L to R: Scott Chambers, Gerard Norton, Wendy Miller, Peter Michaelson

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Patent Practice: A Shifting Landscape

Patent practice today is about belt-tightening, changing attitudes and teamwork. We've invited four noted practitioners to give us the lay of the land, and they say they see hard times and changing laws as an opportunity for creative lawyering. Our panelists are Scott A.M. Chambers, partner at Patton Boggs in McLean, Va.; Peter L. Michaelson of Michaelson & Associates in Shrewsbury, N.J.; Wendy E. Miller, partner at Cooper & Dunham in New York City; and Gerard P. Norton, partner at Fox Rothschild in Princeton. This roundtable was moderated by freelance reporter Anne Dorfman and reported by Robert M. Levine of Rosenberg & Associates.

MODERATOR: Let's start by taking a look at the trend toward alternative dispute resolution in intellectual property cases.

MICHAELSON: As a profession, we need to do things faster, cheaper and better. In no area is that more important than dispute resolution, particularly in litigation. Most firms, and certainly very large firms, have an overhead rate of approximately 50 to 80 percent. The current recession-induced decrease in IP litigation is unprecedented and is devastating to law firm profitability, and law firms, particularly large ones, are scrambling to reduce costs. I've been an arbitrator and mediator for 18 years, and I've seen a pronounced uptick in what I do, particularly in the last five years, due to a confluence of factors. We've had pressure from the courts since the mid-'90s, when President Clinton signed a bill requiring each federal judicial district to implement an ADR process. The second factor was a movement by state ethics boards, starting in the late '70s, which basically required all attorneys to counsel clients to use ADR prior to instituting litigation. The third factor, which is probably the most important, is our clients — our customers. Corporations need to save money and are decreasing their litigation expenditures. This is a significant impetus for lawyers to at least become familiar with ADR processes and not just run off to court reflexively as they have often done in the past. Also, judges, by and large, do not like patent cases. Consequently these cases tend

to be shunted off to mediation very quickly because, generally speaking, court-annexed mediation has a settlement rate of about 50 percent.

MODERATOR: Have the rest of you seen evidence of a move toward ADR in your practices?

NORTON: It's case specific. ADR can come in at the very beginning of the process, where you ask your client, "Look, is there something we can do to settle this? Because it is going to be very expensive." Depending on the complexity of the issues, it can cost as little as $100,000 or many millions of dollars to litigate a patent case. I had a recent case in the Southern District of New York where about two months into the litigation I picked up the phone, called the other attorney, and asked, "Why don't we just take it out of the court's hands and let a neutral arbitrator decide?" We were able to wrap it up in two hours.

MICHAELSON: As an example, I had a $2 million case — rather small as patent cases go — that was referred to me by the AAA. The disputants had pulled the matter out of court in the Eastern District of Texas after discovery was completed and the court had issued a claim construction ruling. The disputants wanted to resolve the matter cost effectively and get it behind them. I ran an expedited arbitration, including a full day of hearings. It was about eight weeks from the time I received the case until I issued my reasoned award. Rarely, if ever, will a court act this quickly. Why are cases being pulled out of court midway through the process for arbitration? Predominantly for cost.

NORTON: New Jersey is No. 5 in the country in the total number of patent cases being litigated in federal courts. A tremendous number of patent cases are currently being litigated here, and the magistrate judges are working with the attorneys early on in the process to try to streamline the issues as much as they can.

CHAMBERS: The District Court of Delaware actually has a particular magistrate, Judge Mary Pat Thynge, who does a great deal of mediation and settlement. She knows whose arm to twist and when to twist it. She's done a very good job of resolving things long before they had to go to trial.

NORTON: In many, many cases it makes sense to settle, and judges are putting pressure on both sides to settle — some of them through mediation. Sometimes the judges themselves act as mediators.

