



## Thomas L. Duston

Partner

Tel 312.423.3446  
tduston@marshallip.com

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Tom Duston is a hands-on trial lawyer who focuses on patent litigation for some of the world's most sophisticated companies. With more than thirty years' experience, he has been lead counsel in over 60 patent infringement matters in U.S. Federal courts. Tom is praised by clients and adversaries alike for both his creativity and tenacity as a trial attorney. He has represented Groupon, Abbott Laboratories, CDW, Newegg, T-Mobile, Charter Communications, Express LLC, GE Aviation, TRINOVA (now part of Eaton), Russell Athletic, Raytheon, Home Depot, Classified Ventures, as well as Zappos.com, to name but a few.

Leading Lawyers, a division of the *Law Bulletin Publishing Company*, has named him a "Leading Lawyer" in IP Litigation and profiled him in its September 2014 edition of *Leading Lawyers Magazine*. *U.S. News and World Report* has repeatedly listed him as among "The Best Lawyers in America" in the practice areas of Litigation–Intellectual Property, Litigation–Patent, and Patent Law. Tom has been awarded a Martindale-Hubbell® AV Preeminent Rating®, a designation held by "an elite group of approximately 10 percent of all attorneys," "a designation trusted worldwide," and the highest honor given by Martindale-Hubbell®. He has also received Martindale-Hubbell's AV Preeminent Award – Judicial Edition. Thomson Reuters has repeatedly identified Tom as among the "Top 100" attorneys in Illinois and named him to the *Illinois Super Lawyers* list. *American Lawyer Media (ALM)* and Martindale-Hubbell selected him as a "Top Rated Lawyer in Intellectual Property." The *Managing IP* IP Stars Survey named him an "IP Star." He has authored a number of articles in the areas of patent and trade secret litigation. Earlier in his career, Tom was named by the *Law Bulletin Publishing Company* as one of "Forty Illinois Attorneys Under 40 to Watch," a list of the State's most talented and well-regarded lawyers.

### Practices

- IP Litigation
- ITC 337 Investigations
- Trade Secrets
- Post-Grant Patent Proceedings

## Industries

- Aerospace
- Automotive & Transportation
- Chemical Sciences
- Electrical & Computer Technologies
- Internet & Cyberlaw
- Medical Devices
- Pharmaceutical

## Representative Experience

- Lead trial counsel for one of the defendants in *Eolas Technologies LLC v. Adobe, et al.* (E.D. Tex.) in which defendants successfully invalidated before a Tyler, Texas jury two of the most notorious early Internet patents.
- Achieved a multi-million dollar settlement of a patent infringement claim on behalf of the inventor of a revolutionary silicone device used in reconstructive surgery from the world's largest manufacturer of such devices.
- Successfully represented several of the nation's largest internet retailers, with combined annual revenues in excess of \$10 billion, in the Eastern District of Texas against allegations by Soverain Software that they infringed early e-commerce patents directed to electronic shopping carts and methods for communications via HTTP.
- Gained favorable results for the patent holder in infringement actions against several of the nation's largest online digital photofinishing services.
- Successfully represented a former Fortune 500 company, now one of the largest privately held companies in the U.S., in connection with infringement claims directed at use of HTML forms in online shopping.
- Gained favorable outcome for client in patent infringement claim involving diagnostic immunoassays utilizing monoclonal antibodies.
- Litigated patent infringement claims for aluminum alloys used to construct upper wing surfaces of commercial passenger jets.
- Defended one of the largest technology resellers in connection with infringement claims directed to dynamic taxonomies employed in electronic catalogs for e-commerce applications and electronic auctions.
- Litigated infringement claims on behalf of one of the largest private companies in the U.S. relating to asymmetric data compression techniques for use with online digital images employed in web pages.

- Gained favorable outcome for clients in patent infringement claim involving hydraulic fittings for aerospace applications.
- Represented company with multi-billion dollar annual revenues in litigation alleging infringement of patents claimed to cover intelligent, web-based sales automation systems.

