MARSHALL GERSTEIN ip

Benjamin T. Horton

Partner and Chair, IP Litigation

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Benjamin T. Horton manages complex litigation involving high tech patents. He has a degree in electrical engineering, and before law school he worked for technology companies in the automotive and semiconductor industries. He is a member of the Trial Bar for the Northern District of Illinois and litigates intellectual property cases in federal courts across the country. Mr. Horton also practices before the Patent Trial and Appeals Board, representing both petitioners and patent owners in inter partes review (IPR) and covered business method review (CBM) proceedings.

Mr. Horton speaks regularly on patent litigation and strategy and he is a frequent contributor to various IP publications. *SuperLawyers*, a *Chicago Magazine* publication, selected Mr. Horton for the 2012-2016 *Illinois Rising Stars*® lists, which feature top attorneys in intellectual property law. Mr. Horton has been selected as one of the"World's Leading Patent Practitioners" in 2016 by *IntellectualAsset Management (IAM)* magazine. He was also selected as a 2015-2016 "Emerging Lawyer" in *Emerging Lawyers Magazine*, as a top Illinois attorney under 40. Mr. Horton has also been recognized by intellectual property publications such as *InsideCounsel*, *Thomson Reuters*, *Intellectual Property Magazine*, *Law360*, and *IPPro*.

Practices

- Design Patents
- IP Litigation
- Post-Grant Patent Proceedings

Industries

- Consumer Products
- Electrical & Computer Technologies
- Industrial & Mechanical Technologies
- Internet & Cyberlaw
- Medical Devices

Representative Experience

Mr. Horton's cases involve diverse industries across a wide range of technologies, including these exemplary matters:

- Representing semiconductor manufacturer in litigation with rival involving micro-electro-mechanical system (MEM) technology.

- Representing LED manufacturer against competitor in district court litigation.
- Representing patent owner in IPR proceeding, successfully defending 27 of 30 originally challenged claims against institution, the remaining claims proceeding to trial.
- Defended multi-defendant patent litigation involving cellular data packet technology.
- Represented global manufacturer in international electrical power product litigation to favorable resolution. This patent and antitrust case involved fifteen U.S. patents spanning multiple countries and hundreds of products.
- Represented patent owner in IPR proceeding, successfully defending as patentable all challenged claims through trial.
- With over $30 million at stake in a patent infringement action between HDTV component manufacturing rivals, secured non-infringement jury verdict after a three week trial.
- Secured non-infringement jury verdict after successful defense involving multiple copyrights.
- Represented author and film producer in copyright, contract, and bankruptcy dispute in federal court.
- Achieved favorable disposition in defense of global manufacturer by defeating plaintiff in the claim construction phase of patent infringement action involving arc fault circuit interrupters.
- Secured a favorable ruling and damages award for plaintiff in arbitration involving contract dispute and fraud.
- Represented global manufacturer of electronically timed construction explosives in patent infringement litigation against multiple competitors in multiple jurisdictions.
- Won summary judgment in patent infringement action in defense of overseas manufacturer of wireless tracking devices.
- Represented child safety seat manufacturer in patent infringement dispute, obtained favorable outcome with witness deposition testimony and aggressive motion practice.
- Represented manufacturer of networked air quality monitoring systems in patent infringement litigation through appeal to the Federal Circuit.

Background and Credentials

Mr. Horton specialized in microwave circuit design and antennas as an undergraduate in electrical engineering at the University of Michigan in Ann Arbor. He went on to work for Panasonic Semiconductor as a field applications engineer assisting in the design of automotive, cell phone, and display technology components. He also worked for Motorola Semiconductor as a co-op field applications engineer working with Ford Motor Company and DaimlerChrysler Corporation.

Mr. Horton received his J.D. from DePaul University College of Law and his B.S.E. in electrical engineering from the University of Michigan, with honors.

Education

- DePaul University College of Law (J.D.)
- University of Michigan (B.S., *with honors*)
    - Electrical Engineering

Bar Admissions

- Illinois
- U.S. District Court, Northern District of Illinois, Trial Bar

- U.S. District Court, Eastern District of Texas
- U.S. Court of Appeals, Federal Circuit
- Admitted to practice pro hac vice in various district courts throughout the U.S.

Publications and Presentations

July 19, 2016
"Venue patent reform 'necessary and urgent' claims new Bill" (featured quotes)
Intellectual Property Magazine

June 8, 2016
"Since ven-did-ue care?" (featured quotes)
IPPro Patents

May 12, 2016
"A Balanced Enforcement Strategy For Operating Companies"
IP Strategy Summit – Houston

December 24, 2015
"Patent Cases To Watch In 2016" (featured quotes)
Law360

December 24, 2015
"The Decision That Could Change the US Semiconductor Industry"
Corporate Counsel

October 1, 2015
"Strategies for Dealing with NPEs – Fight or Flight"
2015 IP Defense Summit, Seattle

August 5, 2015
"Fed. Circ. Toss Of $1.5B Verdict Complicates Patent Damages" (featured quotes)
Law360

April 17, 2015
"5 Recent Fed. Circ. Rulings IP Attys Need To Know" (featured quotes)
Law360

April 14, 2015
"Sweeping Changes"
Intellectual Property Magazine

February 9, 2015
"House appears ready to approve patent reform again" (featured quotes)
InsideCounsel

February 6, 2015
"The Innovation Act is Back" (featured quotes)
IPPro

February 5, 2015
"New Troll Bill Could Hobble All Patent Suits, Attys Say" (featured quotes)
Law360

October 31, 2014
"The non-practicing entity: A troll by any other name?"
InsideCounsel

October 23, 2014
"Fed. Circ. Judges' Bid To Revisit Willfulness May Aid Patentees" (featured quotes)
Law360

October 16, 2014
"Strategies for dealing with NPEs – Fight or Flight"
2014 IP Defense Summit, Palo Alto, CA

October 8, 2014
"Strategies for dealing with NPEs – Fight or Flight"
2014 IP Defense Summit, Chicago, IL

2013
"Preparation is the Key to Successful Patent Litigation"
Inside the Minds: Litigation Strategies for Intellectual Property Cases, Aspatore Books

November 28, 2012
"IP Pro Bono Opportunities for Chicago-Area Attorneys"
Richard Linn American Inn of Court

March 15, 2012
"Civility Referee: How Not to Behave"
Richard Linn American Inn of Court

November 17, 2011
"Practical Tips to Prepare You to Succeed in the Legal Profession"
Richard Linn American Inn of Court, sponsored by DePaul University College of Law's Center for Intellectual Property Law & Information Technology

May 14, 2009
"Advocacy Challenge"
Richard Linn American Inn of Court

August 11, 2004
"Wagging the Dog: Substantial Defenses, Adverse Inferences, and Opinion Production Under En Banc Reconsideration in Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp"

Community and Professional Involvement

- Intellectual Property Owners Association
- Intellectual Property Law Association of Chicago – Judicial Appointments Committee
- Lawyers for the Creative Arts – Pro Bono Representation

- The Richard Linn American Inn of Court
- DePaul University College of Law – Career Advisory Board
- Mentor, Chicago Intellectual Property Alliance (CIPA) Mentorship Program