

## **Eric E. Bensen**

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### **CURRICULUM VITAE**

#### **PROFESSIONAL**

##### **Intellectual Property Law Author, Consultant, & Expert Witness**

Aug. 2008 – Current (State Bar of Texas from 2022; New York bar from 1997 to 2023; prior experience summarized below)

#### **INTELLECTUAL PROPERTY TREATISES**

Roger M. Milgrim & Eric E. Bensen, MILGRIM ON TRADE SECRETS (5 vols., Matthew Bender)

Eric E. Bensen, PATENT LAW PERSPECTIVES (9 Vols., Matthew Bender)

Roger M. Milgrim & Eric E. Bensen, MILGRIM ON LICENSING (4 vols., Matthew Bender)

Eric E. Bensen, BENSEN ON PATENT LICENSING TRANSACTIONS (3 Vols., Matthew Bender)

Eric E. Bensen, U.S. PATENT OPINIONS & EVALUATIONS (1 vol., LexisNexis)

Eric E. Bensen, NEW YORK INTELLECTUAL PROPERTY LAW (1 vol., LexisNexis)

#### **INTELLECTUAL PROPERTY BOOKS/PRODUCTS**

Eric E. Bensen, PATENT STATEMENTS OF LAW (online, LexisNexis)

Eric E. Bensen, ATTORNEY'S DICTIONARY OF PATENT CLAIMS (3 vols., LexisNexis)

Eric E. Bensen, GRAY MARKETS: PREVENTION, DETECTION AND LITIGATION (1 vol., LexisNexis)

Eric E. Bensen, INTELLECTUAL PROPERTY IN BANKRUPTCY: A COLLIER MONOGRAPH (LexisNexis)

#### **EXPERT WITNESS**

*Universal Engraving, Inc. v. Polsinnelli PC, et al.* (Mo. Cir. Ct. 2018). Retained by plaintiff's counsel, Kutak Rock LLP, to provide expert testimony regarding trade secret law and practice. Retention included testifying at trial, which trial resulted in a jury verdict and full damages award for plaintiff.

*DexCom, Inc. v. Abbott GmbH* (District Court, Patent Lit. Div., Mannheim, Germany 2022). Retained by Kirkland & Ellis LLP to provide expert testimony regarding U.S. patent law.

*DexCom, Inc. v. Abbott Diabetes Care, Inc.* (District of Delaware 2022). Retained by Kirkland & Ellis LLP to provide expert testimony regarding U.S. patent licensing practice.

*Koninklijke Philips N.V. v. Asustek Computer, Inc., et al.* (High Court of Justice, Chancery Division, London 2016). Retained by Hogan Lovells International LLP to provide expert testimony regarding U.S. law pertaining to patent license agreements.

## **OTHER INTELLECTUAL PROPERTY PUBLICATIONS**

### **Treatise Chapters:**

INTELLECTUAL PROPERTY COUNSELING & LITIGATION (Matthew Bender)

Chapter 3, *Copyright Law Overview*

Chapter 24, *Bankruptcy & Intellectual Property Licensing* (2011, since 2022)

Chapter 81, *Trial Techniques in Trade Secret Cases* (since 2011)

COLLIER BANKRUPTCY PRACTICE GUIDE (Matthew Bender)

Chapter 126, *Intellectual Property in Bankruptcy*

COLLIER GUIDE TO CHAPTER 11 PRACTICE (Matthew Bender)

Chapter 10, *Intellectual Property in Bankruptcy*

### **Book Chapters:**

PATENT COMMENTARIES ANALYZING THE AMERICA INVENTS ACT (LexisNexis 2012)

Chapter 1, *Leahy-Smith America Invents Act*

Chapter 2, *Charts of PTO Proceedings after the America Invents Act*

## **OTHER BOOKS**

Eric E. Bensen & Rebecca K. Myers, *BENSEN & MYERS ON LITIGATION MANAGEMENT* (LexisNexis 2010)

## **TWITTER**

“IP Thoughts of the Day”, @ericbensen

## **ARTICLES & OTHER PUBLICATIONS**

### **Articles (Law Review & Law Journal):**

Eric E. Bensen & Danielle M. White, *Using Apportionment to Rein in the Georgia-Pacific Factors*, 9 COLUM. SCI. & TECH. L. REV. 1 (Fall 2007)

