

## GCs Name Favorite IP Lawyers

By Erin Coe

*Law360, San Diego (February 7, 2016, 3:29 PM ET)* -- General counsel and other in-house lawyers from some of the largest corporations have named 30 intellectual property attorneys who are at the top of their game when it comes to delivering outstanding client service, recognition they earned by aligning IP strategies with clients' business goals and by offering more advice on reaching better patent litigation settlements.

The 2016 BTI Client Service All-Stars report by BTI Consulting Group (Wellesley, Mass.) has honored 312 attorneys for their superior dedication to client service, and 30 of those attorneys are devoted to the IP area, including litigators, prosecutors and transactions experts who work in patent, trademark and copyright law.

BTI conducted in-depth phone interviews with more than 300 general counsel and legal decision-makers at large organizations with \$1 billion or more in revenue, and those in-house lawyers named the attorneys who have provided them with unbeatable service. BTI noted that the common traits shared among all the All-Stars are a focus on client needs and goals, thought leadership, business understanding, legal skills, good value and outstanding results.

One reason the 30 IP attorneys stood out to clients was because of their ability to provide IP strategy in a way that enhances a company's goals, whether in relation to its technology, product line or revenue stream, according to Michael Rynowecer, president and founder of BTI.

"These attorneys look beyond the patent, trademark or IP issue in front of them and see the broader perspective," he said. "They see the impacts of IP law and where it is headed and provide advice, like when clients ought to change the way they apply for protection to avoid exposure or risk. That's one thing that stood out."

Robert Conway, a Duane Morris LLP partner who was named on BTI's All-Star list for the second year in a row, knows the importance of having a deep understanding of the business priorities and needs of his clients, and it helps that before he moved over to private practice, he served as in-house counsel for more than two decades at several companies, including General Electric and Lucent Technologies.

"Sometimes outside attorneys don't recognize the financial pressures that are put on in-house counsel or what happens in the hallways of companies," Conway said. "When I'm negotiating an IP transaction, I know what the other side is going through internally and all the committees and higher-ups that have to review an issue. I tailor my position and strategy to take that into account, and it helps me get a better

result for my client. I'm realistic about what I can do as well as when and how I can do it."

Conway also mentioned that having a master's degree in business administration in addition to his law degree has given him a leg up when working on IP commercial transactions and general commercial work.

"Being able to understand the business lingo and theory behind what is going on is a real advantage," he said. "When my clients are up against a situation that has risks or problems, I never say 'no' without giving alternatives. My job is to help them understand various courses of actions and the risks as well as to help them meet their objectives in a legal and sound way."

In-house counsel also told BTI that the IP attorneys who provided top-notch client service were those who offered more counseling on settlements, particularly as companies put a greater emphasis on settling patent litigation than they did three years ago, according to Rynowecer.

"The IP All-Stars are helping their clients reach better litigation settlements that in-house counsel can justify to management and while saving money and time," he said. "There are still many patent litigators who would much rather litigate than settle since patent litigation can be large and lucrative. Yet the All-Stars know that there is no shortage of work, and they are just as happy to settle as they are to litigate."

John Froemming, a Jones Day partner who landed on BTI's All-Star list for the second year in a row, said clients turn to him and his team at Jones Day because they are prepared to take on the tough, high-stakes IP cases, often fights between competitors, and also because they get results: Froemming's team has won every IP litigation trial it's had in the last 10 years.

At the same time, Froemming and his team know that it's critical to provide their clients with an honest assessment of the IP case at the start. If a case will be tough for the client to win, Froemming said it is far better to be upfront about it and settle the case on favorable terms, rather than wait until the client may be forced to settle for a suboptimal deal or not be able to settle at all.

"You need to find a diplomatic way to convey the realities without being misperceived as a wimp," he said. "[When a case will be hard to win], I tell my client, 'I'd like nothing more than to say you have a 90 percent chance of winning, but I'd be remiss as your lawyer if I didn't tell you about these challenges.' I give the client a plan and strategy for addressing the challenges. Then it can make a decision, but it does so with its eyes open."

Another aspect that in-house counsel applauded IP All-Stars for was their ability to put together an experienced team that can handle litigation and prosecution, ideally with the All-Star directing the team, according to Rynowecer.

