



Gino Cheng

Partner

Admitted to practice only in Patent and Trademark Office and California

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Gino is a registered U.S. patent attorney with an engineering background. He focuses his practice on intellectual property disputes, cross-border arbitration, and licensing negotiations. He serves as a member of the firm’s Technology, Media & Telecom Industries Group as well as the cross-functional Cryptocurrencies, Digital Assets and Blockchain Technology Group.

Since joining Winston in 2014, Gino has represented leading companies in the console and PC video game industry (Electronic Arts, Take-Two Interactive Software, 2K Sports, Rockstar Games), the medical device industry (Medtronic), the vision care industry (Hoya, EHS Lens), the semiconductor/LED industry (Macronix, Everlight Electronics), and blockchain technology companies.

Gino has also represented clients in complex IP disputes in international arbitration, in U.S. federal district courts, at the federal appellate court level, and at the United States Patent and Trademark Office (USPTO). His experience further includes both patent and trademark prosecution, namely *inter partes* and *ex parte* proceedings before the U.S. Patent Trial and Appeal Board (PTAB) and Trademark Trial and Appeal Board (TTAB). Clients in multimillion-dollar, high-stakes litigation have commended Gino’s courtroom savviness, praised his “professional excellence,” and rated him as a “first class” attorney.

Gino has successfully instituted *inter partes* review of asserted patents on defense, and successfully defeated institution of IPRs on offense for clients in various tech industries. He has experience with a wide range of technologies, including flash memory, semiconductors, probe polish and debris removal, mobile phones, chemically strengthened cover glass, bendable glass, optical amplifiers, photonics, wave-division multiplexed systems, telecommunication systems, LTE, signal transport protocols, digital media recorders and players, optical storage media, magnetic storage media, thin lithium batteries, optoelectronics, LEDs, touch-panels, optics, progressive lenses, blockchain, distributed networking, plant- and factory-level control systems, and time-multiplexed emulation systems. Gino's strong background in technology includes a technical degree in electrical engineering.

Gino has represented clients in California state court and various federal district courts throughout the United States, including those in the Eastern District of Texas, District of Delaware, Northern District of California, Eastern District of Virginia, Middle District of Florida, Northern District of Illinois, and District of Oregon. He is admitted to practice in the United States District Courts for the Central and Northern Districts of California, the U.S. Court of Appeals for the Federal Circuit, the Supreme Court of the United States, and before the United States Patent and Trademark Office.

Gino served as a co-author of an amicus brief in the landmark *Lexmark* case on behalf of HTC Corp. and HTC America, Inc., in support of the winning position handed down by the United States Supreme Court in May 2017. This case arose out of a dispute relating to spent and refilled printer cartridges and has broad implications for licensed manufacturing and gray market goods. By a seven to one majority, the Supreme Court held that the authorized sale of a patented product releases (or 'exhausts') the holder's U.S. patent rights, regardless of the location of sale or existence of post-sale restrictions. *Lexmark* addresses the much-debated issues of extraterritoriality and conditional sales that had complicated the first-sale doctrine.

Prior to law school, Gino worked for the world's largest optical media manufacturer.

Key Matters

A sample of Gino's experience includes:

- Representing a top 10 global PC and console game developer in state court to a final judgment finding liability of major competitor for breach of a copyright settlement agreement.
- Successfully defending Electronic Arts Inc.'s most popular video games, *FIFA 15*, *FIFA 16*, *NHL 15*, *NHL 16*, *PGA Tour 14*, *Plants vs. Zombies: Garden Warfare*, in multiple venues to a final judgment of non-infringement on six network architecture patents asserted by a non-practicing entity.
- Successfully defending Take-Two Interactive Software, Inc.'s and its subsidiaries' most popular video games, *Grand Theft Auto V*, *NBA 2K15*, *NBA 2K16*, in multiple venues to a final judgment of non-infringement on six network architecture patents asserted by a non-practicing entity.
- Representing another top three global gaming company and its subsidiary in multiple patent infringement litigations involving software and peer-to-peer network management.
- Representing a top three global specialty materials and optical solutions provider in a cross-border IP-related arbitration.
- Counseling a top five global developers of advanced process control solutions in adversarial, cross-border patent licensing negotiations involving industrial test, measurement, control, and information technologies.
- Auditing a Forbes Asia Fab 50 company in mainland China for compliance with licensing terms.
- Assessing a Forbes Global 2000 company in mainland China for data security breaches and theft.
- Investigating a top five global smartphone manufacturer for trade secret misappropriation.

