



## Charles M. McMahon

Partner

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### Main Bio

**Charles (Charlie) McMahon is a first-chair litigator who focuses his practice on patent, trademark, copyright, trade secret, and unfair competition law.**

Charlie has represented domestic and multinational clients in more than a dozen federal district courts and before the Patent and Trademark Office, the Patent Trial and Appeal Board (PTAB), the International Trade Commission (ITC), the Court of Appeals for the Federal Circuit, and the Supreme Court. Charlie believes that litigating to win is also the best way to settle a case, and he has extensive experience with mediation and negotiating settlements. Charlie also counsels clients on licensing and litigation avoidance. Collectively, he has advised clients on worldwide IP licensing and settlement deals valued in excess of sixty million dollars.

Charlie is a registered patent attorney with a bachelor's degree in electrical engineering and experience helping clients apply for and obtain patents in the United States and abroad. Charlie is experienced in a variety of technical areas, including wireless communications, solid-state electronics, encryption systems, vehicular transmission systems, digital imaging systems, electronic measurement devices, lithium batteries, software applications, and online business-to-business exchange systems.

*\*Matter completed prior to joining Benesch.*

### Experience

#### Intellectual Property

- Class Technologies Inc. v. AK Meeting IP LLC (S.D. Fla. 2024); defended a provider of online collaboration services against patent infringement charges filed by a non-practicing entity, resulting in favorable resolution.\*
- Jawbone Innovations, LLC v. ZTE Corporation (E.D. Tex. 2024); defended a manufacturer of wireless communication devices in this patent infringement action, which resulted in a favorable resolution.\*

#### Related Practices

Intellectual Property

#### Education

- George Washington University Law School, J.D.
- University of Notre Dame, BS, Electrical Engineering

#### Credentials

- Illinois
- Minnesota
- Supreme Court of the United States
- U.S. Court of Appeals for the Federal Circuit
- U.S. District Court for the Northern District of Illinois
- U.S. District Court for the Eastern District of Michigan
- U.S. District Court for the Western District of Michigan
- U.S. District Court for the Eastern District of Texas
- U.S. District Court for the Northern District of Texas

#### Recognitions

- The Legal 500, 2017 to present
- The Best Lawyers in America, Patent Litigation, 2024
- IAM Patent 1000 – The World's Leading Patent Practitioners 2017 to 2023
- Illinois Super Lawyer 2008 to 2020
- Law Bulletin Publishing Company

- Certain Semiconductor Devices Having Layered Dummy Fill (ITC Inv. No. 337-TA-1342, 2023); represented a leading manufacturer of imaging sensors as a respondent in this investigation, resulting in favorable resolution and the client paying zero in settlement fees.\*
  - Werner Co. v. Louisville Ladder, Inc. (W.D. Ky 2023); represented a leading ladder manufacturer accused of infringing a competitor's patent, resulting in dismissal of the competitor's patent infringement claim after successfully challenging the asserted patent claims.\*
  - Certain Cloud-Connected Wood Pellet Grills (ITC Inv. No. 337-TA-1237, 2022); represented a leading manufacturer of wood pellet grills as the complainant in this investigation, resulting in a finding of infringement and issuance of a limited exclusion order.\*
  - INVT SPT LLC v. ITC (Fed. Circ. 2022); represented manufacturer of cellular communications devices in this appeal filed by a non-practicing entity, resulting in affirmance of the ITC's favorable ruling of non-infringement.\*
  - Wakefield v. Blackboard, Inc. (Fed. Cir. 2022); represented a provider of online collaboration services in defending this appeal filed by a non-practicing entity, favorably resulting in affirmance of the district court's claim constructions and summary finding.\*
  - CoolTVNetwork.com v. Blackboard Inc. (D. Del. 2021); defended a provider of online collaboration services against in this patent infringement case filed by a non-practicing entity, resulting in favorable claim construction and a summary finding of invalidity as to all asserted claims.\*
  - TrickleStar Inc. v. AM Conservation Group, Inc. (N.D. Ill. 2021); defendant manufacturer of advanced powerstrips against claims of patent and trademark infringement, resulting in favorable resolution.\*
  - Evolved Wireless, LLC v. ZTE Corporation (D. Del. 2021); defended supplier of cellular communications devices in this patent infringement case, resulting in favorable resolution after the PTAB canceled all asserted claims from four of the five asserted patents.\*
  - Louisville Ladder, Inc. v. Werner Co. (Fed. Cir. 2021); represented a leading ladder manufacturer on competitor's appeal from a PTAB decision canceling all challenged claims, resulting in affirmance of the PTAB's favorable decision.\*
  - Werner Co. v. Louisville Ladder, Inc. (PTAB IPR2019-336, 2020); represented a leading ladder manufacturer as petitioner in this IPR proceeding challenging a competitor's patent, resulting in cancelation of all challenged claims.\*
  - Certain LTE- and 3G-Compliant Cellular Communications Devices (ITC Inv. No. 337-TA-1138, 2020); defended a
- Leading Lawyers Network

supplier of cellular communications devices in this investigation, resulting in a finding of no infringement.\*