Eric E. Bensen, *Apportionment of Lost Profits in Contemporary Patent Damages Cases*, 10 VA. J.L. & TECH. 8 (2005)

Eric E. Bensen, *Understanding the Federal Circuit on Patent Damages for Unpatented Spare Parts*, 12 FED. CIR. B.J. 57 (2002)

Eric E. Bensen, note, *The Visual Artists’ Rights Act of 1990: Why Moral Rights Cannot be Protected Under the United States Constitution*, 24 HOFSTRA L. REV. 1127 (1996)

### **Lexis Practice Advisor**

Eric E. Bensen, *The Defend Trade Secrets Acts* by

Eric E. Bensen, *The Defend Trade Secrets Acts Checklist*

Eric E. Bensen, *Trade Secret Fundamentals*

Eric E. Bensen, *Patent Fundamentals*

Eric E. Bensen, *Copyright Fundamentals*

Eric E. Bensen, *Trademark Fundamentals*

Eric E. Bensen, *Inventions: Patent vs. Trade Secret*

Eric E. Bensen, *Nonfunctional Product Design: Design Patent vs. Copyright vs. Trade Dress* by

Eric E. Bensen, *Literary Works: Copyright vs. Trade Secret*

Eric E. Bensen, *Marketing Images, Characters, Slogans: Copyright vs. Trademark*

Eric E. Bensen, *Quick Reference: Work Made for Hire*

Eric E. Bensen, *Trademark Distinctiveness Spectrum*

Eric E. Bensen, *Chart: Trade Secret State Statutes*

Eric E. Bensen, *IP Comparison Chart*

## **Expert Commentaries & Emerging Issue Analyses:**

### **Most Recent**

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Patent Eligibility of Software Claims”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on Apportionment of Lost Profits for Patent Infringement”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Defend Trade Secrets Act”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on Apportionment of Reasonable Royalties for Patent Infringement”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on How Patent Law Can Alter State Contract Law Rules of Construction for Patent License Agreements”

### **Intellectual Property in Bankruptcy**

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Seventh Circuit’s Holding that a Nondebtor Trademark License can Retain its License After Rejection of the License Agreement in Bankruptcy, *Sunbeam Products Inc. v. Chicago American Mfg.*, 2012 U.S. App. LEXIS 13883 (7th Cir. Jul. 9, 2012)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on Intellectual Property Infringement Claims in Bankruptcy”

### **Economic Espionage Act**

LexisNexis Emerging Issue Commentary, “Eric E. Bensen on the Economic Espionage Act & the Uniform Trade Secret Act”

## Patent Law

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Federal Circuit’s Holding in *In re MSTG, Inc.*, 2012 U.S. App. LEXIS 7092 (Fed. Cir. Apr. 9, 2012), that Settlement Negotiations with a Third Party Respecting the Patent in Suit may be Discoverable.”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen of Supreme Court’s Decision in *Mayo Collaborative Servs. v. Prometheus Labs.* on the Patent Eligibility of a Medical Diagnostic Claim”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen, A Preview of the Supreme Court’s Decision on Patent Eligibility in *Mayo Collaborative Servs. v. Prometheus Labs.* (10-1150)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the America Invents Act”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on PTO Reissue, Reexamination, and Supplemental Reexamination Proceedings after the America Invents Act”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Supreme Court’s Holding that a Clear and Convincing Standard of Proof Must be Met to Show Patent Invalidity, *Microsoft Corp. v. i4i L.P.*, 2011 U.S. LEXIS 4376 (Jun. 6, 2011)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen, A Preview of the Supreme Court’s Decision on the Burden of Proof for Showing Patent Invalidity in *Microsoft Corp. v. i4i L.P.*, No 10-290”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Supreme Court’s Decision Regarding the Patent Eligibility of Process Claims Under 35 U.S.C. § 101: *Bilski v. Kappos*”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Patent Reform Act of 2011”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Federal Circuit’s Holding that Isolated Genes are Patent Eligible Subject Matter: *Association for Molecular Pathology v. United States Patent & Trademark Office*, 2011 U.S. App. LEXIS 15649 (Fed. Cir. Jul. 29, 2011)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Federal Circuit’s Landmark Ruling on Patent Damages: *Uniloc USA, Ltd. v. Microsoft Corp.*, 2010 U.S. App. LEXIS 11”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Federal Circuit’s En Banc Decision on Patent Misuse: *Princo Corp. v. ITC*, 2010 U.S. App. LEXIS 18101 (Fed. Cir. 2010)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 576 F.3d 1348 (Fed. Cir. 2009), and the Infringement of Method Patents under 35 U.S.C. § 271(f)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on *Lucent Techs., Inc. v. Gateway, Inc.*, 2009 U.S. App. LEXIS 20325 (Fed. Cir. Sep. 11, 2009), and its Impact on Patent Damages Law”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Patent Reform Act of 2009”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on *In re TS Tech USA Corp.*, 551 F.3d 1315 (Fed. Cir. 2008), and Motions to Transfer Venue in Patent Cases”

