



## Gerard P. Norton, Ph.D.

Partner

Princeton, NJ

Tel: 609.844.3020

Fax: 609.896.1469

[gnorton@foxrothschild.com](mailto:gnorton@foxrothschild.com)

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Chair of the firm's Intellectual Property Litigation Practice Group, Gerry has extensive experience litigating complex matters pertaining to patents, trademarks, copyrights, trade secrets and breach of contract. Gerry serves as managing partner of Fox's Princeton office and is also former chair of the Intellectual Property Department.

An experienced intellectual property lawyer, Gerry focuses his practice on patent law and intellectual property litigation. He has litigated numerous cases involving patents, copyrights, trademarks, trade dress and trade secrets. He counsels clients regarding:

- Validity and scope of intellectual property rights
- Portfolio development for clients in worldwide patent prosecution and licensing matters
- Assisted clients with proceedings at the USPTO in Inter Partes Reviews (IPRs) and Reexaminations
- Represented biotechnology company in IP due diligence in merger transaction valued at \$8.4 billion
- Strategic positioning of corporate assets, opinion work and evaluating legal risk in the pharmaceutical and medical device industries
- Evaluating third-party intellectual property rights relating to chemistry and molecular biology, such as therapeutic compounds, biopharmaceuticals, formulations, manufacture, importation, methods of use and related FDA issues
- Representation of intellectual property matters and transactions relevant to corporate acquisitions and divestitures

Gerry also provides skilled knowledge to manufacturers and developers in the fields of pharmaceutical, biotechnology, chemical and medical device arts.

Gerry's clients include *Fortune* 100 companies as well as universities and other not-for-profit organizations.

### Representative Matters (District Court and ITC Litigation)

- *IMO Certain High-Potency Sweeteners, Processes for Making Same, and Products Containing Same*, Investigation No. 337-TA-1030 (ITC 2017). Represented Respondent Vitasweet and obtained a dismissal/withdrawal of the Complaint due to issues regarding the invalidity of the asserted patent relating to a process for manufacturing acesulfame potassium.

- *IMO Certain Footwear Products*, 337-TA-936 (ITC 2015). As lead counsel representing Respondent Highline United LLC obtained a ruling that all accused shoes being sold by client were not infringing and that Converse lacked any common law or registered TM rights.
- Obtained injunctive relief in a several hundred million dollar patent infringement matter against a competitor's infringing biologic product involving a case of first impression for the Federal Circuit. *Bio-Technology Gen. Corp. v. Genentech*, 80 F.3d 1553 (Fed. Cir. 1996);
- Litigated a patent infringement case to favorable settlement. *Rutgers, The State University of New Jersey v. Qiagen, Inc.*, 3:15-cv-07187 (D.N.J. 2015);
- Litigated a trademark infringement case to favorable settlement. *Glam and Glits Nail Design, Inc. DBA Kiara Sky Professional Nails v. Sky Beauty, LLC*, 3:16-cv-1271 (C.D.CA. 2016);
- Litigated a patent infringement case to favorable settlement. *DRG- International v. Bachem Americas, Inc. and Peninsula Laboratories International, Inc.*, 2:15-cv-07276 (C.D.CA 2015);
- Defeated four preliminary injunction motions in multimillion-dollar pharmaceutical patent case. *Everett Laboratories, Inc. v. Acella Pharmaceuticals, LLC* (D.N.J. 2013);
- Litigated a trademark infringement case to favorable settlement. *Mr. Water Heater Enterprises, Inc. v. 1-800-Hot Water Heater, LLC*, 648 F.Supp.2d 576 (S.D.N.Y., 2010);
- Obtained a multimillion-dollar jury award for damages in a hard-fought breach of contract trial on behalf of client Nature's Plus Nordic AS, a Norwegian distributor of skin care, makeup and health supplements in the Nordic region. *Nature's Plus Nordic AS v. Natural Organics Inc.*, 2:09-cv-04256 (E.D.N.Y. 2009);
- Obtained favorable *Markman* decision on behalf of medical device manufacturer. *Howmedica Osteonics Corp. v. Tranquil Prospects Ltd.*, WL 2750228 (N.D.I. 2009); *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 482 F.Supp.2d 1045 (N.D.Ind., 2007);
- Obtained permanent injunctions on behalf of the National Lacrosse League in separate trademark infringement matters. (S.D.N.Y. 2006);
- Litigated multimillion-dollar medical device patent case to favorable settlement. *Precimed, S.A. v. Orthogenesis, Inc.*, 2006 WL 6160497, 2006 *Markman* 6160497 (E.D.PA. 2006);
- Litigated multimillion-dollar medical device patent case to favorable settlement. *IMCOR Pharmaceutical Co. and Alliance Pharmaceutical Corp. v. Amersham Health, Inc., Amersham Health As and Amersham plc.*, 03-2853 (SRC) (D.N.J. January 10, 2005);
- Successfully litigated multimillion-dollar semiconductor patent case. *Greene, Tweed of Del., Inc. v. DuPont Dow Elastomers, LLC*, 2003 U.S. Dist. LEXIS 21034 (E.D.P.A. 2003);
- Obtained favorable *Markman* decision on behalf of Biotech company and favorable settlement. *Genentech, Inc. v. Boehringer Mannheim GmbH*, 989 F. Supp. 359 (D.Mass. 1997); and
- Obtained preliminary injunctive relief in a several hundred million dollar patent infringement matter against a competitor's infringing biologic product. *Genentech, Inc. v. Novo Nordisk A/S*, 935 F. Supp. 260 (S.D.N.Y. 1995).

