



Portfolio Media, Inc. | 860 Broadway, 6th Floor | New York, NY 10003 | www.law360.com
Phone: +1 646 783 7100 | Fax: +1 646 783 7161 | customerservice@portfoliomedia.com

Q&A With Kenyon & Kenyon's James Galbraith

Law360, New York (January 11, 2010) -- James Galbraith, a partner and intellectual property litigation practice area member at Kenyon & Kenyon LLP, has more than 30 years experience in intellectual property litigation, including trials and appeals of patent, trademark and trade secret misappropriation cases. Galbraith's litigation practice includes a variety of technical areas. In patent litigation, he has represented polymer manufacturers in cases involving plastics and catalysts, manufacturers of pharmaceuticals, agricultural chemical producers and producers of computer products and components.

Galbraith also counsels clients on intellectual property issues, including validity and infringement of intellectual property rights, and the transfer of intellectual property.

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

A: *Merck & Co. v. Teva Pharmaceuticals Inc.*, 395 F.3d 1364 (Fed. Cir. 2005). On behalf of Teva, we were challenging the validity of a patent that covered a drug product, Fosamax, which was the leading prescription drug for the treatment of osteoporosis. We had lost in the district court, which made our appellate burden particularly difficult.

The patented drug was a huge commercial success, with yearly sales of approximately \$2 billion, and we had to convince the court of appeals that it nevertheless "would have been obvious." The Federal Circuit reversed the district court, which opened the door for generic competition a decade before the patent would otherwise have expired.

Q: What do you do to prepare for oral argument?

A: First, I review the briefs and the record. I spend a considerable time studying the record, so that I am completely familiar with the facts and can instantly find every important bit of evidence in the appeal appendix. I make sure that I am thoroughly familiar with all the cases cited in the briefs.

I then prepare an outline of my argument. In the Federal Circuit, where all my appeals are heard, the oral argument is only 15 minutes per side, so that it is critical to focus on only the most important and most difficult points. Typically, the panel will interrupt with questions early and often, so that the outline never gets followed, but just in case the panel is quiet, I want to be able to present a cogent argument that covers the principal issues. I often have one of my colleagues who is not involved in the case read the briefs and act as a devil's advocate against my presentation and argument.

Q: What are some of the biggest problems with the U.S. appeals process?

A: Since all my appeals are to the Federal Circuit, I cannot speak generally. My observation has been that the Federal Circuit is required to decide too many cases. It has jurisdiction over all patent appeals, as well as jurisdiction over several other specific types of appeals, each of which involves a different body of law. Patent cases are probably the most complex of all federal cases, and almost all of them are for high stakes.

The Federal Circuit was established in the first place primarily to handle patent appeals, and I would like to see its jurisdictional mix changed so that it could devote more attention to those cases.

Q: Aside from your own cases, which cases that are currently on appeal are you following closely, and why?

A: In my practice, which is patent litigation, I am following *Ariad Pharmaceuticals v. Eli Lilly*, in which the court will decide en banc an important issue of patent law, which is whether a patent application must contain a separate "written description" of the invention.

Although this appears to be an inside-the-Beltway kind of issue, it has broad implications in patent litigation. I am also following *Bilski v. Doll*, which the Supreme Court will decide this term, and which deals with the patentability of business methods.

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

A: I have argued two appeals against John F. Lynch [partner at Howrey LLP], and was impressed both times with his presence in the courtroom and his ability to communicate with and engage the panel.

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

A: In patent litigation, the devil is often in the details. A young lawyer should develop the habit of digging deeply into the evidence in every case. Advice for any young lawyer interested in appellate practice: Develop your writing skills. The oral argument is typically only 15 minutes per side; the briefing is vastly more important.

