



## PRACTICE FOCUS

In his over 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; video and audio broadcast equipment, systems and networks; 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 Tony'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 involving antibiotic, antifungal, treatment of asthma, treatment of male pattern baldness, anti-organ transplant rejection, antiviral and anti-coagulant drug products.

Another major focus has been Tony's practice in ITC Section 337 investigations. He has successfully represented both Complainants and Respondents in ITC Section 337 investigations involving biologics, SeaDoos/WaveRunners, wireless communication devices, including mobile phones and tablets, computer routers and Segway/hoverboards. Tony is Past President (2009) of the ITC Trial Lawyers Association.

Many significant companies around the world have called on Tony for representation in large-scale patent litigations in the federal district courts and ITC. Few attorneys, if any, can match Tony's record of obtaining injunctions in federal district court cases as well as exclusion and cease and desist orders in ITC Section 337 investigations.

Tony has also prosecuted patent and trademark applications and rendered opinions and counseling for US and foreign corporate clients involving intellectual property matters.

## REPRESENTATIVE EXPERIENCE

- *Advanced Transactions, LLC v. Regis Corporation, Supercuts, Inc., and Supercuts Corporate Shops, Inc. dba, Supercuts, Cost Cutters, Roosters, and Smartstyle* (W.D. Tex. 2022): Represented Defendants Regis Corporation et al. in dismissing patent infringement action brought by Plaintiff Advanced Transactions, LLC asserting eight patents directed to methods and systems using a computer to perform electronic marketing. All claims have been dismissed with prejudice based on a covenant not to sue with no acknowledgement of wrongdoing by either side.
- *Evertz Microsystems Ltd. v. Lawo Inc., Lawo Corp., and Lawo AG* (D.Del. 2019 – 2022): Represented Defendants Lawo; Parties limited to the following public statement: "After several years of litigation, the parties have mutually agreed to settle the litigation pending between them in the United States Court for the District of Delaware. All claims have been dismissed with prejudice with no acknowledgement of wrongdoing by either side."
- *iFixit Corporation v. Locket IP LLC* (C.D. Cal. 2022): Represented Plaintiff iFixit Corporation in dismissing declaratory judgment action for noninfringement and invalidity of asserted patent directed to a method using a computer for locating regions of interest in a user interface based on settlement.
- *Hawaii Life Real Estate Services, LLC v. Locket IP LLC* (D. Hawaii 2022) Represented Plaintiff Hawaii Life Real Estate Services in dismissing declaratory judgment action for noninfringement and invalidity of asserted patent directed to a method using a computer for locating regions of interest in a user interface; received favorable press in IPWatchdog® (March 9, 2022).
- *Shuangma Plastic Co., Ltd. v. Chef'n Corp., Tupperware Brands Corp. and Tupperware U.S. Inc.* (W.D. Wash. 2021): Represented Plaintiff Shuangma Plastic Co. in dismissing with prejudice declaratory judgment action for noninfringement and invalidity of asserted patent, directed to hand-held food processor, and all counterclaims asserted by Defendants based on favorable settlement and reinstatement of accused products for sale on Amazon.
- *Anton International, Inc. v. Ningbo Mizhihe Import & Export Co., Ltd.* (C.D. Cal. 2021): Represented Defendant Ningbo Mizhihe Import & Export Co. in successfully dismissing with prejudice action for copyright infringement, with respect to accused costumes, based on favorable settlement.
- *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 Walmart.Com USA LLC*, Civil Action No. 3:19-CV-00754-N (N.D. Tex. 2019-2021) and Civil Action No. 3:20-CV-02023 (N.D. Tex. 2020-2021) and *Golabs Inc. v. Unicorn Global, Inc., Hangzhou Chic Intelligent Technology Co. Ltd., And*

## TONY PEZZANO

Principal, New York

### PRACTICE AREAS

- Intellectual Property
- International Practice

### ACTIVITIES

#### PROFESSIONAL MEMBERSHIPS

- ITC Trial Lawyers Association – Past President (2009)
- New York Intellectual Property Law Association

*Shenzen Uni-Sun Electronic Co., Ltd.*, Civil Action 3:21-cv-00311 (N.D. Tex. 2021): Represented Golabs and the Walmart entities in favorable settlement of actions involving claims of patent infringement with respect to accused hoverboard products and counterclaims of tortious interference with contractual relationship, unfair competition, Walker Process fraud and sham litigation.