MILLER: What I've found is that the parties who participate in ADR are not always prepared to reach a resolution. They don't want to give up their principles, and they hold on to the advice they got from their lawyer at the beginning of the case. In more than one case we've had to go back for two, three and four sessions. In the meantime, you've got to continue to litigate. We suggest that when budgets are tight, you adjust your approach to ADR. You have to reset your risk basis, because right now the risk is not just losing — the risk is blowing your budget. You also have to reset your principles to make ADR work. You can't always stand on principle, even if you're right, because you don't have the budget to prove you're right.

MICHAELSON: What I try to impress upon people is the difference between mediation and arbitration. Arbitration, like litigation, is about finding the truth. Mediation is about finding a deal; the truth is irrelevant. It's amazing the deals you can structure when you're not limited by what a court can do — which is essentially awarding money damages or issuing an injunction.

MILLER: It's our job to tell the client, "I know I told you at the beginning that your upside was $20 million, but we're on a different playing field now. I wasn't wrong, but circumstances have changed."

NORTON: Cost, speed, and product are paramount, and if you deliver those things to your client by working with them as a team from the beginning, you can save costs. For example, having the client do a lot of the discovery work in house can keep costs down.

MICHAELSON: The days of the big patent case are numbered. We're no longer going to have cases which last for years and years, and employ legions of associates, and which lawyers can make a career of. The stark reality is that clients won't pay for it. If you look at a patent litigation, 80 percent of its cost is expended during discovery, and, more and more, the cost of a traditional, full-blown patent litigation is becoming prohibitive.

MODERATOR: Wendy mentioned the adjustments clients are making in their legal departments. What kinds of adjustments are your firms making because of the economic situation?

MILLER: My firm is making adjustments which map onto the adjustments that my clients are making. The most productive thing I'm seeing clients do is to build more efficient channels of communication to avoid miscommunications with me or their business people. If you have to come back to me for a do-over, the costs add up. For example, I have a client who engages me for clearance opinions. We've changed the way we work. Now he is more involved in the planning stages. His bills have decreased at least 20 percent just because I'm doing exactly what his company needs and nothing more.

NORTON: We are now more focused on bringing the client onto the team and including them in all strategy decisions. Clients do not like surprises. If it's a nuance that's come up in discovery that will impact a legal issue in the case, you communicate it to the client rather than waiting until it shows up during cross-examination at trial. Although this has always been good practice, you would be surprised at how often attorneys forget to do this.

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— Wendy Miller

CHAMBERS: Having the CFO in on some of the planning sessions can be very helpful, because I can ask, "When do you next intend to roll out a marketing initiative?" They might not want to be crimped in the third quarter, and if we know that, we can balance the case so that we file at a certain time; the cost is then not found when they can least absorb it. I've seen a push from a lot of clients to use a smaller number of firms. The large clients don't like to go to 60 firms; they want to go to perhaps five or 10 firms. This allows us to become more involved, and more proactive, so that we can actually suggest areas they have not previously considered. For example, my work primarily involves intellectual property, but I can certainly see that a client might need to have an FDA lawyer review a particular issue or pull an export control lawyer into an area that in the past might have been considered purely a patent issue. We have also been pursuing a strategy whereby if the client is willing to give us a certain level of business, we're willing to reduce our rates for certain services. The clients seem very receptive to this; and while most firms seem to be having problems in the recession, this has been responsible for some of the recent growth in our firm's IP section.

NORTON: We've discussed fixed fee arrangements and, sometimes in patent litigation matters, partial contingency fees. As long as the client has skin in the game, such as when they're paying disbursements and a portion of the legal fees, they're more involved in the process than if it's a complete contingency fee case. When your lawyer is working for free, so to speak, you're on the phone with them all the time; it leads to very bad habits. With the partial contingency we're letting the client know that we are working together to achieve the same result.

MICHAELSON: Even in the ADR context, when I run a preliminary hearing in an arbitration, I require that a client representative — not just their counsel, but a business representative — be present, because I want that person to hear what counsel is proposing. I want to get buy-in from the corporation. The client drives the process, because at the end of the day, in ADR, the client owns the process.