Jonathan Kagan, an Irell & Manella LLP partner who was named an IP All-Star, said he has fostered a number of relationships with clients for a decade and longer by looking not just at the immediate lawsuit or prosecution proceeding in front of him, but incorporating each matter into a long-term strategy that aligns with clients' business needs.

"I work from an offensive and defensive standpoint," he said. "Offensively, I try to figure out what type of technologies are working for a client and what direction to pursue patents. Defensively, I think about whether a client is going to get attacked and what it wants to have as a weapon to counterstrike with and how to make sure that weapon is strong."

While some clients take a never-settle approach, others are open to negotiating early settlements, and Kagan takes that into account when litigation arises.

"I look at the client's overall approach to litigation, and then I look at how the immediate case fits within that structure," he said.

The process of how clients are selecting IP attorneys has changed over the years, according to attorneys.

"Clients are much more sophisticated and more demanding of their attorneys," Kagan said. "They don't just hand a case over and then are hands off for the rest of the litigation. Clients are very involved and want frequent updates and want more of a role in decision-making for particular cases."

Knowing about one aspect of IP law doesn't seem to be enough for clients. They want litigators who have a deep understanding of the interplay among multiple types of IP, such as utility patents, design patents and trade dress, according to Froemming.

"Clients are looking for specialists who are experienced in the intersection of IP and understand how to layer protection for clients," he said.

Corporate attorneys also are increasingly relying on their outside counsel to stay current on the law, including on issues that pertain to their industry, according to Dale Cendali, a Kirkland & Ellis LLP partner who was recognized as an IP All-Star.

"In-house counsel are usually so busy with their day-to-day operations that they don't have time to be exhaustively reading every new case that comes down," she said. "They expect and need outside counsel to be able to help them know what they need to know. As life becomes more fast-paced, it's more important than ever to help clients synthesize information quickly."

To keep clients up to speed, Cendali reaches out to clients when an important IP decision comes down or a business development arises. She also leads frequent in-house trainings and continuing legal education events to go in-depth on IP subjects, such as the use of social media and enforcement strategies of intellectual property.

Taking a one-size-fits-all approach to client service doesn't tend to work. For Catherine M.C. Farrelly, chair of Frankfurt Kurnit Klein & Selz PC's trademark and brand management group who was named an IP All-Star, she considers a variety of factors when looking at how best to serve a client, including the size of the portfolio, the client's appetite for risk, the budget and individual personalities of the people on the client's team. She also says it's important for attorneys to "be coachable."

"I regularly talk to my clients and seek out constructive feedback on ways we can be more useful to them," she said. "We continually make adjustments to every aspect of our dealings with each client to make sure we are being responsive to their individual needs and preferences. No detail is too small. If a client prefers email to the phone, they only have to mention it once."

The 30 IP attorneys recognized in the BTI report are MVP Robert Conway of Duane Morris; MVP John Froemming of Jones Day; MVP David McIntosh of Ropes & Gray; Dianne Elderkin of Akin Gump Strauss Hauer & Feld; Daniel Hulseberg and Robert Scheinfeld of Baker Botts; Joseph Drayton of Cooley; Jeffrey Elikan of Covington & Burling; Donald Jackson of Davidson Berquist Jackson & Gowdey; Sandra Edelman of Dorsey & Whitney; Douglas Sorocco of Dunlap Codding; Michael Florey of Fish & Richardson; Catherine M.C. Farrelly of Frankfurt Kurnit Klein & Selz; Jonathan Kagan of Irell & Manella; Jeffrey

Lederman of Joseph & Cohen; Dale Cendali of Kirkland & Ellis; Adeel Akhtar of Knobbe Martens Olson & Bear; David Barnard of Lathrop & Gage; Enoch Liang of Lee Tran & Liang; Jason Mueller of Locke Lord; Christopher Tobin of Michael Best & Friedrich; Rachel Krevans and Kenneth Kuwayti of Morrison & Foerster; Russell Jones Jr. of Polsinelli; Mark Bellomy of Ropes & Gray; Patrick Whalen of Spencer Fane Britt & Browne; Peter Pappas of Sutherland; Jason Wilson of Willenken Wilson Loh & Delgado; and Gregory Lantier and William Lee of WilmerHale.

--Editing by Catherine Sum.

---

All Content © 2003-2016, Portfolio Media, Inc.