LexisNexis Expert Commentary, “Eric E. Bensen on the Federal Circuit’s Landmark Decision Regarding the Patent Eligibility of Process Claims Under 35 U.S.C. § 101: *In re Bilski*, 2007-1130 (Fed. Cir. Oct. 30, 2008)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Patent Reform Act of 2007”

LexisNexis Expert Commentary, “Eric E. Bensen on the Seventh Circuit’s Holding of No Patent Misuse Where a Non-Compete Provision in a Patent License Prohibited Post Termination Competition in Nonpatented Goods: *County Materials Corp. v. Allan Block Corp.*, No. 06-2857, 2007 U.S. App. LEXIS 22216 (7<sup>th</sup> Cir. Sep. 18, 2007)”

### **Copyright Law**

LexisNexis Emerging Issue Commentary, “Eric E. Bensen on *Costco Wholesale Corp. v. Omega S.A.*: What Does a 4-4 Tie Say About the Future of the First Sale Doctrine?”

LexisNexis Emerging Issue Commentary, “Eric E. Bensen, A Preview of the Supreme Court’s Decision on the Scope the Copyright First Sale Doctrine in *Costco Wholesale Corp. v. Omega S.A.* (2010)”

LexisNexis Emerging Issue Commentary, “Eric E. Bensen on the Google Library Project Class Action”

LexisNexis Expert Commentary, “Eric E. Bensen on the Ninth Circuit’s Holding that a Compulsory License Did Not Give a Karaoke Machine Manufacturer the Right to Display Song Lyrics *in Real Time* with the Licensed Song Recordings: *Leadsinger, Inc. v. BMG Music Publ’g*, 512 F.3d 522, 85 U.S.P.Q.2D 1257, Copy. L. Rep. (CCH) P29,499 (9<sup>th</sup> Cir. 2008)”

LexisNexis Expert Commentary, “Eric E. Bensen on the First Circuit’s Holdings Concerning Standing to Sue for Copyright Infringement, Constructive Notice of Copyright Ownership and Allegations of Copyright Infringement Based on Authorization of Musical Performances: *Latin Am. Music Co. v. Archdiocese of San Juan*, 499 F.3d 32, 82 U.S.P.Q.2d (BNA) 1007, Copy. L. Rep. (CCH) P29,434 (1<sup>st</sup> Cir. 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the First Circuit’s Holding that a Party’s State Law Claim for an Accounting of Profits from a Co-Author on the Sales of a Copyrighted Work was Subject to the Copyright Act’s Three-Year Statute of Limitations Where the Party’s Ownership in the Copyright was Challenged by the Defendant: *Cambridge Literary Properties, Ltd. v. Goebel Porzellanfabrik G.m.b.H.*, 510 F.3d 77 (1<sup>st</sup> Cir. 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Fourth Circuit’s Affirmance of the Rejection of a Copyright Registration for Lack of Originality in *Darden v. Peters*, 488 F.3d 277, Copy L. Rep. (CCH) P29,381 (4<sup>th</sup> Cir. 2007)”

## **Trade Secret Law**

LexisNexis Expert Commentary, “Eric E. Bensen on the Texas Court of Appeals’ Holding that an Allegedly Misappropriated Formula was Not a Trade Secret Because it Lacked Definiteness: *Global Water Group, Inc. v. Atchley*, 244 S.W.3d 924 (2008)”