## Before Fox Rothschild

Gerry was a named partner of an intellectual property law firm in New Jersey, and was an attorney for 10 years at Rogers & Wells and at Clifford Chance in New York. He held a post-doctoral fellowship with Merck, Inc.

## Client Resources



### **Technology is No. 1 Priority for U.S. Copyright Office**

On October 25, 2011, the U.S. Copyright Office released a paper outlining 17 policy priorities for the next two years. In this podcast, Gerry discusses the highlights of the Office's plans, including its intention to study and develop an alternative process for resolving small copyright infringement claims, conduct a preliminary analysis of the issues surrounding mass book digitization, and provide analysis and support to Congress in its effort to address a number of issues.

### **Honors & Awards**

- Named to a list of Trailblazers in Intellectual Property by *The National Law Journal* (2018)
- Named an Outstanding Litigator in New Jersey by *Managing Intellectual Property* (2018)
- Named a "Life Sciences Star" for his outstanding patent work by *LMG Life Sciences* (2012-2017)
- Named to "IP Stars" by *Managing Intellectual Property* (2012-2017)

### **Practice Areas**

- Intellectual Property
- Litigation
- IP Litigation
- Animal Law
- Antitrust
- Cannabis Law
- China
- Corporate
- Emerging Companies & Venture Capital
- Hatch-Waxman Patent Litigation
- International
- International Trade Commission Litigation
- Life Sciences
- Patents
- Pharma & Biotech
- Post-Grant Proceedings and Inter Partes Review
- Trademarks
- Trade Secrets

### **Bar Admissions**

- New Jersey
- New York
- U.S. Patent & Trademark Office

### **Court Admissions**

- U.S. Supreme Court
- U.S. Court of Appeals, Federal Circuit

- U.S. Court of Appeals, Second Circuit
- U.S. District Court, Northern District of Indiana
- New Jersey state and federal courts
- New York state and federal courts

## **Education**

- Fordham University School of Law (J.D.)
- Mount Sinai School of Medicine (Ph.D.)
  - in Microbiology, Virology and Immunology
- Fordham College (B.A.)
  - Biology

## **Memberships**

- American Bar Association
- American Association for Justice
- American Intellectual Property Law Association
- New Jersey State Bar Association
- New York State Bar Association
- New York Intellectual Property Law Association