## **Background and Credentials**

Tom has experience with a diverse array of technologies in the medical, pharmaceutical, semiconductor, computer, Internet, explosives, automotive and metals industries, among others. His work on behalf of his clients has encompassed not only patent infringement litigation, but also trade secret disputes, the enforcement of non-competition agreements, trademark actions, claims of unfair competition, and contract and negligence claims relating to technology failures. He has tried intellectual property disputes before both judges and juries, and has handled injunction proceedings, arbitrations, mediations and appeals in such cases.

A graduate of Columbia University (B.A. 1984), Tom received his J.D. in 1987 from University of California, Hastings College of the Law, where he was a member of the Moot Court Board and an instructor in the Moot Court Program. While at Hastings, he externed as a staff attorney for the Ninth Circuit Court of Appeals.

## **Education**

- University of California Hastings College of the Law (J.D.)
- Columbia University (B.A.)

## **Bar Admissions**

- Illinois
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Appeals, Third Circuit
- U.S. Court of Appeals, Fifth Circuit
- U.S. Court of Appeals, Seventh Circuit
- U.S. District Court, District of Colorado
- U.S. District Court, Northern District of Illinois
- U.S. District Court, Eastern District of Michigan
- U.S. District Court, Eastern District of Texas
- U.S. District Court, Western District of Texas
- U.S. District Court, Eastern District of Wisconsin
- Admitted to practice pro hac vice in various district courts throughout the U.S.

## Publications and Presentations

December 3, 2020

**"A Comparative Analysis of Litigation in the International Trade Commission and District Court"**

*AUTM Professional Development Webinar*

April 24, 2018

**The Supreme Court Finds IPR Proceedings Constitutional**

*Marshall Gerstein Alert*

November 16, 2017

**"Federal Circuit Confirms TC Heartland Changed the Law" (featured quotes)**

*World Intellectual Property Review*

November 15, 2017

**"Federal Circuit Sends Muddy Message on 'TC Heartland' Venue Waivers" (featured quotes)**

*The National Law Journal*

June 27, 2017

**"Lessons From This Year's High Court IP Rulings: Part 1" (featured quotes)**

*Law360*

May 30, 2017

**"SC Ruling Signals New Era for Software Patent Enforcement" (featured quotes)**

*TechNewsWorld*

May 25, 2017

**"Where to File Patent Complaints After High Court Venue Ruling?" (featured quotes)**

*Bloomberg BNA*

May 23, 2017

**"Supreme Court Upends Thirty Years of Patent Litigation, Declaring for Venue Purposes That Corporate Defendants 'Reside' Only Where Incorporated"**

