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Depth And Diversity Enhance IP Practice At Norris, McLaughlin & Marcus

The Editor interviews Kurt G. Briscoe and Jeanne Hamburg, Members of Norris McLaughlin & Marcus, P.A. Mr. Briscoe devotes his practice to patent, trademark and other intellectual property matters as well as trade secret law. He can be reached at kgbriscoe@nmmlaw.com. Ms. Hamburg focuses her practice on all aspects of copyright and trademark law, both in litigation and in the transactional area. She can be reached at jhamburg@nmmlaw.com.

Editor: Please tell our readers about your firm's Intellectual Property practice.

Briscoe: Even though Norris McLaughlin & Marcus is a general practice commercial law firm of 80 attorneys, your readers may be somewhat surprised to learn that our IP group consists of 20 attorneys and patent agents who collectively specialize in virtually all aspects of patent, trademark and copyright law. Our group has exceptional depth in the intellectual property area for any firm, and especially a firm of our size. Jeanne and I work out of our Manhattan office with nine other intellectual property attorneys and patent agents. The rest of our attorneys are located at our main office in Somerville, New Jersey.

Hamburg: I would like to add that Norris McLaughlin is a member of MERITAS, a world-wide network of law firms. As such, we can better serve our clients with multi-jurisdictional needs by drawing on the expertise of attorneys throughout the United States and the world.

Editor: Please tell us about your firm's commitment to diversity.



Kurt G. Briscoe

Hamburg: Norris McLaughlin's commitment to diversity is firm-wide but is perhaps best exemplified by the intellectual property department. In an age where law firms and the legal profession in general are struggling to attract and retain women and minorities, Norris McLaughlin stands out for its ability to do so. In the intellectual property department alone, we have two women members, one African-American member, one African-American Of Counsel and one woman senior associate. Additionally, we have two Asian-American patent agents. So nearly half of the department is comprised of women and minorities – and many at high levels within the firm. That's really remarkable.

Editor: Are you observing increased diversity within the legal profession?



Jeanne Hamburg

Briscoe: We are seeing an increased emphasis on diversity within the legal profession. Pressure is being exerted on law firms by their clients to increase diversity. The clients, in turn, are under pressure from consumers of their products and, also, to some degree, from society at large, to be more sensitive about diversity, and to take steps to ensure that they represent a diverse population and are represented by diverse servers. There is an appreciation growing that diversity is good and positive for growth and understanding, and that the product of a diverse outlook is a better product than one that is the result of a narrow outlook.

Hamburg: With respect to women within law firms this is perhaps better than it was decades ago, but still there is a long way to go. The greatest disparity is in the upper

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echelon – the partnership ranks. As a matter of fact, relative to the number of women graduating law schools and entering law firms as junior associates very few are making it to the partnership ranks. Many drop out due to family pressures. This is coming at a time when in-house departments are doing better at retaining women than law firms. It is also coming at a time when shareholders of publicly held corporations are demanding that those corporations themselves and those firms they partner with more closely reflect the population of the consumers they serve – in other words, the shareholders are asking for diversity, loudly. This should help.

Editor: Please tell our readers about your firm's ranking as a top patent firm in Intellectual Property Today's recent survey.

Briscoe: Norris McLaughlin & Marcus ranked 121 out of almost 400 law firms surveyed. Considering the numbers of attorneys at the various firms actively engaged in the practice, I believe that our production/attorney ratio was excellent. In addition, I believe our attorney billing rates are significantly lower than that of many other intellectual property law firms in the New York City metropolitan area. Still, our work product is second to none. Billing rates are only a part of the cost analysis. The number of hours spent doing a particular piece of work is also important. We pride ourselves on being able to do a first rate job at a reasonable cost. I believe the firm's efficiency at handling intellectual property matters coupled with the reasonable fees charged enhances our patent ranking to a high mark.

Editor: What role does intellectual property play in today's increasingly global marketplace?

