



## Ethan Horwitz

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## Overview

Listed as one of the top 50 trial lawyers in the United States in *Law360's* "Trial Aces," and included in *Euromoney's Guide to the World's Leading Experts in Patent Law* and *Euromoney's Guide to the World's Leading Experts in Trademark Law*, Ethan Horwitz has more than 25 years of experience as a first-chair trial and appellate lawyer across the full range of intellectual property law. He litigates and advises clients in the full range of intellectual property matters in the United States and internationally. He is the author of four treatises by LexisNexis, including the three-volume *Horwitz on Patent Litigation* and five-volume *Horwitz on World Trademark Law*. He was described as a "fantastic trial lawyer" in *World Trademark Review*.

Ethan has long represented clients in significant electronic, chemical, and mechanical patent cases, including a case in which he obtained the first-ever preliminary injunction on a design patent on behalf of Oscar Mayer, defending its Lunchables product against Sara Lee. He also has represented Miller and Molson, who were accused of violating Labatt's patent on the process for making ice beer. He represented Spansion, a flash memory fabricator in one of the largest International Trade Commission cases in history, involving a two-week trial on two patents — one on the construction of a flash chip and the other on the programming of a flash chip.

He has litigated and advised clients regarding a variety of technologies, including computer software, telephone logging, Voice over Internet Protocol, computer vision, video compression, brewing, pharmaceuticals, food chemistry, chemical processes, skin transplants, antioxidants, and simple mechanical products.

In a case in the Western District of Texas, Ethan obtained two writs of mandamus in less than a month. He first obtained a writ of mandamus compelling the district court to stay the case and rule on his client's venue motion — a decision that was followed by a change in the district court's procedure regarding venue motions. When the district court issued its decision and refused to move the venue of the case, he then obtained a second writ of mandamus reversing the district court's decision. This rare feat moved the case from the Western District of Texas, the top patent litigation venue in the United States, known not to transfer cases.

Ethan has also tried numerous trademark, trade dress, and dilution lawsuits. These include representing Pepperidge Farm in a landmark case that resulted in a preliminary injunction based on Pepperidge Farm's rights to the shape of its Goldfish cracker. This case was among the first to issue a preliminary injunction based solely on a dilution claim.

In other trademark and trade dress cases, he defended Lotus' mark "Notes" against an attack by Borland; Kraft's trade dress for its Singles product against infringement by Borden; and Kraft's trade dress and trademark for its Philadelphia Cream Cheese product from infringement by Bongrain. He also defended Cosmair (L'Oreal) and Ralph Lauren in an action brought by Calvin Klein to enjoin their new fragrance, Ralph Lauren Romance.

He defended JPMorgan Chase's adoption of its name after its merger against a claim of infringement by the owner of the mark Morgan Chase. Additionally, he defended JPMorgan Chase's use of Freedom Card from a claim of infringement by former executives of the Freedom National Bank of Harlem; the judgment was affirmed by the Third Circuit.

In false advertising cases, Ethan represented Kraft's Jell-O gelatin and stopped Del Monte from calling its product "Gelatin Snacks." The snacks were actually made of carrageenan, which is commonly described as gelatin though it fails to meet the technical definition. In addition to many court actions involving false advertising, he has brought and defended cases before the National Advertising Division of the Better Business Bureau and its Canadian and German equivalents.

In copyright cases, he represented Joe Simon, a co-author of the comic character Captain America, against Marvel Comics and won a landmark Second Circuit case holding that Mr. Simon could sue to recover his copyright from Marvel. In another case, his client, Colgate, was accused of copying Procter & Gamble's advertising for Crest toothpaste. The respective ads were used by both companies in many countries around the world. Ethan argued the case before the National Copyright Administration in Beijing, and then tried to a verdict for Colgate, which was affirmed by the Second Circuit.

In another copyright case, J. Walter Thompson and Northwest Mutual Life were accused of copying Chase Manhattan's advertising. He resisted a preliminary injunction and created new law that a preliminary injunction could be refused based on the movant's delay alone.

