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Using Experienced Trial Lawyers To Win Patent Cases

The Editor interviews ***William R. Robinson****, a Partner and Chair of the Intellectual Property Department at Norris, McLaughlin & Marcus, P.A.*

Editor: We would like to introduce Norris McLaughlin as a new Patron of the newspaper. Could you tell us a little bit about the firm and its practice areas?

Robinson: Our firm has been in business for 50 years. In fact 2003 is our 50th anniversary. We have 80 lawyers, 72 in New Jersey and eight in our New York City office. We have a large New Jersey client base, but many of our clients are from other parts of the United States, Canada, Europe and Asia. Our clients include *Fortune* 100 companies and a broad range of companies of other sizes including closely held companies and startups. We also represent individuals, especially in estate planning and family law. We are a full service business law firm with strong departments in corporate and M&A, litigation, taxation, environmental, bankruptcy, health care, labor and employment, products liability defense, real estate and land use, public utility and, of course, intellectual property. When I joined our firm in 1998, we had about 55 lawyers. We have been growing steadily since by targeting growth in specific practice areas. Our intellectual property department has grown from one attorney in 1998 to 20 attorneys now, including 12 registered patent attorneys, a trademark attorney and seven litigators. In our day-to-day IP practice we frequently need to involve attorneys from other practice areas in order to provide full service to our IP clients.

William R. Robinson

Editor: Could you tell us a little about your background?

Robinson: I started out in 1972 with the New York IP boutique of Brumbaugh Graves Donohue and Raymond, which is now part of Baker Botts. I worked primarily on pharmaceutical patents and the *Xerox* v. *IBM* patent infringement litigation. Then I spent four years with Stauffer Chemical Company as a patent and trademark attorney before joining the legal department at CPC International, which was later known as Bestfoods. During my eleven years with CPC, I took a seven-year detour from IP law and became an M&A lawyer traveling all over Europe, Asia, South America and the United States doing deals. In 1989, I decided to return to private practice in New York. I joined the firm of Brooks Haidt Haffner & Delahunty, which was an eight-lawyer IP boutique. I eventually became managing partner before joining Norris McLaughlin in 1998. Six months after joining Norris, I convinced Larry Brooks, a name partner at my prior firm, to join us. That gave us the opportunity to open our New York City office. At Norris Mclaughlin, I chair the IP Department and I serve on the Management Committee. In my law practice here I keep a hand in prosecution, but most of my practice involves transactions, litigation and strategic counseling.

Editor: Could you tell us about your IP practice?

Robinson: We have a broad range of experience among the attorneys in our department. We have lawyers who excel in preparation and prosecution of patent applications in a broad range of technologies. We have strong transactional experience and we have traveled all over the world putting together licenses, joint ventures and other deals. On the litigation side, we have developed effective teams made up of trial attorneys who appear frequently in front of juries, and patent attorneys who have the litigation experience needed to support the trial attorneys. This gives us an advantage over firms who exclusively use so-called

patent litigators because patent cases are so big that most patent litigators have little trial experience. It has been a successful formula for us. The large IP boutiques and regional firms are learning that they have a formidable opponent when they are up against Norris, McLaughlin & Marcus in a patent case. All of this experience also provides us with broad expertise as counselors and in the preparation of opinions and assisting business people and in-house attorneys in the development of intellectual property strategies.

Editor: Do you feel having been an in-house attorney helps you in counseling your clients?

Robinson: I understand the pressures in-house lawyers face on a daily basis. When I was in-house, I wanted my outside counsel to be responsive and supportive and to save me time. I also appreciated creative suggestions for resolving problems. We are the kind of outside counsel that I looked for as an in-house attorney. When we take on an assignment, we consider in-house counsel's perspective and needs in order to generate the most appropriate work product.

Editor: Having litigated and arbitrated claims, what are the pros and cons of litigation versus arbitration?

Robinson: We like mediation as a dispute resolution process because it forces upper management to focus on what is really important to them. It is cost effective, and it is not unusual to see opposing CEOs settle their disputes and then shake hands smiling. If mediation is not a possibility, arbitration can make sense if you have opponents who are reasonably willing to narrow the issues in advance. But IP arbitration has become nearly as complex as litigation, particularly when dealing with issues of patent infringement and validity. Most lawyers avoid arbitrating validity because they think this should be determined by a court. We have also found in some cases that litigation follows even after parties have arbitrated their disputes. When an IP dispute is unavoidable, we favor litigation, particularly in some of the federal district courts that are experienced at patent litigation.

Editor: In what circumstances can an arbitrated issue wind up in litigation?

Robinson: One example is when the parties have not agreed to arbitrate all of the issues. They may agree to arbitrate infringement but not validity of a patent. Then, there still is an opportunity to litigate validity.

Editor: What are some hot issues in intellectual property law now?

Robinson: We keep a careful watch on decisions of the Court of Appeals for the Federal Circuit, which has exclusive appellate jurisdiction over patent cases decided by the federal district courts. The most important decision over the past few years was the *Festo* case, which had to do with the interpretation of patent claims. As a result of *Festo*, many patent claims are construed more narrowly. *Festo* has also caused us to change strategies in filing and prosecuting patent applications.

Editor: What types of things result in the narrow claims construction under *Festo*?

Robinson: Amendments to your patent claims and arguments to avoid a rejection by the examiner will be used later by a court to narrow your claims. *Festo* concerns the doctrine of equivalents, which is used to broaden patent claims beyond their literal meaning. *Festo* has restricted that doctrine.

Editor: What issues do you see looming in the future?

Robinson: Because the world is getting smaller, there is a great deal of discussion about the concept of harmonization, which would make patent practice around the world more uniform. The United States has already taken many steps in this direction. One proposal being discussed is to have a single examination for a patent that could be enforceable worldwide.

Editor: Can you tell us how you work with corporate counsel?

Robinson: Most corporate general counsel today understand intellectual property, and some of our clients have in-house intellectual property counsel. Corporate counsel who have had little or no IP exposure usually see it for the first time with the threat of a lawsuit, perhaps coupled with an offer of a license. This becomes a high profile issue in the company. We explain the options and the risks to corporate counsel and management and then help them to develop a strategy. We also are sensitive to the fact that corporate counsel usually is already buried with work and we try to develop an approach that meets their needs. In many cases, these experiences sensitize a company to IP issues, and they end up taking a more proactive approach to protecting their own IP.

Editor: What if the company has no in-house counsel and you are dealing with a manager?

Robinson: We handle this very similarly to dealing with in-house attorneys who do not have an intellectual property background. We sit down with management and explain the risks and options for resolution. We try to determine what their business objectives are and help them to develop a strategy.

Editor: What is in the future for Norris McLaughlin?

Robinson: We intend to continue to grow our IP department, both in New York and New Jersey. We plan to grow other practice areas as well, including our litigation, corporate and bankruptcy practices in New York, and those areas, as well as others, in New Jersey.