

**Interview with Anthony L. Miele, Partner, Weingarten Schurgin Gagnebin & Lebovici LLP. Conducted by JHTL Staff Member Kenneth J. Rodriguez, April 2004.**

*Anthony L. Miele is the author of Patent Strategy: The Manager's Guide to Profiting from Patent Portfolios, John Wiley & Sons, 2001, ISBN: 0471390755, 264 pages.*

**JHTL: *What was it like writing your book Patent Strategy: The Manager's Guide to Profiting from Patent Portfolios? If you had the opportunity to write an addendum for it, what would you include?***

ALM: It was a very rewarding experience. The effort allowed me to think through patent issues from the perspective of a business executive, and has thus helped me better communicate with my clients. An addendum might concentrate more on patent portfolio development and the logistics and internal politics associated with such a task.

**JHTL: *In your book, you write that “depending upon a company's patent portfolio strategy and the diversity of its business, litigation is the best course for maximizing and protecting one's competitive advantage in the marketplace” (p. 76). Are there any new trends in patent litigation?***

ALM: Litigation is the only way to enforce a patent, if someone is using the patented technology and refuses to cede to the patent owner's wishes. There has been an increase in patent litigation involving software patents of all types and involving business methods and Internet-related inventions. Examples of such litigations include those between MercExchange and eBay in VA, between National Instruments and Cognex Corp. in Delaware, and between National Instruments and The MathWorks in Texas. Litigation of pharma-related technologies continues to be prevalent.

**JHTL: *What are common misconceptions that clients have about patents?***

ALM: One is that patents provide little value, if any, to a company. I have heard a few business executives and investors state this notion, because they have seen companies fail to successfully exploit their patent portfolio, or because they have managed a company that did not have sufficient revenue to justify and fund patent litigation. The company needs three things for its patents to be valuable (and usable): (1) it needs to get the right patents; (2) it needs to have markets and revenue on a scale to substantiate enforcement of the patents; and (3) it needs to execute its exploitation strategy successfully. The value (or lack thereof) of a patent should not be presumed without considering these factors.

**JHTL: *What are some of the major challenges that intellectual property attorneys face?***

ALM: Intellectual property attorneys are in demand by competing organizations. Companies want them to work for the company as an employee; full-service firms want them to work for them; and intellectual property specialty firms want them to work for them. This has resulted in more mobility and in some cases inconsistencies in the quality of life of the intellectual property attorney. Some of the bigger full-service law firms require a lot more hours from their IP attorneys than they worked while at an IP specialty firm. Some of the IP specialty firms are also increasing their demands for billable hours. Attorneys that accept positions working for a company sometimes find themselves later rejoining a law firm because the company is downsized or acquired.

**JHTL: *Are there any issues currently being litigated that intellectual property lawyers are keeping an eye on?***

ALM: For a patent to be valid, Section 112, paragraph 1 of the patent statute requires that its specification contain an adequate written description. There have been some inconsistencies in the way the courts have applied this requirement to hold a patent claim invalid (*Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 45 USPQ2d 1498 (Fed. Cir. 1998)) or to fail to hold that a claim is invalid (*Moba, B.V., et al. v. Diamond Automation, Inc.*, a recent Federal Circuit decision 01-1063, -1083). In *Moba*, Judge Rader explains in his concurring opinion that “[e]ach time a claim encompasses more than the preferred embodiment of the invention described in the specification, a defendant can assert that the patent is invalid for failure to describe the entire invention.” He explains what he believes are problems with what he characterizes as a “non-statutory doctrine” created in the *Lilly* case. *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 43 USPQ2d 1398 (Fed. Cir. 1997).

**JHTL: *Law professor Lawrence Lessig has said that because too many patents involving the Internet have been granted, “Bad patents’... [have] become the space debris of cyberspace” (<http://www.lessig.org/content/standard/0,1902,4296,00.html>). Do you agree with that? Do you think that the issuance of software patents can sometimes inhibit software development?***

I see no evidence that patents are hindering any particular market, the Internet included. I also have not seen any indication that the validity rate of Internet-related patents is any higher than it is for any other technology area. Software and the Internet are both areas for which patents are still relatively new. I believe that this lack of history makes bleak forecasts, such as that of Professor Lessig, more common (in this case, of bad patents).

**JHTL: *What has been the most significant change in practicing intellectual property law since you began your legal career?***

ALM: The interest of the national full-service firms in the business. When I worked with the IP specialty firm Cushman Darby & Cushman in Washington, D.C., in 1996, they were acquired by Pillsbury Madison & Sutro, then a 550 lawyer firm, now an 800 lawyer firm (named Pillsbury Winthrop).

**JHTL: *Who are some of the attorneys you admire, and why?***

ALM: These attorneys (and others I don't mention here) I admire, because they are people of knowledge, determination, and integrity: Bruce Bernstein of Greenblum & Bernstein, Ray Lippit, retired from Pillsbury Winthrop (formerly Cushman Darby & Cushman), Art Wineburg of Pillsbury Winthrop, and Fran Lynch of Palmer & Dodge.

**JHTL: *What role should intellectual property law, including patent law, have in the law school curriculum today?***

ALM: Intellectual property law is a very important component of the law school curriculum, particularly because it is so prevalent and will likely be dealt with at some level by any business lawyer.

**JHTL: *What advice do you have for students who are interested in intellectual property?***

ALM: That is a tough question. As is the case for anyone considering a career in law, the student must enjoy the field and find a job later that is a good fit. Consider both of those factors, and expect bumps along the road in finding the right job.

**JHTL: *Are there any other intellectual property books that you recommend?***

ALM: There are so many. There is a book I have not read, yet I'd look at it because I had one of the co-authors as a professor at George Washington University and I like the way he explains intellectual property: [Intellectual Property: The Law of Copyrights, Patents and Trademarks](#) (Hornbook Series. Student Edition), by Roger E. Schechter, John R. Thomas, and Jay Thomas.