MILLER: Streamlining the process is especially important in litigation because you can manage a litigation in a thousand different ways. If the budget is down seven percent, you can cut your litigation budget by an even larger margin by building in efficiencies, so there's no need to avoid "necessary" litigation. We lawyers have a habit of doing things the same way over and over again — we staff a case with so many people, we file a motion to dismiss, we ask for every kind of document imaginable and then we depose everybody under the sun. As a client you want more involvement from the beginning in deciding what you really need for trial. My favorite thing to do is to skip the *Markman* claim-construction hearing. Everybody loves them, but sometimes you can handle claim construction on summary judgment and save the cost of a separate motion. Sometimes that's not possible, but that's where you have to get creative, and the client should participate.

MICHAELSON: There are CPR and AAA protocols that limit the number of documents you ask for in discovery. This can effectuate significant savings and really not prejudice your case at all; even under the best approaches to discovery, you're always going to miss documents.

MILLER: And if you turn over every stone and get every piece of paper, 90 percent of what you get will never see the light of day at trial.

MODERATOR: What else are firms doing in response to hard times?

MILLER: As a boutique, we've always stayed pretty lean, so we haven't suffered too much, although we're watching costs closely and

building in our own efficiencies — just as I suggest that our clients do.

NORTON: When I first started out we had a multidistrict litigation with 600 days of depositions. There was no limit on the number of depositions and the attorneys spoke more than the witnesses. Now the courts allow 10 witnesses per side — that's it — and the only thing they want to hear out of the attorney's mouth is objection as to form. No more colloquy. As Wendy said, you staff a case lean and mean. If you're taking two or more depositions at the same time, that's a different story, but for the most part you work with a core group of three or four attorneys, sometimes even fewer. You may have one attorney who is responsible for brief writing. The litigation attorney roles are more focused. You may have first- and second-year associates who are getting on-the-job training, but the clients are not going to be charged for that.

CHAMBERS: We have a history of being heavily involved in public policy, so hiring 20 associates to service a senior partner has never been part of the equation, and we have not had a problem as we've added business units and intellectual property components to the mix. If an associate is not going to make it, we probably tell them a little bit sooner now than we did four years ago, but we have been able to avoid layoffs because we never performed work in a highly leveraged manner. Having a small number of associates working with a small number of partners — we've always done cases like that. This works best for communication because everybody has the information. You don't have little Balkanized areas where individuals have knowledge that is not shared by the group.

MILLER: Clear communication with associates and staff is as important as clear communication with clients. If you give a vague instruction to an associate who then does the wrong thing, a client might not know, but it will show in the bills.

CHAMBERS: One of the worst things you do for a young associate is to just turn them loose with no direction. I'll usually tell them how long I think an assignment is going to take, and that way they can gauge what they need to do. If they think they need to search every district court case, they probably didn't hear it right, and they'd better find out before they run up the bill. If they need more time, they will tell me.

NORTON: Surfing Westlaw can get very expensive.

MILLER: Legal research is not a Google search. Young lawyers must learn how to do legal research properly and efficiently. If you're a client and you see that the lawyers are working around the clock on one case, unless it's right before trial, a big motion, or something very important, ask questions. This could suggest a miscommunication or inefficiency which if corrected can avoid costs, and your case doesn't have to suffer.

MODERATOR: Are clients are scrutinizing bills this way?

MILLER: Not in this way. But they should.

NORTON: I would hope so. Twenty years ago you would submit a bill and it would get paid; there wasn't much question. That luxury is over. Now attorneys are scrutinizing the bills. Now the client is only as loyal as the product you delivered that month. You've got to keep delivering speed, good product, and cost. The product is obviously the most important, but the other two are also important.