*Marshall Gerstein Alert*

May 22, 2017

**"High Court Rocks 25 Years of Patent-Venue Precedent" (featured quotes)**

*Courthouse News Service*

May 22, 2017

**“Industry Reaction to SCOTUS Patent Venue Decision in TC Heartland v. Kraft Food Group” (featured quotes)**

*IPWatchdog*

May 17, 2017

**“Fee Shifting in Patent Litigation”**

*IP Defense Summit–Chicago*

March 22, 2017

**“SCOTUS Laches Ruling Won't Have ‘Monumental’ Impact, Says Lawyers” (featured quotes)**

*World Intellectual Property Review*

March 22, 2017

**“Patent Owners Can Wait to Sue, Get Six Years Damages” (featured quotes)**

*Bloomberg BNA*

March 22, 2017

**“SCOTUS Weakens Laches as a Defence” (featured quotes)**

*IPPro Patents*

March 21, 2017

**“Justices’ Laches Decision Could Be Boon For Patent Owners” (featured quotes)**

*Law360*

February 21, 2017

**“Groupon Succeeds in Fed Circuit Patent Fight” (featured quotes)**

*World Intellectual Property Review*

February 20, 2017

**“Evolutionary Intelligence Patents Dismissed” (featured quotes)**

*IPPro Patents*

February 17, 2017

**“Apple, Tech Giants Win Data Patent Dispute At Fed. Circ.” (featured quotes)**

*Law360*

December 21, 2016

**“Supreme Court Might End Texas’ Preferred Patent Venue Status, Attorneys Say” (featured quotes)**

*Thomson Reuters Legal Solutions Blog*

December 16, 2016

**“Forum shopping decision could reduce patent lawsuits” (featured quotes)**

*IPPro The Internet*

December 15, 2016

**“Justices Could Deal Blow To East Texas Patent Docket” (featured quotes)**

*Law360*

December 15, 2016

**“TC Heartland Has Potential to ‘Shake-Up’ Patent Litigation” (featured quotes)**

*Intellectual Property Magazine*

December 15, 2016

**“SCOTUS to Hear TC Heartland Case on Patent Venue” (featured quotes)**

*World Intellectual Property Review*

December 9, 2016

**“Attorneys Weigh in on High Court ‘Substantial Portion’ Patent Debate (U.S.)” (featured quotes)**

*Westlaw Journal, Intellectual Property*

December 8, 2016

**“U.S. High Court Hears Patent Case With Global Trade Implications” (featured quotes)**

*Intellectual Property Watch*

December 7, 2016

**“Analysing Life Tech v. Promega Arguments At The US Supreme Court” (featured quotes)**

*Managing Intellectual Property*

December 6, 2016

**“Life Tech Litigation Clashes with ‘America First’ Trade Policy” (featured quotes)**

*Intellectual Property Magazine*

December 5, 2016

**“Promega IP Case May Portend More Liability for Exporting Cos.” (featured quotes)**

*Law360*

November 8, 2016

**“Divided Infringement after ‘Akamai’ and other Hot Topics in Patent Litigation”**

*IP Strategy Summit: Chicago*

August 17, 2016

**“When a Tech Patent is Neither” (featured quotes)**

*Bloomberg Businessweek*

May 23, 2016

**“The Special Issues Arising from Disputes with NPEs”**

*PLI's 10th Annual Patent Law Institute Course Handbook*

May 19, 2016

**“Adapting Your Defensive Litigation Strategy”**

*IP Strategy Summit 2016: Boston*

April 25, 2016

**“Cuozzo at SCOTUS: Day One Arguments and ‘Tectonic Shift’ Calls” (featured quotes)**

*World Intellectual Property Review*

October 9, 2015

**“NPEs—The Special Issues Arising from Disputes with NPEs”**

*Practising Law Institute's Patent Litigation Program*

May 12, 2015

**“Strategies for Dealing with NPEs—Fight or Flight”**

*IP Strategy Summit: Chicago*

February 26, 2015

**“Strategies for Dealing with NPEs—Fight or Flight”**

*IP Strategy Summit: Seattle*

June 19, 2014

**“Lawyers Weigh In On High Court's Software Patent Ruling” (featured quotes)**

*Law360*

May 13, 2014

**“Show Me the Money... To Sell, To License, To Hit Quota?”**

*IP Strategy Summit: Chicago*

December 19, 2012

**“2012: A Year of Patents, Mobile Fights, and One Big IPO” (featured quotes)**

*CNET News*

March 27, 2012

**“Shifts in the e-commerce patent battle”**

*Internet Retailer*

October 19, 2011

**“Newegg and Overstock win a patent-infringement case in federal court”**

*Internet Retailer*

February 2011

**“Chicago Patent Litigator Offers Advice on How E-Tailers Can Stave Off Costly Infringement Suits”**

*Intellectual Property Lawcast*

January 2011

**“Defusing the Patent Bomb” (featured quotes)**

*Internet Retailer*

July 28, 2010

**“HSN Receives Two E-Commerce Patents” (featured quotes)**

*Internet Retailer*

January 1, 2005

**“Intellectual Property Protection for Trade Secrets and Know-How”**

*IPO Law Journal*

### **Community and Professional Involvement**

- American Bar Association (sections on Intellectual Property Law and Litigation)
- American Intellectual Property Law Association
- American Judicature Society
- Chicago Bar Association (member of the Judicial Evaluation Committee)
- Intellectual Property Owners Association
- Seventh Circuit Bar Association
- Executives' Club of Chicago
- Intellectual Property Owners Association (member of the Damages and Injunctions Committee)