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Patent Practice: A View from Munich

MCC INTERVIEW John Conroy / Fish & Richardson P.C.

*MCC interviews **John Conroy**, a principal in **Fish & Richardson's** Munich, Germany office, about the firm's European patent practice, Unitary Patents and rejoining Fish after working as in-house counsel at Power Integrations. He can be reached at **conroy@fr.com**.*

MCC: You have recently rejoined Fish in Munich as an American attorney who is admitted to the bar in California and is registered to practice before both the United States Patent and Trademark Office and the European Patent Office. What kind of legal work do you do? Why Munich?

Conroy: I help clients maximize the value of their patents – both on a matter-by-matter basis and as it pertains to the value of their entire patent portfolio. In individual patents, an understanding of both U.S. and European law allows me to help clients protect their ideas outside the U.S. without endangering their U.S. rights. By tailoring a patent portfolio both to the client's market and competitive environment – as well as to jurisdictional peculiarities – the value of the portfolio as a whole can also be optimized.

Munich is a natural location for my practice. At the threshold, Munich is the home of the European and German patent offices as well as the German Federal Patent Court. Further, Munich is the high-tech center of Germany and, to some extent, Europe as a whole. I also believe that the new Unified Patent Court will be heavily influenced by German patent litigation practice in much the same way that the EPO has been heavily influenced by German patent prosecution practice. I wouldn't want to miss that influence by being anywhere else.

MCC: What are some examples of the jurisdictional peculiarities of U.S. and European patent practice?

Conroy: There are several differences, but the one issue that consistently confounds patent attorneys on both sides of the Atlantic is the written description or support requirement for claim amendments. U.S. patent attorneys inevitably want to amend claims without regard to the direct and unambiguous support standard in the EPO's interpretation of Art. 123(2) EPC. On the other hand, European patent attorneys seem determined to enforce that same standard in the U.S. and elsewhere.

In the end, this is wrongheaded, and the clients' interests often suffer. For example, my 17-year-old daughter travels back and forth between the U.S. and Germany quite often. In the U.S., she is licensed to drive but cannot drink. In Germany, she is old enough to drink beer but cannot drive. She understands these jurisdictional differences quite well and exploits them to the fullest extent. We patent attorneys should be able to do the same for our clients.

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—John Conroy

MCC: You practiced at Fish for 11 years before leaving to become Managing Counsel, Intellectual Property at Power Integrations, a long-time Fish client. What is different about practicing in-house versus at an outside law firm, and what lessons learned will you take back into private practice?

Conroy: In-house attorneys generally play a different role than outside counsel. Put somewhat jocosely, it is the job of the in-house counsel to "pre-chew the food," that is, to identify legal issues and risks, gather as much information as possible about them and their relationship to the business, and to educate the stakeholders and ultimately get their buy-in on plans of action. Outside counsel will often handle the implementation of those plans within different practice areas. Ideally, this process tailors the representation to the client's needs.

One thing that struck me was the need for that communication to continue throughout the course of representation. Often, once implementation of a plan begins, communication with and feedback from the business stakeholders decreases.

The plans take on their own institutional momentum. Occasionally, it will be years before someone stands up and re-asks the questions that were asked at the beginning of the implementation. Without constant communication and feedback, the representation suffers.

MCC: Tell us about some of Fish's work in Munich and how the office interacts with Fish's 11 other offices across the U.S.

Conroy: A majority of the work in Munich is the representation of U.S. clients before the European and German patent offices, but we also have a solid European client base that is interested in using the Munich office as a gateway to the U.S. These clients like to be able to meet in person during business hours with a U.S. patent attorney without much ado. Fish's expertise in the U.S. is an easy sell, and the Munich office is there to help facilitate such interactions.

MCC: What hot button issues of U.S. patent law are Fish's clients in Europe concerned about right now?

Conroy: Much like in the U.S., patent holders in Europe are somewhat concerned by recent legislative and judicial steps that almost uniformly weigh against patent holders, be it in the subject matter that can be patented, the likelihood of surviving a post-grant challenge or the remedies that can be obtained if the patent is successfully enforced. For example, the PTAB is currently invalidating patents at a higher rate than the EPO is revoking patents in oppositions. Such uncertainty discourages investment – both in patent protection and in bringing products that embody new technologies to market.

MCC: How will the availability of the Unitary Patent change how U.S. companies should think about protecting IP in Europe?

Conroy: The Unitary Patent has been in the works for some time. However, a large number of open issues remain. For this reason, I believe that it is too early to say how effective the Unitary Patent Courts will be. Indeed, many of the more experienced observers predict a period of potentially disquieting uncertainty as the different trial courts blaze fresh trails across the legal landscape. I understand that there is historical precedent for such uncertainty in the early decisions in EU-wide trademark law by the Office for Harmonization in the Internal Market (OHIM), and I would be surprised by a different result.

MCC: How can U.S. patent owners prepare for the implementation of the Unitary Patent?

Conroy: I would advise U.S. companies to face the Unitary Patent with even more input from the business team and a full understanding of the strategic possibilities. It is of course always possible to deal with legal uncertainty by throwing money at the problem, that is, by filing more applications, parallel utility model applications and the like. It is unlikely that such measures are appropriate in every circumstance, which means that the filing strategy should truly be tailored to the commercial and technical importance on an application-by-application basis. Further, the business stakeholders should be involved throughout the lifetime of the application to optimize the representation.

MCC: Some European business groups are not enthusiastic about the Unitary Patent. What is the concern?

Conroy: Aside from potential cost, many companies are concerned about the uncertainty mentioned above. For example, pharmaceutical and other companies are – in my opinion, understandably – concerned that a valuable patent may be litigated in front of a relatively inexperienced trial court that has the ability to nullify the patent in all participating member states in one fell swoop. From the perspective of business people who rely at least in part on IP protection when making business and investment decisions, such uncertainty is of great concern.

MCC: You have a unique two-continent practice and a rare set of qualifications: you passed a rigorous set of exams in order to qualify as a European patent attorney. What advice do you have for young lawyers who might want to follow a similar career path?

Conroy: When advising newcomers to the patent field, whether in the U.S. or in Europe, I analogize the skills needed by a prosecuting patent attorney to those needed by a carpenter. To gain entry into the field, a carpenter has a set of rules to learn and follow, namely, the building codes. Similarly, a prosecuting patent attorney has to learn and follow the rules that govern interactions with a patent office – claiming priority, payment of fees and the like. It is a command of these rules that is tested by both the European Qualifying Exam and the USPTO's registration examination.

However, those rules are only the starting point for a successful career. In much the same way that a carpenter has to master the daily skills of cutting wood and hammering nails, a patent attorney needs to master the daily skills of patent practice. These aren't the sorts of skills that can be learned from a book. Rather, they are learned by performing under the guidance of more experienced attorneys – day after day, week after week – until a level of competence is achieved.

On a personal level, I have been blessed with the opportunity to be guided by several exceptional patent attorneys at Fish & Richardson. These attorneys are truly professional in their care for the clients and their responsibility for the work, and they were genuinely willing to mentor me in the course of my development.

On the path to becoming a patent attorney – be it in the U.S., in Europe, or in both – I would advise young lawyers to seek out as many such mentors as possible and devote themselves to learning from them. It is not enough to learn how to make one partner happy. Rather, learn how to make several partners happy. Finally, fuse what you have learned to create your own approach. In other words, the objective for the first few years of practice should not so much be to complete particular tasks but to learn the skills and the perspectives that can be carried forward to the completion of future tasks. The race is a marathon, not a sprint, and time spent learning the daily skills of the trade is well spent.