In addition, he has extensive experience handling the unique issues related to computer programs protection, including litigating the related copyright and patent issues, and helping to develop compatible programs that do not infringe the basic program. He has advised clients on establishing worldwide protection for their intellectual property, and has set up and implemented anti-counterfeiting programs for clients, including Timberland and David Yurman. Ethan has also advised clients regarding the launch of products and advertisements to ensure that they do not violate the intellectual property rights of others and to ensure that all claims are substantiated.

Ethan has also acted as an expert in a variety of settings. He has testified before Congress on legislative issues, has spoken before the Japan Patent Office on its proposed legislation, has testified before the courts in China regarding U.S. law, and has been an expert witness on IP issues.

Ethan has extensive experience in appellate work as well. He has argued appeals in such courts as the Federal Circuit, the Second Circuit, and the New York Court of Appeals, and in administrative settings, including the Patent Trial and Appeal Board. Some of his appeals involved landmark decisions relating to reversionary rights under the Copyright Act, the status of well-known marks, and issues of attorney-client privilege in patent cases.

## Treatises

- Author, "*Horwitz on Patent Litigation*," Vol. 1-3, LexisNexis Matthew Bender
- Author, "*Horwitz on World Trademark Law*," Vol. 1-5, LexisNexis Matthew Bender
- Editor, "*Intellectual Property Counseling and Litigation*," Vol. 1-7, LexisNexis Matthew Bender
- Co-Author, "*Patent Office Rules and Practice*," Vol. 1-13, LexisNexis Matthew Bender

He has also authored *Patent Litigation: Client Handbook* and *Trademark Law and Practice in the United States* (translated into Japanese) (Yoshodo Press 2004). He was also on the board of editors of *Commercial Damages Reporter* and *Managing Intellectual Property*. He is the author of numerous intellectual property articles in such publications as *The National Law Journal*, *New York Law Journal*, *Managing Intellectual Property*, and *Metropolitan Corporate Counsel*. Ethan is also an attorney author for *Lexis Practice Advisor*.

Ethan was an adjunct professor at Fordham University School of Law, and is a frequent lecturer around the world in intellectual property matters. In addition, he has co-chaired PLI's annual Patent and High Technology Licensing program and PLI's annual Advanced Licensing Seminar. He also testified before Congress on changes in intellectual property law and spoken before the Japanese Patent Office regarding changes in Japan's intellectual property law.

# Experience

## Trials and Evidentiary Hearings – First Chair

- *TracFone Wireless, Inc. v. Clear Choice Connections, Inc.*, No. 1:13-cv-23066 (S.D. Fla.). Jury decision on all counts for our client; settled before judgment.
- *Nextec Applications, Inc., v. Brookwood Cos., Inc.*, No. 1:07-cv-06901 (S.D.N.Y. June 21, 2012), *aff'd*, No. 12-1670 (Fed. Cir. Sept. 25, 2012). Four-week trial resulting in decision of non-infringement of two patents relating to the use of shear thinning to lower the viscosity of a coating to fabric.
- *In re Spansion, Inc.*, No. 1:09-bk-10690 (D. Del. 2009). Bankruptcy evidentiary hearing on the value of a patent claim against the bankrupt estate. This was a trial on the viability and value of a patent infringement claim for semiconductors.

