

## GCs Name Favorite IP Lawyers

By Kurt Orzeck

*Law360, New York (February 03, 2014, 9:34 PM ET)* -- In-house counsel from large and Fortune 1000 companies have named 21 intellectual property lawyers as the most client-service savvy, a distinction they achieved by thoroughly understanding the business impacts of their clients' companies while becoming well-versed in the technical aspects of those businesses.

The 2014 BTI Client Services All-Stars report from The BTI Consulting Group Inc. (Wellesley, Mass.) features 330 lawyers who excel at serving their clients, with 21 of them specialize in trademark law, confidential information and other areas of intellectual property.

More than 300 corporate counsel — compared with 240 last year — nominated attorneys based primarily on their client focus, but also on their innovative thought leadership, legal skills, outsize value, outstanding results and exceptional understanding of client business.

BTI President Michael Rynowecer told Law360 that the latter quality was most prevalent among IP lawyers who made the list because IP often relates to mission-critical products and processes within a company.

“Understanding that the legal issues could directly affect revenue and new product, bringing that hard-core business-minded approach as well as the technical approach, was a top trend in the nominations,” he said.

Bereskin & Parr LLP partner Donald H. MacOdrum — a two-year All-Star who practices in Canada — agreed, saying a technical background is especially helpful for IP lawyers who deal in complex patent-drafting areas such as biotechnology.

“It is important to bring a thorough knowledge of the applicable legal principles, a good understanding of the technical issues and their interplay in the client’s business, and a good sense of the business issues in advising clients,” he said.

For those IP lawyers who may be lacking technical expertise, they may better serve clients by bringing together different teams from project to project, said Duane Morris LLP partner Sandra A. Jeskie, who has appeared on the BTI survey for the past three years.

“Each lawyer brings unique attributes to any client relationship, and identifying lawyers with appropriate skill sets for each client matter is key to achieving the best result, as well as gaining client

confidence and loyalty," she said.

Like Jeskie, who was nominated for her deep knowledge of her clients' companies and solid communication skills, Quarles & Brady LLP partner Gregory P. Sitrick emphasized the importance of looking at his clients' problems from their perspective.

"Once you know what your client wants to do, and you know how your client operates, you can work backward to figure out what action to take," he said. "Sometimes, especially in IP cases, that means acting as a business partner with your adversary rather than treating them as a litigant."

Fenwick & West LLP partner Rodger R. Cole, based in Mountain View, Calif., said that acting fast and with a sharp business mind is critical to being an IP lawyer, especially in fast-paced IP meccas like Silicon Valley.

"Technology companies make decisions quickly. To give good advice, a lawyer needs to understand the business goals and the risk tolerance of the client," he said. "I learn my client's business before problems arise to identify and respond to issues promptly."

Banner & Witcoff Ltd. attorney Christopher J. Renk said that a deep understanding of his clients' technology and business goals allows him to "bridge communication gaps between engineers and business people, and help extract maximum value out of [his] client's spend on intellectual property protection."

Another BTI All-Star, Edwards Wildman Palmer LLP partner Rory J. Radding, emphasized the importance of cost-effective client services.

"I bring a client-based business focus to my advice by developing an IP strategy that complements and fulfills the client's business strategy in a cost-effective and efficient manner," he said. "When appropriate, I use the tools of litigation, prosecution (design-around) and licensing to reach those goals."

Andrus Scales Starke & Sawall LLP partner Peter Holsen added: "[I] invest significant time and resources staying up-to-date on current technologies, the worldwide economy and the state of the client's industry. I have found that this type of high-quality service marries well with large-scale businesses, including those of Fortune 50 and 500 companies."

Buchanan Ingersoll & Rooney PC executive shareholder Todd R. Walters noted that client-service costs can be cut by turning to post-issuance proceedings, which involve sophisticated decision-makers, a lower burden of proof and lower costs compared with district court litigation.

David J.F. Gross, a partner at Faegre Baker Daniels LLP, said that through his firm's use of alternative fee agreements, it has demonstrated to clients that the firm "is part of the business solution to an IP problem as opposed to a mere transaction cost."

Like other attorneys who serve budget-minded corporations, Foley & Lardner LLP partner Richard S. Florsheim noted the appreciation his clients have for his cost-effective approach to IP litigation.

"Different types of patent infringement cases require different levels of firepower," he said. "A strategic case between competitors seeking to exclude one another from offering product features that are critical to customers requires one level of intensity; a troll case in which my client's only exposure is

payment of a modest royalty is an entirely different matter.”

Indeed, the management of patent trolls was another oft-cited topic in this year's survey, according to Rynowecer. Winston & Strawn LLP partner Michael A. Tomasulo said he and his clients have prevailed over them by deploying a variety of legal strategies.

“We have been successful with aggressive counter-offensives in cases where the plaintiff’s claims were plainly of little or no merit,” he said. “This has led to several instances where we convinced the plaintiff to simply ‘walk away’ from the case.”

The IP attorneys named as 2014 BTI Client Service All-Stars are Peter T. Holsen of Andrus Scales Starke & Sawall LLP, Christopher J. Renk of Banner & Witcoff Ltd., Donald H. MacOdrum of Bereskin & Parr LLP, Todd R. Walters of Buchanan Ingersoll & Rooney PC, Stephen E. Bondura of Dority & Manning PA, Sandra A. Jeskie of Duane Morris LLP, John S. Letchinger and Rory J. Radding of Edwards Wildman Palmer LLP, David J.F. Gross of Faegre Baker Daniels LLP, Rodger R. Cole of Fenwick & West LLP, Juanita R. Brooks of Fish & Richardson PC, Richard S. Florsheim of Foley & Lardner LLP, Morgan Chu of Irell & Manella LLP, John W. Keke of Keke & Van Nest LLP, Michael A. Jacobs and Rachel Krevans of Morrison & Foerster LLP, Terry E. Welch of Parr Brown Gee & Loveless PC, Gregory P. Sitrick of Quarles & Brady LLP, Paul I. Fleischut of Senniger Powers LLP, Peter G. Pappas of Sutherland Asbill & Brennan LLP, and Michael A. Tomasulo of Winston & Strawn LLP.

--Editing by Edrienne Su.