- *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®): 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 for noninfringement, invalidity or lack of domestic industry in investigation involving accused SeaDoo® personal watercraft that favorably settled after hearing on remaining five patents.
- *Hoffmann-La Roche v. Genpharm* (D.N.J. 1999-2000): Represented Hoffmann-La Roche; successfully dismissed antitrust and sham litigation counterclaims in case involving complaint alleging infringement of patents directed to process for manufacturing Ticlid® (ticlopidine hydrochloride) a medication that prevents blood clots, and seeking expedited discovery on the accused process; affirmed on appeal by Federal Circuit.

Tony chairs Offit Kurman's monthly patent group meetings. He is a frequent author and lecturer on patent litigation topics, including Hatch-Waxman and biopharma patent litigation, FRAND-Encumbered Standard Essential Patents and ITC Section 337 investigations. His most recent publications and presentations include:

#### RECENT PUBLICATIONS

- The Political Pendulum Relating to the Enforcement of FRAND-Encumbered Standard Essential Patents - Part 2, *Intellectual Property Technology Law Journal*, Volume 35, Number 2, February 2023
- The Political Pendulum Relating to the Enforcement of FRAND-Encumbered Standard Essential Patents - Part 1, *Intellectual Property Technology Law Journal*, Volume 35, Number 1, January 2023
- Preparing for Competitive Challenges to Biologics With Expiring Exclusivity, *Pharmaceutical Executive*, January 31, 2020

- The ITC As A Forum For Biologic And Biosimilar Patent Disputes, *IAM-Media* (May/June 2019)
- Federal Circuit Judges Disagree On Proper Standard For Evaluating Patent Validity Under 35 U.S.C. §103, *Law360*, 29 Nov 2018

#### RECENT PRESENTATIONS AND SEMINARS

#### RECENT PUBLICATIONS

- “The Political Pendulum Relating To The Enforcement Of FRAND-Encumbered Standard Essential Patents – Parts I and II,” *Intellectual Property Technology Law Journal*, Vol. 35, Nos. 1-2 (January and February 2023)
- “Preparing for Competitive Challenges to Biologics With Expiring Exclusivity,” *Pharmaceutical Executive* (January 31, 2020)
- “The ITC As A Forum For Biologic And Biosimilar Patent Disputes,” *IAM-Media* (May/June 2019)
- “Federal Circuit Judges Disagree On Proper Standard For Evaluating Patent Validity Under 35 U.S.C. §103,” *Law360* (November 29, 2018)
- “Latest Developments On Injunctive Relief For Infringement Of FRAND-Encumbered SEPs,” *Intellectual Property Technology Law Journal*, Vol. 26, Nos. 2-4 (February, March, April 2014)

#### RECENT PRESENTATIONS AND SEMINARS

- “ITC Litigation and Enforcement: Recent Legal Issues and Compliance Strategies Explored,” Webcast on “The Political Pendulum Relating To The Enforcement Of FRAND-Encumbered Standard Essential Patents,” The Knowledge Group (September 27, 2022)
- “Analyzing Trends in Filings and Dispositions of 337 Proceedings,” ACI ITC Litigation and Enforcement Conference (August 24-25, 2020 Webcast)
- The Hatch-Waxman and IPR Strategy in Light of Recent Case Decisions: Addressing Emerging Issues,” The Knowledge Group (August 5, 2020 Webcast)
- Non-traditional, Non-patent Use of ITC Section 337,” The ITC Section 337 Investigations: Trends, Development, and Issues, The Knowledge Group (June 5, 2020 Webcast)
- “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 Philadelphia)
- “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 (June 26-27, 2019 Washington, DC)
- “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)
- “Obviousness Update For PIV Litigation: Matters Of Inherency, Anticipation And Secondary Considerations,” ACI 12th Annual Paragraph IV Disputes (New York April 23-25, 2018)
- Moderator for panel on “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 (March 5-6, 2018 Washington, DC)
- “Biosimilar Patent Litigation In The United States And Europe,” IAM 2nd Annual Pharma and Biotech IP Summit (February 8, 2018 London)

#### COURTS AND FORUMS

- United States Court of Appeals for the Federal Circuit
- United States District Court for the Southern District of New York
- United States District Court for the Eastern District of New York

#### PROFESSIONAL MEMBERSHIPS

- ITC Trial Lawyers Association – Past President (2009)
- New York Intellectual Property Law Association

#### RECOGNITIONS

Tony has been consistently ranked in the *Legal 500 US* and listed in the prestigious *IAM Patent 1000*, which called him a “top-notch and untiring litigator... the first in the door and the last out.” He has also been named to the Best Lawyers in America list in 2023.

#### 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