

THOMAS HOXIE

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SUMMARY

Experienced pharmaceutical patent attorney. Founded intellectual property law firm. Managed large IP department for major pharmaceutical company and headed global IP litigation function for branded, generic and consumer businesses. Extensive business development and licensing experience. Worked in industry in Switzerland and US, and in private practice. Handled bench and jury trials in state and federal court, as well as patent matters before the United States Patent and Trademark Office, the European Patent Office, the United States Patent Trial and Appeals Board, and the United States Court of Appeals for the Federal Circuit. Expert witness on patents and patent licensing. Neutral evaluator, mediator in patent, trade secret and licensing disputes.

PROFESSIONAL EXPERIENCE

HOXIE & ASSOCIATES LLC, Millburn, NJ (June 2007 – present)

- Founder of patent firm specializing in patent matters relating to pharmaceuticals, chemicals, and biotechnology. Work includes patent preparation and prosecution, licensing, litigation, appeals, and opinions. Clients include multinational pharmaceutical and consumer products companies, as well as small biotechnology companies and their investors.

HOXIE & TSO LLP, Millburn, NJ (April 2004 - May 2007)

- Founding partner of law firm specializing in patent matters relating to pharmaceuticals, chemicals, and biotechnology.

NOVARTIS GROUP, Basel, Switzerland; Research Triangle Park, NC; East Hanover, NJ (1991–2004)

Vice President, Head of Global IP Litigation / Head of Patents, Global Pharma Markets (2003-2004)

- Managed Novartis intellectual property litigation for all businesses worldwide (branded pharmaceuticals, generics, consumer products), including over 80 patent infringement cases in 30 countries.
- Deputy Head of Pharma patents, responsible for patent matters with respect to Novartis Pharma market organizations and market products worldwide, including due diligence and patent licensing for market products.
- Member of Executive Committee, Novartis Corporation.

Vice President, Head of Intellectual Property (NAFTA), Summit and East Hanover, NJ (2000-2003)

- Responsible for patent and trademark matters in North America for Novartis group companies, including IP prosecution, licensing and litigation for pharmaceuticals, generics, and consumer businesses.
- Deputy Head of Pharma patents worldwide.
- Managed US patent and trademark department of 29 attorneys/agents and 18 administrative staff. Received Novartis Business Excellence Award (2001).
- Member of Portfolio Review Committee, Novartis Pharmaceuticals Corporation; Member of Executive Committee, Novartis Corporation.

Other positions in the Novartis group

- **Sector Patent Counsel, Pharmaceuticals** (Summit, NJ, 1999) - Responsible for pharmaceutical patent matters in US; managed group of 12 attorneys and agents; managed U.S. litigation on branded pharmaceuticals.
- **Sector Patent Counsel, Seeds/NABRI** (Research Triangle Park, NC, 1996-1999) - Responsible for US patent matters in areas of seeds and agricultural biotechnology, including prosecution, licensing and litigation; managed satellite patent department of five attorneys and three administrative staff; managed extensive litigation over transgenic crops.
- **Patent Attorney, Pharmaceuticals** (Sandoz Technology Ltd, Basel, Switzerland 1991-1996) - Responsible for patent matters initially in the area of immunology/transplant, later in the areas of asthma, rheumatoid arthritis, and cell and gene therapy, including drafting and prosecuting patent applications, handling litigation and opposition proceedings, managing litigation, and negotiating contracts and licenses. Promoted to Handlungsbevollmächtigter (1993), then to Prokurist (1995).

SEMMES, BOWEN & SEMMES, Baltimore, MD and Washington, D.C. (1985-1991)

- Trial lawyer in large, general practice law firm, with specific focus on intellectual property, business litigation (contract and antitrust), and maritime law. Handled a wide variety of civil and criminal matters, including bench and jury trials, as well as patent and trademark matters before USPTO. Associate (1986-1991); Law Clerk (1985-1986).

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EDUCATION & PROFESSIONAL DEVELOPMENT

Juris Doctor, with honors, May 1986, University of Maryland School of Law, Baltimore, MD

Top 10% in class; Order of the Coif; Maryland Law Review, Assistant Editor; Moot Court Board; American Jurisprudence awards in Criminal Law, Evidence, and Sales and Secured Transactions; Bridgewater M. Arnold Prize for Commercial Law; Margaret A. Cooning Memorial Book Award for Legal Method.

Bachelor of Science, May 1982, University of Maryland, College Park, MD

Majored in Zoology. Honors curriculum in Chemistry and English. Research assistant in Physiology Department, Uniformed Services University of the Health Sciences, Bethesda, MD, 1981-1982, studying hypertension.

