
Intellectual Property Law



Michael J. Kasdan

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PRACTICE AREAS

- Alternative Dispute
- Anti-Counterfeiting
- 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
- Mobile Devices & Wireless

Michael J. Kasdan concentrates his practice on intellectual property litigation, licensing, portfolio analysis, and strategic counseling. He has a technical background in electrical engineering and had a prior career as a technology consultant. His law practice focuses on a broad range of technologies ranging from consumer electronics to computer architecture and networks to semiconductor chips to wireless devices to medical products and devices.

Mr. Kasdan has experience handling all aspects of patent litigations and disputes before district courts, the Federal Circuit, and the International Trade Commission, as well as in private licensing negotiations, in arbitrations, and in mediations. He also counsels clients on strategic patent prosecution, portfolio development, and provides opinions and analyses on issues including patent infringement, validity, and enforceability.

BAR ADMISSIONS

- U.S. Court of Appeals Federal Circuit, 2005
- U.S. District Court, Southern District of New York, 2003
- U.S. District Court, Eastern District of New York, 2003
- New York, 2002

EDUCATION

- New York University School of Law, New York, New York J.D., magna cum laude, Order of The Coif, Fish & Neave Fellow for the Engelberg Center on Innovation Law and Policy, Law Review Alumni Association Award; *NYU Law Review Notes* Ed., Editor, 2000-2001, Staff Editor, 1999-2000. InSITE NY Student Fellow, 2000-2001.
- University of Pennsylvania, Philadelphia, Pennsylvania, 1996 B.S., Electrical Engineering, magna cum laude, Dean's List (1994-1995), Tau Beta Pi, Engineering Honor Society

After graduating magna cum laude from NYU School of Law, Mr. Kasdan worked as law clerk to the Honorable Judge Roderick R. McKelvie in the United States District Court for the District of Delaware. Prior to joining Amster Rothstein & Ebenstein LLP in the Fall of 2004, he was an associate in the intellectual property department of Kirkland & Ellis LLP.

During 2008-2009, Mr. Kasdan was seconded from our firm and joined Panasonic Corporation in Japan, where he worked as in-house patent counsel in Panasonic's licensing center. In this role, he provided a diverse range of legal counseling. Mr. Kasdan acted as lead counsel representing Panasonic in addressing numerous third party patent assertions and license negotiations and developing substantive defensive positions. He also provided legal advice and opinions across a broad set of technology areas and in many facets of patent law. Mr. Kasdan also negotiated and drafted complex agreements, including portfolio cross-license agreements, and provided legal advice concerning the interpretation of such agreements.

Mr. Kasdan has spoken and written articles on various areas of intellectual property law, including licensing practices, defending against patent infringement cases, the doctrine of patent exhaustion, willful infringement, patent misuse and standards estoppel, damages and patent valuation, inequitable conduct, and business methods patents.

Mr. Kasdan attended the University of Pennsylvania where he graduated magna cum laude with a degree in electrical engineering with a minor in mathematics. He attended New York University School of Law where he was the Notes Editor for the NYU Law Review, President of the Intellectual Property and Entertainment Law Society and a member of the Order of the Coif.

He is admitted to practice before all New York State courts, the U.S. District Courts for the Eastern and Southern Districts of New York and the U.S. Court of Appeals for the Federal Circuit.

Mr. Kasdan serves on the Board of Directors of CityScience.

PROFESSIONAL ASSOCIATIONS & MEMBERSHIPS

- New York State Bar Association, IP Section
- Member, American Bar Association

SPEAKING ENGAGEMENTS

- **November 6, 2012 – November 7, 2012**
4th Annual Social TechNet Intellectual Property Forum
Location: New York, NY
- **May 16, 2012 – May 17, 2012**
The 4th Annual Corporate IP Counsel Summit
Location: New York, NY
- **November 16, 2011 – November 17, 2011**
3rd Annual Social TechNet Intellectual Property Forum
Location: New Yorker Hotel, New York, NY
- **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
- **November 15, 2010 – November 16, 2010**
World Research Group The TechNet Patents Forum
Location: New York, NY
- **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
- **March 24, 2010**
NYU School of Law - 2010 Trade Regulation Brown Bag Lunch Series: Practicing IP Law In A Global Economy
Location: New York, NY
- **February 25, 2010**
InSITE Alumni Advising Session
Location: New York, NY

PUBLISHED WORKS

- **ARE Litigation Alert:**
U.S. Supreme Court Finds Prometheus Method of Diagnosing and/or Treating Unpatentable Law of Nature
March 20, 2012
- **Practice Note: Patent Infringement Claims and Defenses (Updated for America Invents Act)**
Practical Law Company, New York, (October 15, 2011)
- **ARE Patent Law Alert:**
President Obama Signs Leahy-Smith America Invents Act into Law: Overview of Provisions Now In Effect
September 19, 2011
- **ARE Patent Law Alert:**
Overview of the Leahy-Smith America Invents Act on Patents
September 13, 2011