- *In re Flash Memory Chips and Products Containing the Same*, ITC Inv. No. 337-TA-664 (2008). Two-week trial on two patents, one on the construction of a flash chip and the other on the programming of a flash chip — press announced it was “one of the largest” ITC cases in history. Settled after trial.
- *Montblanc-Simplo v. Aurora Due S.r.l.*, 363 F. Supp. 2d 467 (E.D.N.Y. 2005). Montblanc sued Aurora for violation of settlement agreement. Decision after trial for Montblanc.
- *Chase Manhattan Bank USA, N.A. v. Freedom Card, Inc.*, 333 F. Supp. 2d 239 (D. Del. 2004), *aff'd*, 432 F.3d 463 (3rd Cir. 2005). The owners of the Freedom credit card originally issued by Jackie Robinson’s Freedom National Bank of Harlem sued Chase for issuance of the Freedom credit card. Summary judgment of non-infringement was affirmed. Trial on contempt; plaintiff held in contempt.
- *Steak n Shake Co. v. Burger King Corp.*, 323 F. Supp. 2d 983 (E.D. Mo. 2004). After an evidentiary hearing on trademark infringement, preliminary injunction denied.
- *J. Schwab Co. v. Polo Ralph Lauren*, American Arbitration Association (2003 trial). Ralph children’s clothing licensee sued Polo Ralph Lauren based on its cancellation of license. After trial, the case was settled before decision.
- *Princeton Video v. Scidel USA Ltd.*, No. 1:99-cv-00386 (D. Del. 1999). Patent infringement action on the technology to insert material into a video (used for example to put the first down line into the field during a football game). Case settled favorably — Princeton bought Scidel — after trial but before verdict.
- *Nabisco, Inc. v. PF Brands, Inc.*, 50 F. Supp. 2d 188 (S.D.N.Y. 1999), *aff'd*, 191 F.3d 208 (2d Cir. 1999). Trial resulting in landmark decision enjoining Nabisco from using a fish-shaped cheese cracker based on dilution of Pepperidge Farms’ famous Goldfish crackers. Affirmed on appeal. As a result of this case, Mr. Horwitz testified before Congress regarding amending the dilution laws.
- *Conopco, Inc., v. Cosmair, Inc.*, 49 F. Supp. 2d 242 (S.D.N.Y. 1999). Unilever and Calvin Klein brought this preliminary injunction against L’Oreal and Ralph Lauren to prevent Polo from launching ROMANCE perfume claiming it infringed the trade dress of Calvin Klein’s ETERNITY. After a multiweek trial, preliminary injunction was denied. ROMANCE went on to replace ETERNITY as the world’s best-selling perfume.
- *Benckiser N.V. v. Colgate-Palmolive Co.*, No. 1:98-cv-00275 (S.D.N.Y. 1998). Arbitration trial involving false advertising on claims relating to dishwashing liquid.
- *Proctor & Gamble Co. v. Colgate-Palmolive Co.*, No. 1:96-cv-09123, 1998 WL 788802 (S.D.N.Y. Nov. 9, 1998), *aff'd*, 199 F.3d 74 (2d Cir. 1999). Two-week trial on copyright and Lanham Act case resulting in a decision for defendants, affirmed on appeal. Mr Horwitz also argued a related case in China.
- *Kraft Gen. Foods, Inc. v. Allied Old English, Inc.*, 831 F. Supp. 123 (S.D.N.Y. 1993). After an evidentiary hearing on a trademark claim, the court issued a preliminary injunction.

- *Kraft Gen. Foods, Inc. v. BC-USA, Inc.*, 840 F. Supp. 344 (E.D. Pa. 1993). After an evidentiary hearing, the court used its extraterritorial power to preliminarily enjoin the use of "Philadelphia" on cream cheese sold in Brazil and Argentina.
- *Kraft Gen. Foods, Inc. v. Del Monte Corp.*, No. 1:93-cv-04413, 1993 WL 557864 (S.D.N.Y. Sept. 22, 1993). After an evidentiary hearing, a preliminary injunction issued preventing the use of "gelatin" to describe carrageenan, which dictionaries define as "gelatin" although it lacks the characteristics of traditional gelatin.
- *Oscar Mayer Foods Corp. v. Sara Lee Corp.*, No. 3:90-cv-00043, 1990 WL 114745 (W.D. Wis. 1990). Preliminary injunction issued after evidentiary hearing against Sara Lee copying packaging of LUNCHABLES, the best-selling new food product in industry history — first preliminary injunction ever issued on a design patent.
- *General Foods, Inc. v. Beatrice Hunt Wesson*, No. 88-cv-8757 (S.D.N.Y.). After trial on the merits of trademark infringement, the case settled — defendant agreed to drop the product in issue — after trial but before verdict.
- *Playboy Enterprises*. Various evidentiary hearings in New York, California, Florida, New Jersey, and Utah as to the sufficiency of the evidence to support an ex parte TRO and seizure of counterfeit Playboy goods. These actions were prior to the Anti-Counterfeiting Act.

