



Benjamin (Ben) T. Horton

Partner and Chair, IP Litigation

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Ben is an electrical engineer turned IP litigator who has represented some of the world's largest companies in complex, high-tech disputes. Think Amazon, Charter Cable, Dow Chemical, McDonalds, T-Mobile, and United Airlines, among others. Ben also represents cutting-edge research and development companies and institutions, like Argonne National Laboratories and the University of Strathclyde in Glasgow. And he is honored to have helped PopSockets, Final Co., AEON BioPharma, BearBox and other early-stage companies, as he likes to say, "when things were happening at lightning speed and every decision felt like life or death."

Ben takes a collaborative approach to client relationships, no matter the company's size or where they are in their business life cycle. Whether setting high-level strategy or reviewing drafts in the trenches, he recognizes clients as a valued member of the team whose input is welcome at every stage of a case. His business-minded litigation philosophy favors a firm but constructive approach over a combative stance, which can jeopardize the client's objectives and increase expense. As a result, he is able to achieve a degree of credibility with judges and juries, and even his opponents, that ultimately benefits his clients.

Ben serves as Chair of Marshall Gerstein's IP Litigation group, a post he assumed in 2014 when he was the youngest litigation partner at the firm. He has led more than 70 intellectual property cases in federal courts across the country and is a member of the Trial Bar for the Northern District of Illinois. Ben also practices before the Patent Trial and Appeal Board (PTAB), representing both petitioners and patent owners in inter partes review (IPR) and covered business method review (CBM) proceedings. Additionally, he has helped establish Marshall Gerstein as one of the most active and successful firms in the country for International Trade Commission (ITC) investigations and enforcement actions.

A contributor to the firm's PTABWatch blog, Ben has been quoted in dozens of publications and has been invited to speak at leading IP events across the country. Since 2016, *Intellectual Asset Management (IAM)* magazine has selected Ben as one of the "World's Leading Patent Practitioners," and in 2021, he was honored as a "Midwest Trailblazer" by *The American Lawyer*. Ben was honored as an "Elite Boutique Trailblazer" by *The National Law Journal*. Most recently, Ben was included in the inaugural *Lawdragon 500* Leading Litigators in America list. Ben has also authored articles for and been quoted by other leading IP and legal publications such as *Managing Intellectual Property*, *Intellectual Property Magazine*, *IPPro Patents*, *Law360*, *Corporate Counsel*, and *Emerging Lawyers Magazine*.

Practices

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

- Design Patents

Industries

- Automotive & Transportation
- Consumer Products
- Electrical & Computer Technologies
- Industrial & Mechanical Technologies
- Medical Devices

Representative Experience

Ben has litigated more than 70 patent cases from coast to coast involving diverse industries and technologies, including

- Light-emitting diode (LED) technologies
- Micro-electro-mechanical system (MEM) and other semiconductor technologies
- Global positioning and mapping
- Electrical power products
- Medical devices, including surgical and drug-delivery
- Electrical and mechanical consumer products
- Streaming technology
- Website and database architecture
- Voice over
- Artificial intelligence and machine learning
- HDTV components
- Wireless tracking technologies

Additional representative matters include the following:

- Member of the trial team that won—and successfully defended on appeal to the Federal Circuit—an eye-popping \$70M jury award for infringement of a manufacturing process patent for a biosimilar product.
- Obtained a \$2M pre-trial defense bond (the largest ever awarded by a federal district court in a patent case) after briefing and oral argument establishing fraud by the defendants.
- Secured two general exclusion orders (GEOs) from the ITC, a rare remedy awarded only a handful of times per year. One of these GEOs has been the most effective in ITC history, generating more counterfeit seizures in the first 10 months than all other patent-based exclusion orders combined.
- Serving as lead IP counsel, has advised a consumer electronics accessory company on its IP acquisition policies and strategies—including multiple IP deals, strategic acquisitions, and product development efforts—and has counseled the client on its IP disputes worldwide, including matters in China, the United Kingdom, Canada, Germany, Australia, and South America.
- Defended an HDTV component manufacturer accused of patent infringement by a competitor. The lengthy, high-stakes litigation led to a three-week jury trial that ended with a verdict of non-infringement.

