

# Tom Duston

## Patent Law Passion

by Dan Campana

The symbolism of, and the story behind, the samurai armor in Thomas L. Duston's office serves as a meaningful point of reference for his legal career.

It was presented to Duston, of **Marshall, Gerstein & Borun LLP**, by Dr. Ernest Manders, who turned to the firm in a patent infringement dispute involving a tissue expander he had created. Manders eventually prevailed at the end of the lengthy case and used the armor as a sign of his gratitude to Duston who loyally and fiercely battled for him.

Duston counts it as one of his most gratifying moments.

"Some of my most rewarding experiences as a lawyer have been representing individuals. (Manders) was really a selfless guy whose intellectual curiosity just led him to constantly innovate," Duston offers. "We came in and fought hard on his behalf for a number of years against a succession of large firms. Ultimately we prevailed."

Although the multimillion dollar settlement in the case is just one of many notable moments in Duston's 27-year career, it is an example of how he has crafted an approach to patent law—from infringement claims to trade secret disputes—that clearly balances technical and scientific aspects with the human element.

Duston, 52, prides himself on having a thirst for the details in his work, whether it be

a case related to, among other things, e-commerce or medical technology. He's also keenly aware of the human side, the people who are the stories behind innovation disputes. And, he knows how to package his position in a way that a judge or jury can grasp during a trial that lasts but a fraction of the time a patent case lasts.

Manders, a professor of surgery at the University of Pittsburgh and founder of a biotechnology company, was struck by how Duston and his team handled all aspects of the case, but also by how Duston allowed collaboration and input throughout the process.

"It was a wonderful working relationship. (Tom) is just as sharp as a tack, knowing the legal process and knowing which way to go," Manders explains. "It was a tour de force. He is our samurai warrior."

### Coast to Coast, Chicago Roots

Born in the Bronx, Duston didn't spend much time on the East Coast before his family eventually made it to Chicago around 1967. The family, with Duston the oldest of four children, planted roots in the Rogers Park neighborhood near Loyola University.

Duston was just 7 when his father passed away. He also remembers taking on responsibility not common at such a young age.

"I think I had my first job when I was about



7 or 8. I was delivering newspapers,” he recalls, noting his mother had to talk the newspaper company into letting him work. “For whatever reason, I got it in my head that it was important to be responsible.”

High school took Duston to Lane Tech from which he graduated in 1980 after experiencing the combination of typical course work, such as English, mixed with the school’s focus on technical trades.

“It was kind of a unique experience to go from European history to a class where you had a blast furnace in the classroom and you’re pouring molten metal into things,” he says.

Duston headed back east for college at Columbia University in Manhattan. He acknowledges being an English literature major was not a common entry into patent law, but he saw it as another part of the journey that briefly had him entertaining the thought of a career in academics.

Through his school years, an underlying thought remained that he wanted to be a lawyer. It wasn’t dictated by his lineage or a clear understanding of the profession.

“I don’t know where the idea came from. My mother would probably tell me I always talked about being a lawyer,” he says. “My dad was a chemist. We have doctors and other types of scientists in the family, but I ended up deciding to go to law school.”

His motivations for choosing the law were somewhat founded by the essence of Clarence Darrow and fighting to protect others. Duston also describes himself as having a fondness for debate.

Law school sent him west to the University of California Hastings College of Law in San Francisco, which he called a “perfect fit” because of his aspirations to be a litigator. Hastings was very trial focused and sat in a “huge hub of courtroom activity” in downtown San Francisco. A bevy of state and federal courts are nearby. The non-legal environment—Yosemite National Park, wine country and more—also proved to be a draw that keeps him visiting the area to this day.

During his third year at Hastings, Duston worked as an extern staff attorney for the 9th U.S. Circuit Court of Appeals writing bench briefs and other memorandums while working with many accomplished people. Duston says he had an open mind about where to go after law school, but an offer to work in Chicago hit the sweet spot: more urban than San Francisco, more livable than New York and he already knew how to survive the winters.

“It really has a feeling of home for me,” he says of Chicago.

## Digging into Patent Law

Duston returned to Chicago and began work at Chadwell & Kayser. He describes the “baptism by fire” of being thrown almost immediately into the scientific side of patent law in a case representing Abbott Laboratories. He spent the better part of two years in San Diego taking depositions and working various aspects of the case, all in an area of the law where he might not have necessarily seemed best suited.

Duston points out that in his early days of

patent law, a fair share of his peers had doctorates and many more carried backgrounds in science or engineering, while he walked in the door with his English literature degree.

