



## Thomas I. Ross

Of Counsel

Tel 312.474.6635  
tross@marshallip.com

---

Thomas I. Ross has litigated successfully in district courts throughout the United States and in the International Trade Commission (ITC) on matters involving patents, trademarks, copyrights, and trade secrets. He has first-chaired numerous trials, both bench and jury, and has been the lead attorney on a number of appeals before the Federal Circuit Court of Appeals and other Circuit Courts. His skills derive from his experience, as well as his training in mechanical engineering and work as an examiner at the U.S. Patent and Trademark Office. He has been engaged for expert testimony on patent law and Patent Office practices.

Tom has received numerous professional honors throughout his career.

- Fellow, Litigation Counsel of America (invitation-only, national trial lawyer honorary society)
- Illinois Super Lawyer list (peer recognition of professional achievement)
- Member, Barristers of the Patent Law (invitation-only, regional patent trial lawyer honorary society)
- Listed in Leading Lawyers Illinois (invitation-only, regional lawyer honorary society)
- Listed in Who's Who in American Law
- Martindale-Hubbell® AV Peer Review Rating™

### Representative Experience

When it comes to trials, he wins. In the past 10 years, Tom has won 4 of 5 of his Intellectual Property trials and 5 of 6 appeal cases. These include the following, where \* denotes our client.

- *\*Golden Voice Technology & Training v. Rockwell International, et al.* Golden Voice's patents for a call center operator voice storage and retrieval system were found infringed in a jury trial, where we presented the jury with actual and animated demonstrations of the subject technologies. The jury found Rockwell infringed and that the infringement had been willful. The verdict, including willfulness, was affirmed by the Federal Circuit Court of Appeals.
- *The Illinois Coalition Against Handgun Violence (ICAHV) v. \*Illinois State Rifle Association (ISRA).* When the ICAHV failed to re-register its corporate name, the ISRA registered the ICAHV corporate name and promoted pro-gun legislation under the auspices of ICAHV. A trademark infringement action ensued. Mr. Ross averted the temporary restraining order with ISRA stipulating not to use the ICAHV moniker. Further, although infringement was found in a bench trial, the assessment of damages was reduced from what the ICAHV had sought.
- *ADC Communications v. \*Switchcraft, Inc.* ADC's patent covered a switching jack with impedance matching afforded by fin-shaped "waveguides" adjacent the stationary and movable conductors. ADC marketed its

patented jack for the transmission of high-definition television signals. Switchcraft's competing jack design was a PCB-based switching jack that included fin-shaped walls between conductor strips. The jury concluded that ADC failed to carry its burden of proving by a preponderance of the evidence that the fins in the Switchcraft jack did in fact impedance match. In his JMOL decision, the judge cited Switchcraft's explanation and test evidence as supporting the jury's verdict of non-infringement.

- *Bass Pro Trademarks v. \*Cabela's*. Cabela's appealed the lower court's finding of contempt for violation of a patent infringement consent judgment. On appeal, Mr. Ross successfully argued that the new product did not infringe, a necessary prerequisite for finding contempt of a patent judgment; and the Federal Circuit Court of Appeals vacated the contempt order and sanctions.
- *\*Franklin Electric v. Dover (OPW)*. We were engaged to handle the appeal of a lower court's summary judgment of non-infringement of Franklin's patent on an improved fuel multi-port sump containment assembly. The Federal Circuit Court of Appeals expressly adopted Mr. Ross' reasoning, rejecting the lower court's narrow view of the patent and claim construction, and remanded for further proceedings.
- Served as first-chair during a seven-day jury trial in the *Applied Biosystems v. Illumina, et al.* case in which we successfully represented the defendants. The issue was patent ownership of a new method of DNA sequencing by ligation, conceived by a former employee of Applied Biosystems while he had worked there. The jury agreed with us that Illumina owned the patents.
- The South Dakota Supreme Court handed Mr. Ross a win in the trademark infringement dispute *Dakota Industries v. Cabela's*, after he had already obtained a favorable judgment for Cabela's in the lower court. He successfully argued that plaintiff abandoned the trademark through non-use.