LexisNexis Expert Commentary, “Eric E. Bensen on the District Court of Utah’s Holding that Knowledge of a Trade Secret is Not a Requirement for Trade Secret Misappropriation: *ClearOne Comms., Inc. v. Chiang*, No. 2:07-cv-37, 2007 U.S. Dist. LEXIS 91693 (D. Utah Dec. 13, 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on Intellectual Property Protection for Software and the California Court of Appeal’s Holding that Allegedly Misappropriated Source Code Routines Did Not Have the Necessary Independent Economic Value to Qualify for Trade Secret Protection: *Yield Dynamics, Inc. v. TEA Systems Corp.*, 154 Cal. App. 4th 547, 66 Cal. Rptr. 3d 1 (2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Georgia Court of Appeals’ Application of the Discovery Rule for Trade Secret Misappropriation: *Porex Corp. v. Haldopoulos*, 644 S.E.2d 349 (Ga. App. 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the South Carolina Supreme Court’s Holding that a Real Estate Agency’s List of Renters Did Not Constitute a Trade Secret: *Atwood Agency v. Black*, 646 S.E.2d 882 (S.C. 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the First Circuit’s Holding that a Trade Secret Claimant’s Obligation to Show that it Took Reasonable Steps to Preserve Secrecy is Not Met by Showing Actual Confidential Treatment: *Incase, Inc. v. Timex Corp.*, 488 F.3d 46 (1<sup>st</sup> Cir. 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Sixth Circuit’s Application of the Discovery Rule for Trade Secret Misappropriation in *Adcor Indus., Inc. v. Bevcorp.*, No. 06-4260, LLC, 2007 U.S. APP. LEXIS 25102 (6th Cir. Oct. 23, 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the New Hampshire Supreme Court’s Holding that the Uniform Trade Secret Act Preempts All Tort Claims Arising Solely from the Misappropriation of Information: *Mortgage Specialists, Inc. v. Davey*, 904 A.2d 652 (N.H. 2006)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Seventh Circuit’s Holding that a Trade Secret Owner Failed to Prove Secrecy: *BondPro Corp. v. Siemens Power Generation, Inc.*, 463 F.3d 702 (7th Cir. 2006)”

## **Licensing**

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on the Supreme Court’s Decision Respecting the Impact of a Covenant Not to Sue on a Defendant’s Standing to Seek a Declaratory Judgment of Trademark Invalidity in *Already, LLC v. Nike, Inc.*, 2013 U.S. LEXIS 602 (Jan. 9, 2013)”

LexisNexis Emerging Issue Analysis, “Eric E. Bensen on A Preview of the Supreme Court’s Decision in *Already, LLC v. Nike, Inc.*, 11-982, Respecting the Impact of a Covenant Not to Sue on a Defendant’s Standing to Seek a Declaratory Judgment of Trademark Invalidity”

LexisNexis Expert Commentary, “Eric E. Bensen on the Federal Circuit’s holding that Where a Patentee and its Exclusive Licensee Together Bring Suit for Infringement, the Patentee Need Not Join in an Appeal of the Decision for the Exclusive Licensee to Have Standing to Pursue the Appeal: *Schwarz Pharma, Inc. v. Paddock*, 504 F.3d 1371 (Fed. Cir. 2007)

LexisNexis Expert Commentary, “Eric Bensen on the Federal Circuit’s Holding that an Exclusive Field of Use Patent Licensee Does Not Have Standing to Sue in its Own Name Without Joining the Patentee: *International Gamco, Inc. v. Adams*, 2007-1034, 2007 U.S. App. LEXIS 24099 (Fed. Cir. Oct. 15, 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Second Circuit’s Rejection of Retroactive Copyright Licensing: *Davis v. Blige*, No. 05-6844-cv, 2007 U.S. App. LEXIS 23375 (2d Cir. 2007)”

LexisNexis Expert Commentary, “Eric E. Bensen on the Sixth Circuit’s Holding that the Receipt of Royalties Did Not Support an Inference of the Existence of a License: *Bridgeport Music, Inc. v. WB Music Corp.*, 508 F.3d 394 (6th Cir. 2007)”

#### **Articles (Other):**

Eric E. Bensen, “The Major Provisions of the America Invents Act”, The Metropolitan Corporate Counsel (2011)

Eric E. Bensen, “What are the Best Practices for Assigning Tasks to Various Levels of Attorneys?”, LexisNexis Legal Business Community (2011)

Eric E. Bensen & Rebecca K. Myers, “Budgets are a Reality for Litigators”, HB Litigation Conferences (2011)

