

## Gilberto M. Villacorta Of Counsel

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Dr. Gilberto M. (Ybet) Villacorta is an intellectual property lawyer with Foley & Lardner LLP where he focuses on *establishing, exploiting and enforcing intellectual property rights in marketable products, systems and services*?. He assists technologically diverse clients worldwide with their intellectual property and business transactions needs. These needs may include the planning, development and maintenance of patent and trademark portfolios; IP monetization, licensing, marketing, product development negotiations and the preparation of the resulting agreements; due diligence investigations in connection with mergers, acquisitions, formation of joint ventures and financing; patentability, registrability, peer review, market assessment, validity and infringement opinions; and enforcement and litigation. Dr. Villacorta is the immediate past chair of the firm's Washington, D.C. office Intellectual Property Department. Ybet likes to work closely with his legal colleagues in the Firm to deliver interdisciplinary (business, corporate, immigration, antitrust, tax, compensation, commercial disputes and litigation) solutions to the Firm's clients. Prior to his legal career, Dr. Villacorta was a Member of the Technical Staff, AT&T Bell Laboratories, Murray Hill, New Jersey.

### Representative Experience

- *[redacted] v. [redacted]* — arbitration to resolve disputes arising from a license agreement
- *[redacted] v. [redacted]* — books and records case and allegations of breach of fiduciary duty
- *Amgen v. Elanex* — patent infringement case concerning a gene for erythropoietin
- *Taguchi v. Jorgensen* — interference matter to determine how much of gene one has to sequence to own it
- *Eli Lilly v. Teva* — ANDA case involving the PMS drug, Sarafem
- *ADS v. USCubed* — misappropriation of trade secrets and copyright infringement of information management system
- *Parkson v. Severn Trent* — declaratory judgment action against patent for denitrification control system
- *FireStar v. Red Hat* — patent infringement action against marketing, distribution and support for open source software product

## Awards and Recognition

Dr. Villacorta has been peer review rated in the Martindale-Hubbell® Peer Review Ratings™ system and was recognized in 2009, 2007 and 2004 as a Top Lawyer in Intellectual Property by the *Washingtonian Magazine*. He was a previous runner-up in the *Washington Business Journal's* Top Washington Lawyers in Intellectual Property and was identified as “One of 15 leading IP Lawyers in Washington D.C.” by the *Legal Times* in 2003. He was recognized among *IAM Patent 1000 – The World's Leading Patent Practitioners* (2012 – 2016), and has been named an IP Star by *Managing Intellectual Property* magazine every year since 2015.

## Affiliations

Outside his legal work with Foley, Dr. Villacorta has co-founded several early-stage companies in the Life Sciences arena, including three enterprises that have since ceased their operations: TrustedElement LLC, a D.C. Metro Area business accelerator; PL&Y LLC, a developer of products and services in the healthcare space; and Tomopath Inc., a Boston-based startup that aimed to assist biopharmaceutical companies seeking to gain FDA approval to market immunotherapeutic agents by use of radiolabeled pharmaceuticals as imaging agents. He is President of Emission inc., a Texas-based company near Austin, which has developed a new generation of compact, robust and highly sensitive flow instruments, which, along with proprietary magnetic microspheres, comprise a high-performance bead-based molecular and immunoassay, multiplexed, high-throughput diagnostic platform. Dr. Villacorta is a former member of the board of directors of the MIT Club of Washington, former past secretary and member of the board of directors of River Bend Golf & Country Club, Great Falls, Virginia, where he continues to play golf and socialize with fellow members. He is also a member of Kinloch Golf Club, Richmond, Virginia.

## Presentations and Publications

Over the years, Dr. Villacorta has authored or co-authored dozens of scientific and legal publications, been granted his own patents and copyrights, and presented numerous lectures on various intellectual property topics. He appears in a video, “[Establishing Intellectual Property Rights](#),” which was recorded at the ATA Conference, San Antonio, Texas, March 2023. He co-wrote “Biogen Decision Shows Need for Clinical, Legal Collaboration,” published by *Bloomberg Law* (May 2020). He authored “What’s More Unnatural Than A Clone?” that was published by *Law360* (August 2014). Dr. Villacorta participated in a plenary session during the AIPLA Mid-Winter Institute in Las Vegas in January 2012, presenting a talk on “Hot Topics in Patent Law.” A copy of his manuscript is available upon request. He was a panelist in a presentation by seasoned entrepreneurs on “Navigating the Valley of Death,” Nanotech Commercialization Conference, Wake Forest Biotech Place, (April 9, 2013). Dr. Villacorta was a speaker during the 12th Annual NanoBusiness Commercialization Association 2014 DC Roundtable (May 6-7). He spoke on infringement topics before in-house counsel at Novartis Pharma, East Hanover, New Jersey on August 13, 2014.

## Sectors

- [Artificial Intelligence](#)
- [Cloud Computing Infrastructure & Solutions](#)
- [Health Tech & Genomics](#)

- Innovative Technology
- Racial Justice & Equity
- Telemedicine & Digital Health

## Practice Areas

- Chemical, Biotechnology & Pharmaceutical
- Electronics
- Green Energy Technologies
- IP Due Diligence
- Intellectual Property
- Mechanical & Electromechanical Technologies

## Education

- Fordham University School of Law (J.D., 1991)
- Massachusetts Institute of Technology (Ph.D., 1987)
- Rutgers University (M.S., 1982, B.A., 1978)

## Admissions

- New York
- New Jersey
- District of Columbia
- U.S. Patent and Trademark Office
- U.S. District Court for the District of New Jersey
- Supreme Courts of the States of New York and New Jersey
- U.S. Court of Appeals for the Federal Circuit
- Court of Appeals for the District of Columbia