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**Joseph A. Calvaruso**

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**Education**

- J.D., Fordham University School of Law, 1974
- B.E.E., Manhattan College, 1971

**Honors**

- Mr. Calvaruso has a peer review rating of "AV" on Martindale-Hubbell, the highest legal ability and ethical standards rating accorded to lawyers in the legal directory.
- Best Lawyers in America (2006-2011)
- Legal 500 (2010)
- New York Super Lawyers (2006-2010)
- He is listed as a leading intellectual property lawyer in *Marquis Who's Who in the World* (2006 and 2007)
- *Marquis Who's Who in America* (2005)
- *Marquis Who's Who in American Law* (2003-2004, 1994-1995 and 1987-1988)
- *Marquis Who's Who of*

Joseph Calvaruso, who is the head of Orrick's Intellectual Property Group in New York, has more than 30 years of experience in virtually all aspects of intellectual property, with a particular focus on patent litigation. His litigation experience—at the trial and appellate levels, in federal courts throughout the country and before the International Trade Commission (ITC) in Section 337 proceedings—is extensive. In addition to patents, he has litigated cases involving trademarks, trade secrets, false advertising, antitrust and unfair competition.

Mr. Calvaruso has an enviable track record of getting excellent results for his clients. For example, Mr. Calvaruso successfully defended his client Canon USA in a patent case by obtaining summary judgment of noninfringement from the Federal Court in the Eastern District of Texas. Similarly, he successfully defended Cannon Avent Group PLC by obtaining from the Federal Court in the Western District of Louisiana summary judgment that one patent in suit was not infringed while the other patent in suit is invalid. And Mr. Calvaruso was the lead trial attorney for Columbia HCA in a much publicized trademark action involving the mark "Columbia" that was brought in the Federal Court in the Southern District of New York by Columbia University. Following trial, Mr. Calvaruso won for his client a favorable judgment in all respects including a judgment of noninfringement and unenforceability based on laches and estoppel.

As one client put it, "Joe Calvaruso is exceptional, his work has been truly excellent." (*Legal 500*, 2010)

Mr. Calvaruso has experience in diverse fields including

Mr. Calvaruso has experience in diverse fields including consumer products, optical equipment, medical devices, electronics, telecommunications, electro-mechanical devices, coin discrimination equipment, semiconductor devices and fabrication, computer hardware and software, sound abatement apparatus, pharmaceutical products, chemical processes, automotive systems and components, food science, tobacco products and financial services.

Mr. Calvaruso has litigated high stakes trademark cases involving well-known marks. He also handles *inter partes* proceedings before the United States Patent and Trademark Office (USPTO), including trademark oppositions and cancellations.

Mr. Calvaruso also has the proven ability to help clients reach practical business solutions to disputes without having to engage in prolonged litigation. For example, Mr. Calvaruso has successfully represented companies such as Canon USA Inc., Avon Products, Inc., Yokogawa Electric Corporation, Coby Electronics Corporation and Citigroup, Inc. in resolving IP disputes either without litigation or early on in litigation.

Mr. Calvaruso regularly advises clients as to patent validity and infringement issues, including product clearance opinions. He also negotiates licenses and performs IP due diligence in connection with mergers and acquisitions.

Mr. Calvaruso's practice is truly international. He regularly represents technology companies headquartered in Japan and Europe, as well as U.S. companies.

Mr. Calvaruso is an active member of AIPLA's IP Practice in Japan and IP Practice In Europe Committees. He is a regular member of a small delegation from those Committees that goes to Japan and Europe and presents topics concerning U.S. IP law to various IP organizations. As part of this delegation, Mr. Calvaruso regularly meets with the Japan Intellectual Property Association, Japan Patent Attorneys Association, LES Japan, AIPPI Japan, Japan Federal Bar Association, Japanese Trademark Association, The Judges of the Tokyo IP Court, Chartered Institute of Patent Attorneys in the U.K., CNCPI in France and Patentanwaltskammer (German Chamber of Patent Attorneys) in Germany.

Some of Mr. Calvaruso's notable representations include the following cases.

- ***GTX v. Canon USA Inc.*** (E.D. Tex.) Patent. Successfully defended Canon USA Inc. in a patent infringement action involving a patent directed to software use in scanners. Obtained Summary Judgment of non-infringement and Final Judgment in Canon's favor.
- ***Whetstone Electronics, LLC v. Xerox Corporation et al.*** (E.D. Tex.) Patent. Lead counsel for Canon USA Inc. and

Canon Business Solutions Inc. in infringement action involving two patents directed to printers, copiers and multi-function devices.