Eric E. Bensen & Rebecca K. Myers, “What Good is a Litigation Budget?”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Effective Caseload Management: Tips from Bensen & Myers”, LexisNexis In-House Advisory (2010)

Eric E. Bensen & Rebecca K. Myers, “Does Bringing this Suit Make Sense?”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Does Settling the Case Make Sense?”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Do Litigation Team Members Have Access to the Information They Need?”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Is Discovery Being Managed Properly? Introduction”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Is Discovery Being Managed Properly? Document Collection”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Is Discovery Being Managed Properly? Document Review”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Are Attorneys Properly Prepared for Privilege Review?”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Is the Litigation Team Ready for Trial?”, LexisNexis Legal Business Community (2010)

Eric E. Bensen & Rebecca K. Myers, “Does Bringing this Suit Make Sense?” In-House Counsel Quarterly (2010)

Eric E. Bensen, Striking a Chord, Los Angeles Daily J., Oct. 24, 2008, at 7 (analysis of *Leadsinger, Inc. v. BMG Music Publ'g*, 512 F.3d 522 (9th Cir. 2008) and compulsory licensing under the Copyright Act)

**Headnotes (as United States Reporter for LexisNexis Australia’s *Intellectual Property Reports*)**

*LKQ Corp. v. GM Glob. Tech. Operations LLC* (Fed. Cir. 2024) (en banc)

*Edwards Lifesciences Corp. v. Meril Life Scis. Priv. Ltd.* (Fed. Cir. 2024)

*Regeneron Pharms., Inc. v. Novartis Pharma AG* (2d Cir. 2024)

*UIRC-GSA Holdings, LLC v. William Blair & Co., L.L.C.* (7<sup>th</sup> Cir. 2024)

*In re Go & Assocs., LLC* (Fed. Cir. 2024)

*Hunley v. Instagram, LLC* (9<sup>th</sup> Cir. 2023)

*Jack Daniel’s Props. v. VIP Prods. LLC* (U.S. 2023)

*Andy Warhol Found. for the Visual Arts, Inc. v. Goldsmith* (U.S. 2023)

*Amgen Inc. v. Sanofi* (U.S. 2023)

*RiseandShine Corp. v. PepsiCo, Inc.* (Fed. Cir. 2022)

*INVT SPE LLC v. ITC* (Fed. Cir. 2022)

*Benjamin Moore & Co. v The Attorney General of Canada* (Canada Fed. Ct. 2022)

*Thaler v. Vidal* (Fed. Cir. 2022)

*Pyrotechnics Mgmt. v. XFX Pyrotechnics LLC* (3d Cir. 2022)

*Wreal, Ltd. Liab. Co. v. Amazon.com, Inc.* (11<sup>th</sup> Cir. 2022)

*Hamilton Int’l Ltd. v. Vortic LLC* (2d Cir. 2022)

*Cont’l Auto. Sys. v. Avanci* (5<sup>th</sup> Cir. 2022)

*Campbell Soup Co. v. Gamon Plus, Inc.* (Fed. Cir. 2021)

*Midlevelu, Inc. v. ACI Info. Grp.* (11<sup>th</sup> Cir. 2021)