- Representing a leading Taiwanese semiconductor manufacturer in multiple section 337 ITC actions involving non-volatile memory products.
- Counseling a top three global specialty materials manufacturer regarding enforcement of its patents covering smartphone components.
- Representing a top three global ophthalmic lens designer and manufacturer and its subsidiaries in a patent infringement litigation involving progressive lens technology.
- Counseling a top five global telecom equipment manufacturer and its subsidiaries regarding section 337 ITC actions involving LTE wireless device products.
- Representing a top 10 global distributed control system supplier in patent licensing negotiations involving industrial plant management tools and controllers.
- Representing a leading photonics technology manufacturer and its subsidiaries in multiple patent infringement litigations involving optical communication products.
- Representing a leading global LED manufacturer and its subsidiaries in a patent infringement litigation involving semiconductor packaging technology.
- Representing a leading global probe card cleaning materials manufacturer in a patent infringement litigation involving semiconductor probe polishing technology.
- Representing a leading smartphone manufacturer in multiple patent infringement litigations involving mobile devices and coding algorithms.
- Representing a leading CAD tool developer and its subsidiaries in a patent litigation seeking declaratory judgment on various patents involving hardware emulation technology.
- Representing a leading consumer electronics manufacturer in a patent infringement litigation involving digital media and handheld devices.
- Representing a leading LED manufacturer in intellectual property licensing negotiations involving semiconductor chip and packaging technologies.
- Representing a leading primary battery manufacturer in intellectual property licensing negotiations involving flexible microbattery technology.
- Representing a photonics technology manufacturer in intellectual property licensing negotiations involving optical communication technology.
- Representing an electronics developer in intellectual property licensing negotiations involving media storage technology.
- Counseling a crypto-currency start-up in intellectual property licensing negotiations involving blockchain- and consensus-protocol-based technology.
- Representing the World Parkinson Coalition in various trademark-related matters.
- Representing Helen Keller International and its subsidiaries in various copyright-related matters.

Activities

Gino is a member of the Law Society of Hong Kong.

“Led by Gino Cheng—who is praised for his ‘ability to understand

complex technologies’—Winston & Strawn LLP is known in the market for the ease with which it is able to ‘work seamlessly together’ with lawyers from across the firm’s international network on cross-border contentious matters.” ”

The Legal 500 Asia-Pacific 2020

“ “[Gino Cheng has] excellent pedigree representing Asian clients in patent disputes in the [U.S.] federal courts and International Trade Commission (ITC) investigations.” ”

The Legal 500 Asia-Pacific 2019

Credentials

EDUCATION

Gino received his B.S. in engineering sciences (electrical) and his B.A. in humanities with distinction from Yale University in 2004, prior to which he had completed three terms at the University of Oxford. He received his J.D. with an intellectual property concentration from Benjamin N. Cardozo School of Law in 2008, where he served as notes editor on the *Cardozo Journal of Conflict Resolution* and where his note, “Doubling Up the Horses in Midstream: Enhancing U.S. Patent Dispute Resolution by the PTO’s Adoption of the JPO’s *Hantei* Request System,” was awarded first place in the annual *Santa Clara Computer & High Technology Law Journal’s* Comments Contest in 2007. Gino was a recipient of the Association of the Bar of the City of New York Diversity Fellowship in 2005.

ADMISSIONS

- Patent and Trademark Office
- California

LANGUAGES

- English
- Japanese
- Mandarin

Related Insights & News

Gino is a frequent speaker and writer on legal issues affecting his practice. His recent work follows.

