

Trial Ace: Carlton Fields' Ethan Horwitz

By **Chelsea Naso**

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Intellectual property litigator and Carlton Fields Jordan Burt LLP partner Ethan Horwitz knew two things when he was studying for his mathematics doctorate: He was not interested in law, and he certainly had no desire to become a litigator.

But as Horwitz slogged through his mathematics thesis — which centered on a more efficient means of testing artificial heart valves — and began looking into his job prospects, the Law360 Trial Ace realized he did not want to pursue a career in such an isolated field.

“I always thought, ‘I’ll get a doctorate and get a good job,’” Horwitz said. “The math was very interesting, but it was also very isolating. You sat in your room and did work, but you weren’t around people.”

With an LSAT coincidentally approaching, Horwitz figured he would take the test just in case.

Soon he was studying law during the day while developing his thesis at night — and finding time in between to support himself.

Finally, Horwitz recalled, something had to give. He dropped out of the doctorate program at New York University's Courant Institute of Mathematical Sciences and never looked back.

“I never got my Ph.D., but I loved the law. The first semester in, I said, ‘OK, yeah, law is for me.’ Best decision I ever made in my life,” Horwitz said.

On top of the opportunity to regularly meet a new cast of characters, Horwitz was also intrigued by the privilege to get paid to learn about various types of technology, he noted.

“You use your mind, you interact with people, and one of the things I saw in science was you take one subject area and beat it to death, where as a patent attorney or patent litigator, I would be seeing technology after technology, and now I get the best experts in the world to teach me and I don’t have to



Ethan Horwitz

pay tuition," he said. "They pay me. What more could I ask for in life?"

Horwitz earned his law degree from St. John's University School of Law in 1976 and lined up a job, but the firm fell apart while he was preparing for the bar exam. He then landed a temporary position as an associate at Cooper & Dunham LLP, where he would be tasked with doing the one thing he truly thought would never interest him: litigation.

But he was proven wrong yet again. That first taste of the courtroom, where he had to defend a patent related to X-ray computed tomography, or CT scans, had him hooked. The defendant's argument was that the patent was obvious, but when the inventor, Sir Godfrey Newbold Hounsfield, won a Nobel Peace Prize for his work, the case was settled, Horwitz recalled.

"I was positive I didn't want to be a litigator. Reality proved me wrong," Horwitz said. "Being in the courtroom, there's almost no experience like it. But also the strategy."

That twist of fate turned out to be the first step in a more than 25-year career as a first-chair litigator in high-stakes intellectual property matters, representing clients in patent, trademark, trade dress, copyright and false advertising cases that landed him among Law360's Trial Aces.

Horwitz's long list of trial achievements include the first-ever preliminary injunction on a design patent in his representation of Oscar Mayer's Lunchables prepacked lunches against Sara Lee, as well as one of the first preliminary injunctions based on dilution in his representation of Pepperidge Farm's claim to the shape of its Goldfish cracker.

On the copyright front, Horwitz also helped Captain America co-creator Joe Simon reclaim his rights to the character from Marvel Comics in a landmark Second Circuit case. In an earlier attempt to regain his rights to Captain America, Simon had settled the case and admitted in the settlement that the work done had been for hire. In an appeal, however, Horwitz was able to clinch a game-changing ruling.

"The court said it really didn't matter under the copyright law what previous judgments were, but what had really happened," Horwitz said. "That was a case that shook up the publishing industry."

Much of his success can be attributed to his fearlessness in the courtroom and his ability to navigate complex litigation on his feet, without getting too caught up in a script, noted former colleague Jonathan Ball, a Greenberg Traurig LLP partner who worked alongside Horwitz during their shared time at King & Spalding LLP.

"We were at a hearing, and Ethan was trying to demonstrate the difference between something being intentionally placed in a particular location versus something being nearly in that location. Ethan's on his feet arguing in front of the judge. He takes a pen and throws it across the room, and I think everyone's jaws dropped," he recalled. "It caught the attention of the court and certainly proved the point."

Horwitz's fearlessness and ability to break down complex topics was certainly key in his representation of flash memory fabricator Spansion in one of the largest International Trade Commission cases in history.

The two-week trial on two patents — one concerning flash chip construction and another, flash chip programming — ultimately settled, and was one of a family of suits that resulted in a total of \$300 million for the client. While the travel associated with the trial was intriguing, it was learning about the

construction and operation of a pinky-nail-size chip that really drew Horwitz into the case.

“We had depositions around the world,” he said. “It was two different types of technology relating to the chip, both just fascinating.”

While it would be easy to attribute Horwitz’s success to his intelligence, it’s much more than that, Carlton Fields associate Morgan Swing pointed out. Horwitz’s ability to strategize, his calm and friendly demeanor, and the way he easily picks up what makes people tick helps set him apart.

“That combination of intelligence and great strategy along with his grounded nature I really think is what makes him successful. He can listen; he can reason; he can take information from different places and put it together. He really listens to his client and sees the whole picture,” she said. “I think that combination is a killer combination, both as a person and a litigator.”

Swing is working alongside Horwitz for the first time, as the intellectual property heavyweight only joined Carlton Fields in 2014, after about seven years at King & Spalding. Previously, Horwitz served as the intellectual property chair at Goodwin Procter LLP, which he called home for about five years, but he “grew up” during a roughly 20-year stretch at Darby & Darby.

Throughout his time as a lawyer, Horwitz also authored Matthew Bender & Co: Horwitz on Patent Litigation, a three-volume collection on IP law, as well as the seven-volume Intellectual Property Counseling and Litigation, the five-volume World Trademark Law and Practice, and the 13-volume Patent Office Rules and Practice

While winning cases for clients is certainly important, it’s clear in Horwitz’s recollections of his career highlights that it’s his fascination with technology, love of strategizing and genuine interest in other human beings that drives his love of intellectual property law.

“You have to live your life in an interesting manner,” he said. “If you’re in an office with the door closed all day long, you can go crazy.”

--Editing by Jeremy Barker and Edrienne Su.