Certificate in European Patent Law, January 1994, Centre d'Etudes Internationales de la Propriété Industrielle (CEIPI), Université de Strasbourg, Strasbourg, France. Four semester tutorial course in basic European patent law.

Other: 21 credits towards a master's degree at Johns Hopkins University, Baltimore, MD, part-time (1987-1990); biotechnology course, U. of Warwick (1991); Management Development Program, Ashridge Management College, Berkhamsted, England (1994); Novartis Leadership Program, Bürgenstock, Switzerland (2001); Executive Program, Harvard Business School, Cambridge, MA (2002); numerous seminars and continuing legal education courses on intellectual property law, licensing, antitrust law, international law, and other practice areas. Certificate: Mediator Essentials (AAA)(2025).

ADMISSIONS TO PRACTICE

- **Attorney**, admitted in Maryland (1986); the District of Columbia (1988); New Jersey (2004); U.S. District Court for the District of Maryland (1987), the District of Columbia (1989), and New Jersey (2004); U.S. Court of Federal Claims (1990); U.S. Court of Appeals for the Federal Circuit (1990) and for the Fourth Circuit (1991); and the U.S. Supreme Court (1991).
- **Registered Patent Attorney**, U.S. Patent and Trademark Office (1988)
- **European Patent Attorney**, European Patent Office (passed qualifying examination in 1994; inactive, not listed due to citizenship/residency requirements)
- **Solicitor**, admitted to practice in England and Wales (1996) (inactive)

PROFESSIONAL ACTIVITIES

Co-author of **PATENTS FOR CHEMICALS, PHARMACEUTICALS, AND BIOTECHNOLOGY**, 6th ed. (Oxford Univ. Press, 2016)
Member of Editorial Board, American Intellectual Property Law Association (AIPLA) Quarterly Journal (2020-2023)

Association of Corporate Patent Counsel; Intellectual Property Owners Association; American Intellectual Property Law Association (Speaker, 1998); Licensing Executives Society; American Bar Association; American Association for the Advancement of Science; American Chemical Society; PhRMA, IP Committee Staff Work Group and IP/Patents Focus Group (2000-2004). New Jersey Intellectual Property Law Association (Speaker, February 2006); American Conference Institute (Speaker, February 2013), Gibbons Institute "European Unitary Patent and Unified Patent Court" (Speaker, December 2015); US-China Intellectual Property Exchange and Development Foundation (Speaker, June 2020); American Conference Institute, 21st Annual Summit on Life Science Patents (Speaker/Moderator, May 2023).

Tutor, Centre d'Etudes Internationales de la Propriété Industrielle (CEIPI), Université de Strasbourg, Strasbourg, France—
Part-time paid position tutoring students studying to qualify as European patent attorneys (1995-1996). Lectured for CEIPI in Helsinki, Finland to support Finland's accession to EPC (1996).

COMMUNITY ACTIVITIES

EMT, Millburn-Short Hills Volunteer First Aid Squad (2005-2016) - Crew Chief (2007-2016) and Captain (2011)