- ***PACid Group, LLC v. Canon USA Inc. and Canon Imaging Systems, Inc.*** (E.D. Tex.) Patent. Lead counsel for Canon in infringement action involving two patents directed to deterministic encryption key generator and system.
- ***Landmark Technology, LLC v. Canon USA Inc.*** (E.D. Tex.) Patent. Lead counsel for Canon in infringement action involving two patents relating to doing business on the Internet.
- ***Personal Audio, LLC v. Apple, Inc. et al.*** (E.D. Tex.) Patent. Lead counsel for Coby Electronics Corporation in infringement action involving two patents directed to MP3 players.
- ***Tsera, LLC v. Apple, Inc. et al.*** (E.D. Tex.) Patent. Lead counsel for Coby Electronics Corporation in infringement action involving a patent directed to MP3 players.
- ***Harthcock v. MIPS Technologies, Inc. et al.*** (E.D. Tex.) Patent. Lead counsel for Yokogawa Corporation of America in infringement action involving microprocessors. Case dismissed with no payment by Yokogawa.
- ***Panavision Imaging, LLC v. Canon USA Inc.*** (C.D. Cal.) Patent. Lead counsel for Canon in infringement action involving four patents directed to image sensors in digital cameras.
- ***California Institute of Technology v. Canon Inc. and Canon USA Inc.*** (C.D. Cal.) Patent. Lead Counsel for Canon in infringement action involving eleven patents directed to image sensor in digital cameras.
- ***Hakim v. Cannon Avent GRP PLC, et al.*** (W.D. La.) Patent. Lead counsel for Cannon Avent Group in action involving two patents directed to non-spill cups. Won dismissal based on summary judgment of noninfringement and invalidity. Federal Circuit affirmed in all respects.
- ***Laboratory Corporation Holdings v. Metabolite Laboratories, Inc. et al.***, U.S. Supreme Court (2006) Counsel for American Express Company.
- ***Trustees of Columbia, et al. v. Columbia/HCA Healthcare Corporation.*** (S.D.N.Y.) Trademark. Lead counsel for Columbia/HCA; defeated motion for temporary restraining order (TRO) and, after full trial, court found for Columbia/HCA based on no infringement and plaintiff's laches and estoppel.
- ***Int'l Nutrition Co. v. Arkopharma, Inc. et al.*** (D. Conn.) Patent. Lead counsel for Arkopharma in action involving patent directed to dietary supplement; successful motion to dismiss for lack of standing; upheld by Court of Appeals for the Federal Circuit.

- ***E. Boselli v. Bosselli Industrie Tessile S.p.A.*** (S.D.N.Y.) Trademark. Lead counsel for Boselli Industries. Settled after dissolving temporary restraining order.
- ***In re certain Daisy Wheel Printers*** (U.S. ITC) Patent. Counsel for Juki Corporation in ITC action involving patent directed to daisy wheel printers.
- ***Cannon Rubber Limited and Avent America, Inc. v. The First Years, Inc.*** (N.D. III.) Patent. Lead counsel for Cannon and Avent in action involving a patent directed to a breast pump; brought into case after district court granted summary judgment of no infringement and successfully argued Federal Circuit appeal.
- ***Duracraft Corp. v. Honeywell, Inc.*** (D. Mass.) Patent, trade dress, false advertising. Lead counsel for Duracraft in action involving patent directed to HEPA cleaner; won summary judgment motion on trade dress count; case ultimately settled.
- ***Citibank, N.A. and Citicorp v. City Bank, et al, City Bank-Rankin and City Financial Bancorp., Inc.*** (N.D. III.) Trademark and contract. Lead counsel for Citibank and Citicorp. After a mini-trial, the court enforced oral settlement agreement and awarded Citibank attorney's fees.
- ***Citibank, N.A. and Citicorp v. Citytrust.*** (E.D.N.Y.) Trademark. Lead counsel for Citibank and Citicorp; case settled favorably for the client after a 13-day trial.
- ***Procter & Gamble Co. v. Nabisco Brands, Inc. et al.*** (D. Del.) Patent. Counsel for P&G in a patent and trade secret case involving sugar chemistry. Settled on eve of trial for payment to P&G of US\$125 million, which was the largest settlement in a patent case at the time.
- ***Sirrio Maccioni d/b/a Le Cirque 2000 v. Genemarco Co. LLC.*** (N.D. Ohio) Trademark. Lead counsel for Le Cirque 2000 in case involving mark "Le Cirque."
- ***Better Methods, Inc. v. Perforated Pattem Co., Inc.*** (S.D.N.Y.) False advertising. Counsel for Better Methods; obtained preliminary and final injunction.
- ***Casco Products Corp. v. Valeo Vision SA*** (S.D. N.Y.) Patent, antitrust and unfair competition. Lead counsel for Valeo Vision in action involving patents directed to automotive lighter assemblies.
- ***Valeo Electrical Sys, Inc. v. Siemens Auto Corp.*** (E.D. Mich.) Patent. Lead counsel for Valeo Electrical Systems in action involving patents directed to automotive fan assemblies; case settled with payment to Valeo.
- ***Veeco Instruments v. Commonwealth Corp.*** (S.D.N.Y.) Patent. Lead counsel for Veeco in action involving patent directed to semiconductor fabrication method; case settled with payment to Veeco.
- ***Duracraft Corp. v. Bionaire Inc. et al.*** (D. Mass.) Patent. Lead counsel for Duracraft in action involving patent