WINSTON PUBLICATIONS

- “Does the New U.S.-Taiwan Bilateral Trade Mandate Signal the End of U.S. Adherence to the One-China Policy? Multinational Companies Should Expect a Catch-22 Soon,” *Global Trade & Foreign Policy Insights*, Aug. 23, 2022
- “Taiwan’s MOJ Raids 10 Chinese Tech Companies for Local Talent Poaching Immediately After Taiwan’s Legislature Amends Its Anti-Espionage Law to Include Stiff Penalties,” *Winston & Strawn Insights*, Jun. 2, 2022

- “Hong Kong Citizen Indicted for Conspiracy to Pass Million-Dollar Semiconductor-Related Trade Secrets to China,” Winston & Strawn Insights, Mar. 23, 2021
- “New Judicial Interpretation in China Strengthens Protection of Trade Secrets,” Winston & Strawn Insights, Jan. 5, 2021
- “Korean LED Manufacturer Prevails in Local Criminal Case against Major Taiwanese Competitor,” Sep. 9, 2020
- “U.S. International Trade Commission To Review Default Judgment Against South Korean EV Battery Component Maker,” Winston & Strawn Insights, Apr. 20, 2020
- “2019 Trade Secrets Mid-Year Review,” Winston & Strawn Publication, Aug. 20, 2019
- “Another Stain, Albeit an Inexpensive One, on Huawei’s Trade Secret Practices,” Winston & Strawn Insights, Jul. 2, 2019
- “Taiwanese District Court Sentences Company Executive to Prison for Theft of Trade Secrets Relating to Optical Film Coating,” Winston & Strawn Insights, Jun. 24, 2019
- “Researcher Arrested on Charges of Hiding His Connections to PRC-Sponsored Talent Recruitment Program From His Long-Term U.S. Government Employer,” Winston & Strawn Insights, Jun. 6, 2019
- “Federal Circuit Gives ITC Respondent Chance to get its ‘Swag’ Back, Reaching Res Judicata Decision on Trademark Claim That may be Argued to Have Trade Secret Implications,” Winston & Strawn Insights, Jun. 3, 2019
- “Former Top Designer Sentenced to Nearly Eight Years in Prison by Taiwanese Court for Trade Secret Misappropriation,” Winston & Strawn Insights, May 20, 2019
- “China Revises Anti-Unfair Competition Law to Further Enhance Trade Secret Protection,” Winston & Strawn Insights, May 13, 2019
- “Intellectual Property Concerns Take Center Stage Before the U.S. Senate Judiciary,” Winston & Strawn Insights, Mar. 21, 2019
- “ITC Complainant Throws a Wrinkle in Korean Pharmaceutical’s Bid to Introduce New Botox Product into the U.S.,” Winston & Strawn Insights, Mar. 7, 2019
- “2019 Trade Secrets Year in Review,” Winston & Strawn Publication, Jan. 22, 2020
- “Taiwanese Prosecutors Indict Four Former Employees Over Suspected Theft of Valuable Virtual Reality Research for Competing PRC Micro-Electronics Manufacturer,” Winston & Strawn Insights, Jan. 21, 2019
- “Taiwanese Officials Arrest Six Engineers Over Suspected Theft of Chemical Solutions and Process Flows to Aid Competing Chinese Electronics Manufacturer,” Winston & Strawn Insights, Jan. 14, 2019
- “Rights-Holding Complainant in U.S. ITC Investigation Need Not Re-Litigate Trade Secret Theft Issue in U.S. District Court,” Winston & Strawn Insights, Dec. 27, 2018
- “China Says It Will Blacklist and Sideline Repeat Intellectual Property Right Violators,” Winston & Strawn Insights, Dec. 10, 2018
- “California Passes First State Law Requiring Manufacturers to Secure Internet-Connected Devices,” Winston & Strawn Insights, Nov. 5, 2018
- “Section 230 Applies to Trade Secret Claims in Craft Beer Franchisor Suit Against Glassdoor,” Winston & Strawn Insights, Oct. 29, 2018
- “Global LED Manufacturer Alleges Half Billion Dollar Theft and Industrial Espionage by Former Employees and Fierce Rival,” Winston & Strawn Insights, Oct.10, 2018

EXTERNAL PUBLICATIONS

- “Collecting Electronic Evidence in China? Beware!” *Corporate Counsel*, Oct. 23, 2019
- “A Fresh Look at Japanese Trade Secret Protection,” *Today’s General Counsel*, Sep.18, 2019

