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3 Reasons IP Specialists Have An Edge At Trial

By **Erin Coe**

Law360, San Diego (March 14, 2016, 1:48 PM ET) -- With high-stakes intellectual property litigation often steeped in complex technology and part of broader fights that extend to the Patent Trial and Appeal Board, clients are best served at trial by specialists who focus primarily on IP cases as opposed to attorneys with a more general commercial litigation background, according to some lawyers.

Here is the first of a two-part series on the benefits that specialists and generalists offer to clients at an IP trial:

They Offer a Comprehensive View

When attorneys center on patent and other IP matters, and especially when they are skilled at both prosecuting and litigating patents, there are few surprises that catch them off guard at trial, according to lawyers.

"I don't just do patent litigation and prosecution; I also handle trademark and trade secret matters and the whole IP gamut," said Jordan Sigale, a director at IP boutique Dunlap Codding who has been practicing IP law for 25 years. "There is little that comes up at trial, and more importantly in depositions, that I'm not prepared for. Generalists can't say that. Having the breadth of knowledge in IP, and particularly in patent law and prosecution, is an immense advantage for a litigator."

There are a number of ways drafting a patent can go wrong, and if attorneys have greater exposure to the patent prosecution process, they will have more opportunities to uncover mistakes that could be leveraged for their client at trial, according to Luke Pedersen, head of Baker Botts LLP's IP section in Washington, D.C., whose practice includes litigating patents, managing patent portfolios and handling technology transfers.

"The most effective lawyers I've seen in patent litigation are those who have a deep understanding of patent prosecution, a technical degree, preferably in the technical area at issue in the patent trial, and a specialization in patent litigation," he said. "Because there are so many potential issues that can arise that are related to the black-letter patent law from the prosecution perspective or the technology at issue, I think a trial lawyer with experience in neither area will struggle."

When a witness testifies about how an invention was developed or what happened with an application at the patent office, litigators with patent prosecution experience can delve deeper in their direct examinations and cross-examinations, according to Sigale.

“When you have experience with patent prosecution, you know how the process goes and what to expect,” he said. “You can get to the bottom of an opposing witness’ testimony and refute it, or when it’s your client’s patent, support it. That experience also helps you get the witness, judge or jury where they need to get.”

Most patent suits these days are not confined to the district courts and include parallel proceedings at the PTAB, where accused infringers can challenge the validity of patents. While the PTAB allows certain non-patent attorneys to make an appearance before the board, it requires lead counsel to be a patent attorney or patent agent registered to practice before the U.S. Patent and Trademark Office.

The post-grant proceedings brought before the board can be very challenging — legally, technically and procedurally — according to Kurt Glitzenstein, head of the litigation group at IP boutique Fish & Richardson PC. To have a real edge at trial, lawyers need to be familiar with the practice at the PTAB and understand the law and technology deeply, he said.

“We have a large docket of both patent cases and inter partes review matters, and that means we’ve seen and done it all,” he said. “Frankly, there are few, if any, litigation or post-grant strategies we haven’t faced. These IP areas are where getting it right is absolutely critical. There is no margin for error on these issues.”

They Have an Appreciation for Nuance

Whether an IP dispute involves a smartphone device or a blockbuster drug, many IP specialists have advanced technical degrees that can give them further insight into strategies for navigating complex litigation.

Fish & Richardson, for instance, boasts 300 attorneys and staff with technical or science degrees, including 88 with Ph.D.s, according to Glitzenstein.

“The facts and technical history for the underlying patents are so critical for the presentation of the issues,” he said. “We have a natural advantage right from the start in terms of understanding what the technology in the dispute is.”

Having a technical degree also allows attorneys to strengthen bonds with their clients, he said.

“When we sit down with chemists or electrical engineers, it gives them comfort to know their matters are being handled by lawyers who appreciate the work they do,” he said. “That makes for an environment that is conducive to comfortable exchanges to understand what the technology is and to prepare if we need to go to trial.”

Jurors want to deliberate on the evidence while having a clear understanding of the technology in dispute, and trial attorneys who generalize or oversimplify the issues aren’t necessarily helping jurors arrive at a decision, according to Glitzenstein.

“I had a case go to trial that involved what happens to light as it travels through fiber optics,” he said. “You couldn’t see the light passing through the fiber, but our ability to understand the fundamental physics of what was going on allowed us to effectively explain the very special way light propagates through a small optical fiber. We could really educate the jury about the underlying physics to allow them to deliberate on the core questions of the case.”

To be effective in an IP trial, lawyers often need to be familiar with the nuances of the technology and the way IP cases are handled, according to Graham Day, a shareholder at Polsinelli PC who

started out doing general commercial litigation, including environmental, real estate and contract cases, but has been a full-time IP litigator for nearly 10 years.

"Generalists can get themselves into trouble if they are dabbling because there may be issues they don't fully appreciate," he said. "There is no substitute for deep specialized knowledge in a particular subject matter or IP litigation generally. If you really want to be good at trying IP cases, you have to have specialized knowledge."

One criticism against specialists is that their technical expertise can sometimes bog them down from telling a clear story that resonates with jurors, but Sigale said he works with other attorneys to make sure he doesn't get stuck in the technical weeds.

"Attorneys can get too specialized and miss the forest through the trees," he said. "Attorneys sometimes forget that jurors and judges don't speak the same language that they do. I usually have a generalist to remind me of that when I'm preparing for a case."

Their Trial Knowhow Is Only Going to Grow

While the IP litigation area is made up of a mix of specialists and generalists, the space is going to become dominated by more specialists, according to Day.

"Like the world as a whole, IP litigation is becoming increasingly specialized," said Day, who has been practicing law for nearly 20 years. "From my generation and the generation before me, there were not a whole lot of IP litigators, though there were some litigators who became specialists like I did."

But now as time goes on, firms are increasingly focusing on people who already have a specialized IP background coming out of law school, he said.

"If they are looking to hire somebody to be an IP litigator, the candidate with specialized IP experience is going to get the nod over someone who doesn't have that experience," he said.

In 2015 alone, Fish & Richardson tried 12 patent cases — nine district court cases and three at the U.S. International Trade Commission — and Glitzenstein isn't worried about competition coming from general trial lawyers.

"I have not seen a situation where I think a general lawyer would be naturally better at handling an IP case for some reason," he said. "That lawyer isn't going to resonate in the same way as my colleagues who can take complex issues and present them in ways that are effective in helping juries understand what the issues are and reach a verdict."

And he said client demand for his firm's patent litigation specialists speaks for itself.

"We are hired for patent litigation matters more than twice as often as our nearest competitor," he said. "It shows that clients recognize the benefits of specialization."

--Editing by Jeremy Barker and Emily Kokoll.

This article is the first in a two-part series on the benefits specialists and generalists can bring to an IP trial. Check Wednesday's newsletter to see the advantages general commercial litigators may have in such cases.

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