Briscoe: Of course, intellectual property plays a crucial role in today's increasingly global marketplace. It is the centerpiece of virtually every new venture, and even well established businesses are coming to understand that their intellectual property assets are just as valuable as and, in many cases, even more valuable than their tangible assets. This evolution in thought means that businesses are increasingly becoming more appreciative of the importance of superior intellectual property counsel, as well. This has translated into a boon in intellectual property protection filings both here and abroad, with no end in sight

Editor: Please tell us about your firm's technology base that supports e-filings and other electronic communications essential to today's prosecution, enforcement and licensing of patents, trademarks, copyrights and other IP assets.

Hamburg: Norris McLaughlin is on the cutting edge with respect to electronic filings with the Trademark Office. We can complete and file trademark applications and virtually any other document needed to accomplish federal registration of a mark electronically. We can also accomplish anything we need to do with the Trademark Trial and Appeal Board on-line. This saves us time and that means a cost savings for clients. We also have the ability to file patent applications electronically and stand ready to take advantage of this capability as acceptance of this method of filing and improvements to the U.S. PTO software continues to grow. We currently make extensive use of the U.S. PTO's Patent Application Information Retrieval (PAIR) site which allows us to keep track of all internal PTO actions on our client's patent applications from the convenience of our desktop.

Additionally, through electronic docketing systems we can receive automatic reminders about due dates on particular patent and trademark applications. This means we, and the client, are on top of a deadline way before it comes up so there's no scrambling. Electronic docketing systems are also a tool for managing policing efforts. Particularly when you are policing a large portfolio, receiving reminders about a particular policing effort is invaluable and ultimately creates efficiencies and produces great outcomes for the client.

Editor: Jeanne, you have been speaking at a number of bar association events recently. What intellectual property issues are of most interest to corporate counsel today?

Hamburg: I think many in-house counsel are really excellent at staying on top of intellectual property issues and realize the significance of staying current. In the copyright area that's particularly challenging because the law has been evolving to take into account new media for consumption and delivery of content. The in-house counsel want to know the latest precedent and rulemaking under the Digital Millennium Copyright Act, whether they're with traditional copyright industries, or not, because they recognize that those cases can affect

every kind of business. And many in-house counsel are involved in "clearing" promotional content for distribution, whether it's marketing brochures, a print ad, or a TV spot. They want to be sure they're covered in the copyright, trademark and publicity right areas, especially if the advertising is created in-house and there's no ad agency which has promised to indemnify the client for attorneys' fees and damages associated with claims by third parties of infringement.

On the trademark side, many in-house counsel are concerned with protecting company brands, in the U.S., and world-wide, dealing with protests by third parties of their company brands, and doing it as cost-effectively as possible given the size of many company portfolios. False advertising claims are also an issue in those industries in which comparative advertising is common. Consequently, cost-effective vehicles for making and defending such claims, such as the National Advertising Division ("NAD") process, are of interest to those in-house counsel.

Briscoe: On the patent side, I believe corporate counsels today are increasingly becoming interested in turning the unused portions of their patent portfolios into profit centers. I've seen a significant increase recently in the number of seminars relating to the management of intellectual property assets. This, in turn, indicates to me that there is significant interest here.

Editor: Are arbitration and mediation becoming more favored than litigation as a means for resolving intellectual property disputes?

Hamburg: As long as "equitable" relief – that is relief in the form of an injunction stopping infringing activity – is important, and it really is critical in the patent, trademark and copyright areas, arbitration and mediation will not be popular. The reason is that brand owners and copyright owners may suffer what's called "irreparable harm" – or harm which cannot be redressed by monetary damages – if they do not stop infringements. Arbitrators and mediators do not have the power to issue nation-wide injunctive relief. Only the federal courts can do this – and they can do it on an expedited basis.

However, where the relief is in the form of money damages, alternative dispute resolution techniques such as arbitration or mediation can be cost-effective ways of settling disputes.