- Technology Properties Limited v. ZTE Corporation (Fed. Cir. 2019); represented supplier of communications devices in defending favorable PTAB ruling, resulting in affirmance of summary judgment of non-infringement.\*
- ZTE (USA) Inc. v. Evolved Wireless (Fed. Cir. 2019); represented supplier of communications devices in defending favorable PTAB ruling, resulting in affirmance of the cancelation of all challenged claims.\*
- ZTE (USA) Inc. v. Evolved Wireless, LLC (PTAB IPR2016-757, -758, -1277, -1280, -1349; 2018); represented supplier of cellular communications devices in this campaign of IPR proceedings, resulting in cancelation of all asserted claims for four of the five asserted patents.\*
- Technology Properties Limited v. ZTE (N.D. Cal. 2017); defended a manufacturer of wireless communication devices on remand from the Federal Circuit in this patent infringement action, resulting in summary judgment of non-infringement.\*
- InterDigital v. ZTE (D. Del. 2015); led a trial team to a favorable defense jury verdict in this case involving wireless communication technology.\*
- ZTE v. InterDigital (PTAB 2015); served as lead counsel in a successful inter partes review proceeding, in which the Patent Trial and Appeal Board cancelled claims that had previously survived a jury validity verdict.\*
- Technology Properties Limited v. ZTE (N.D. Cal. 2015); defended a manufacturer of wireless communication devices in this patent infringement action, which resulted in a favorable claim construction ruling and a stipulation of non-infringement.\*
- InterDigital v. US International Trade Commission (Fed. Cir. 2015); represented a named respondent from the underlying ITC investigation, resulting in a decision affirming the ITC's finding that no valid patent claim was infringed.\*
- Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof (ITC Inv. No. 337-TA-868, 2014); represented a manufacturer of wireless devices named as a respondent in this investigation, resulting in a finding of non-infringement.\*
- McDavid v. NIKE (N.D. Ill. 2014); represented NIKE and an individual challenging inventorship in this patent infringement litigation involving athletic wear; the case was resolved on the eve of a trial on the inventorship claim.\*
- Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof (ITC Inv. No. 337-TA-800, 2013); represented a manufacturer of wireless devices named as a

respondent in this investigation, resulting in a finding of non-infringement.\*

- AOL, Inc. v. Yahoo! Inc. (S.D.N.Y. 2009); represented Yahoo! as a declaratory judgment defendant and asserted patent infringement claims on behalf of Yahoo! against AOL; the dispute was resolved on favorable terms.\*
- Lithium Battery Patent Enforcement (W.D. Wis. 2008); represented Energizer Holdings, Inc., and Eveready Battery Co. in this case involving two patents for advanced primary battery technology; the court granted a preliminary injunction to halt sales of the infringing batteries.\*
- Eaton Corporation v. ZF Friedrichshafen A.G. and ArvinMeritor, Inc. (E.D. Mich. 2008); represented defendants.\*
- ZF Friedrichshafen A.G. and ArvinMeritor, Inc., in this patent infringement action involving automated heavy-duty truck transmission technology; after a two-week trial, the jury returned a unanimous defense verdict on all issues.\*
- Certain Automated Mechanical Transmission Systems for Medium-Duty and Heavy-Duty Trucks and Components Thereof (ITC Inv. No. 503, 2005); represented respondents ZF Friedrichshafen A.G. and ArvinMeritor, Inc., in this Section 337 patent infringement investigation at the International Trade Commission; in the violation phase of the investigation, the ITC granted respondents' motion for summary determination with respect to one of the six asserted patents; the ITC also terminated the investigation, at the patent owner's request, with respect to two other patents and several claims of the remaining three patents; after a ten-day hearing on the merits, the administrative law judge ruled in favor of the respondents on all but one claim of one patent; the respondents designed around the one remaining claim, and Charles helped them work with Customs and Border Protection to ensure continuous importation of the redesigned product; when the patent owner brought an enforcement action, Charles helped ZF and ArvinMeritor become the first respondents ever to defend successfully against such a proceeding at the ITC; as a result of this victory, ZF and ArvinMeritor were able to continue the importation and sale of the redesigned product without interruption.\*

## News

- Charles M. McMahon and Andrew J. Meyer mentioned in Crain's Chicago People on the Move, June 17, 2024
- Charles McMahon and David Bluestone quoted in Law360 | "Benesch Grows IP Practice With Chicago Litigation Duo", May 9, 2024
- Benesch Continues Expansion of Chicago IP Litigation Practice, Adding BigLaw Partners Charles McMahon and

David Bluestone, May 7, 2024