Q&A With Amster Rothstein & Ebensteinâ€™s Anthony F. Lo Cicero

- IP Law360, September 21, 2007

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Anthony F. Lo Cicero took time out of his busy schedule working on IP cases to talk with Law360 about patent reform, his most challenging cases and the future of IP litigation.

Q. What's the most challenging IP case you've worked on, and why?

A. The cases that I find most difficult are those where a patentee is not merely seeking monetary compensation, but instead is seeking to put a competitor out of business. In these types of cases, it is often necessary to come up with some kind of creative business solutions in order to resolve the case, short of final judgment. We have had many cases like that over the years. In one case, we were able to have the parties enter into a supplier relationship, resulting in both sides profiting from the settlement of the case.

Q. What's the most ridiculous IP lawsuit you've defended a client against?

A. While I would not want to characterize any case as ridiculous, I think that a lawsuit brought by NCMC against Discover Card would fall in this category. It was brought in Maryland before the State Street decision came down at the Federal Circuit level. NCMC asserted a business method patent directed at taking check information over the telephone. We represented the Discover Card division of Dean Witter (later Morgan Stanley Dean Witter). In the claims there was a requirement that certain information be "coded embedded." The Discover Card system did not do anything special with the claimed information. We successfully obtained summary judgment of no infringement for Discover Card.

Q. Which aspects of IP law do you think are in need of reform, and why?

A. I think that there is definitely a public perception that the patent system is broken. There are concerns about the quality of patents that issue. There are issues about the appropriateness of juries determining technical issues. There are issues about whether the damage awards issued are reasonably related to the damages suffered by patentees. While these issues need to be addressed, we have to be careful not to lose sight as to the purpose of the U.S. patent system and the fact that good patents are good things, and bad patents are bad things. I think that one revision I would like to make is to have both infringement and validity issues be judged by the same preponderance of the evidence standard.

Q. If you were the head of the USPTO, what changes would you make?

A. I think the USPTO needs to provide examiners with greater incentives to spend more time on each application, speak to applicants to understand what the inventions are, and have better supervision of the rejections being made. I think one positive change would be to encourage examiners to identify if there is anything which the examiner thinks is patentable about the invention and share that information with the client.

Q. Where do you see the next wave of IP cases coming from?

A. I think we are still seeing a lot of IP cases coming from patents being purchased by the Texas Bar. I think that as the patent auctions become more prevalent, we will be seeing more and more auctioned patents being asserted in patent litigation.

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

A. Marty Glick of the Howard Rice firm in San Francisco has always impressed me for the common sense, businessoriented approach he brings to litigation and settlement strategy.

Q. What advice would you give to a young lawyer who's interested in getting into IP?

A. I think it is important for an IP lawyer to learn three important skills: technology, law and economics/accounting. First, a good IP lawyer has to understand the subject matter about which the lawsuit centers. That is why our firm has so many attorneys with technical degrees and advanced technical degrees. Second, a good IP lawyer needs to understand the law. We also have experienced litigators who worked at major litigation firms prior to coming to our firm and have extensive experience at litigation both at our firm and prior to joining. In the past decade, our firm has handled over 450 IP litigations. Finally, it is important to have an understanding of what a case is worth. We have many lawyers at our firm with formal and practical education in economics and accounting who are thus able to understand the appropriate value that clients and opponents should place on a particular claim.

Q. I'm a general counsel with a Fortune 500 company facing a major patent lawsuit. Why should I hire your firm?

A. Our firm offers a unique service to the industry. We are one of the few true intellectual property law firms that are left. We have over 40 lawyers, which is enough to handle even the most complex litigation but not so many that a client is not able to have the attorney that it retained handle the case. Our attorneys, in addition to having substantial experience in IP law, for the most part have technical degrees in a wide range of technologies. Ninety percent of our attorneys have technical degrees, eight have master's degrees and three have doctorates.

Our attorneys are also stable. Not only have all of our partners been with the firm for one or more decades, but most of our associates have been with the firm for years. This means that the odds of your IP litigation having the same associates working on the case when it goes to trial as worked on it when it was filed are very good. This again distinguishes us from many

larger firms, which have so much turn over in the partnership and associate ranks that institutional knowledge of a client or particular case is virtually nonexistent.

Our firm also tends to be more cost effective in its billing rates and preparation and presentation of a client's positions. Finally, our track record of success in resolving patent and other intellectual property disputes with creative business resolutions or through favorable final judgments makes us the best choice.

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