directed to a humidifier; case settled with payment to Duracraft.

- ***Industrial Acoustics Company, Inc. v. Austin Acoustics, Inc.*** (S.D.N.Y.) Patent. Lead counsel for IAC in action involving patent directed to anechoic chambers and components; case settled with payment to IAC.
- ***Industrial Acoustics Co. Inc. v. BVA Systems, Ltd.*** (S.D.N.Y.) Patent. Lead counsel for IAC in action involving patent directed to duct silencer; case settled with payment to IAC.
- ***C. R. Bard, Inc. v. SciMed Life Systems, Inc.*** (D. N.J.) Patent. Counsel for Bard in action involving patents directed to perfusion catheters.
- ***Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*** (D. Ky.) Patent. Counsel for Brown & Williamson in action involving patent directed to tobacco products.
- ***Boehringer Ingelheim GmbH, et al. v. Pharmadyne Laboratories, et al.*** (D. N.J.) Patent and trade dress. Counsel for Boehringer in patent and trade dress case involving pharmaceutical products; judgment for Boehringer after trial.
- ***Condatis LLC v. Arcturus Marine Systems Inc. et al.*** (S.D. Fla.) Patent. Lead counsel for Yokogawa Electric Corporation, Yokogawa Corporation of America and Yokogawa Denshikiki Co. Ltd. in infringement action involving patent directed to a sailboat and new performance optimization system.
- ***LuK Lamellen Und Kupplungsbau GmbH v. Valeo Clutches & Transmission, Inc. and Valeo SA*** (E.D. Mich.) Patent. Lead counsel for Valeo in action involving patent directed to automotive flywheel assembly.
- ***Lemelson Medical, Education & Research Foundation, Limited Partnership v. Alcon Laboratories, et al.*** (D. Ariz.) Patent. Lead counsel for Molson Breweries and Maple Leaf Foods in action involving patents directed to bar code readers and machine vision apparatus.
- ***Mars Incorporated v. Coin Industries, pIc, Coin Controls Limited and Coin Controls, Inc.*** (D. Del.) Patent. Lead counsel for Coin Controls in action involving patent directed to coin recognition apparatus.
- ***Kearns v. Saab Scania (E.D. Mich.)*** Patent. Lead counsel for Saab in action involving patents directed to intermittent windshield wipers systems.
- ***Eckel Industries, Inc. v. Industrial Acoustics, Co. Inc.*** (D. Mass) Patent. Lead counsel for Industrial Acoustics in a patent infringement action involving acoustical wedges in anechoic chambers.
- ***Medical Marketing v. CR. Bard, Inc.*** (N.D. Ga.) Patent. Counsel for Bard in action involving patents directed to urinary catheters.

- **Thomson-Leeds Co. v. Creative Displays, Inc.** (S.D.N.Y.) Patent. Counsel for Creative Displays; successful motion to dismiss for lack of personal jurisdiction.

#### **Admitted in**

- New York
- United States Patent and Trademark Office

#### **Court Admissions**

Supreme Court of the United States

United States Court of Appeals

- Federal Circuit
- Second Circuit
- Third Circuit

United States District Court

- Eastern District of New York
- Southern District of New York

#### **Memberships**

- American Intellectual Property Law Association, IP Practice In Japan Committee, IP Practice In Europe Committee, IP Practice In The Far East Committee
- Intellectual Property Owners Association
- New York Intellectual Property Law Association (NYIPLA)

#### **Publications**

- *Anatomy of a Patent Case*, "Chapter 5: Preliminary Injunction Motions," Complex Litigation Committee of the American College of Trial Lawyers, Federal Judicial Center, 2009
- Co-Author, "Placing Single Use Restrictions On The Sale Of Patented Products Can Avoid Patent Exhaustion And Maintain Market Share," *Metropolitan Corporate Counsel*, February 2006

