



PRACTICE FOCUS

In his 30-year career as a patent litigator, Tony Pezzano has successfully tried cases involving technology innovation across a diverse range of industries – particularly consumer, recreational and pharmaceutical products; chemical and petroleum products and processes; wireless telecommunication devices and equipment; computer software, hardware, and systems; and printing engines and systems. He has appeared in numerous trials in the federal district courts, including both bench and jury trials, and International Trade Commission (ITC) Section 337 Hearings. One of Mr. Pezzano’s major areas of focus has been his representation of brand pharmaceutical companies in suits against generic drug companies under the Hatch-Waxman Act. He has served as lead counsel for brand pharmaceutical companies in over two dozen filed Hatch-Waxman cases during the past ten years involving antibiotic, antiviral, antifungal, anticoagulant, and anti-organ transplant rejection drug products.

Another major focus has been Mr. Pezzano’s practice in ITC Section 337 investigations. He has successfully represented both Complainants and Respondents in ITC Section 337 investigations involving biologics, SeaDoos/Wave Runners, wireless communication devices, including mobile phones and tablets, computer routers, and Segways/hoverboards. Mr. Pezzano is Past President (2009) of the ITC Trial Lawyers Association. Many significant companies around the world have called on Mr. Pezzano for representation in large-scale patent litigations in the federal district courts and ITC. Mr. Pezzano has obtained both injunctions in federal district court cases as well as exclusion and cease and desist orders in ITC Section 337 investigations.

Mr. Pezzano has also prosecuted patent and trademark applications and rendered opinions and counseling for U.S. and foreign corporate clients involving intellectual property matters. He has had particular success in counseling pro bono small businesses through such programs as Start Small Think Big in obtaining patent and trademark protection for their products.

REPRESENTATIVE EXPERIENCE

- Unicorn Global, Inc., Hangzhou Chic Intelligent Technology Co. Ltd., And Shenzhen Uni-Sun Electronic Co., Ltd. v. Golabs, Inc., d/b/a Gotrax, Walmart, Inc., Wal-Mart Stores Texas, LLC, And Com USA LLC, Civil Action No. 3:19-CV-00754-N (N.D. Tex. 2019 - present) and Civil Action No. 3:20-CV-02023 (N.D. Tex. 2020 – present): Representing Defendants and Counterclaimants Golabs and the Walmart entities in pending actions involving claims of patent infringement with respect to accused hoverboard products and counterclaims of tortious interference with prospective contractual relations, unfair competition, Lanham Act violations and Sherman Act violations.
- Personal Transporters and Components Thereof, Inv. No. 337-TA-1007/1021 (hearing before ALJ Shaw ITC 2016-2018): Represented complainants Segway, DEKA and Ninebot; obtained default judgments against seven respondents, termination for cause against one respondent, consent orders against two respondents, favorable settlement with one respondent, and limited exclusion orders and cease-and-desist orders against two respondents after hearing in first consolidated ITC investigation ordered by Commission in a multi-patent and trademark infringement investigation brought against numerous manufacturers of accused imported hoverboards.
- Merck v. Hospira (tried before J. Andrews D.Del. 2014-2017): Represented Merck; won at bench trial and obtained injunction; Orange Book patent and method of manufacturing patent relating to antibiotic drug Invanz®; affirmed on appeal by Federal Circuit.
- Merck v. Sandoz (D.Del. 2014-2015) (antibiotic drug Invanz®): Represented Merck; withdrawal of all patent defenses and settlement on highly favorable terms.
- Schering v. Sandoz (D.N.J. 2011-2012) (antifungal drug Noxafil®): Represented Schering; withdrawal of all patent defenses and settlement on highly favorable terms.
- Products and Pharmaceutical Compositions Containing Recombinant Human Erythropoietin, Inv. No. 337-TA-568 (ITC 2006-2011): Represented respondents Hoffmann-La Roche family of companies; first 100-day ID procedure initially dismissing patent infringement investigation on summary determination of noninfringement; remanded after rehearing en banc before Federal Circuit; terminated investigation based on global settlement including parallel district court action; no hearing was ever held in ITC; no exclusion order or consent order was ever issued; and settlement allowed respondents to begin selling their accused product, MirCera®, under license.
- Hoffmann-La Roche v. Apotex (D.N.J. 2009) (anti-organ rejection drug Cellcept®): Represented Hoffmann-La Roche; following motion for preliminary injunction, Apotex agreed to not commercially launch its accused product prior to expiration of Hoffmann-La Roche's Orange Book patent.
- Roche Palo Alto v. Ranbaxy (tried before J. Wolfson D.N.J. 2008-2009) (antiviral drug Valcyte®):

