



**James J. DeCarlo**

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**Intellectual Property & Technology | Intellectual Property Litigation**

James J. DeCarlo is an Intellectual Property Shareholder in Greenberg Traurig’s New York and New Jersey offices. A registered patent attorney and Electrical Engineer, he is actively involved in virtually all aspects of intellectual property counseling. Jim’s experience includes litigating patent matters in District Courts around the country, handling matters before the PTAB, counseling clients on the strategic use and management of intellectual property assets and drafting infringement, validity and freedom to operate opinions. He also counsels clients on the drafting and negotiating of complex technology agreements and directs the prosecution of patent applications in areas such as electronic commerce, cloud computing, virtual and augmented reality, streaming media, Internet search engines, search advertising, client/server systems, mobile and land based telecommunications, and computer software and hardware. In addition, Jim’s matters have covered other wide ranging technology areas including semiconductors, semiconductor fabrication, pharmaceuticals, medical devices, fiber optics, cameras, injection molding, manufacturing, toys, pulp and paper, steel production, electronics and electro-mechanical devices.

**Areas of Concentration**

- > Intellectual property litigation
- > Intellectual property counseling
- > Patent procurement
- > Technology and emerging companies

**Significant Representations**

- > *Texas Patent Imaging LLC v. FUJIFILM Holdings America Corp.*, 2:16-cv-00356-JRG-RSP, Eastern District of Texas.
- > *Verify SmartCorp. v. Yahoo! Inc.*, 2:15-cv-07965, District of New Jersey.
- > *Raster Printing Innovations v. Fujifilm Holdings*, 1:15-cv-03964, Northern District of Illinois.
- > *eDigital v. FujiFilm Corporation, et al.*, 3:13-cv-00112, Southern District of California.

- > *LED Tech Development, LLC v. Fujitsu America, Inc.: Fujitsu Ltd.*, 1:12-cv-01443, District of Delaware.
- > *GeoTag, Inc. v. Canon Inc., and Canon U.S.A., Inc.*, 2:12-cv-00043, Eastern District of Texas.
- > *Data Carriers, LLC v. Fujitsu America, Inc.*, 1:12-cv-00332, District of Delaware.
- > *Walker Digital LLC v. FUJIFILM North America Corporation*, 1:11-cv-00326, District of Delaware.
- > *e.Digital v. Canon USA, Inc. and Canon Inc.*, 1:09-cv-2578, District of Colorado.
- > *Ambato Media, LLC v. Garmin International, Inc., et al.*, 2:09-cv-242, Eastern District of Texas.
- > *Furnace Brook LLC v. Aéropostale, Inc., et al.*, 1 :09-cv-4310, Northern District of Illinois.
- > *VoxPath Networks, Inc. v. Broadview Networks, Inc., et al.*, 4:08-cv-127, Eastern District of Texas.
- > *Bennett v. Alcoa Inc., et al.*, 2:07-cv-00558, Eastern District of Texas.
- > *NextCard, LLC v. American Express Company, et al.*, 2:07-cv-354, Eastern District of Texas.
- > *In re Certain Laminated Floor Panels*, Investigation 337-TA-545, U.S. Int'l Trade Comm.
- > *Turn-Key-Tech, LLC v. Fuji Photo Film USA, et al.*, 01-1490-B, Southern District of California.
- > *Touchstone Technology, Inc., et al. v. Fuji Photo Film, et al.*, 00-1-700, District of Massachusetts.
- > *Connectel, LLC v. Arbinet Holdings, Inc.*, 00-3354, Southern District of New York.
- > *In re Certain Lens Fitted Photographic Film Packages*, Investigation 337-TA-406, U.S. Int'l Trade Comm.

