

Sean Casey

Orange County, California
Shareholder

P (949) 224-6456
F (949) 720-0182
scasey@buchalter.com

Areas of Practice & Industry Specialties

Intellectual Property Law; Litigation; Trade Secrets & Employee Mobility; Privacy & Data Security Law



Sean Casey is a member of the Intellectual Property, Corporate, and Litigation Practice Groups in the Firm's Orange County office. Mr. Casey's practice involves all aspects of intellectual property and related areas in complex domestic and cross-border litigation and transactional matters. He represents clients in matters involving patents, copyrights, trademarks, and trade secrets in many industries, including aerospace, automotive, ecommerce, electronics, information technology, medical device, software, and consumer products technology areas.

In addition to his district court and administrative tribunal litigation practice, Mr. Casey's transactional practice includes large enterprise and small business technology portfolio management and monetization. His practice includes licensing and contracts, corporate and asset valuation and capitalization, patent / trademark clearance, acquisition, and enforcement, supplier and distribution agreements, and analyses including IP validity, patentability, infringement, and enforceability opinions. He actively assists clients with inventor education, iterative engineering/patenting design around efforts, industry technology monitoring, competitor portfolio analysis and monitoring, patent technology data mining, and investor, joint venture, and technology partner collaborations.

Mr. Casey is well versed in drafting, reviewing, analyzing, and negotiating multinational, commercial, and governmental agreements, which enable joint venture, investor, and technology development, as well as supplier and manufacturer relationships (long-lead, short-term, advanced production planning), and distribution and sales. Mr. Casey also has hands-on experience in federal and university engagements and procurement, including issues surrounding export controls, and DOD and FDA requirements of the U.S. Code, CFRs, FARs, & DFARS, and related rules, procedures, & guidance.

Representative Matters

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- *Jason Marketing Co. v. Rampart Glove et al.*, plaintiff, trademark, won on pleadings and motions for summary judgment. Successfully prosecuted trademark claims on behalf of medical supplies manufacturer against competitor, and obtained injunctive relief, seizure order, and recovery of economic damages and legal fees.
- *Atwood Industries et al. v. Norco Industries*, defense, patent, extensive fact, technology, & witness discovery, won on pleadings & motions for summary judgment, awarded fees and costs. Defended aftermarket recreational vehicle manufacturer in patent infringement action, and obtained summary judgment of non-infringement, invalidity, and obtained an exceptional case ruling awarding fees and costs.
- *ICU Medical v. Tristate Hospital Supply*, plaintiff, patent infringement, settled pre-trial. Achieved pretrial, court-house steps settlement of patent infringement claims for plaintiff medical device manufacturer, resulting in injunction and damages payment from infringing competitor. Proved exceptional case, awarded fees & costs.

