

Driving the NextGen Movement

By Andrea Papaqianis-Camacho

Forward-thinking industries are investing in the next generation of leaders.

The NextGen movement is gaining momentum in the legal sector as experienced attorneys work to ensure their up-and-coming counterparts receive proper training and gain the meaningful experiences necessary to grow their careers.

The industry faces unique challenges in grooming its NextGen leaders, however. As litigation becomes more expensive, and fewer cases go to trial, junior lawyers are seeing fewer stand-up court opportunities.

In an effort to promote mentoring, diversify the profession and level the playing field for all attorneys, the global patent and intellectual property firm Fish & Richardson, in collaboration with ChIPs, an organization committed to advancing women at the intersection of law, technology and regulatory policy, and the Federal Circuit Bar Association, created nextgenlawyers.com.

The site is a resource of news, articles, seminars and judicial orders to guide law firms and judges who want to provide courtroom experience to junior attorneys.

With a push from the bench and bar to provide green attorneys with stand-up trial experience, and a firm-wide commitment to the industry's future, San Diego-based Fish associate Nicole Williams got her shot.

U.S. Patent 5,370,389 ('389) was her ace.

Filed in 1994, in its most basic form, the '389 patent covered the start-to-finish progression of playing point-scoring games at a driving range. Included were simple driving range plans with target greens placed throughout at various distances and locations from the teeing area. The patent expired in 2012.

Four years later, the '389 patent was at the heart of an infringement dispute involving Topgolf International, Inc.

Topgolf pioneered a technology to make golf more fun and engaging. Through the



Fish & Richardson associate Nicole Williams.

experience of play, food and beverage and music, Topgolf brings people of all ages and skill levels — even non-golfers — together for playful competition in point-scoring golf games using microchipped balls that instantly score themselves, showing players the accuracy and distance of their shots on a TV screen in their hitting bay.

The Dallas-headquartered company whose signature multi-level, golf entertainment and event complexes have taken the nation by storm, turned to Fish & Richardson after a Florida-based investor and patent owner asserted the '389 patent in federal court in Florida against some of the targets found on Topgolf courses.

Then-fourth-year associate Williams was tasked with day-to-day management of the case.

Topgolf sought a motion to dismiss for the claim filed in Florida but was denied.

The Fish team (comprised of Southern California principals Bill Hunter and Craig Countryman along with Steven McCracken, Dorothy Whelan and Williams) determined that their strategy should ask a more central question: Should the patent have been issued in the first place?

Topgolf filed a petition for inter partes review of the '389 patent to answer that question.

As the issue made its way through the

United States Patent and Trademark Office's Patent Trial and Appeal Board, Williams' role expanded to handle tasks typically managed by more senior attorneys. She and Countryman split the workload, with Countryman handling the written petition for inter partes review and Williams taking on the expert declaration, expert depositions and stand-up oral proceedings before the PTAB to review the patentability of the claims.

"Having had that experience myself, I know how important it is," Countryman, a principal of the firm whose practice centers on complex legal analysis and writing, said. "Knowing that, I wanted to give Nikki (Williams) the opportunity to get her chance on this case — to give her the same opportunities that partners at the firm gave me as a junior lawyer."

Understanding the importance of investing in the next generation of the law, Topgolf agreed. The decision turned out to

be the right one.

Travelling to Columbus and Phoenix, Williams handled all the offensive and defensive expert depositions and obtained admissions from the patent owner's lineup of expert witnesses that proved to be instrumental. At the PTAB hearing, which mirrors trial proceedings in a federal court, Williams assumed the role of first chair. Williams had just two weeks' notice to prepare for what would be her first lead role at a PTAB oral hearing. She went on to deliver a focused presentation flawlessly.

"They (the client) had never seen me in action before," Williams said. "The district court case was stayed very early on and they hadn't seen my work. They really had to trust in the quality of the firm to allow this. A lot of this takes advocating from the principals themselves. That, and a trusting, working relationship with the client."

In the end, the Fish team was on target. The result was an 82-page PTAB opinion

issued in June siding completely with Topgolf.

The patent owner's claims were deemed unpatentable because they were rendered obvious by previous inventions. Therefore, the earlier district court action was mooted as the claims it was based upon no longer existed. It hasn't happened yet, but the decision could still be appealed. If it is, Williams is ready.

Williams' position isn't all that unique at Fish.

"I have seen sixth-year associates running the day-to-day on cases," she said. "There is always your first. You don't jump in on a case as an associate being able to run a case. It is something you've seen someone do. I am not by any means an anomaly. The firm's mentoring and hands-on training is so good that clients trust — and trust for good reason — associates to do substantive and very hands-on work."

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