patents

August 15, 2024 Firm News

60 Neal Gerber Eisenberg Attorneys Included in 2025 *Best Lawyers In America*

June 7, 2024 Firm News

Four Intellectual Property Attorneys Recognized in *IAM Patent 1000*

April 17, 2024 Event

Emer Simic and Jeff Ward Attend the Paragraph IV Disputes Conference

January 29, 2024 Firm News

Thirty-One Neal Gerber Eisenberg Attorneys Recognized on 2024 Illinois Super Lawyers List

December 19, 2023 In The Media

Emer Simic Quoted in *Law360* Article “The Biggest PTAB Developments In 2023”

December 8, 2023 Firm News

Emer Simic Elected President of the Coalition of Women’s Initiatives in Law—Chicago Chapter for 2024



September 14, 2023 Publication

Emer Simic Authors "What Vidal's *Sua Sponte* Director Review of Unprecedented PTAB Sanctions Order Could Mean for PTAB Practice"

August 30, 2023 Firm News

Three Neal Gerber Eisenberg Attorneys and the Trademark Practice Listed in the 2023 Edition of *Managing IP*

August 17, 2023 Firm News

55 Neal Gerber Eisenberg Attorneys Included in 2024 *Best Lawyers In America*

June 29, 2023 Firm News

Neal Gerber Eisenberg Intellectual Property Practice Places Four Attorneys in *IAM Patent 1000*

June 9, 2023 Event

Firm Hosts Intellectual Property 102 Webinar Series

December 16, 2022 In The Media

Emer Simic's Article "USPTO Guidance Reduces PTAB Discretionary Denials, Signaling Potential Uptick of IPRs in 2023" Published in IP Watchdog

December 15, 2022 Firm News

Emer Simic Named Vice President of the Coalition of Women's Initiatives in Law—Chicago Chapter

November 29, 2022 Publication

The Future of Biotech: Diving Into the Latest Trends in Life Sciences Patent Litigation

August 18, 2022 Firm News

60 Neal Gerber Eisenberg Attorneys Included in 2023 *Best Lawyers*

July 27, 2022 Event

Lifting as you Climb: Empowering for Success

July 7, 2022 In The Media

Emer Simic Quoted in *Bloomberg Law* Article on Pharma Patents

May 20, 2022 In The Media

Emer Simic Quoted in Law360 on Pandemic Patent Filings

March 22, 2022 In The Media

Emer Simic Quoted in Bloomberg Law on New Hurdles for Pharma Patents

February 8, 2022 In The Media

Emer Simic Quoted in Bloomberg Law on Promoting Diversity Among Inventors

January 24, 2022 In The Media

Emer Simic Discusses Her Career and the IP Legal Field on Above the Law's The Jabot Podcast

January 6, 2022 Firm News

Emer Simic Elected as Secretary for the Coalition of Women's Initiatives in Law—Chicago Chapter

December 27, 2021 Publication

Method-of-Treatment Patents: Increasing Value & Risk

November 15, 2021 In The Media

Emer Simic Quoted in Bloomberg Law on Increasing Opportunities for Underrepresented Lawyers at the PTAB

November 3, 2021 Event

Emer Simic Joins Panel Discussion at UIC's 65th Annual Intellectual Property Law Conference

October 27, 2021 In The Media

Emer Simic Quoted in Law360 on Kathi Vidal's Nomination to Lead the USPTO

October 15, 2021 In The Media

Emer Simic Quoted in Law360 on Challenges to PTAB Constitutionality

July 20, 2021 In The Media

Emer Simic Quoted in Law360 on Tiffany Cunningham's Appointment to the Federal Circuit

July 13, 2021 Publication

Emer Simic's Article "On Tiffany Cunningham's Appointment to the CAFC" Published in IP Watchdog

July 12, 2021 Publication

PTAB Developments During the Pandemic

July 8, 2021 In The Media

Emer Simic Quoted in Law360 on Patent Cases to Watch

April 30, 2021 Firm News

Neal Gerber Eisenberg Adds Intellectual Property Partner Emer Simic

April 30, 2021 Publication

Artificial Intelligence in the Life Sciences Industry: Strategies for IP Protection

April 30, 2021 Event

Emer Simic Participates in Patent Law Virtual Panel

April 30, 2021 Publication

Equity Matters: How My Firm Defies the Statistics on Women in Legal Leadership—and How Yours Can Too

April 30, 2021 Event

Emer Simic Moderates Patent Litigation Panel

PROFESSIONAL AFFILIATIONS

- American Bar Association
- The Coalition of Women's Initiatives in Law: President (2024), Vice President (2023), Secretary (2021-2022); Chicago Chapter Board Member (2020 – Present), National Board Member (2023 – Present)
- Chicago Women in IP