



JOSHUA JAMES ASSOCIATE

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EDUCATION

J.D., cum laude
Indiana University Maurer School of Law, 2014
B.S., summa cum laude, Biomedical Engineering
Illinois Institute of Technology, 2011
B.S., summa cum laude, Chemical Engineering
Illinois Institute of Technology, 2011

BAR ADMISSIONS

Illinois
U.S. Patent & Trademark Office
U.S. Court of Appeals, Fed. Cir.
U.S. Dist. Court, N.D. Illinois

Energetic and committed, Josh James brings a strong background in biomedical and chemical engineering to helping clients strengthen and enforce their intellectual property rights. His practice focuses on patent litigation, particularly Hatch-Waxman pharmaceutical litigations in federal courts and *inter partes review* (IPR) proceedings before the Patent Trial and Appeal Board (PTAB), as well as trademark counterfeiting litigation.

Josh's scientific knowledge helps him hit the ground running, especially in cases involving highly complex chemical compounds. He easily meets technical experts on their own terms and uses that knowledge to take a key role on joint-defense groups. Thinking forward, Josh is able to use his experience to help clients evaluate strategies that involve both federal courts and the PTAB.

Josh has been involved in multiple bench trials; arguing motions before judges in both federal courts and the PTAB; taking and defending depositions; drafting appellate briefs; drafting IPR and reexamination briefs; drafting pleadings on invalidity, noninfringement and claim construction issues; reviewing and producing documents; and leading coordination and strategy sessions among members of joint defense groups.

EXPERIENCE | OVERVIEW

- Josh has participated in bench trials, drafted and argued a motion, and drafted substantive briefs in several Hatch-Waxman pharmaceutical litigations.
- He has taken a deposition in federal district court and defended a deposition in an IPR proceedings.
- Josh has drafted an IPR petition that invalidated 19 of 34 claims and drafted a request that instituted reexamination on the remaining claims.

EXPERIENCE | LEGAL EXPERIENCE

- **Brinks Gilson & Lione**, Chicago, IL
Associate, September 2014-Present
- **Marshall Gerstein & Borun LLP**, Chicago, IL
Summer Associate, July 2013-August 2013

EXPERIENCE | NON-LEGAL EXPERIENCE

- **Illinois Institute of Technology (IIT)**, Chicago, IL
Research Experience for Undergraduates, June 2010-August 2011
Inter-Professional Research Opportunity (IPRO), January 2011-May 2011
Biomedical Engineering Senior Design, August 2009-May 2010
Research Experience for Undergraduates, June 2009-August 2009
- **Rehabilitation Institute of Chicago**, Chicago, IL
Research Experience for Undergraduates, June 2008-August 2008

EXPERIENCE | CIVIC ACTIVITIES

- ACS Spike Out Cancer Participant, 2008-2010
Project Linus Blanket Day, 2007-2009

PRACTICE GROUP

Litigation

AREA OF FOCUS

Medical Device
Biotechnology & Pharmaceutical

FORWARD THINKING

Alerts

- USPTO Announces Rules Changes: "Quick-Fixes" to AIA Rules Effective Immediately; Previews Additional Potential Rule Changes , March 27, 2015
- Is It Accessible? Internet Publications As CBM Prior Art, December 08, 2015
- Update: Is it Accessible? Internet Publications As CBM Prior Art, March 07, 2016
- USPTO Seeking Potential Reforms to PTAB Proceedings, April 14, 2017
- Improper Venue Causes a Hatch-Waxman Case To Leave the District of Delaware, October 24, 2018
- Federal Circuit Sets a High Bar for Article III Standing for Petitioners Not Yet Sued on Patents Under Inter Partes Review, July 24, 2019

Blog Posts

- USPTO Seeking Potential Reforms to PTAB Proceedings, April 14, 2017
- PTAB Sua Sponte Reconsiders Institution Nearly One Year After Institution Decision Issued, November 22, 2016
- Updated: Is It Accessible? Internet Publications As CBM Prior Art , March 07, 2016

HONORS

- Biomedical Engineering Distinguished Undergraduate Alumnus, Illinois Institute of Technology, 2017
- Dean's Honors, Indiana University Maurer School of Law, Fall 2011 and Spring/Fall 2013
- Camras Scholarship, Dean's List, and Tau Beta Pi, Illinois Institute of Technology, 2007-2011

AFFILIATIONS

- PTAB Bar Association, 2016-present
- American Intellectual Property Law Association, 2011-present
- Chicago Bar Association, 2015-present
- *Indiana Law Journal*, Board Member, 2013-2014
- Intellectual Property Association, 2011-2014
- Phi Alpha Delta, Clerk, 2013