*Hyatt v. Hirshfeld* (Fed. Cir. 2021)  
*Minerva Surgical, Inc. v. Hologic, Inc.* (U.S. 2021)  
*Google LLC v. Oracle Am., Inc.* (U.S. 2021)  
*FTC v. Qualcomm* (9<sup>th</sup> Cir. 2020)  
*In re PersonalWeb Techs. LLC* (Fed. Cir. 2020)  
*United States Patent v. Booking.com B. V.* (U.S. 2020)  
*Romag Fasteners, Inc. v. Fossil Grp., Inc.* (U.S. 2020)  
*Duncan Parking Techs.* (Fed. Cir. 2019)  
*FTC v. Qualcomm Inc.* (N.D. Cal. 2019)  
*Mission Prod. Holdings v. Tempnology, LLC* (U.S. 2019)  
*Trading Techs. Int'l, Inc. v. IBG LLC, 2017-2257* (Fed. Cir. 2019)  
*Trading Techs. Int'l, Inc. v. IBG LLC, 2017-2323* (Fed. Cir. 2019)  
*Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC* (U.S. 2019)  
*Helsinn Healthcare S. A. v. Teva Pharms. USA, Inc.* (U.S. 2019)  
*Capitol Records, LLC v. ReDigi Inc.* (2d Cir. 2018)  
*Converse, Inc. v. ITC* (Fed. Cir. 2018)  
*Plixer Int'l v. Scrutinizer GmbH* (1<sup>st</sup> Cir. 2018)  
*Sazerac Brands, LLC v. Peristyle, LLC* (6<sup>th</sup> Cir. 2018)  
*Rentmeester v. Nike, Inc.* (9<sup>th</sup> Cir. 2018)  
*Spanski Enters. v. Telewizja Polska, S.A.* (D.C. Cir. 2018)  
*WesternGeco LLC v. Ion Geophysical Corp.* (U.S. 2018)  
*BMG Rights Mgmt. (US) LLC v. Cox Communs., Inc.* (9<sup>th</sup> Cir. 2018)  
*Oracle America, Inc. v. Google, Inc.* (9<sup>th</sup> Cir. 2018)  
*Ventura Content, Ltd. v. Motherless, Inc.* (9<sup>th</sup> Cir. 2018)  
*Google LLC v. Equustek Sols. Inc.* (N.D. Cal. 2017)  
*TCL Commun. Tech. Holdings, Ltd. v. Telefonaktiebolaget LM Ericsson* (C.D. Cal. 2017)  
*Amgen, Inc. v. Sanofi* (Fed. Cir. 2017)  
*Technomed Ltd. v. Bluecrest Health Screening Ltd.* (U.K. I.P. Ct. 2017)  
*Neptune (Europe) Ltd. v. Devol Kitchens Ltd.* (U.K. Pats. Ct. 2017)  
*Unwired Planet Int'l v. Huawei Technologies Co.* (U.K. Pats. Ct. 2017)  
*Google, Inc. v. Equustek Solutions, Inc.* (S. Ct. Canada 2017)

*AstraZeneca Canada, Inc. v. Apotex, Inc.* (S. Ct. Canada 2017)

*Matal v. Tam* (U.S. 2017)

*Impression Prods. v. Lexmark Int'l, Inc.* (U.S. 2017)

*TC Heartland LLC v. Kraft Foods Grp. Brands LLC* (U.S. 2017)

*Elliot v. Google, Inc.* (9th Cir. 2017)

*Star Athletica, L.L.C. v. Varsity Brands, Inc.* (U.S. 2017)

*Life Technologies Corp. v. Promega Corp.* (U.S. 2017)

*Samsung Electronics Co. v. Apple, Inc.* (U.S. 2016)

*Meds. Co. v. Hospira, Inc.* (Fed. Cir., en banc 2016)

*Cuozzo Speed Techs., LLC v. Lee* (U.S. 2016)

*Halo Electronics v. Pulse Electronics* (U.S. 2016)

*Kirtsaeng v. John Wiley & Sons, Inc.* (U.S. 2016)

*Lexmark Int'l, Inc. v. Quality Cartridges, Inc.* (Fed. Cir., en banc 2016)

*Suprema, Inc. v. ITC* (Fed. Cir., en banc 2015)

*Akamai Techs. v. Limelight Networks, Inc.* (Fed. Cir., en banc 2015)

*Kimble v. Marvel Entm't, LLC* (U.S. 2015)

*Commil USA, LLC v. Cisco Sys.* (U.S. 2015)

*Teva Pharm. USA, Inc. v. Sandoz, Inc.* (U.S. 2014)

*ABC, Inc. v. Aereo, Inc.* (U.S. 2014)

*Alice Corp. Pty. v. CLS Bank Int'l* (U.S. 2014)

*Limelight Networks, Inc. v. Akamai Techs., Inc.* (U.S. 2014)

*Nautilus, Inc. v. Biosig Instruments, Inc.* (U.S. 2014)

*Octane Fitness, LLC v. ICON Health & Fitness, Inc.* (U.S. 2014)

*Medtronic, Inc. v. Mirowski Family Ventures, LLC* (U.S. 2014)

*Lighting Ballast Control LLC v. Philips Elecs. N.A. Corp.* (Fed. Cir., en banc 2014)

*Kirtsaeng v. John Wiley & Sons, Inc.* (U.S. 2013)

*Federal Trade Commission v. Actavis, Inc.* (U.S. 2013)

*Bowman v. Monsanto Co.* (U.S. 2013)

*Association for Molecular Pathology v. Myriad Genetics* (U.S. 2013)

