Litigation Depts. 2017

Lerner David's Technical Knowledge Yielded Victories at Numerous Levels

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From left to right (not by row):. .Charles P. Kennedy; Jonathan David; Paul H. Kochanski; Stephen F. Roth; Maegan A. Fuller; Gregg A. Paradise; Robert B. Hander; Roy H. Wepner; Andrew T. Lane; William L. Mentlik; Alexander Solo; Aaron S. Eckenthal; Orville R. Cockings; Tedd W. Van Buskirk; Gregory S. Gewirtz; Russell W. Faegenburg

Carmen Natale

Lerner David Littenberg Krumholz & Mentlik of Westfield, which focuses on intellectual property work, handled cases in many jurisdictions last year—including, of course, before the U.S. Court of Appeals for the Federal Circuit and the U.S. Patent Trial and Appeal Board (PTAB). Some cases yielded significant written decisions, including plaintiff-side litigation on behalf of Iron Gate Securities, which litigated against Lowe's Cos. in connection with patents on video surveillance systems. There, Lerner David defeated a Rule 12(b)(6) motion to dismiss and saw the case through to settlement. The litigation team represented numerous clients in the wireless communication industry, and has pending matters for clients in the aviation and pharmaceutical industries.

** *The responses were provided by litigation partners William Mentlik, Roy Wepner and Greg Gewirtz.* **

What were some of the department's most satisfying successes of 2016, and why?

Mentlik: Winning at the appellate level is always a huge lift for us and our clients, whether we represent the appellant or the appellee. We won two appeals at the Federal Circuit last year. In one of them, that I worked on with Roy Wepner and Bob Hander, we received an opinion which stated that our adversary was trying to twist a contractual provision "like a pretzel."

Gewirtz: Russ Faegenburg and I scored a victory at the Patent Trial and Appeal Board that was especially satisfying. On behalf of Sony, we successfully invalidated two patents based upon the same prior art references that another party—represented by another law firm—had employed in an unsuccessful effort (before the same three judges) to invalidate those same patents.

Is it a penchant for efficiency, or a willingness to go the distance as effective trial advocates, that gives the litigation department its reputation?

Gewirtz: Sometimes both; sometimes neither. With certain clients that get sued for patent infringement with regularity, we have developed strategies designed to achieve a quick resolution, such as a simple explanation to the plaintiff about the strength of our case, a motion to dismiss, or a motion to transfer the case to a forum that is considered less hospitable to plaintiffs, or to stay the case while we attack the patents at the PTAB, where there is no presumption of validity.

Mentlik: With other clients, we get hired because the case looks to be an especially difficult one to win. We sometimes urge our client to drop certain weaker arguments so that we can focus on issues where we can hit a home run. While we are as thorough as anyone where we need to be, we sometimes make a tactical decision to leave certain stones unturned, because we have the decades of experience and judgment to predict which stones are most promising and which stones have nothing under them but mud.

A prospective client in crisis calls and asks why your team should be retained—what is your answer?

Wepner: When you get called in on a fire drill, job one is to put out the fire. When a client is faced with a motion for a temporary restraining order or a preliminary injunction where the plaintiff has had weeks to prepare, if there is a serious risk that the motion will be granted, we will sometimes urge the client to consent to the motion without prejudice to litigating the merits on a less hectic schedule. A decision granting an early injunction can sometimes take on a life of its own. It is sometimes better to keep our powder dry until such time as we can marshal evidence, enlist experts, thoroughly research the law, and litigate on a more level playing field.

On the other hand, where the plaintiff's case seems weak, we may cross-move for summary judgment. In one case, the plaintiff told the judge that it needed discovery before responding to the summary judgment motion. The judge suggested that if the plaintiff needed discovery to stave off summary judgment, perhaps the plaintiff should withdraw its motion for preliminary injunction—which the plaintiff did. The judge subsequently granted our cross-motion for summary judgment, ending the case in our client's favor.

It's a challenging litigation market, with flat or declining demand, rate pressures, and other factors. From a business perspective, what does it take for a litigation department to succeed in this environment?

Mentlik: It sure helps to win cases. When I started practicing, pretty much all of the IP litigation in this country was done by a handful of what are today considered IP boutiques. Some of those firms seemed to lose every case—and some of those losses were huge—but they continued to get litigation business because they were the only game in town. Today, obviously, the competitive landscape could not be more different. So we not only have to leverage our history of success; we also have to take advantage of what makes our firm unique: Multiple decades of experience; expertise in virtually every technology; and experience in numerous trial and appellate courts, administrative agencies, and other forums.

Litigators are extraordinarily busy people. What does the firm do to ensure that they remain engaged with pro bono work, their communities and their families?

Mentlik: We recognized early on that everyone relieves stress in their own unique way, and we try to not only encourage—but celebrate—different outlets.

Gewirtz: Some of us have found that coaching our kids' sports teams keeps us connected to our families and the community. And teaching our kids about teamwork provides a constant reminder that teams and hard work produce winning results.

Wepner: Over 20 years ago, I started to teach IP courses in law schools, first at Seton Hall and then at Rutgers, on a pro bono basis. I rediscovered how fascinating the law can be when you don't have to deal with an adversary or a judge! I also found that by reading certain landmark opinions every year or so, I always learned something new that I hadn't appreciated previously. A number of our partners have served as adjuncts at New Jersey law schools as well.

What is the firm doing to ensure that future generations of litigators are ready to take the helm?

Mentlik: It doesn't happen often, but every now and then, a young associate is asked to assist on a particular aspect of a litigation and—without any prodding—takes ownership of the whole case. We welcome that with open arms. Those are invariably the lawyers that become first-chair litigators. And it happens a lot quicker than anyone ever expects. These self-starters will achieve their goals at whichever firm they work. The best thing we can do is steer them away from mistakes, and help fix the problems when we can't.