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Q&A With Seyfarth's Brian Michaelis

Law360, New York (May 28, 2009) -- Brian L. Michaelis, chair of Seyfarth Shaw LLP's intellectual property practice group, practices broadly in intellectual property and technology business law. His practice includes intellectual property litigation, with a focus on patent litigation and counseling, as well as validity and infringement analysis. **Q: What is the most challenging case you've worked on, and why?**

A: I was lead patent counsel to a Belgian company as defendants in an infringement case in the S.D.N.Y. Our foreign client was relatively big (the “Goliath”) as compared with the smaller U.S.-based plaintiff.

The two patents-in-suit related to computer-based three-dimensional inspection of Ball Grid Array (BGA) interconnections on electronic devices. To be infringed, the claims of the two patents required that the allegedly infringing method and apparatus include “triangulation” calculations in the inspection.

A primary argument for noninfringement was that our client used “bilinear interpolation” as opposed to triangulation calculations. This was not going to be an intuitively obvious distinction for a jury. Another problem was that our client’s system documentation had the word “triangulation” littered throughout.

We litigated this case for about 5 years: getting a favorable claim construction; winning noninfringement on summary judgment only to be reversed on appeal.

We went to NY on a Friday: myself, my general-litigator partner; a second year associate; and a paralegal, to try the case and convince a jury that bilinear interpolation is just not triangulation. We ended up not getting a jury for some reason, and the judge managed to persuade the parties to try the case to the bench.

As defendants, we were happy to do that, except that literally overnight we had to

reconfigure our case because we had inequitable conduct arguments we wanted to get in earlier with a powerful witness. We had to reschedule and rearrange witnesses, travel arrangements, prep, etc.

We ended up trying the case for eight or nine days and got a great result — noninfringement, the patents found invalid for obviousness AND the patents found unenforceable for inequitable conduct!

Q: What accomplishment as an attorney are you most proud of?

A: Probably becoming a member of the patent bar and thus having the opportunity to learn from, work with and be inspired by some of the "greats" in the IP game.

The greats in this game don't seem to ever want to stop playing, so I am privileged as well to be a member of a great bar.

Q: What aspects of law in your practice area are in need of reform, and why?

A: Rules regarding re-examination could be overhauled. It seems like the threshold for raising a Substantial New Question of Patentability is low to the point that all it takes is a reference or two that was not considered in the original examination and a colorable obviousness argument and you get a reexam request granted.

Many courts are inclined to grant a stay of litigation in the face of a granted re-exam request, so the result is that litigation may be delayed years as the re-exam is conducted.

On another front, there seems to be a trend toward earlier Markman (claim construction) hearings in patent cases, and the separation of claim construction from dispositive motions (summary judgment). I think that is good, and courts should embrace that trend.

Unfortunately though, the rules are not uniform and there are many situations where litigation is protracted as a result of schedules where the identity and meaning of claim terms in dispute is held off until very late in the litigation.

Further, I guess I've always thought there should be more "teeth" in Rule 11, as that might keep some very questionable patent litigations from being filed in the first place.

Q: Where do you see the next wave of cases in your practice area coming from?

A: 337 actions in the ITC are a "next wave" of cases. The potential to get an exclusion order

against a foreign infringer in a relatively short period of time is a compelling reason, among others, to use that mechanism.

Hatch-Waxman is also a present wave, if you will, that has not crested but will be the source of increasing amounts of patent litigation.

Q: Outside your own firm, name one lawyer who's impressed you and tell us why.

A: I'd say Paul Hayes presently of Mintz Levin. The first time I saw Paul he was doing a presentation for a trial advocacy class at Franklin Pierce Law Center. He dropped two or three profanities in the first five minutes, and jaws dropped. But, the class was listening to him from then on.

He was doing a spiel on using bench books for the judge. I said to the person next to me: "I could work for this guy."

After that, the stars aligned and I was blessed to work with Paul and his partners as my first private practice experience, for more than five years.

I learned a ton and worked on great cases, like the Vitronics v. Conceptronics case that has been cited in virtually every brief with claim construction issues I've read in my career.

Paul loves trying patent cases. The guy puts his heart and soul into a case, and clearly loves what he does – whether he knows it or not. He just won a $388 million verdict against Microsoft and he's about 100 years old.

Q: What advice would you give to a young lawyer interested in getting into your practice area?

A: The advice I gave my nephew when he was getting into the private practice of patent law was: Record your time as you are working on matters and don't go home until you get all of your time in for the day. Practical advice.

Beyond that, I would say — find a way to get regular exercise.