

Fenwick & West Flaunts Interdisciplinary Approach To IP

Monday, March 20, 2006 --- As the third-largest law firm in Silicon Valley, where new technologies emerge and IP matters converge, Fenwick & West understands first-hand the value of addressing the crossover among patent, trademark, copyright and licensing laws.

In one of the largest IP litigation payouts last year, Fenwick & West won a \$400 million settlement for its client Compuware in a suit against IBM, which involved a wide-ranging dispute of IP and antitrust laws.

Compuware accused IBM in 2002 of copyright infringement, misappropriation of trade secrets, intentional interference with contractual relations, unlawful tying, monopoly leveraging, attempted monopolization, tortious interference with business expectancy, unfair competition and unfair trade practices.

The case involved millions of documents, and at one point the firm had up to 150 individuals working on the case, recalled Stuart Meyer, a senior partner in the firm's IP and litigation groups and a key attorney for Compuware. He underscored the importance of being able to draw from the strength of the team when a case spans multiple areas of law.

"Organization is very important," Meyer said. "And you need to have a tremendous amount of trust in your team members."

What also helped was having 90 IP attorneys who can see the big picture or focus on a precise point at any given moment to help explain the interplay of IP laws, as well as issues that spread into other practice groups, such as the corporate or tax groups.

The practice's clients are mainly in technology fields, including software, electricity, communications, biotech and the Internet. The firm has a soup-to-nuts approach within its patents, trademarks, copyrights and licensing groups, and its many services include offensive and defensive counseling, copyright registration, licensing works and litigation.

Fenwick & West's IP practice does not have a separate subgroup for trade secrets issues because they span practices from corporate to employment to litigation.

"This is an area where the overall interdisciplinary approach we take pays dividends for our clients," Meyer said.

Although the majority of the firm's clients come from technology fields, such

as Apple Computer, Google, Cisco and Sun Microsystems, Meyer noted that its practice also deals with large companies, such as the casino Harrah's, which do not sell technology but have to deal with technological issues constantly.

Having a wide range of clients with varying degrees of technological know-how also affects how the firm's attorneys choose to communicate with their clients.

"We'll have large companies with a laser-beam narrow focus. The next day we'll be dealing with a start-up that has a good idea but doesn't have much knowledge of the industry, and involves more hand-holding. You are a neurosurgeon one day, and a country doctor the next," Meyer said.

Fenwick & West attorneys also tend to keep a practical, business focus in mind when communicating with their clients. Steering clear of theoretical advice, they want to offer clients clear-cut recommendations on what they should do in order to get from point a to point b.

"One of the things we do is we perform IP audits for clients. When a client is thinking about buying another company to help get another type of technology, we are supposed to see if the company has any warts that are not apparent or any problems that are not clear. I view my job as kicking the tires. If I was coming in, what would I want to know?" Meyer said.

When counseling clients, Fenwick & West attorneys try to keep their ears perked up for any issues that may pop up that can save the company headaches later. For example, if a company is lax on how it handles employees that come from its competitors, the company could find itself dealing with trade secret issues later.

"By giving employees of our clients enough context and knowledge, they can help us to do the issue-spotting early on that keeps everyone out of trouble," Meyer said.

The firm, which was founded in 1972 and has more than 250 attorneys in its Silicon Valley and San Francisco offices, has expanded by "measured growth" by trying to determine where its clients needs will be and putting the necessary infrastructure in place.

In the 1980s, software companies typically did not protect their programs using patents, but Fenwick & West saw that patent law was moving toward protection for software and decided to ramp up its patent practitioner ranks to include those with software backgrounds.

Today, the marketplace is changing with certain types of convergence. A company that used to deal with one function, such as cell phones, now is dealing with smart phones, which feature phone, e-mail and computer functions, Meyer said.

“We believe it is important to grow and to identify those areas that will be important. We are careful not to over-expand,” he said, giving the example of the 1990s’ Internet boom and sudden bust.

He said Fenwick & West tends to have more stability during economic upticks and downturns.

“It’s a lot better to work a little harder with a team that’s growing at a slower rate,” Meyer said.

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