### Other Trials and Significant Evidentiary Hearings

- *In re Certain Nitrile Gloves*, ITC Inv. Nos. 337-TA-608, 337-TA-612 (2008). Shortly before trial, lead counsel took ill and could not try the case. Ethan was asked to "coach" the second chair who stepped up to take the trial.
- *Freixenet, S.A. v. Admiral Wine & Liquor Co.*, 731 F.2d 148 (3d Cir. 1984).
- *Olay Co. v. Cococare Prods., Inc.*, No. 18-cv-4102, 1983 WL 44369 (S.D.N.Y. Apr. 19, 1983).
- *Playboy Enters. v. P. K. Sorren Export Co.*, No. 81-cv-1264, 1983 WL 178 (S.D. Fla. Jan. 5, 1983).
- *Standard & Poor's Corp. v. Commodity Exch., Inc.*, 538 F. Supp. 1063 (S.D.N.Y. 1982), *aff'd*, 683 F.2d 704 (2d Cir. 1982). Landmark case using the "hot news" doctrine to prevent the Commodity Exchange from basing a trading vehicle on the S&P 500.
- *Playboy Enters., Inc. v. Baccarat Clothing Co.*, 692 F.2d 1272 (9th Cir. 1982). Trial and appeal of a landmark case leading to passage of the anti-counterfeiting section of the Lanham Act.
- *Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc.*, 511 F. Supp. 486 (S.D.N.Y. 1981), *aff'd*, 687 F.2d 563 (2d Cir. 1982).
- *Windsurfing v. BIC* (S.D.N.Y.). Trial for patent infringement requesting an injunction against the use of BIC Windsurfers in the LA Olympics. Directed verdict for client after defendant's case in chief.

### Other Important Decisions – Lead Counsel

- *ITC Ltd. v. Punchgini, Inc.*, 880 N.E.2d 852 (N.Y. 2007). Decision by the New York Court of Appeals on a question of rights of a famous mark referred to it by the Second Circuit.

- *ITC Ltd. v. Punchgini, Inc.*, 373 F. Supp. 2d 275 (S.D.N.Y. 2005), *aff'd*, 482 F.3d 135 (2d Cir. 2005). Decision on protection of a well-known mark not used in the United States.
- *Marvel Characters, Inc. v. Simon*, 310 F.3d 280 (2d Cir. 2002). Landmark decision on author's reversion rights under the 1976 Copyright Act.
- *Dorf & Stanton Commc'ns, Inc. v. Molson Breweries*, 100 F.3d 919 (Fed. Cir. 1996). Often-cited decision involving attorney-client privilege.
- *Dorf & Stanton Commc'ns, Inc. v. Molson Breweries*, 56 F.3d 13 (2d Cir. 1995). Landmark decision involving the jurisdiction of the Federal Circuit.
- *Chase Manhattan Corp. v. Nw. Mut. Life*, No. 1:92-cv-04978, 1993 WL 60602 (S.D.N.Y. Mar. 1, 1993). Decision denying preliminary injunction due solely to delay without the need to address the merits of the case. The case created an informal rule regarding the timing of motions for preliminary injunctions in the Second Circuit.
- *Morgan Chase v. JP Morgan Chase*, D.C., Michigan. When JP Morgan and Chase merged, it adopted the name JP Morgan Chase. Morgan Chase, a 20-year-old national financial company, sued for trademark infringement. Despite demands in the hundreds of millions of dollars, the case settled the morning of the pretrial conference for less than \$2 million.