- *Critical Device Corp. et al. v. ICU Medical*, DJ defense, trade secret theft. Defended against theft of trade secrets claims asserted by competitor against client medical device manufacturer, forcing plaintiff to dismiss all claims.
- *Rembrandt Photo Services v. Pyramid Plastics, Roundhouse, et al.*, defense, patent, extensive discovery leading to settlement on close of discovery. Defended plastic products manufacturer against patent infringement claims of competitor, and forced dismissal with draft summary judgment motions of non-infringement and invalidity.
- *Charles E. Hill v. CompuServe, America Online, et alia.*, defense, SW patent infringement. Successfully defended large internet media clients, and collaborated with counsel for IBM in parallel proceedings, against patent infringement claims by limiting claim scope during claim construction briefings, and disposing of remaining claims with winning summary judgment motion of non-infringement.
- *DuroLast v. Custom Seal*, defense, patent, discovery, pre-trial, trial pleadings, won pretrial motions, jury found for defense, win affirmed on appeal. Assisted in trial defense of roofing products manufacturer, reduced patent infringement exposure with successfully summary judgment motions limiting claim scope and eliminating asserted patent claims as being noninfringed, resulting in jury verdict of no infringement of remaining claims. Verdict and summary judgments affirmed on appeal.
- *Block Financial v. Destiny Software et al.*, plaintiff, patent, discovery & pleadings. Successfully asserted patent infringement claims on behalf of client software manufacturer against competitor, achieving favorable pretrial settlement and voluntary injunction.
- *Harris Instrument Corp. v. Banner Engineering*, plaintiff, patent, settled on close of extensive fact & witness discovery. Enabled client-plaintiff to minimize costs and liability exposure in patent infringement claims asserted against competitor, which became untenable during discovery phase, and negotiated no-cost dismissal of counterclaims with defendant.
- *Paxton K. Beale v. Med-Pro et al.*, plaintiff, patent infringement, discovery and pleadings. Negotiated favorable license and royalty provisions for client plaintiff, while prosecuting patent infringement action against competitor to ensure optimal benefits for client and patent portfolio.
- *Ross Industries v. Industrial Vehicle Specialties et al.*, plaintiff, trademark, cybersquatting, ghost wrote pleadings for GP law firm, prepared complaint, affidavits, and evidence that forced pre-filing settlement. Prosecuted trademark infringement and cybersquatting claims for plaintiff client against multiple defendants, preventing brand injuries while obtaining voluntary injunction and fees and costs for client.
- *Internet Transaction Partners v. PayMyBills.com & Paytrust, Inc.*, defense, trademark, settled after comprehensive discovery effectively limited plaintiff's damage contentions. Defended internet clients against trademark infringement claims with comprehensive defense strategy that forced plaintiff to revise and drastically limit damage contentions, while negotiating favorable trademark concurrent use agreement that enabled client to continue operations without changes to branding.
- *SMG Marketing v. Jennifer Braley et al.*, defense, patent, won default judgment after brief but thorough discovery. Successfully defended and protected small business owner from overbroad patent infringement claims by successful summary judgment and default judgment motions.
- *Pearpoint Ltd, SPX, et al. v. SRECO Flexible*, defense, common law trademark, settled after win on summary judgment. Enabled common law trademark owner / client to protect nationwide brand despite having allowed federal trademark registrations to lapse, and negotiated favorable settlement after succeeding on summary judgment motions directed to dispositive issues of continuous and nationwide use of client marks.
- *SRECO Flexible v. Sewer Equipment Corp of America*, plaintiff, contempt, trademark injunction, won damages, fees and costs. Successfully prosecuted common law, nationwide trademark infringement claims in three district courts (California, Illinois, Ohio, and Utah), and a fourth action (Utah) action for breach of prior injunction claims against competitor, protecting client's nationwide brand despite having allowed federal trademark registrations to lapse, resulting in multiple large damages, fees, and costs awards in favor client.
- *Columbus State Community College (Ohio AG) v. John Barry et al.*, plaintiff, trademark, cybersquatting, after asset searches, won default/summary judgment, judgment enforcement. Successfully enjoined

cyber-squatter from continued use of client trademarks, resulting in ICANN transfer of domains to client, award of fees and costs and permanent injunctive relief.

- *The Home Store LLC v. TheHomeStore.com*. Enforced common law trademark claims of senior trademark user in local mid-west real estate market, against federal trademark owner attempting to expand identical trademark use into senior user's market. Successfully negotiated substantial monetary settlement on behalf of senior user client.

Education

Mr. Casey earned his J.D., in Intellectual Property and Aviation, from Southwestern Law School. Mr. Casey earned a B.S., *cum laude*, in Aerospace/ Mechanical Engineering from Boston University.

Bar Admissions

- U.S. Patent and Trademark Office
- California
- Ohio

Court Admissions

- United States Supreme Court
- Supreme Court of California
- Supreme Court of Ohio
- Federal Circuit Court of Appeals
- United States Patent and Trademark Office, Registered Patent Attorney
- USPTO Patent Trial and Appeal Board
- United States Court of Appeals for the Sixth Circuit
- United States Court of Appeals for the Ninth Circuit
- United States District Court for the Central District of California
- United States District Court for the Eastern District of California
- United States District Court for the Northern District of California
- United States District Court for the Southern District of California
- United States District Court for the Northern District of Ohio
- United States District Court for the Southern District of Ohio

Community

- Atlantic Legal Foundation
- Association of Corporate Counsel
- LA Intellectual Property Law Association
- South Bay Aerospace Alliance
- PTAB Bar Association
- Orange County Bar Association
- Federal Bar Association
- Intellectual Property Owners Association
- American Intellectual Property Law Association (AIPLA)