*Akamai Techs., Inc. v. Limelight Networks, Inc.* (Fed. Cir., en banc 2013)

*Mayo Collaborative Servs. v. Prometheus Labs.* (U.S. 2012)

*Association of Molecular Pathology. v. United States PTO* (Fed. Cir. 2012)

*Sunbeam Prods. v. Chicago Am. Mfg.* (7th Cir. 2012)

*Apple, Inc. v. Samsung Elecs. Co.* (Fed. Cir. 2012)

## **AMICUS BRIEFS**

Jan. 3, 2018 Brief of Amicus Curiae Intellectual Property Law Scholar in Support of Petitioners, *EVE-USA, Inc. v. Mentor Graphics Corp.*, No. 17-804 (U.S.).

May 15, 2017 Brief of Amicus Curiae Intellectual Property Law Scholar in Support of Defendants-Appellants' Petition for Rehearing En Banc, *Mentor Graphics Corp. v. EVE-USA, Inc.*, Nos. 15-1470, -1554, -1556 (Fed. Cir.).

Feb. 5, 2015 Brief of Amici Curiae Center for Intellectual Property Research of the Indiana University Maurer School of Law and Other Scholars in Support of Petitioners, *Kimble v. Marvel Enterprises, Inc.*, No. 13-720 (U.S.).

Jan. 17, 2014 Brief of Amici Curiae for the Center for Intellectual Property Research of the Indiana University Maurer School of Law and Other Legal and Economic Scholars in Support of Petitioners, *Kimble v. Marvel Enterprises, Inc.*, No. 13-720 (U.S.).

Aug. 8, 2009 Brief of Amicus Curiae Intellectual Property Owners Association in Support of Neither Party, *Bilksi v. Doll*, No. 08-964 (U.S.).

Apr. 7, 2008 Brief of Intellectual Property Owners Association as Amicus Curiae in Support of Neither Party, *In Re Bilksi*, 2007-1130 (Fed. Cir.) (en banc).

## **SPEAKING**

### **In Person**

Oct. 29, 2019: Suffolk University Law School's Second Annual Intellectual Property & Innovation Conference, Speaker, "Defend Trade Secrets Act: Advantages and Disadvantages of Federal v. State Law"

Sep. 30, 2010: Houston Intellectual Property Law Association Annual Intellectual Property Law Institute, Speaker, "Post-*Lucent* Damages Issues and Case Update"

Nov. 15, 2007: European Patent Lawyers Association's ("EPLAW") Congress, Brussels, Belgium, Speaker, provided expertise on U.S Patent Damages Law in connection with EPLAW's consideration of Article 13 (Damages) of the Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the Enforcement of Intellectual Property Rights

Dec. 1, 2008: Patents Committee of the Bar Association of the City of New York, Speaker, Roundtable Discussion of *In re Bilksi*

Oct. 17, 2008: New York State Bar Association Intellectual Property Section Fall Meeting, Cooperstown, New York, Moderator, "Changing Corporate Teams: Will the New Team Inevitably Get to Use the Old Team's Playbook?"

May 2, 2014: Environmental and Emerging Claim Manager Association 2014 Conference,

Speaker, “Avoiding the Hazards of E-Discovery: Preparing for a Conference Pursuant to Federal Rule of Civil Procedure 26(f)”

Feb. 22, 2011: Nassau County Bar Association Intellectual Property Law Committee, Speaker, “*Uniloc USA, Ltd. v. Microsoft Corp.* and Its Likely Impact on the Development of Patent Damages Theories”

Nov. 22, 2010: Suffolk County Bar Association Intellectual Property Law Committee, Speaker, “Developments in Patent Damages Law Since *Lucent*”

Feb. 19, 2010: Nassau County Bar Association Intellectual Property Law Committee, Speaker, “*Lucent* and the State of Reasonable Royalties for Patent Infringement”

Dec. 3, 2009: Suffolk County Bar Association Intellectual Property Law Committee, Speaker, “*Bilksi* at the Supreme Court”

### **Podcasts**

Jun. 29, 2022: LexisNexis Practical Guidance Podcast, Speaker, “Exploring the Defend Trade Secrets Act”

### **Webinars**

Oct. 8, 2014: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

Dec. 17, 2013: LexisNexis/Managing Intellectual Property Web Seminar, Speaker, “Patent Trolls & Damages”

Dec. 11, 2013: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

Jun. 27, 2013: Speaker, “Latest US Biotech Developments: Monsanto & Myriad.”

