Q&A With Seyfarth's Brian Michaelis

Law360, New York (April 12, 2013, 12:59 PM ET) -- Brian Michaelis is a partner in Seyfarth Shaw LLP's Boston office and chairman of the firm's intellectual property practice group. He has practiced IP law for almost 25 years and has headed Seyfarth Shaw's IP practice group for the past four years. His practice includes a broad range of IP disciplines, focusing on patent matters, including patent litigation, opinion/counseling work and patent prosecution. A registered patent attorney, he previously spent over seven years in manufacturing and engineering with a large multinational computer company. His technical background is electrical/electronic engineering and computer hardware/software, but he works on patent matters on a wide range of technologies.

Q: What is the most challenging case or deal you have worked on and what made it challenging?

A: The most challenging case I worked on thus far was a U.S. International Trade Commission matter that involved 20 respondents, of which we represented 19. The 19 respondents were in something like nine countries spread across three continents and included small Chinese, Japanese and German companies. The ITC has a tight and unforgiving schedule so coordinating such diverse clients — from getting engagement letters and common interest agreements in place to getting answers reviewed and filed and coordinating discovery — was a major challenge. On top of the tight schedule, we were under a fairly tight budget, so we had a pretty lean team. In the end, we were successful in our efforts as Judge Paul Luckern granted our motion for summary determination. To say that was a relief is a major understatement.

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

A: While the America Invents Act is an "interesting" (and expansive) change in the patent laws, it does not appear to help the U.S. Patent and Trademark Office address the seemingly age-old issue of pendency and efficiency of getting applications through the agency. The time, and maybe more significantly expense, that it takes to get a patent is frustrating to clients and attorneys alike. The cost is a very significant issue and the AIA certainly does not help in that regard. I am a staunch believer that a vibrant patent system spurs innovation and economic advancement/prosperity. Difficulties with the system can only hinder the same. Such criticisms could probably also be made with respect to patent enforcement, but at least on that front it appears that some jurisdictions are genuinely interested in moving patent cases along and have facilitated same by accepting schedules for early claim construction and dispositive motions.

Q: What is an important issue relevant to your practice area and why?

A: The troll/nonpracticing entity/patent assertion entity issue is an important issue — the major issue being the proliferation of same and the seeming "abandon" with which assertions are made and suits are brought. While I am an ardent supporter of mechanisms to monetize IP and legitimately enforce patent rights, I am becoming more concerned that suits are being brought in which there has been little or no prefiling investigation, and that have no merit. There do not appear to be any consequences for bringing baseless suits. While there is a place for entities to assist small inventors and companies to enforce their rights, for example by providing/contributing resources to assist with patent enforcement, there needs to be a higher level of discrimination between "legitimate" patent enforcement and filing suits to collect money.

Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.

A: I have been asked this before, and I always look to the senior folks that have helped shape my career, or at least helped me get settled into this profession as I was transitioning from an engineering existence and mindset. This time I will give a “shout-out” to Stan Schurgin, who was managing partner of Weingarten Schurgin Gagnebin & Hayes, a Boston IP boutique where I undertook my first foray into private practice back in the late '80s. Stan was then, as he is now, a dedicated IP practitioner with great business sense and appreciation for the IP profession. Stan has probably mentored, to some extent, hundreds of IP practitioners over his career as a lawyer and a teacher of IP. In my experience, he did so with great humility and commitment. I believe he is blessed in truly enjoying what he does and has done for many, many years.

Q: What is a mistake you made early in your career and what did you learn from it?

A: While I am thinking of early experiences, I recall in my second or third year of private practice being given an office action to respond to in an application that, as I reviewed it, appeared to be very poorly written. I went into the assigning partner’s office (whom I knew did not write the application), and I proceeded to trash the application and articulate my concerns that the case might be a lost cause (I may have suggested that it needed to be completely rewritten). It turns out the case was written by another partner under very difficult circumstances. My criticisms were not at all appreciated.

What I learned was that a “can do” attitude was/is very important (then and now), and that you cannot be too delicate in your criticisms of other’s work.

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