#### **Speeches & Programs**

- "Recent Federal Circuit Decisions On Damages," American Intellectual Property Law Association, IP Practice In Japan Committee presented to the Judges of the Tokyo IP High Court and the Tokyo District Court, Tokyo, Japan, April 22, 2010
- "Recent Federal Circuit Decisions," American Intellectual Property Law Association, IP Practice In Japan Committee presented to the Japan Patent Attorney Association, Tokyo, Japan, April 20, 2010
- Patentanwaltskammer (German Chamber of Patent Attorneys), March 3, 2010; CNCPI (Professional Association of Intellectual Property Counsel of France), Paris, France, March 2, 2010; "Recent Federal Circuit Decisions And Issues In IP Enforcement," American Intellectual Property Law Association, IP Practice In Europe Committee presented to Chartered Institute of Patent Attorneys, London, England, March 1, 2010
- CNCPI (Professional Association of Intellectual Property

Counsel of France), Paris, France, March 3, 2009; "Patent Enforcement In The ITC," American Intellectual Property Law Association, IP Practice In Europe Committee, presented to Chartered Institute of Patent Attorneys, London, England, March 2, 2009

- "Opinions of Counsel In View of Seagate and Qualcomm Cases", American Intellectual Property Law Association; IP Practice in Japan Committee presented to Japan Patent Attorneys Association, Tokyo, Japan, April 21, 2009
- "Willful Patent Infringement In The U.S.A Sea Change," American Intellectual Property Law Association, IP Practice In Japan Committee, presented to the International Association for the Protection of Intellectual Property (AIPPI) and the Japan Federation of Bar Associations (JFBA), Tokyo, Japan, April 16 2008
- "Injunctions after *eBay v. MercExchange, LLC*," American Intellectual Property Law Association, IP Practice In Japan Committee, presented to the Judges of the IP High Court and the Tokyo District Court, Tokyo, Japan, April 16, 2008
- "Willful Patent Infringement In The U.S.A Sea Change," American Intellectual Property Law Association, IP Practice In Japan Committee, presented to the Japan Intellectual Property Association (JIPA), Tokyo, Japan, April 15, 2008
- "Willful Patent Infringement In The U.S.A Sea Change," American Intellectual Property Law Association IP Practice In Europe Committee Presentation to Chartered Institute of Patent Attorneys (CIPA), London, England, March 3, 2008
- "Recent Federal Circuit Decisions," American Intellectual Property Law Association Mid-Winter Institute, IP Practice in Japan Committee, Presentation to members of Japan Patent Attorneys Association and LES Japan, Phoenix, Arizona, January 22, 2008
- "Permanent Injunctions After *eBay v. MercExchange LLC*," American Intellectual Property Law Association Annual Meeting, IP Practice in Japan Committee, Presentation to members of Japan Patent Attorneys Association and LES Japan, Washington, DC, October 16, 2007
- "*In re Seagate Technology, LLC*, Federal Circuit Changes the Law of Willful Patent Infringement," American Intellectual Property Law Association Annual Meeting, IP Practice in Japan Committee, Presentation to members of Japan Patent Attorneys Association and LES Japan, Washington, DC, October 16, 2007
- "Recent Cases on Inequitable Conduct and Unenforceability," American Intellectual Property Law Association, 30th Mid-Winter Institute, New Orleans, Louisiana, January 24-27, 2007
- "Recent Federal Circuit Decisions," joint meeting of the American Intellectual Property Law Association's IP Practice in Japan Committee and the Japan Patent Attorneys Association, Tokyo, Japan, April 20, 2007
- "Basics of Patent Law Enforcement," Federal Bar Council, June 2006
- "Recent Federal Circuit Decisions," American Intellectual Property Law Association Annual Meeting, Washington, DC, October 16, 2006
- "Patent Exhaustion, Repair/Reconstruction and Single Use Restrictions-A U.S. Perspective," The Licensing Executives Society Japan; The International Association for the Protection of Intellectual Property (AIPPI), Japan; and Japan Federation of Bar Associations, May 2006

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- "Recent U.S. Trademark Decisions," Japan Trademark Association, May 2006
- "Electronic Records Retention and Production: Getting it Right," IPR Summit, Bangalore, India, January 2006
- "Prefiling Issues in Electronic and Computer Patent Law," PLI Seminar on Electronics and Computer Law, March 29, 1990

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