IN THE PRESS

- **In the Press:**
K-C Diaper Patent Wiped Out In First Quality IP Suit
IP Law360, December 5, 2011
- **In The Press:**
Michael Kasdan cited in IP Law 360 article, 2nd Circ. Counsel Ruling Could Upend Google Books Deal
IP Law360, New York (September 8, 2011)

PUBLISHED WORKS EXTENDED

- **ARE Litigation Alert:**
U.S. Supreme Court Finds Prometheus Method of Diagnosing and/or Treating Unpatentable Law of Nature
March 20, 2012
- **Practice Note: Patent Infringement Claims and Defenses (Updated for America Invents Act)**
Practical Law Company, New York, (October 15, 2011)
- **ARE Patent Law Alert:**
President Obama Signs Leahy-Smith America Invents Act into Law: Overview of Provisions Now In Effect
September 19, 2011
- **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
- **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 Patent Litigation Alert:**
US Supreme Court Grants Cert for the Second Time in *Prometheus v. Mayo* Case on Patent-Eligible Subject Matter
June 21, 2011
- **ARE Patent Litigation Alert:**
U.S. Supreme Court Addresses Knowledge Element of Claims for Inducing Patent Infringement
June 1, 2011
- **ARE Patent Litigation Alert:**
Federal Circuit Affirms Dismissal of Another False Marking Case and Clarifies Meaning of “Patented Article”
May 2, 2011
- **ARE Copyright Litigation Alert:**
Southern District Judge Rejects Google Books Amended Settlement Agreement
April 5, 2011
- **Is Facebook Killing Privacy Softly? The Impact of Facebook’s Default Privacy Settings on Online Privacy**
The NYU IP and Entertainment Law Ledger, April 21, 2011
- **Second Circuit Confirms Insurance Company Did Not Have Duty To Defend Action Based on Intellectual Property - Related Claims Under Personal Injury and Advertising Injury Clauses**
April 4, 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 Law Alert:**
Federal Circuit Holds That False Marking Must Be Pled With Particularity Under Fed. R. Civ. P. Rule 9(b)
March 16, 2011
- **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
- **Student Speech in Online Social Networking Sites: Where to Draw the Line**
*NYU IP and Entertainment Law Ledger, November 22, 2010 (selected for publication in introductory edition of *Teen Rights and Freedoms: Social Networking*, scheduled for release Dec., 2011)*
- **The Impact Of American Needle On IP And Contracts**
IP Law360, May 26, 2010
- **ARE Patent Law Alert:**
Supreme Court to Decide Whether Foreign Sale Exhausts Copyrights
April 23, 2010
- **The 2nd Circ. Stance On *Tiffany V. eBay***
IP Law360, April 6, 2010
- **Update To Recent Patent Damages Article**
Patently-O Guest Blog, April 1, 2010
- **ARE Trademark Law Alert:**
Second Circuit Decides *Tiffany v. eBay* Appeal
April 1, 2010
- **Implications of *Reed Elsevier v. Muchnick***
IP Law360, March 17, 2010
- ***SEB v. Montgomery Ward*: Extending the Reach of U.S. Patent Laws to Foreign Defendants—Developments in the Law of Direct Infringement and Inducement**
March 10, 2010

PUBLISHED WORKS EXTENDED CONT.

- **ARE Patent Law Alert:**
Developments in the Law of Inducement and Direct Infringement
March 8, 2010
- **Federal Courts Closely Scrutinizing and Slashing Patent Damage Awards**
2010 Patently-O Patent L.J. 24
- **ARE Patent Litigation Alert:**
U.S. Government Files Brief in *Bilski v. Kappos*
September 26, 2009
- **ARE Patent Law Alert:**
***Prometheus Labs v. Mayo Clinic*: Federal Circuit Applies Transformation Prong of *In re Bilski* Test and Finds Drug Usage Method Claim to be Patentable Subject Matter Under Section 101**
September 17, 2009
- **Will The High Court Clarify The Exhaustion Doctrine?**
IP Law360, January 16, 2008
- **Reviving The Exhaustion Doctrine**
IP Law360, January 10, 2008
- ***Quanta Computer v. LG Electronics*: Will The Supreme Court Revive The Exhaustion Doctrine?**
Amster, Rothstein & Ebenstein, LLP, January, 2008
- **Infringement Assertions In The New World Order**
IP Law360, October 17, 2007, Guest Column
- ***In re Seagate Technology*: Willfulness and Waiver, a Summary and a Proposal**
Patently-O Patent L.J. 1, May 14, 2007
- **Refining In U.S. Patent Law For Software**
IP Law360, May 7, 2007
- ***KSR v. Teleflex*, Redefining The Obvious**
IP Law360, May 3, 2007