- “Hong Kong-China Agreement Offers Advantages For IP Cases,” Law360, Mar. 7, 2019
- “Is There a Trilemma Associated with Using Blockchain to Protect Trade Secrets?” Legaltech News, Feb. 2019
- “Trade Secrets, Cross-Border Disputes, and the ITC (Part Two),” *Hong Kong Lawyer*, Dec. 2018
- “Trade Secrets, Cross-Border Disputes, and the ITC (Part One),” *Hong Kong Lawyer*, Nov. 2018
- “The Issue of Lost Profits Stemming from Lost Service Contracts Abroad ION-izes the Federal Circuit,” *Bloomberg BNA’s Patent Trademark & Copyright Journal*, Jan. 8, 2016
- “JVC v. Nero’s Strategic Retreat From The Precipice Of Patent Exhaustion,” *Bright Ideas (New York State Bar Association Intellectual Property Law Section Publication)*, Vol. 24, No. 3, Winter 2015
- “What Fed. Circ. Is Considering In Patent Exhaustion Case,” Law360, Dec. 15, 2015
- “Piggybacking Off Of Another’s Patent License,” *Intellectual Property Magazine*, Dec. 8, 2015
- “Whether The Federal Circuit Chose The Strongest Response Or The Best Response To The Patent Exhaustion Question In *JVC Kenwood v. Nero*,” *Keep Your Counsel*, Oct. 1, 2015
- “LifeScan May Be Why Patent Exhaustion Had No Pulse In *Nero*,” Law360, Sept. 29, 2015
- “Finding a Place for *Mallinckrodt* and Conditional Sales in the Patent Exhaustion Doctrine: Will ‘Lex’ Mark the Spot?” *New Matter (The State Bar of California’s Intellectual Property Law Section Publication)*, Vol. 40, No. 3, Fall 2015
- “Whether International Sales Under Worldwide Licenses Exhaust U.S. Patents: The Days of the *Jazz Photo*, *Ninestar*, and *Benun* Line of Cases may be Numbered,” *Bloomberg BNA’s Patent Trademark & Copyright Journal*, Jul. 24, 2015
- “Helping the U.S. Federal Circuit Find a Place for *Jazz Photo* in the Legal Landscape of International Patent Exhaustion: Will ‘Lex’ Mark the Spot?” *Keep Your Counsel*, Jul. 15, 2015
- “Runaway Jurisprudence: Has the ‘But For’ Test for Proving Inequitable Conduct in Patent Cases Gone Awry, Gone Rogue, or Gone Quiet?” *New Matter (The State Bar of California’s Intellectual Property Law Section Publication)*, Vol. 40, No. 2, Summer 2015
- “Quanta-fying *Helferich Patent Licensing’s* Contribution To The Exhaustion Doctrine,” *Bloomberg BNA’s Patent Trademark & Copyright Journal*, Apr. 10, 2015
- “The Future of ‘Egregious Misconduct’ in Patent Cases,” Law360, Jul. 7, 2014
- “Therasense Revisited: *In re Rosuvastatin Calcium Patent Litigation* and the Interplay Between Reissue and Inequitable Conduct,” *Bloomberg BNA’s Patent Trademark & Copyright Journal*, Apr. 5, 2013. Republished in *Bloomberg BNA Pharmaceutical Law & Industry Report*, Apr. 12, 2013.
- “Inequitable Conduct: One Thing Less to Worry About, One More Thing to Consider,” *New Matter (The State Bar of California’s Intellectual Property Law Section Publication)*, Vol. 38, No. 1, Spring 2013
- “Inequitable Conduct: Rethinking Egregious Misconduct,” Law360, Jan. 9, 2013
- “Overcoming Structural Indefiniteness for Means-Plus-Function Claims After *Telcordia v. Cisco*: Is the Bar for Structural Sufficiency a Moving Target?” *Bloomberg Law Reports*, Mar. 14, 2011

SPEAKING ENGAGEMENTS

- “Additional Perspectives on Intellectual Property at the U.S. International Trade Commission,” Yuanda IP Seminar, Shanghai, May 23, 2023
- “Alice in Hardware Land: Whether Smart Cities are Patent-Ineligible in the U.S.,” Taiwan Optoelectronic Semiconductor Industry Association (TOSIA) IP Committee, Hsinchu, Taiwan, Jul. 9, 2019
- “Trade Secrets Actions in Practice,” Taiwan Optoelectronic Semiconductor Industry Association (TOSIA) IP Committee, Hsinchu, Taiwan, Jul. 9, 2019

