

Q&A With Fish & Richardson's Kurt Glitzenstein

Law360, New York (April 17, 2013, 2:26 PM ET) -- Kurt Glitzenstein is a principal in Fish & Richardson PC's intellectual property litigation group where he focuses his practice on high technology patent and trademark litigation before the U.S. appellate courts, the U.S. district courts and the U.S. International Trade Commission. He has experience in software, lasers, optics, telecommunications, medical products, industrial and systems control, semiconductors, and consumer products.

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

A: While every case poses a unique set of challenges, the one that really stands out for me is my work for Microsoft in the *Uniloc v. Microsoft* case. We measured events and milestones in that case not in years, but in the total number of children born to members of the team while the case was pending. The case spanned about nine years, during which Microsoft prevailed twice at the district court, and faced remands after two separate Federal Circuit appeals, each followed by a jury trial before different judges.

On the technical front, we had to come up with ways to educate the jury on the detailed operation of a technology central to cryptography and how communications are kept secure over the Internet. The animation we developed to explain those concepts ultimately found its way into one of the district court's opinions siding with us on noninfringement, which to my knowledge is the first time a judicial opinion included a playable animation.

On the damages front, this case gave us the opportunity to put front-and-center on appeal two issues that we had fought over the years in many other cases: when it is proper to use, for any purpose, the total sales revenue of an accused product to assess damages, and whether it is ever proper to use the so-called "25 percent rule" as a basis for calculating reasonable royalty damages in a patent case. In my view, these two issues were among the main drivers for inflating damages demands in patent cases, and it was very gratifying to prevail on both on appeal. In the end, the appellate court reigned in the ability to rely on total sales revenue of accused products, and rejected outright the longstanding "25 percent rule" as a basis for calculating patent reasonable royalty damages.

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

A: Both junk science and junk math (with regard to damages) continue to be serious issues in many patent cases, with conclusory and sometimes specious assertions from experts supplanting critical analysis based on sound factual investigation. With a bit more guidance at the appellate level, and more deference to district courts when they do make the hard decision to exclude or constrain such testimony, I believe district courts would become more willing to give serious consideration to Daubert motions, allowing cases to be tried more on the merits.

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

A: I have been closely watching the CLS Bank case, which is set for en banc review at the Federal Circuit. The case is important because it involves the scope of patentable subject matter under Section 101 in regards to software cases. We've recently seen an increasing number of district courts take a hard look at software patents from this perspective, with several thoughtful and well-reasoned decisions invalidating claims from such patents on this basis. The number of patents that are subject to scrutiny on this basis is tremendous, so it will be beneficial to get some further guidance on this important issue from the appellate court.

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

A: I've been fortunate to work with many terrific attorneys over the years, but one who stands out is Isabella Fu at Microsoft. She immediately sees the important issues in the most complex of cases, always keeps the short- and long-term business objectives in mind, and has great trial lawyer instincts. I also would not want to be on the other side of the table in a negotiation with her.

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

A: In my first appeal, I made the mistake of approaching the issues, and addressing questions from the panel, in the same way I would handle a dispositive motion hearing in district court. I was confident I had the "law on my side," and framed my responses to the panel accordingly. But I never felt that I got any traction with them. It was only afterwards, during my post-mortem assessment, that I realized the panel not only wanted to know what the law is (which of course they already knew), but also wanted to hear from me on what the law should be. Since then, I prepare for appellate arguments with equal emphasis on both issues.

The opinions expressed are those of the author and do not necessarily reflect the views of the firm, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.