DESMARAIS LLP

Vi T. Tran Ph.D.

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Vi T. Tran's practice focuses on chemical and pharmaceutical patent litigation and concurrent patent proceedings, including *Inter Partes* Reviews (IPRs) and Post Grant Reviews (PGRs), before the Patent Trial and Appeal Board (PTAB) of the US Patent and Trademark Office. Her extensive experience includes writing briefs,preparing witnesses for deposition and trial, developing infringement and patentability positions and opinions, as well as pre-suit analyses and intellectual property due diligence. Over the last decade, she has assisted life science clients with a wide variety of patent matters, including Abbreviated New Drug Application (ANDA) and Biologics Price Competition and Innovation Act (BPCIA) litigations.

Dr. Tran's recent work for plaintiffs includes helping Ravgen enforce its patents covering groundbreaking genetic testing methods against several defendants, including Natera, LabCorp, and Quest Diagnostics. In those cases, Dr. Tran assisted with the preparation of infringement and invalidity arguments, which led to a trial win against Labcorp and a favorable settlement agreement with Quest. Dr. Tran also assisted with the successful defense of Ravgen's patents in multiple proceedings before the PTAB.

Dr. Tran has been honored for her legal writing and she has co-authored legal publications in *World Intellectual Property Review*, *Intellectual Property Magazine*, *Law360* and the *PTAB Bar Association Law Journal* on topics ranging from the enablement standard for life sciences patents to expert discovery protections in district courts and before the PTAB. Recently, she was invited to speak about her unorthodox path into the legal field as a panelist for the New York Intellectual Property Law Association. She has published her research on organic chemistry in numerous peer-reviewed journals, including the *Journal of Organic Chemistry, Organic & Biomolecular Chemistry* and *Organic Process Research & Development*.

Before joining Desmarais LLP, Dr. Tran was an IP litigation associate in the New York office of Dechert. While attending law school at night, Dr. Tran was a science advisor/ law clerk at Goodwin Procter, where she assisted with patent litigation matters. Before law school, she obtained her Ph.D. in Organic Chemistry from the University of California, Irvine, where she was

EDUCATION

Fordham University School of Law, J.D., 2019

University of California, Irvine, Ph.D., Organic Chemistry, 2013

California Institute of Technology, B.S., 2005

ADMISSIONS

2020, New York

Registered to practice before the United States Patent and Trademark Office

an inaugural member of the Medicinal Chemistry and Pharmacology Gateway Program. Her doctoral thesis research focused on the stereoselective addition of carbon nucleophiles to constrained oxocarbenium ions. In addition, Dr. Tran was a research associate at Johnson & Johnson, where she conducted drug discovery research on treatments for neurological dysfunctions. She is an inventor on five patents directed to compounds useful as serotonin receptor modulators.

Courts

- United States Court of Appeals for the Federal Circuit

Other Distinctions

Dr. Tran is a named inventor on the following United States patents:

- N.I. Carruthers, J.A. Jablonowski, C.R. Shah, B.T. Shireman, D.M. Swanson, V.T. Tran, V.D. Wong, *Serotonin Receptor Modulators*, U.S. Patent Nos. 8,642,583 and 9,981,909.
- N.I. Carruthers, B.T. Shireman, V.T. Tran, J.A. Jablonowski, *Modulators of Serotonin Receptor*, U.S. Patent Nos. 8,575,364 and 8,957,059.
- N.I. Carruthers, G.J. MacDonald, B.T. Shireman, V.T. Tran, *2-Aminopyrimidine Compounds as Serotonin Receptor Modulators*, U.S. Patent No. 8,829,011.

Memberships

- American Intellectual Property Law Association
- Asian American Bar Association of New York
- National Asian Pacific American Bar Association

Representative Matters

- Represented Ravgen in patent litigation and parallel PTAB proceedings that resulted in a $272.5M jury verdict finding willful infringement.
- Represented Boston Scientific Corp. against Micro-Tech Endoscopy USA in a patent infringement dispute over hemostatic clips used in endoscopic surgery.
- Represented a major pharmaceutical and biotechnology company in a district court litigation and copending Post-Grant Review (PGR) petition relating to a monoclonal antibody therapy.
- Represented Bicycle Therapeutics in two *inter partes* reviews (IPRs) of patents relating to peptide therapeutics.
- Advised Royalty Pharma on its acquisition of a partial royalty interest in PrevymisTM (letermovir) royalties from AiCuris Anti-Infective Cures GmBH.

Publications

- Invited Speaker, “Leading Ladies of the Law -– Advice from the Top,”

New York Intellectual Property Law Association, February 15, 2023.

- *Law360* - "Jury Says LabCorp Owes $272M For Infringing Prenatal Test IP"
- B.M. Hackman, V.T. Tran, K.A. Helm, *Expert Discovery Protections: Comparing District Courts with the PTAB*, 19 Chi.-Kent J. Intell. Prop. 504 (2020).
- K.A. Helm, V.T. Tran, *Enablement for Life Sciences Patents Requires Sweat Equity*, Law360.com, Dec. 16, 2019.
- F. Rein, A. Riley, V. Tran, *Extraterritoriality and infringement of blockchain claims*, World Intellectual Property Review, Sept. 3, 2018.
- F. Rein, A. Riley, V. Tran, *Stumbling Blocks*, Intellectual Property Magazine, Mar. 2, 2018, at 52.
- O. Lavinda, V.T. Tran, K.A. Woerpel, *Effect of Conformational Rigidity on the Stereoselectivity of Nucleophilic Additions to Five-membered Ring Bicyclic Oxocarbenium Ion Intermediates*, Organic & Biomolecular Chemistry, Vol. 12, pp. 7083-7091 (2014).
- V.T. Tran, K.A. Woerpel, *Nucleophilic Addition to Silyl-protected Five-membered Ring Oxocarbenium Ions Governed by Stereoelectronic Effects*, Journal of Organic Chemistry, Vol. 78, pp. 6609-6621 (2013).
- J.T. Liang, J. Liu, B.T. Shireman, V. Tran, X. Deng, N.S. Mani, *A Practical Synthesis of Regioisomeric 6- and 7-Methoxytetrahydro-3-benzazepines*, Organic Process Research & Dev., Vol. 14, pp. 380-385 (2010).