

DAILY REPORT

A SPECIAL SECTION • JUNE 29, 2017

PROFESSIONAL 2017 EXCELLENCE

DISTINGUISHED LEADERS

PROFESSIONAL EXCELLENCE

DISTINGUISHED LEADERS



THAD KODISH

Principal, Fish & Richardson

Last year, Kodish went ahead of the curve again when he won a decision from the U.S. Court of Appeals for the Federal Circuit for his client, Dalton-based carpetmaker Shaw Industries, against Automated Creel Systems.

The decision answered the thorny question of whether patent challengers would have only a single shot to invalidate a patent—and the answer was no. Leading a team that also included Erin Alper and John Dragseth, Kodish established this fundamental point of law, now often referenced as the Shaw doctrine. The court followed Fish's reasoning that, if the Patent Board declines to take on certain grounds of invalidity that a party presents, then the party could not have raised or reasonably could have raised them under Section 315(e), so that those grounds should be available to the petitioner in later litigation.

WHEN THE DAILY REPORT named Thad Kodish to its 2013 "On the Rise" list, a colleague of his at Fish & Richardson noted that many of his clients preferred to have lawyers with 25 years of experience serve as expert witnesses, but Kodish was ahead of the curve.

Kodish has defended Shaw, Samsung and McKesson Corp., among others, in cases involving “patent trolls,” a name given to people who sue for infringement using questionable patents and tactics to win quick settlements or licensing fees, especially in the high-tech industry. A 2000 graduate of Emory University law school, he joined Fish & Richardson in 2007 and became local managing principal in 2009.

What prompted you to pursue a career in law after working as a chemical engineer in the aircraft industry?

My interest in patent litigation actually preceded my time as an engineer at United Technologies Corp. and stemmed from college study groups discussing legal careers that drew upon scientific backgrounds. In this role, my focus was developing improvements in chemical and electrical processes used to manufacture jet engines. That period working in an inventive, product development environment helped me better understand the perspectives and challenges facing innovative technologists for whom I would someday advocate. To this day, I draw upon that work experience to direct and cross-examine witnesses and ultimately to prepare case themes that

I believe in and can expect will be credible to judges and juries.

What was your biggest concern going into the Federal Circuit argument for the Shaw case?

Arguing at the Federal Circuit for Shaw Industries, the leader of Georgia’s flooring and textile industry, was a pressured but exciting charge. More specifically, that appeal was daunting, given the sheer number of issues spanning Patent Act interpretation, Administrative Procedures Act-based due process arguments, a mandamus petition and detailed factual disputes. Add to that, our adversary had its own list of issues on cross-appeal, and the Patent and Trademark Office Solicitor intervened with briefing of its own, given the potential impact of the ruling. Of course one needs to be prepared on everything, but the reality was that only portions would or could get attention at the hearing.

Diffusing that tension, things got started in an unusual way when Judge [Evan] Wallach began the hearing with a humorous Sir Walter Scott quote for a carpet case—“What a tangled web we weave ...” Fortunately, my liberal arts studies didn’t completely fail me, and I mustered the quote’s completion, “... when first we practice to deceive,” and we were off and

running. In the end, the judges homed in on our APA issue that established precedent in Shaw’s favor.

What is one of your proudest accomplishments in the law, and what challenge did you have to overcome so you could achieve it?

I am very proud of the work done with my Fish & Richardson colleagues to build a talented, diverse and thriving Atlanta office. Over 50 percent of our constituency consists of female and minority lawyers with exemplary technical and legal credentials. Given the relatively small pool of matriculating law students having technical backgrounds, we have worked hard to recruit and maintain our team and to follow through on our promise to champion diversity. Our whip-smart group of practitioners bring unparalleled perspective, creativity, adaptability, experience and know-how to their cases. I am so grateful on a daily basis to work with an extraordinary group of people who help their clients drive innovation and lead their industries.

FISH.
FISH & RICHARDSON