- “International Trade Secret Laws,” Winston Four-Part Webinar Series, Hong Kong, Jun. 19, 2019
- “The Importance of Being Earnest: Pitfalls Faced by Applicants in the U.S. Patent System,” CPD Seminar, Hong Kong, Oct. 3, 2017
- “Issues with Licensing Upstream and Downstream Participants in the Same Distribution Chain,” Licensing Executives Society Chinese Taipei (LESCT), Taipei, Jul. 1, 2016
- “Updates on the European Unitary Patent,” Licensing Executives Society Chinese Taipei (LESCT), Taipei, Jul. 1, 2016
- “Inequitable Conduct in Patent Cases,” IP Business Strategy for Gaining Strategic Advantage in U.S. Markets, Taipei, May 27, 2016
- “Taiwan Hot Topic: Patent Exhaustion in the Global Economy,” IP Business Strategy for Gaining Strategic Advantage in U.S. Markets, Taipei, May 27, 2016
- “Update on Recent U.S. Federal Circuit Briefing: How To Structure Licenses To Avoid Patent Exhaustion,” Licensing Executives Society Chinese Taipei (LESCT), Taipei, Oct. 22, 2015
- “Recent U.S. Court Decisions and Developments Affecting Licensing,” Licensing Executives Society Chinese Taipei (LESCT), Taipei, Jul. 17, 2015
- “Quanta-fiable Differences in U.S. Law on Patent Exhaustion,” PRIP Tokyo, N.P.O., University of Tokyo, RCAST, and the National Graduate Institute for Policy Studies (GRIPS), Tokyo, Apr. 16, 2015
- “Alternative Dispute Resolution for Patent Disputes: A Focus on Technology Valuation,” PRIP Tokyo, N.P.O., University of Tokyo, RCAST, and the National Graduate Institute for Policy Studies (GRIPS), Tokyo, Apr. 16, 2015

RECOGNITIONS

Winston Team Highlighted in Litigator of the Week Column

OCTOBER 14, 2022

BLOG

Does the New U.S.-Taiwan Bilateral Trade Mandate Signal the End of U.S. Adherence to the One-China Policy? Multinational Companies Should Expect a Catch-22 Soon.

AUGUST 23, 2022

BLOG

Taiwan’s MOJ Raids 10 Chinese Tech Companies for Local Talent Poaching Immediately After Taiwan’s Legislature Amends Its Anti-Espionage Law To Include Stiff Penalties

JUNE 2, 2022

BLOG

CFIUS Is Preparing to Block China from Acquiring Magnachip Semiconductor Corporation

AUGUST 31, 2021

BLOG

What Dealmakers Need to Know About CFIUS and Semiconductors

JULY 21, 2021

BLOG

Hong Kong Citizen Indicted for Conspiracy To Pass Million-Dollar Semiconductor-Related Trade Secrets To China

MARCH 23, 2021

RECOGNITIONS

Winston and Yuanda Recognized in *The Legal 500 Asia Pacific 2021*

JANUARY 22, 2021

BLOG

New Judicial Interpretation in China Strengthens Protection of Trade Secrets

JANUARY 5, 2021

BLOG

Korean LED Manufacturer Prevails in Local Criminal Case against Major Taiwanese Competitor

SEPTEMBER 9, 2020

BLOG

U.S. International Trade Commission To Review Default Judgment Against South Korean EV Battery Component Maker

APRIL 22, 2020

NEWS

Judge Rules for Winston Client in Videogame Patent Dispute

MARCH 25, 2020

RECOGNITIONS

Winston Named as IAM Patent Litigation Firm of the Year

JANUARY 30, 2020

Capabilities

Intellectual Property

International Arbitration

International Trade

ITC – Section 337

Patent Litigation

Privacy & Data Security

Trademark Litigation, Prosecution & Brand Protection

Trade Secrets, Non Competes & Restrictive Covenants

Litigation/Trials

Technology, Media & Telecommunications

Cryptocurrencies, Digital Assets & Blockchain Technology

Medical Devices

Life Sciences