



Thomas L. Duston

Partner

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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. Patexia also recognized Tom as a "Top Attorney for District Court Patent Cases" for Patent Litigation. Tom was included in the "America's Most Honored Lawyers" and "Top Lawyers in the Midwest" lists for 2022. Most recently, Tom was recognized by *Crain's Chicago Business* as one of the "Notable Litigators and Trial Attorneys" for 2023. The guide spotlights the Chicago area's top trial lawyers and litigators for their professional and community successes and accomplishments over the last 18 months. *IAM*, has named Tom as one of their "IAM Patent 1000: The World's Leading Patent Professionals" for 2024. This guide includes detailed reviews of firms and individuals engaged in patent prosecution, transactions, and patent litigation in over 60 jurisdictions.

LAWCAST Pod cast

Practices

- Design Patents
- IP Litigation
- ITC 337 Investigations
- Trade Secrets

- Post-Grant Patent Proceedings

Industries

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

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

- "How Cos. Can Protect IP in Light of FTC Noncompete Rule," *Law360*, May 3, 2024.
- "FTC Outlaws Noncompetes—What You Need to Know," Marshall Gerstein Insights, April 25, 2024.
- "A Comparative Analysis of Litigation in the International Trade Commission and District Court," Presenter, AUTM Professional Development Webinar, December 3, 2020.
- "[The Supreme Court Finds IPR Proceedings Constitutional](#)," Marshall Gerstein Alert, April 24, 2018.
- "[Federal Circuit Confirms TC Heartland Changed the Law](#)," *World Intellectual Property Review*, November 16, 2017 (featured quotes).

[See Tom's additional Publications and Presentations.](#)

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)
- International Association for the Protection of Intellectual Property (AIPPI) (member of the Standing Committee on Trade Secrets)

Insights

May 3, 2024

"How Cos. Can Protect IP in Light of FTC Noncompete Rule"

Law360

April 25, 2024

FTC Outlaws Noncompetes—What You Need to Know

Marshall Gerstein Alert

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

Client Successes

Fierce Advocates

In presenting this gift of Samurai armor to Marshall, Gerstein & Borun LLP, a grateful client explained that he chose the gift because Marshall Gerstein's team of trial lawyers had "represented him as loyally and fiercely as any Samurai warrior." Also, he added, he feared he could not have carried an actual Samurai sword through the building security.

Our client, a pioneer in reconstructive surgery, invented a revolutionary device known as a differential tissue expander. This balloon-like device, when implanted beneath the skin and inflated in stages over time, permitted a surgeon to expand a patient's skin—in fact prompting the body to grow new tissue—for use in reconstructing adjacent wounds or defects. The invention, for the first time, permitted surgeons to tailor this skin expansion to more easily perform truly anatomic surgical reconstructions.

A professor of surgery who had devoted his career to academic medicine, the client faced the deliberate infringement of his patent by one of the largest manufacturers of these silicone devices. Despite relentless assaults by the defendant and its expansive team of attorneys, we did not waver, shrink or give ground. Through such tenacity, we successfully achieved a highly favorable result for the client.

Whether our client is an individual or corporation, patentee or defendant, we approach each engagement with the same commitment, the same fierce dedication, the same tenacity and the same focus and resolve which prompted this particular grateful client to liken us to Samurai warriors.

IPR Win for ACCO's ClickSafe® Locks

Marshall Gerstein successfully represented ACCO Brands Corporation and ACCO Brands USA LLC in Inter Partes Reviews (IPR) before the Patent Trial and Appeal Board (PTAB), appeal of that decision to the U.S. Court of Appeals for the Federal Circuit, and in related infringement litigation in the Eastern District of New York, in which Think Products accused ACCO's ClickSafe® line of computer locks of infringing two Think Products patents.

Marshall Gerstein petitioned for IPR of each asserted patent, arguing that the Think Products patents were obvious over combinations of prior-art references, and anticipated by a published video disclosing the accused ClickSafe® product.

In both IPRs, the PTAB ruled in favor of ACCO on all grounds of review, cancelling all challenged claims of the patents, and these decisions were upheld on appeal to the Federal Circuit.