May 8, 2013: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

Nov. 28, 2012: Managing IP/Wolters Kluwer webinar, Speaker, “IP Licensing: What’s Lurking in Common Provisions”

Nov. 7, 2012: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

Sep. 19, 2012: LexisNexis/Managing Intellectual Property Web Seminar, Speaker, “The State of Patent Eligibility”

Apr. 18, 2012: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

Oct. 13, 2011: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

Aug. 10, 2011: LexisNexis/Managing Intellectual Property Web Seminar, Speaker, “Dissecting the Gene Patent Debate”

Aug. 3, 2011: Business Development Academy, Speaker, “Calculating Damages Resulting from Patent Infringement”

May 12, 2011: LexisNexis Web Seminar, Speaker, “LexisNexis Presents: Bensen & Myers’ Best Practices for Litigation Management Budgeting Tools, Settlement Strategies, and Solving Ethical Dilemmas”

Mar. 22, 2011: Lexis Business Community Podcast, “Eric E. Bensen and Rebecca K. Myers on Litigation Management”

Dec. 21, 2010: LexisNexis/Managing Intellectual Property Web Seminar, Speaker, “Patent Damages in the Post-*Lucent* Landscape”

Oct. 28, 2010: LexisNexis Bankruptcy Law Community Podcast: “Eric Bensen Discusses Collier Guide to Chapter 11: Intellectual Property Issues in Bankruptcy”

Aug. 16, 2010: LexisNexis/Managing Intellectual Property Web Seminar, Speaker, “Post-*Bilski* Perspectives: Practical Advice and Abstract Ideas”

July 16, 2009: LexisNexis Webinar, Speaker, “Gain More Control Over Every Stage of Litigation-Including Costs”

Apr. 2, 2009: LexisNexis/Managing Intellectual Property Web Seminar, Speaker, “Software Patents after *Bilski*”

Feb. 18, 2009: Intellectual Property Owner’s Association Licensing Committee, Speaker, Discussion of *In re Bilksi*

Mar. 7, 2008: LexisNexis Intellectual Property Podcast, interviewed at length concerning the Patent Reform Act of 2007

## **LEXISNEXIS BLOGS**

Aug. 21, 2011: “What are the Best Practices for Assigning Tasks to Various Levels of Attorneys?”

Aug. 16, 2011: “Does the Gene Patent Decision Raise Questions about the Eligibility of Other Compositions of Matter?”

May 11, 2011: “Is the Litigation Team Ready for Trial?”

May 11, 2011: “Will Discovery Management Avoid Ethical Pitfalls?”

May 11, 2011: “Are Attorneys Properly Prepared for Privilege Review?”

May 10, 2011: “Budgets Are A Reality For Litigators”

May 5, 2011: “Litigation Budgets Can Help Resolve Differences Between Inhouse And Outside Counsel”

## **PRIOR PROFESSIONAL**

**Vandenberg & Feliu LLP** (N.Y.)

*Of Counsel*, May 2013 – December 2015

**Hofstra University School of Law** (N.Y.)

*Visiting Associate Professor of Law*, 2008 academic year

Courses: Patent Law, Copyright Law, Intellectual Property Licensing

**Paul, Hastings, Janofsky & Walker LLP** (N.Y.)

*Intellectual Property Litigation & Licensing*, Feb. 2000 – Aug. 2008

**Dewey Ballantine LLP** (N.Y.)

*Litigation & Intellectual Property Litigation*, Sep. 1996 – Feb. 2000

**Mudge, Rose, Guthrie, Alexander & Ferdon** (N.Y.)

*Summer Associate*, Summer 1995

## **EDUCATION**

**Hofstra University School of Law**, J.D., 1996

*Hofstra Law Review*, Associate Editor

### **Judicial Internships:**

Hon. Frank X. Altimari, United States Court of Appeals for the Second Circuit, Fall 1995

Hon. Leo F. McGinity, Chief Administrative Judge, New York State Supreme Court,  
Nassau County, Summer 1994

Hofstra University, B.B.A. (Marketing), 1987

## **ADMISSIONS**

**State:** Texas (from 2022), New York (1997-2023)

**Courts:** United States Supreme Court; United States Court of Appeals for the Federal Circuit