## Background and Credentials

Tom is a seasoned intellectual property litigator who has experienced repeated success in litigation and at trial. He has led cases in federal district courts throughout the United States, as well as numerous appeals before the United States Courts of Appeals for the Federal Circuit and other regional Circuit Courts, ITC actions, and arbitration and mediation hearings. In addition to his prior work as an examiner in the USPTO, he also served as a law clerk at the Patent Office Board of Patent Appeals and Interferences.

Tom has a B.S. degree in mechanical engineering from Purdue University, and received his J.D. in 1979 from Georgetown University Law Center.

His broad range of experience encompasses such technologies and products as:

- Plastic injection molding machines
- Mechanical seals
- Semiconductor manufacturing equipment
- Head technology for magnetic recording
- Wireless communications network systems
- Computer power supply circuitry
- Medical devices and technology
- Pharmaceutical compounds
- Feedback controls
- Operational circuitry
- Metals alloying and casting equipment
- Hook and loop fasteners

- Digital subtraction angiography
- Cryogenic cooling systems

## Education

- Georgetown University Law Center (J.D.)
- Purdue University (B.S.)
  - Mechanical Engineering

## Bar Admissions

- Illinois
- U.S. Supreme Court
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Appeals, Seventh Circuit
- U.S. Court of Appeals, Sixth Circuit
- U.S. District Court, Eastern District of Wisconsin
- U.S. Patent and Trademark Office
- U.S. District Court, Northern District of Illinois, Trial Bar

## Publications and Presentations

- “[Trial Pros: Marshall Gerstein's Tom Ross](#),” *Law360*, July 6, 2016.
- “[Enforcing Intellectual Property Rights in China](#),” *China Business Review* (October-December 2012)
- “[Patent enforcement in China is on the upswing](#),” *InsideCounsel*, October 9, 2012.
- “[3 litigation strategies for enforcing IP rights in China](#),” *InsideCounsel*, September 25, 2012.
- “[China's alternative administrative route for enforcing intellectual property](#),” *InsideCounsel*, August 28, 2012.

[Click here](#) to see additional Publications and Presentations.

## Community and Professional Involvement

- ITC Trial Lawyers Association
- Intellectual Property Law Section, American Bar Association
- Litigation Section, American Bar Association
- Federal Circuit Court of Appeals Bar Association

## Representative Matters

*Adolph Hottinger Maschinenbau GmbH v. George Fischer Foundry Systems Inc.\**  
Zurich Arbitral Tribunal  
Case Type(s): Antitrust

*Foseco International Ltd. et al. v. Swiss Aluminium Ltd.\* et al.*  
Northern District of Illinois  
Case Type(s): Antitrust

*Erickson v. Trinity Theatre Inc.\**  
Northern District of Illinois  
Case Type(s): Copyright Infringement

*Real Estate Data Inc. v. The Sidwell Co.\**  
Northern District of Illinois  
Case Type(s): Copyright Infringement

*In re Dental Prophylaxis Devices (Dentsply International Corp. v. Electro Medical Systems SA)\**  
U.S. International Trade Commission  
Case Type(s): Patent Infringement

\* Party Represented

[Click here](#) to see additional Representative Matters.