“When I joined (Chadwell), I didn’t have a vision of doing patent litigation. As luck would have it, they had recently been retained by Abbott to represent them in a number of patent cases,” he explains. “I wouldn’t have been perceived as a natural fit for this kind of litigation, but I love science, I love technology, and I’m pretty adept at it.”

Whether driven by a natural motivation to learn or whether something in his blood passed from a family of doctors and scientists, Duston became increasingly drawn into the nuance of patent law. He was hooked.

“They were fun cases. I enjoyed that I could exercise this science and technology interest that I have at the same time I did legal work and advocacy,” Duston explains.

Duston later moved to Phelan, Pope & John where he grew his trial skills at the firm headed by one-time Cook County Board President Richard Phelan, Mike Pope and Peter John.

“All three of them were phenomenal trial lawyers, so it was really an opportunity to learn from the best,” Duston recalls.

He then worked for six years at Hedlund, Hanley & John, where he focused almost exclusively on patent cases, but sought an opportunity to continue growing his trial experience. In 2000, a contact he had at Marshall suggested the firm might be the place to do it. Duston said he’d be willing to talk. He ended up spending three hours that same day talking to half of their partners. A few days later, Duston joined Marshall, and he has been there ever since.

Over the last 14 years, Duston has honed his craft by handling cases in a wide array of technologies and innovation that include medical devices, Internet and e-commerce, biochemistry and aerospace. His successes have resulted in victories for businesses and individual inventors alike in protecting their patents against infringement or against claims they have infringed on the patents of others.

Duston highlights his involvement in the defense of several Internet retailers relating to patents established for various online interactions. Published reports from 2012 describe the Eolas case as saving millions of dollars in damages for Internet giants such as Amazon, Yahoo, JCPenney and CDW, had they been found to have violated patents for features like streaming video and rotating pictures.

The case played out in a small eastern Texas town and featured a host of Internet pioneers who described the collective development of certain web technologies before any one inventor could claim rights to creating them. Duston called the case significant because of its impact on the further progress of web technology, especially when the majority of recent U.S. patent filings are tied to software, e-commerce and the web.

“Every one of these cases is just fascinating to sit down and dig into all the way up to your elbows to see how a website operates,” Duston says. “In some respects, it’s kind of like archaeology. You’re sort of dusting off 15 or

20 years. While it doesn’t seem like a long time ago, 1991 or 1992 in technology terms is a generation ago.”

The job today involves staying on top of tech development, as well as the changing laws governing patent law, Duston explains.

## Learning, Explaining, Defending

Steve Nieslawski, vice president and assistant general counsel for CDW, believes Duston’s ability to prepare for what’s next is a definite strength.

“Tom is intelligent and stays very much in tune with the changing legal landscape in the IP world,” says Nieslawski. “If something is happening out there that affects our company, I know we will hear about it from Tom.”

Developments in legislation or judicial decisions in the patent law arena require daily attention, according to Duston.

“Being a generalist in the area of IP practice is becoming increasingly difficult to do. You can’t dip your toe in this area and hope to be up to speed on everything that is going on,” he explains. “The rate of change in the law in my experience has accelerated considerably in the last few years.”

That’s where his approach and experience make a difference, he adds. Duston assembles teams that have both the cold learners and topic experts to develop a fuller understanding of the disputed patent on a technical, in-depth level. Although patent cases can take years to run their course, the small percentage that make it to trial involve a “steep learning curve” to inform jurors or judges on vast amounts of information.

“Clearly, you have more time to digest it than the judge or the jury will have,” Duston explains. “Your job is to steep yourself in it, distill it down and figure how to communicate it in a short period of time.”

A key in all of it is the human side, Duston points out. Whether an individual inventor or a company is fighting to protect its rights, there are always stories of the trials and tribulations on the way to creation.

“On the plaintiff’s side, you tell an inventor’s story. That’s what everybody wants to hear. They want to hear the ‘Eureka’ moment. They want to hear the toiling. With a corporation, you’re really representing the individual in the corporation whose activities are being called into question,” Duston offers. “In some respects, it’s kind of a battle of these stories.”

Duston says his “zealous advocacy” is shaped by knowing what it’s like to be on both sides of these cases and a focus on how to work with a variety of clients, from the individual inventor to an in-house patent attorney. The bottom line is about paying attention to their needs.

“You have to listen. I see too many younger lawyers kind of talk at people rather than stopping and letting the client talk to learn from them,” he explains. “I do look for those opportunities of feeling as if what you’re doing is on the side of right.” ■