## Areas of Focus

### Practices

- Intellectual Property
- Health Care
- Litigation and Trials
- Mass Tort and Product Liability
- Appellate & Trial Support
- Technology
- Telecommunications
- Business Transactions
- Intellectual Property Protection & Portfolio Management
- Intellectual Property Litigation
- Pharmaceuticals and Medical Devices
- Aviation

### Industries

- Health Care
- Technology
- Telecommunications

## Insights

07.11.2019

Changes to the Patent Landscape for the Insurance and Financial Industries

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12.29.2017

Major Disruption in the Use of Technology and Trademarks in the Insurance Industry

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05.17.2016

BRI v Phillips: a changing landscape?

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04.20.2016

An Invalid Mark by any Other Name Still Fails

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06.15.2015

The Status of Business Method Patents

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08.28.2014

An Inexpensive Alternative to Patent Litigation

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01.07.2014

A Guide to Conducting IP Due Diligence In M&A

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12.10.2013

Allocating IP Ownership, Use Rights In M&A Deals

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12.03.2013

Transferring Ownership of IP Assets in M&A Deals

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10.01.2013

Intellectual Property in Joint Ventures

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05.13.2013

Internal Use Avoids Cancellation

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09.14.2012

Managing Intellectual Property

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04.19.2012

Patent Litigation: Client Handbook

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01.31.2011

Social Networking Can Lead to Tricky Issues for Trademark Owners

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10.25.2010

ITC: Forum of Choice for Patent Litigation

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07.22.2010

Bilski and Beyond: The Impact of the Bilski Decision for Biotech

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11.20.2008

How to Wake Up Your Dormant Trademarks

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11.04.2008

Key Trademark Issues in Asia

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10.01.2008

Patent Trolls Look to Europe

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11.01.2007

Famous Indian Restaurant, Bukhara, Denied Protection by Second Circuit

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10.01.2007

Famous No More

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06.01.2005

Top 10 Things to Know Before You Launch A Comparative Advertising Campaign

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01.01.2004

What Senior Executives Must Know About IP and Corporate Governance

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01.01.1997

Commercial Damages Reporter

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01.01.1996

Fifty Years of the Lanham Act: A Retrospective of Section 43(a)

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## News

09.22.2023

Carlton Fields Attorneys Named to 2023 New York Metro Super Lawyers and Rising Stars Lists

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09.30.2021

2021 New York Metro Super Lawyers Honors Carlton Fields Attorneys

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09.29.2020

2020 New York Metro Super Lawyers Honors Carlton Fields Attorneys

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09.12.2019

New York Metro Super Lawyers Honors Carlton Fields Attorneys on 2019 Lists

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10.18.2018

New York Metro Super Lawyers Honors Carlton Fields Attorneys on 2018 Lists

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02.08.2018

Carlton Fields Attorneys Named “World’s Leading Trademark Professionals”

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08.15.2017

78 Carlton Fields Attorneys Named “Best Lawyers in America”

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01.18.2017

Three Carlton Fields IP Lawyers Named “World’s Leading Trademark Professionals”

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## Recognition

Listed in:

- Trial Aces, *Law360*
- *Guide to the World’s Leading Trademark Professionals*
- *Guide to the World’s Leading Patent Law Experts*
- *International Who’s Who of Business Lawyers*
- *International Who’s Who of Trademark Lawyers*
- *Expert Guides, Trademarks*
- New York Metro Super Lawyers, *Super Lawyers Magazine* (2006–2023)
- *New York Best Lawyers*
- *Who’s Who Legal*
- *IP Law & Business “Best Lawyers”*
- *Legal500*
- *IAM 250 the World’s Leading IP Strategists*
- *Lawyer’s World-Leading Lawyer Award*
- *New York Area’s Top Attorneys*
- *ALM’s Best Lawyers in America Guide*
- *Lawdragon 3000*
- *WTR 1000*
- *The Best Lawyers in America, Intellectual Property Litigation, Patent Litigation, Trademark Law* (2005–2024)