MICHAELSON: To me, a client is a customer, and as a profession we have a lot to learn from the way large businesses treat their customers. You need to re-earn their trust with each and every thing you do. If you treat them with honesty and respect, they will stay with you for quite some time. That doesn't mean that you need to be the cheapest guy

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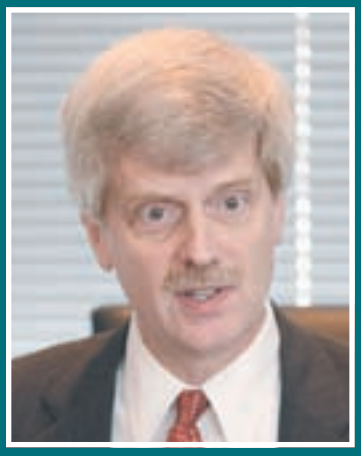

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on the block, but there is a need for transparency, openness, and candor on both sides.

CHAMBERS: As I frequently tell my associates, most of the other attorneys out there are just as smart as we are; the only thing we can really deliver to the client that the others may not is service. You have to be able to provide the right answer, provide it efficiently, and provide it so that the client doesn't suffer needlessly.

MODERATOR: How can you help clients save money during patent prosecution — the process of obtaining a patent?

MILLER: Again, communication is the most important thing. Clients should do the thinking beforehand and come to their attorney with the ideas as well developed as possible. If the attorney prepared an application and it's ready to file based on your first disclosure, and then you offer three new embodiments, you're going to increase the cost, because now the attorney may have to rewrite the specifications and prepare new drawings, not just add a few claims.

NORTON: Even for our Fortune 200 clients there'll be fixed costs, at least a cap. If the cap is X dollars and the young attorney who's done a beautiful job has spent 2X, the client is only going to see 1X. You don't want the product to suffer at all. Make the client, the in-house patent attorney, look good — make them look better than they really are.

MICHAELSON: When I'm faced with, say, some pretty nasty prior art, or with the client's request to take a certain course of action, I always ask , "Why? What's the commercial benefit to you?" I want my client to know that, no matter how well intentioned, that action may be costly. Sometimes when you phrase the question that way they'll say,"Maybe you're right. Maybe it doesn't make much sense." If you can effectuate some cost savings for the client, you may just make the in-house counsel a hero to his or her superiors, and that will reflect well on you.

CHAMBERS: One of the things that is most effective in interacting with the Patent Office is to have a personal interview with the examiner. When I was an examiner, having an interview was important, and a face-to-face interview is so much better than a telephonic one because, for one thing, the examiner will actually have prepared. Get in front of the examiner, get an idea about who that person is and what they can do, and then — to the extent you can — get a commitment from them. Once you understand the examiner, they're more willing to assist you by saying, "Well, if you would add this limitation…," and I can ask, "If I come in with a continuation application or expand this explanation, will it allow me to get over that art?" They're often very helpful, even in this day and age.

NORTON: Do that early in the process so you don't go through a few rounds of rejections before the interview with the examiner. When you're actually in the same room, you reduce the risk that they're not going to get your point, or maybe you're missing their point. The goal is to get the patent application claims allowed. It's not The Rejection Office, it's The Patent Office — and they do allow patents.

CHAMBERS: There's a certain beauty in working through issues with the examiner orally, where the record is not quite as complicated as if you tried to fight those same issues out on paper.

MILLER: Absolutely.

CHAMBERS: It would be much faster.

NORTON: Much cheaper.

MILLER: Scott's point is a good one — avoid prosecution history estoppel by keeping the record clean. Another point is to talk with the client about whether it's possible to determine

whether a particular application has any commercial value for the client. If it is especially important, it might be worth paying a little more money or spending a little more time to get the claims in good shape, because after it issues and later lands on my desk to litigate, it will be really expensive to litigate a mediocre claim.

MICHAELSON: If it gets to me as an arbitrator, it becomes even more problematic because, candidly, if it's not written right — and I see many patents written by junior patent people which are not — it becomes a real horror story for me to go through and come to a decision. What I tell people is, "We don't know which patents will wind up in litigation and which will not. Put in the time and effort to make sure they're written well, because everything will revolve around the patent." That document has to be done right. This doesn't mean it has to be done expensively, but it has to be done right.

MODERATOR: The Supreme Court has granted cert in *In re Bilski*, which addresses the patentability of processes, particularly business methods.