#### Professional and Community Involvement

- > Patent Litigation Committee On-line Program Coordinator, American Intellectual Property Lawyers Association
- > Former Co-chair, Intellectual Property Section, New York County Lawyers Association
- > Member, American Bar Association
- > Member, New York Bar Association

#### Awards and Recognition

- > Listed, *Chambers USA Guide*, 2014-2016
- > Listed, *IAM* magazine, "The IAM Patent 1000," 2014-2016
  - Patent Litigation and Transactions, 2015
  - Patent Litigation, 2014
- > Member, Winning Team, *New Jersey Law Journal's* "General Litigation Department of the Year" award, 2013

- > Rated, AV Preeminent® 5.0 out of 5

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## Articles, Publications & Lectures

### Lectures/Panels

- > Speaker, "Patent Strategies to Strike Back Following the 'Alice Storm' Aftermath," The Knowledge Group Webcast, August 11, 2016
- > Speaker, "The Dos and Don'ts of Functional Claiming After *Williamson v. Citrix*," ABA Landslide Series Webinar, April 2016
- > Moderator, "The Alice Test: Is the Concept of Preemption for Ineligible Subject Matter a Dead Issue?" Patent Disputes Conference, April 2016
- > Speaker, "Patent Litigation Best Practices, Bench and Bar Perspectives," Patent Disputes Conference, May 2015
- > Panelist, Post Grant Proceedings, Patent Disputes Forum
- > Panelist, Patent Reform Legislation, General Counsel Summit, Law Foundation of Silicon Valley
- > Lecturer, Biting Back at Patent Trolls, Ryuka Law Lecture Series, Tokyo, Japan
- > Panelist, Anti-Troll Strategies
- > Panelist, Choosing the Right IP Protection Business Model; Association for Laboratory Automation LabFusion: Innovation Management
- > Lecturer, Developing a Culture of Protection; Drug Discovery Technology Conference
- > Session Chair, Strategies for Successful Biotech Financing; Society for Biomolecular Screening Annual Conference: Intellectual Property and the Business Deal
- > Lecturer, NYU Stern School of Business Entrepreneurs Forum: Intellectual Property Law Concerns For the Start-Up Company
- > Lecturer, NYU School of Continuing Professional Education: Patent Law Basics
- > Lecturer, New York County Lawyer's Association, Patent Law for the Non-Patent Lawyer
- > Continuing Legal Education Lectures: Patent Reform Legislation Update; Patent Law Changes Post AIA; Advanced Trademark Issues; Intellectual Property Basics; Using Videotaped Depositions During Cross Examination; Effective Use of Demonstrative Exhibits in Patent Cases; Intellectual Property Issues for the Entrepreneur; Drafting and Negotiating Non-Disclosure Agreements

### Articles

- > Co-Author, "[McRO v. Bandai: The Return of Preemption after Alice](#)," *Inside Counsel*, October 14, 2016
- > Co-Author, "Patent Eligibility After 'Alice': Light At the End of the Rabbit Hole?" *New Jersey Law Journal*, June 10, 2016

- > Co-Author, "Drafting Software Patents After Recent Federal Circuit Decisions," *New Jersey Law Journal*, November 25, 2015
- > Co-Author, "Biting Back at Patent Trolls," *GT Press*, 2014
- > Author, "The Board's Responsibility for IP Management," *Corporate Governance Advisor/Aspen Corporations Reports*, January 2005
- > Author, "Savvy Prospectors Can Reap Patent Mining Rewards," *Licensing in the Boardroom*, October 2004
- > Author, "The IP Audit," *Stroock Special Bulletin*, July 2004
- > Co-author, "California's Anti-Computer Spyware Statute Goes into Effect," *Stroock Special Bulletin*, February 2005
- > Co-author, "California Online Privacy Protection Act," *Stroock Special Bulletin*, September 2004
- > Co-author, "The Intellectual Property Audit: An Effective IP Asset Management Tool," *Journal of Biomolecular Screening*, April 2003
- > Co-author, "Invention Disclosures Can Streamline Patent Paperwork," *SBS News*, February 2003

#### Education

J.D., *cum laude*, New York Law School, 1991

B.S., Electrical Engineering, Worcester Polytechnic Institute, 1980

#### Admitted to Practice

- > New Jersey
- > New York
- > U.S. Patent and Trademark Office
- > U.S. Court of Appeals for the Federal Circuit
- > U.S. District Court for the Eastern District of New York
- > U.S. District Court for the Southern District of New York
- > U.S. District Court for the District of New Jersey
- > U.S. District Court for the Eastern District of Texas
- > U.S. District Court for the District of Colorado
- > U.S. District Court for the Western District of Wisconsin