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## Q&A With Mayer Brown's James Ferguson

Law360, New York (June 29, 2009) -- James R. Ferguson is a partner in the Chicago office of Mayer Brown LLP and a leader in the firm's intellectual property, complex commercial and white-collar criminal litigation practices. Ferguson has served as lead trial counsel for major corporations in patent, trademark, trade secret and Lanham Act litigation in the pharmaceutical, medical device, insurance, financial and chemical industries.

A former federal prosecutor, Ferguson has also served as lead trial counsel for corporations, partnerships and other entities in a broad range of commercial and white-collar criminal litigation, including antitrust, securities, environmental and tax cases.

### **Q: What is the most challenging case you've worked on, and why?**

A: I represented the innovator company in a Hatch-Waxman case involving a patented combination of a narcotic and ibuprofen. The prior art included more than 10 combinations of narcotics and other agents, which led to a very aggressive "obviousness" challenge to the patent's validity.

To rebut the challenge, we commissioned independent studies at three leading medical centers (Stanford, Sloan-Kettering and the University of California) to show that the patented combination had an unexpectedly synergistic effect.

On appeal, the Federal Circuit upheld the relevance of the synergy evidence, holding that a patentee could conduct new tests after the patent had issued to demonstrate the unique properties of the claimed invention. *Knoll Pharmaceutical Co. Inc. v. Teva Pharmaceuticals USA Inc.*, 367 F. 3d 1381 (Federal Circuit 2006).

By upholding the relevance of post-issuance testing, this decision provided new tools for patentees in Hatch-Waxman and other patent litigation.

**Q: What accomplishments as an attorney are you most proud of?**

A: I am most proud of my accomplishments as a supervisor in the U.S. attorney's office in Chicago, where I had the opportunity to work with lawyers of exceptional integrity, skill and dedication in investigating and prosecuting cases that had very clear and measurable benefits for the public good.

These cases — which ranged from mail and securities fraud to terrorism to judicial and political corruption — helped establish the U.S. attorney's office in Chicago as one of the premier law enforcement offices in the nation.

**Q: What aspects of law in your practice area are in need of reform, and why?**

A: The need for venue reform is especially acute in patent litigation. The current ability of patentees to select "plaintiff-friendly" venues has resulted in the filing of far too many cases in a small number of venues having only the most tangential connection with the defendant.

The Fifth Circuit's recent decision in *In re Volkswagen of America* is an encouraging development, as the Fifth Circuit held that a case filed in the notoriously plaintiff-friendly Eastern District of Texas should have been transferred based on the convenience of the witnesses and the location of the evidence.

More broadly, several of the current legislative proposals seek to amend the patent statute by limiting venue in patent cases to jurisdictions where the defendant resides or where the defendant has committed acts of infringement and has a regular and established place of business.

**Q: Where do you see the next wave of cases in your practice area coming from?**

A: Many of the major pharmaceutical companies are now shifting their research priorities to a focus on protein-based therapies or "biologics."

This development will result in an increase in biologics-based patent claims, and, correspondingly, an increase in disputes involving biologics-based intellectual property.

This is particularly true if, as seems likely, the FDA creates a biologics-approval process for generic competitors of FDA-approved biologics, similar to the Hatch-Waxman Act for generic drugs.

If this occurs, it will result in a sharp increase in biologics patent litigation similar to ANDA litigation in the Hatch-Waxman Act context.

**Q: Outside your own firm, name one lawyer who's impressed you and tell us why.**

A: On April 19, 1995, within hours of the tragic bombing of the federal building in Oklahoma City, Assistant U.S. Attorney Joe Hartzler contacted the Justice Department to offer his help in the investigation and prosecution of the persons responsible.

After the attorney general selected Joe to head the prosecution team, Joe spent more than two years on assignment in Oklahoma City and Denver, first investigating and preparing the case for trial and then presenting the case to a Denver jury.

The successful prosecution was later described by the Washington Post as "perhaps the most complex, massive and emotionally charged criminal case in U.S. history."

I first met Joe when we were both AUSAs in the U.S. attorney's office in Chicago. While many of us ultimately left the office for more lucrative positions in private practice, Joe remained in public service as an AUSA, first in Chicago and then in Springfield, Ill.

In his career, he has received numerous accolades, while raising three sons with his wife, and he has accomplished all this following a diagnosis in 1989 of multiple sclerosis.

Joe has received the National Multiple Sclerosis Society MS Father of the Year award and a Public Education award from the National Multiple Sclerosis Society.

While multiple sclerosis has affected Joe's mobility, it has not affected his spirit and ability.

**Q: What advice would you give to a young lawyer interested in getting into your practice area?**

A: Traditionally, a young lawyer interested in getting involved in patent litigation needed a technical background in areas such as electrical engineering or molecular biology.

However, in recent years, a growing number of corporate clients have placed a premium on experience in presenting complex technical issues in ways that can be understood by judges and juries.

Accordingly, my advice is to seek out every opportunity to gain experience in developing this skill — e.g., by preparing for and conducting depositions, by drafting motions or briefs,

or by preparing witnesses for testimony.

If you learn how to organize a technically complex case around two or three easily understood themes, you will be well on your way to becoming an effective patent litigator.