TONY PEZZANO

Principal, New York



PRACTICE AREAS

- Intellectual Property

ACTIVITIES

- ITC Trial Lawyers Association – Former President, Current Member
- New York Intellectual Property Law Association, Member

- Represented Roche Palo Alto; stipulated judgment that Orange Book patent valid and infringed.
- Computer Products, Computer Components and Products Containing Same, Inv. No. 337-TA-599 (hearing before J. Essex ITC 2008-2009): Represented IBM; patent infringement investigation involving accused computer routers settled together with parallel district court action to the satisfaction of all parties.
- Man Roland v. Goss and Heidelberger (D.N.H. 2006-2007): Represented Heidelberger successfully dismissed eleven counterclaims for alleged antitrust and unfair competition in case involving printing engines and systems.
- Hakim v. Canon Avent (W.D. La. 2005): Represented Canon Avent; won on summary judgment that Canon Avent's accused non-spill sippy cup products do not infringe one of the asserted patents and that the second patent is invalid over the prior art.
- Personal Watercraft and Components Thereof, Inv. No. 337-TA-452 (Hearing before ALJ Terrill ITC 2001-2002): Represented respondent Bombardier; dismissed on summary determination six of eleven asserted patents.

SPEAKING ENGAGEMENTS

- "Analyzing Trends in Filings and Dispositions of 337 Proceedings," *ACI Litigation and Enforcement Conference*, August 24, 2020 (Speaker)
- "The Hatch-Waxman and IPR Strategy in Light of Recent Case Decisions," *Knowledge Group Webcast*, August 5, 2020 (Speaker)
- "The ITC Section 337 Investigations: Trends, Development, and Issues," *Knowledge Group Webcast*, June 4, 2020 (Speaker)
- "The ITC As A Viable Alternative for Biopharma," *An Overview of Section 337 Investigations Before the U.S. International Trade Commission at Kline Institute of Trial Advocacy, Drexel University Thomas R. Kline School of Law sponsored by ITC Trial Lawyers Association, Philadelphia Intellectual Property Law Association and New Jersey Intellectual Property Law Association*, September 17, 2019 (Speaker)
- "Section 337 Exclusion Orders for New Technology (Mock Hearing on Public Interest for Infringing Biologic Product)," *American Conference Institute (ACI) Practitioner's Think-Tank on ITC Litigation & Enforcement in Washington, DC*, June 26-27, 2019 (Speaker)
- "Update on Biopharma Patent Disputes in ITC Section 337 Investigations," *The Knowledge Group's Litigation and Enforcement Updates at the ITC: 2019 Landscape Webcast*, April 29, 2019 (Speaker)
- "Obviousness Update for PIV Litigation: Matters of Inherency, Anticipation and Secondary Considerations," *ACI 12th Annual Paragraph IV Disputes in New York*, April 23-25, 2018 (Speaker)
- "In-House Counsel Decision-Making in Practice: The Latest Approaches to Budgeting, Selecting Outside Counsel and Managing ITC Litigation" *ACI 10th Annual Expert Forum on ITC Litigation & Enforcement in Washington, DC*, March 5-6, 2018 (Moderator)
- "Biosimilar Patent Litigation in The United States and Europe," *IAM 2nd Annual Pharma and Biotech IP Summit* in London, February 8, 2018 (Speaker)

PUBLICATIONS

- "Preparing for Competitive Challenges to Biologics With Expiring Exclusivity," *Pharmaceutical Executive*, January 2020 (Author)
- "The ITC as a Forum for Biologic and Biosimilar Patent Disputes," *IAM-Media*, May/June 2019 (Author)
- "Federal Circuit Judges Disagree on Proper Standard for Evaluating Patent Validity Under 35 U.S.C. §103," *Law360*, November 2018 (Author)

POINTS OF DISTINCTION

- Legal 500 US (2017-2019)
- IAM Patent 1000 (2016-2019): "top-notch and untiring litigator... the first in the door and the last out."

EDUCATION

- Hofstra University, J.D.
- Columbia University, B.S., Dean's List

ADMISSIONS

- Federal District Court
- New York
- U.S. District Court, Southern District of New York
- U.S. District Court, Eastern District of New York
- U.S. District Court of Colorado
- U.S. Patent & Trademark Office
- U.S. Court of Appeals for the Federal Circuit