## Insights

July 6, 2016

**“Trial Pros: Marshall Gerstein’s Tom Ross”**  
Law360

October - December 2012

**“Enforcing Intellectual Property Rights in China”**  
China Business Review

October 9, 2012

**“Patent enforcement in China is on the upswing”**  
InsideCounsel

September 25, 2012

**“3 litigation strategies for enforcing IP rights in China”**  
InsideCounsel

August 12, 2012

**“China’s alternative administrative route for enforcing intellectual property”**  
InsideCounsel

August 30, 2011

**Tom Ross Interviewed By Crain’s Chicago Business on IP Enforcement in China**  
Crain’s Chicago Business

August 22, 2011

**“China is worth it despite the risks”**

Crain's Chicago Business

Fall 2010

**“Patent Damages”**

IPLAC Patent Symposium

February 2010

**“Our Federal Circuit: Its History and Precedents”**

MGB Academy

Spring 2009

**“Trade Secret Protection And The Biofuels Industry”**

Biofuels Journal

Spring 2008

**“Cross-Examination Techniques”**

Law Bulletin Litigation Skills II Conference

June 2006

**“Making Patent Plaintiffs Pay”**

Intellectual Property Technology and Law Journal

Spring 2006

**“Making Patent Plaintiffs Pay”**

Law Bulletin Corporate IP Conference

January 1, 2005

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

IPO Law Journal

June 2003

**“A Discussion Of Issues Affecting Court Reporters Presented By The Engate Patents”**

NCRA Journal Of Court Reporting

2003

**“Intellectual property protection for trade secrets and know-how”**

Building And Enforcing Intellectual Property Value, Globe White Page

## **Representative Matters**

*Adolph Hottinger Maschinenbau GmbH v. George Fischer Foundry Systems Inc.\**

Zurich Arbitral Tribunal

Case Type(s): Antitrust

*Foseco International Ltd. et al. v. Swiss Aluminium Ltd.\* et al.*

Northern District of Illinois

Case Type(s): Antitrust

*Erickson v. Trinity Theatre Inc.\**

Northern District of Illinois

Case Type(s): Copyright Infringement

*Real Estate Data Inc. v. The Sidwell Co.\**

Northern District of Illinois

Case Type(s): Copyright Infringement

*In re Dental Prophylaxis Devices (Dentsply International Corp. v. Electro Medical Systems SA\**

U.S. International Trade Commission

Case Type(s): Patent Infringement

*In re Slide Fastener Stringers (Talon Corp. v. YKK\*)*

U.S. International Trade Commission

Case Type(s): Patent Infringement

*Chromalloy Corp. v. Turbine Components Corp.\**

District of Connecticut

Case Type(s): Patent Infringement

*Coherent Inc. v. Boreal Laser Ltd.\**

Northern District of California

Case Type(s): Patent Infringement

*Consolidated Aluminum Corp.\* v. Foseco International et al.*

Northern District of Illinois

Case Type(s): Patent Infringement

*Eastman Kodak Co. v. Sony Corp.\**

Eastern District of Texas

Case Type(s): Patent Infringement

*Electro Medical Systems SA\* v. Dentsply International, Inc., et al.*

Eastern District of New York

Case Type(s): Patent Infringement

*Engate, Inc. v. WordWave, Inc.,\* et al.*

Northern District of Illinois

Case Type(s): Patent Infringement

*General American Transportation Corp.\* v. Cyro-Trans, Inc.*

Northern District of Illinois

Case Type(s): Patent Infringement

*Husky Injection Molding Systems Ltd.\* v. Electra Form Inc.*

Southern District of Ohio

Case Type(s): Patent Infringement

*Husky Injection Molding Systems Ltd.\* v. R&D Tool and Engineering*

Western District of Missouri

Case Type(s): Patent Infringement

*Itron, Inc. v. CellNet Data Systems, Inc.\**

District of Minnesota

Case Type(s): Patent Infringement

*Linear Technology Corp.\* v. Impala Linear Corp., et al.*

Northern District of California

Case Type(s): Patent Infringement

*Medtronic Corp. v. Siemens-Pacesetter Inc.\**

Southern District of Florida

Case Type(s): Patent Infringement

*Siemens-Elema AB\* v. Puritan-Bennett Corp.*

Southern District of California

Case Type(s): Patent Infringement

*Société L'Oréal, S.A. v. Revlon Consumer Products Corp.\**

Southern District of New York

Case Type(s): Patent Infringement

*Solomon, et al. v. Cabela's, Inc.,\* et al.*

Eastern District of Texas

Case Type(s): Patent Infringement

\* Party represented