



GERARD E. REINHARDT

cell: 516-672-3988

Gerard@ReinhardtIP.com

915 SE Krueger Parkway

Stuart, FL 34996

A Seasoned Intellectual Property Attorney

SUMMARY

In over twenty years of patent law experience, I have developed a sophisticated practice focused on the creation of commercial value, including:

- Drafting & prosecuting **U.S and foreign patent applications**;
- **Licensing** transactions;
- **Due diligence** assessments;
- **Opinions** regarding patentability, freedom-to-operate, infringement and validity;
- Enforcement and defense in **patent disputes**;
- Corresponding services regarding **trademarks, trade secrets, copyrights and domain names**; and,
- Legal matters associated with the above.

I hold BS and MS degrees in Chemical Engineering, and have 25 years of industry experience in pharmaceuticals, hydrocarbon processing, fluoropolymers, avionics and jet engines.

LEGAL EXPERIENCE

REINHARDT IP, PA (solo practice, 2012 – present).

- Prepare and prosecute U.S. and foreign patent applications on a wide array of technologies.
- Prepare and prosecute U.S. and foreign trademark applications.
- Prepare detailed written opinions regarding invalidity, noninfringement and freedom-to-operate.
- Draft and negotiate license agreements to specific IP.
- Advise individuals, start-ups and established businesses on IP strategies that best suit their specific needs on a cost-effective basis.
- Partner with several law firms for services in medicinal chemistry, including adverse proceedings (e.g., USPTO adverse proceedings, EPO adverse proceedings, US litigation).
- Advise clients regarding copyrights, trade secrets and domain names.

CHEMOURS LLP, Wilmington, DE (spun-off from **DUPONT** in July 2015).

Patent Attorney (contract), April 2015 – April 2016.

- Prepared and prosecuted U.S. and foreign patent applications directed to fluoropolymers, synthetic processes and industrial uses.
- Directed European Oppositions and Chinese Appeals.
- Collaborated with colleagues around the world on IP matters, supporting intellectual property-related transactional work.

LEGAL EXPERIENCE (continued)

MERCK & Co. (merged with **SCHERING-PLOUGH CORP.** in 2009) Rahway, NJ.

Senior Counsel, Patents, 2003 – 2011.

Patent Preparation & Prosecution:

- Prepared and prosecuted over 150 U.S. and foreign patent applications in close collaboration with scientists; maintained a docket of over 70 families of patent applications.
- Prepared opinions regarding patentability, validity, freedom to operate and licensing opportunities.
- Maintained competitive intelligence in key areas of interest.
- Counseled scientific, commercial and regulatory clients on patent- and exclusivity-related matters, including NME, pediatric and orphan drug exclusivities, Patent Term Extensions, SPCs, and Orange Book listings.
- Provided training to partners in scientific and business communities on patent matters.
- Solicited inventors for new disclosures of patentable subject matter in small molecules, crystalline forms, salts, second indications, formulations and dosing regimens.
- Developed in-depth expertise in particular therapeutic areas of medicinal chemistry, including cardiovascular, oncology and infectious diseases.

Patent Litigation:

- Supported in-house and outside counsel in large-scale, complex patent litigations.
- ANDA litigations included those on CLARINEX®, ZETIA®, TEMODAR®, and NOXAFIL®.

Licensing/Joint Venture/Merger-Acquisition Opportunities:

- Conducted due diligence to evaluate Intellectual Property/Exclusivity portfolios.
- Partnered with colleagues cross-functionally in the successful \$15B acquisition of Organon Biosciences from Akzo and the \$43B merger of Schering-Plough with Merck.

Client Counseling:

- Provided clear, informed and sophisticated counseling to clients within Research & Early Development, Business Development and other functional areas through all phases of patient-focused drug research, development, and commercialization.
- Influenced business leaders as a trusted advisor and thought partner.

Portfolio Management:

- Managed the maintenance of the entire worldwide portfolio of patents, making determinations to safeguard the most valuable and abandon the less valuable IP assets.
- Maintained a quarterly budget for worldwide patent prosecution.

LEGAL EXPERIENCE (continued)

MORGAN & FINNEGAN LLP, New York, NY.

Associate Patent Attorney, 2000 – 2002.

Patent Litigation:

- Litigated complex patent cases including one before the International Trade Commission (ITC), defending Bombardier against Yamaha in a case involving personal watercraft; settled favorably.
- Pursued an appeal in the CAFC and a subsequent motion for *certiorari* to the U.S. Supreme Court on behalf of Mobil against Unocal in a case involving gasoline additives.

Patent Prosecution:

- Prepared and prosecuted patent applications in technologies including chemistry, metallurgy, mechanical systems, optical systems, telecommunications technologies, business methods and software.

BAR ADMISSIONS

- Texas (1999).
- District of Columbia (2002).
- New York (Second Dept. 2003, Southern District of NY & Eastern District of NY 2012).
- Florida (2021).
- U.S. Patent & Trademark Office (Reg. No. 43,041).

EDUCATION

- **UNIVERSITY OF HOUSTON**, Houston, TX.
J. D.
- **UNIVERSITY OF SOUTH FLORIDA**, Tampa, FL.
M.B.A; Beta Gamma Sigma Honor Society.
- **GEORGIA INSTITUTE OF TECHNOLOGY**, Atlanta, GA.
M.S., Chemical Engineering, Dean's List.
Thesis: "*Studies in the Optimization and Economic Modeling of Distillation Sequences.*"
- **UNIVERSITY OF VIRGINIA**, Charlottesville, VA.
B.S., Chemical Engineering, Dean's List.

PROFESSIONAL ACTIVITIES

- AIPLA, Chemical Practice Committee.
- Licensing Executives Society.
- American Inst. of Chemical Engineers, presented paper entitled “*KABOOM! Misadventures in the Land of Patents*” at the 2018 Spring National Meeting in Orlando, FL.
- American Inst. of Chemical Engineers, presented paper entitled “*Aqualung Inferred: Inequitable Conduct in Regeneron v Merus*” at the 2019 Spring National Meeting in New Orleans, LA.

ENGINEERING EXPERIENCE

RAYTHEON ENGINEERS AND CONSTRUCTORS, Tampa, FL/Houston, TX.

Process Engineer 1991-1999.

Designed processes and components for oil refineries and olefin and chemical plants.

PRATT & WHITNEY AIRCRAFT (Subsidiary of United Technologies), West Palm Beach, FL.

Mechanical Engineer 1987-1991.

Designed components for jet and rocket engines (e.g., Advanced Tactical Fighter, Space Shuttle Main Engine Turbopump).

RAYTHEON COMPANY, Melville, NY.

Mechanical Engineer 1984-1987.

Designed ferrite phase shifter -based avionics countermeasures system components for military aircraft (e.g., B-52 and B-1 bombers).