Thomas Hoxie – Expert witness experience

1. *Medimmune, LLC v. PDL Biopharma, Inc.*, U.S. District Court for the Northern Dist. of California, CV-08-5590-JF
 - Expert for Medimmune; provided expert report and deposition testimony
 - Contract dispute; testimony related to interpretation of royalty provisions of a patent licensing agreement
2. *Ethypharm S.A. France v. Abbott Laboratories*, U.S. District Court for the Dist. of Delaware, 08-126 (SLR)
 - Expert for Ethypharm; provided expert report and deposition testimony
 - Antitrust action; testimony related to reasonableness of certain restrictions in a patent license
- 3a. *Federal Trade Commission v. Cephalon, Inc.*, U.S. District Court for the Eastern Dist. of Pennsylvania, 2:08-cv-2141
 - Expert for FTC; provided expert report and deposition testimony
 - Antitrust action; testimony related to whether patent settlement agreement amounted to unlawful “pay-for-delay” arrangement
- 3b. *King Drug Co. of Florence, Inc., et al. v. Cephalon, Inc., et al.*, U.S. District Court for the Eastern Dist. of Pennsylvania, 2:06-cv-1797
 - Expert for pharmacies; provided expert report and deposition testimony
 - Related to *FTC v. Cephalon* (3a); testimony related to whether patent settlement agreement amounted to unlawful “pay-for-delay” arrangement
- 3c. *Vista Healthplan, Inc. v. Cephalon, Inc. et al.*, U.S. District Court for the Eastern Dist. of Pennsylvania, 2:06-cv-1833
 - Expert for insurers; provided expert report and deposition testimony
 - Related to *FTC v. Cephalon* (3a); testimony related to whether patent settlement agreement amounted to unlawful “pay-for-delay” arrangement
- 3d. *Apotex, Inc. v. Cephalon, Inc., et al.*, U.S. District Court for the Eastern Dist. of Pennsylvania, 2:06-cv-2768
 - Expert for Apotex; provided expert report, deposition testimony
 - Related to *FTC v. Cephalon* (3a); testimony related to whether patent settlement agreement amounted to unlawful “pay-for-delay” arrangement
4. *The Medicines Company, v. Fish & Neave, et al.*; Superior Ct. of NJ, Docket No. MRS-L 2516-2014
 - Expert for The Medicines Company; provided expert report
 - Legal malpractice action; report related to alleged negligence in missing deadline to seek patent term extension
5. *Mylan Pharmaceuticals, Inc. v. Celgene Corporation*, U.S. District Court for the Dist. of New Jersey, No. 2:14-cv-02094-ES-MAH
 - Expert for Mylan; provided expert report and deposition testimony
 - Antitrust action; testimony related to alleged improper use of REMS requirements to interfere with ANDA for generic product
6. *Cipla Ltd. v. Sunovion Pharmaceuticals Inc.*, U.S. District Court for the Dist. of Delaware, C.A. No. 15-424-LPS-CJB
 - Expert for Sunovion; provided expert report and deposition testimony
 - Patent infringement litigation; testimony related to patent validity and infringement
7. *In the Matter of Impax Laboratories, Inc.*, FTC Docket No. 9373
 - Expert for FTC; provided expert report and testimony at deposition and trial
 - Antitrust action; testimony related to whether patent settlement agreement amounted to improper “pay-for-delay” arrangement, and whether agreement prevented generic competition for drug
8. *United Healthcare Services, Inc. v. Cephalon, Inc., et al.* U.S. District Court for the Eastern Dist. of Pennsylvania, 2:17-cv-00555-MSG
 - Expert for United Healthcare; provided expert report
 - Facts overlapped with *FTC v. Cephalon* (3a), although involved a different agreement; testimony related to whether settlement agreement amounted to unlawful “pay-for-delay” arrangement
9. *Pharmaceutical Patent Attorneys LLC, et al. v. Trizell Ltd.*, Superior Ct. of NJ, Docket No. MRS-L-2483-20
 - Expert for Trizell; provided affidavit of merit
 - Legal malpractice action; affidavit related to whether plaintiff law firm was negligent in prosecuting defendant pharmaceutical company’s patent applications
10. *In re HIV Antitrust Litigation*, U.S. District Court for the Northern Dist. of California, Case No. 3:19-cv-02573-EMC
 - Expert for Gilead and Teva; provided expert report, deposition
 - Antitrust action; testimony related to whether patent settlement and license agreement amounted to improper “pay-for-delay” arrangement, and whether agreements delayed generic competition for anti-HIV drugs
11. *AstraZeneca UK Ltd vs. Tesaro, Inc.*, High Court of Justice, Chancery Division, Claim No. BL-2021-002193
 - Expert for AstraZeneca; provided expert reports, testified at trial, High Court of Justice in London
 - Licensing dispute relating to PARP inhibitors; testimony related to patent claim interpretation
12. *Scriptchek Visual Verification Systems, Inc. v. R.R. Donnelley & Sons Co.*, Broward Cty. FL, 17th Jud. Cir., Case No. CACE 20-003398
 - Expert for R.R. Donnelly; provided expert report, deposition
 - Contract dispute; testimony related to scope of licensed patents, and scope and nature of contract
13. *In Re Actos Antitrust Litigation*, U.S. District Court for the Southern Dist. Of New York, Case No. 1:13-cv-09244-RA-SDA
 - Expert for Takeda; provided expert report, deposition
 - Antitrust action relating to pioglitazone; testimony related to whether patents were properly listed in Orange Book
14. *In re Xyrem (Sodium Oxybate) Antitrust Litigation*, U.S. District Court for the Northern Dist. of California, Case No. 3:20-md-02966-RS
 - Expert for Hikma, provided expert report, deposition
 - Antitrust action relating to settlement of patent litigation; testimony related to feasibility of at-risk launch
15. *Alkermes Pharma Ireland Ltd v. Janssen Pharmaceutica, N.V.*, arbitration
 - Expert for Alkermes; provided expert report, testified at arbitration hearing
 - Breach of contract action; testimony related to interpretation of license agreement