NORTON: In *Bilski*, the Federal Circuit created a new test under which a method or process is only patent-eligible if it is tied to a specific machine or transforms a particular article or substance. The biotechnology industry is concerned about this new rule because it applies to all technologies, even though it was crafted to deal with business methods and abstract processes involving logical operations and human thinking. *Bilski* requires that process claims in biotechnology patents be tied to a machine or transformation. This could jeopardize biotechnology patents that have already issued, and it creates uncertainty around future grants of biotechnology patents with process claims.

CHAMBERS: I'm a little concerned about the Supreme Court's taking the case. The cases that have recently come down from the Supreme Court have, generally speaking, diminished the value of patents. There was a case, *LabCorp v. Metabolite*, in which the Supreme Court initially granted certiorari, but after briefing decided (in 2006) that it had been improvidently granted. Three of the justices dissented, saying they thought the patent should not have been granted because it violated the rule against patenting natural processes. Its claims were broad, but not anything that was out of the ordinary in the realm of biotechnology patents. So while most people think *Bilski* might impact software or business method patents, I also have a certain level of angst that it might impact the biotechnology community. Bio and pharmaceutical companies are doing amicus briefs. It's important to recognize that some of the value that has come from biotechnology has been obtained because people were pursuing the possibility of exclusive rights in the patent system. More than 90 percent of biotech companies are not profitable, and you're going to be a bit concerned about pursuing frontier research if you don't know that you can protect it. I'm not so worried that the Supreme Court will do away with business method patents. But sometimes they have a view of the patent system that is different than that of intellectual property lawyers.

MICHAELSON: I agree that the case goes way beyond the importance of business methods per se. Any patent prosecutor who's been dealing with business methods applications for some time realizes that it's essentially much ado about nothing — basically articulating form over substance. It's not terribly difficult to craft a business method case with enough hardware, enough process, enough structure around it that it can pass muster under the *Bilski* test. The real question is how the Supreme Court is going to interpret what is patentable.

CHAMBERS: Justice Sotomayor has replaced Justice Souter, who was one of the justices in *LabCorp* that

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appeared to take the view that the broad invention in the case wasn't patentable subject matter, so her vote will definitely be of interest.

NORTON: Let's not forget that she was married to a patent attorney. She's also extremely bright, and I don't think she's going to negatively impact patent laws. But what the Supremes will do, god only knows.

MILLER: I think the Supreme Court will probably affirm and keep the test more stringent, if only because in *Microsoft v. AT&T* they held that software is not a component that falls within § 271 of the Patent Law. This was the case in which Microsoft was exporting a master software disk.

CHAMBERS: The so-called golden master disk case.

MILLER: They would copy the software onto computers that were for sale in foreign countries. The law calls it an infringement when you export components that can be re-assembled as an infringing product, and the Supreme Court held that software was not a component. If software is not a component in that circumstance, then for the Supreme Court it is probably not patentable per se.

MICHAELSON: The problem with *Bilski* is that the claimed invention at issue has no hardware components at all. Consequently, it is not a good vehicle for the court to use in deciding the extent of patentable subject matter. The fear among many in the bar is that because the result is so clear under existing precedent, the court will simply affirm the Federal Circuit decision. (The government argued this point in its brief opposing certiorari, but it lost.) I suspect that the court will affirm, at least to some extent.

NORTON: Where is the Supreme Court likely to lead us? *Bilski* is a wake-up call to practitioners who should have realized that *State Street v. Signature Financial* — the case that affirmed the PTO position that methods of doing business were patentable subject matter — never opened the floodgates to patenting processes that apply abstract principles without obtaining a tangible result through implementation of the principle. We can expect the court to delineate how tangible that result must be. Knowing that the goal is not to pre-empt a basic principle is adequate guidance for drafting a claim that will survive future challenges. In the interim, the Federal Circuit has left plenty of opportunities to obtain business method patents on the table, provided the applications and claims are carefully crafted. ■