



Joseph M. Casino

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PRACTICE AREAS

- Alternative Dispute
- Copyright
- False Advertising
- Intellectual Property Litigation
- International Trade Commission
- Patent
- Strategic Counseling
- Trade Dress
- Trade Secret
- Trademark
- Unfair Competition

INDUSTRIES

- Computer Hardware and Software
- Consumer Electronics
- Financial Services
- Green Technology and Energy
- Internet and e-Commerce
- MEMS & Semiconductors
- Motors, Machinery & Other Mechanical Devices
- Retailing & Apparel
- Life Sciences & Biotechnology
- Universities & Research Institutions

Joseph M. Casino has broad experience in all aspects of intellectual property law, including litigation, licensing, opinions, and prosecution. Resolution of patent matters through negotiation, litigation, and arbitration has been a focal point of his practice. He has extensive experience handling intellectual property rights matters related to the high technology industries, including computer technology, hybrid electric vehicles, battery technology, semiconductors, fiber optics, and consumer electronics such as cellular technology, televisions, and DVDs. He has spent time in Japan working as in-house patent counsel for Panasonic Corporation (“Panasonic”) and continues to work extensively for Panasonic and other Japanese clients.

Mr. Casino has presented many lectures to clients on topics ranging from patent exhaustion, drafting patent license agreements, damages and risk analysis, claim construction, and the doctrine of equivalents.

BAR ADMISSIONS

- New York, 1997
- U.S. District Court, Southern and Eastern Districts of New York, 1997
- New York, 1997
- U.S. Court of Appeals for the Federal Circuit, 2000

EDUCATION

- Brooklyn Law School, Brooklyn, NY, J.D., cum laude, 1996
- Brooklyn College, Brooklyn, NY, B.S., Computer Science, cum laude, 1991

REPRESENTATIVE CLIENTS

- Panasonic
- Glory, Ltd.
- Victor Company of Japan, Ltd.

Mr. Casino has negotiated many complex license agreements, including cross licenses of large patent portfolios. He has been involved in all aspects of licensing programs from patent assertions, developing defensive positions, drafting agreements and analysis of the surrounding legal issues in settling license disputes such as patent exhaustion, misuse, corporate issues and antitrust issues.

Mr. Casino graduated cum laude from Brooklyn College with a degree in computer science. He received his law degree from the Brooklyn Law School where he graduated cum laude. While in law school he was the Executive Notes and Comments Editor of the Brooklyn Journal of International Law and received multiple academic awards.

Mr. Casino is a member of the New York State Bar and is admitted to practice before the United States Patent and Trademark Office.

PUBLISHED WORKS

- **ARE Patent Law Alert:**
Overview of the Leahy-Smith America Invents Act on Patents
September 13, 2011
- **ARE Patent Litigation Alert:**
Recent Applications of the *Bilski* Test for Patentable Subject Matter by The Federal Circuit and District Courts
August 17, 2011
- **Implications of Post-*Seagate* Cases Finding Willful Infringement**
NYIPLA Bulletin, August/September, 2011
- **ARE Patent Litigation Alert:**
USPTO Proposes to Revise the Materiality Standard for the Duty to Disclose to Conform with the *Therasense*
July 22, 2011

SPEAKING ENGAGEMENTS

- **October 11, 2011 – October 13, 2011**
*Patent Law Seminar: (i) Licensing - Pitfalls and Strategies for License Negotiations and Agreements; (ii) Willful Infringement after *Seagate*; (iii) U.S. Patent Litigation For Japanese Companies*
Location: Tokyo, Osaka, and Nagoya, Japan
- **May 11, 2010**
*Intellectual Property Seminar - (i) The Federal Circuit's en banc decision in *Ariad v. Lilly*: Implications for Patent Litigation and Patent Prosecution; and (ii) Marking: Why to Mark, When to Mark, How to Mark, and the Dangers of False Marking*
Location: Kyoto, Japan

PUBLISHED WORKS EXTENDED

- **ARE Patent Law Alert:**
Overview of the Leahy-Smith America Invents Act on Patents
September 13, 2011
- **ARE Patent Litigation Alert:**
Recent Applications of the *Bilski* Test for Patentable Subject Matter by The Federal Circuit and District Courts
August 17, 2011
- **Implications of Post-Seagate Cases Finding Willful Infringement**
NYIPLA Bulletin, August/September, 2011
- **ARE Patent Litigation Alert:**
USPTO Proposes to Revise the Materiality Standard for the Duty to Disclose to Conform with the *Therasense*
July 22, 2011
- **ARE Litigation Alert:**
U.S. Supreme Court Confirms “Clear and Convincing” Evidence Standard Applies to Validity Challenges for Patents
June 9, 2011
- **ARE Patent Law Alert:**
Federal Circuit Holds That False Marking Must Be Pled With Particularity Under Fed. R. Civ. P. Rule 9(b)
March 16, 2011
- **CAFC rejects the 25% Rule of Thumb as a Fundamentally Flawed Toll in Reasonable Royalty Calculation (Available only in Japanese)**
Nikkei IP Awareness, January 13, 2011 (published in Japanese)
- **ARE Patent Litigation Alert:**
Uniloc USA v. Microsoft: Federal Circuit Held the 25% Rule of Thumb By Damages Expert is a Fundamentally Flawed Tool for Determining a Baseline Royalty Rate In Patent Damages Analysis
January 4, 2011
- **ARE Patent Law Alert:**
Disappointingly: The Supreme Court Does Not Decide Whether Foreign Sale Exhausts Copyrights
December 14, 2010
- **ARE Patent Law Alert:**
U.S. Supreme Court Affirms *Bilski*, But Sets The Course Clear For Business Methods Patents
June 28, 2010
- **The Impact Of American Needle On IP And Contracts**
IP Law360, May 26, 2010
- **Increase of False Patent Marking Litigation (available only in Japanese)**
Nikkei BP Chizai Awareness, April 26, 2010 (published in Japanese)
- **ARE Patent Law Alert:**
Supreme Court to Decide Whether Foreign Sale Exhausts Copyrights
April 23, 2010
- **Update To Recent Patent Damages Article**
Patently-O Guest Blog, April 1, 2010
- **ARE Patent Law Alert:**
Federal District Courts in Texas Have Begun to See The First of What Could Be a Wave of Lawsuits Alleging False Patent Marking in Violation of 35 U.S.C § 292
February 25, 2010
- **ARE Patent Law Alert:**
Federal Circuit Confirms That Fines for False Patent Marking are to be Imposed for Each Unit Falsely Marked
January 6, 2010
- **Federal Courts Closely Scrutinizing and Slashing Patent Damage Awards**
2010 Patently-O Patent L.J. 24
- **ARE Patent Litigation Alert:**
FTC Closes Rambus Investigation
May 14, 2009
- **Transferring Cases Out of Eastern Dist. Of Texas**
IP Law360, October 15, 2008
- **High Court Sets Patent Exhaustion Law Back On Track**
IP Law360, July 10, 2008
- **Will The High Court Clarify The Exhaustion Doctrine?**
IP Law360, January 16, 2008
- ***In re Seagate Technology*: Willfulness and Waiver, a Summary and a Proposal**
Patently-O Patent L.J. 1, May 14, 2007