## Professional & Community Involvement

Professional Activities

- International Trademark Association
  - Chair, Central Asia/Middle East Group (1992–1994)
  - Forums Committee (1988–1991)
  - Board of Directors (1988–1990)
  - Chair, WIPO Committee (1987–1988)
  - Chair, Committee Western Europe (1986–1987)
  - Chair, Committee Canada (1985–1986)
- International Association for the Protection of Intellectual Property
  - Board of Directors, AIPPI-US
- American Intellectual Property Law Association
  - Trademark and Unfair Competition Law Committee
- Chartered Institute of Trade Mark Attorneys
- International Federation of Intellectual Property Attorneys
  - Study and Work Commission (1988–1992)
- Inter-American Association of Industrial Property
- New York Patent Trademark and Copyright Law Association
- Board of Editors, *The Trademark Reporter* (1979–1983)
- Board of Directors, *Managing Intellectual Property*
- Board of Directors, *Commercial Damages Reporter* (Matthew Bender & Co.)
- Intellectual Property Editorial Advisory Board, *Law360*
- Attorney Author, *Lexis Practice Advisor*

## Civic Activities

- American Friends of the Shalom Hartman Institute
  - Board of Directors (2000–present)
- DOROT
  - Board of Directors (1978–present)
  - President (1984–1988)
  - Recipient, William J. Shroder Award and Eleanor Roosevelt Award
- Institute for Myeloma and Bone Cancer Research
  - Board of Directors (2004–present)
- Plaza Jewish Community Chapel Inc.
  - Board of Directors
  - Secretary

# Speaking Engagements

- "E-Discovery in Patent Litigation," E-Discovery Webinar Series (February 12, 2018)
- "Packaging: Plain/Graphic Health Warnings," TMA's 101st Annual Meeting and Conference, Williamsburg, VA (May 2016)
- "Intellectual Property in the Financial Industry" Carlton Fields Webinar (December 2014)
- "Strategic Considerations in Patent Litigation Venues: DC v. ITC v. PTO," LexisNexis (November 2013)
- "IPR – the Powerhouse of Tomorrow," Global Intellectual Property Convention, Bangalore, India (January 23–30, 2013)
- "Recent Developments in Patent Litigation," IP Enforcement and Litigation, Civil and Criminal Update (March 2012)
- "What Is Left for the Jury," NYIPLA Fall CLE Seminar (November 4, 2010)
- "Overview of the Lanham Act: Trademarks, False Advertising, Unfair Competition and Beyond," King & Spalding University (May 7, 2008)
- "Patent and Technology Licensing," Advanced Patent Licensing: What You Need to Know Before Licensing Your Patent (May–June 2008)
- "Advanced Patent Licensing: What You Need to Know Before Licensing Your Patent," PLI (2007)
- "Pitfalls in Licensing, Patent and Technology Licensing," Virginia State Bar's Intellectual Property Section Seminar, Williamsburg, VA (September 28–29, 2007)
- "Advanced Patent Licensing: What You Need to Know Before Licensing Your Patent," PLI (2006)
- "An Inside Look at Surveys - Advance Level," International Trademark Association 127th Annual Meeting, San Diego, CA (May 12–18, 2005)
- "Advanced Trademark Symposium 2004," International Trademark Association, New York, NY (2004)

# Credentials

## Education

- St. John's University School of Law (J.D.)
- New York University Courant Institute of Mathematical Sciences (M.S.)
- Polytechnic Institute of New York (B.S.)

## Bar Admissions

## Court Admissions

- U.S. Supreme Court
- U.S. Court of Appeals, Federal Circuit
- U.S. Court of Appeals, Second Circuit
- U.S. Court of Appeals, Third Circuit
- U.S. Court of Appeals, Tenth Circuit
- U.S. Court of Appeals, Eleventh Circuit

- New York
- Connecticut
- U.S. Patent and Trademark Office
- U.S. District Court, Eastern District of New York
- U.S. District Court, Southern District of New York