- Represented a global manufacturer to favorable resolution in an international patent and antitrust case involving 15 U.S. patents spanning multiple countries and hundreds of electrical power products.
- Represented an author and film producer in a copyright, contract, and bankruptcy dispute in federal court.

Background and Credentials

While earning his undergraduate degree in electrical engineering, Ben specialized in microwave circuit design and antennas. He then went to work for a global semiconductor manufacturer as a field applications engineer. During that time, he designed automotive, cell phone, and display technology components and traveled to Japan for on-the-ground training at an LED research and development center and manufacturing facility. Before attending law school, Ben spent time as a co-op field applications engineer for a major producer of embedded processors, collaborating with leading automotive manufacturers.

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

- "[ITC Blocks Reusable Straw Imports After Patent Probe](#)," *Law360*, February 3, 2021 (featured quotes).
- "[Waging the war on Counterfeits Amid a Pandemic](#)," Co-Author, *Managing Intellectual Property*, December 14, 2020.
- "[ITC Launches IP Probe Into Reusable Straws From China](#)," *Law360*, November 13, 2019 (featured quotes).
- "[Lawyers React as Federal Circuit Takes on Constitutional Conundrum](#)," *Managing Intellectual Property*, November 8, 2019 (featured quotes).
- "[Patent Litigation Trends to Watch in 2018](#)," *Law360*, January 1, 2018 (featured quotes).

See Ben's additional thought leadership.

Community and Professional Involvement

Throughout his career in patent litigation, Ben has made time for pro bono work, which he finds challenging, rewarding, and often fun. He once represented a documentary filmmaker, author, and friend of Mickey Mantle in protecting rights

for his works covering the life and achievements of “The Mick.” Venturing outside the world of intellectual property, Ben invoked the Americans with Disabilities Act to help a stroke survivor force a local supermarket to remove grocery cart barricades that prevented his client from reasonable access to the store.

Ben has also been involved in a number of IP-focused organizations:

- Intellectual Property Owners Association
- Intellectual Property Law Association of Chicago–Judicial Appointments Committee
- ITC Trial Lawyers Association
- Litigation Counsel of America
- 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

Insights

February 3, 2021

"ITC Blocks Reusable Straw Imports After Patent Probe" (featured quotes)

Law360

December 14, 2020

"Waging the war on Counterfeits Amid a Pandemic"

Managing Intellectual Property

November 13, 2019

"ITC Launches IP Probe Into Reusable Straws From China" (featured quotes)

Law360

November 8, 2019

"Lawyers React as Federal Circuit Takes on Constitutional Conundrum" (featured quotes)

Managing Intellectual Property

January 1, 2018

"Patent Litigation Trends to Watch in 2018" (featured quotes)

Law360

May 10, 2017

"Fee Shifting in Patent Litigation"

IP Defense Summit–Boston

March 24, 2017

"Forum Shopping Case to be Heard Next Week" (featured quotes)

IPPro Patents

November 18, 2016

"Neutralizing 'Patent Trolls' for His Clients"

Emerging Lawyers Magazine

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”

Client Successes

Eliminating Spillover via an Inter Partes Victory

The Firm secured a complete victory for SSW Holding Company, Inc., in an inter partes review proceeding challenging the validity of an SSW patent, making its client one of just a handful to emerge from the newly established inter partes review process with every challenged patent claim fully intact.

Inter partes review (IPR) is a streamlined process for challenging patents created through the Leahy-Smith America Invents Act of 2011 and, to date, has proven favorable to those challenging patents. Of the 78 decisions issued in IPR proceedings through June of 2014, the Patent Trial and Appeal Board cancelled or invalidated nearly 80 percent of the patent claims before it. In only 14 percent of such cases did the board find in favor of the patent owner with respect to all of the patent claims under consideration, as it did in *Schott Gemtron Corp. v. SSW Holding Company, Inc.* The Patent Trial and Appeal Board’s decision rejected arguments that SSW’s patent—which covers spill-containing

refrigerator shelving technology used by major appliance manufacturers—was “obvious” and therefore invalid. Oral argument in the case took place on June 23, 2014.