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Q&A With Robins Kaplan's Marla Butler

Law360, New York (May 08, 2013, 1:15 PM ET) -- Marla R. Butler is the assistant regional managing partner of Robins Kaplan Miller & Ciresi LLP's New York office and chairman of the firm's diversity committee. As a trial attorney, she has spent the last 15 years litigating and leading high-stakes intellectual property and patent litigation trials, Markman hearings, mediations and arbitrations. She represents technology clients in the medical, semiconductor, LCD, networking and other electronics technologies industries, and helps them monetize their patent assets and/or defend against lawsuits that threaten their businesses.

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

A: The most challenging case I worked on was a matter in which my firm represented a medical device company in an infringement action related to stents made of a shape memory alloy. I was a young lawyer and it was my first patent case and first patent trial. The patent law learning curve was steep, as was the learning curve for the technology. I recall sitting at home and pondering the complexities of the doctrine of equivalents and the mush of caselaw surrounding obviousness. But while it was very challenging, I fell in love with patent litigation and never turned back. I love the complexities and love diving into new and different technology with every case. Patent litigation is now nearly 100 percent of my practice.

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

A: The cost of patent litigation. I represent plaintiffs as often as I do defendants, and the high cost of patent litigation is not just a concern for defendants. There are patent owners for whom litigation is not an option because of the high costs. There are cases that I cannot take on because of these high costs. I turn away clients that own patents that are being infringed because it does not make sense to spend $3-6 million (often more) to litigate a case when only $1-2 million (perhaps less) is at stake. Effectively, there is no real remedy for infringement unless the damages exceed $10 million, and no remedy for the small business owner whose patent is being infringed by another small business owner. Lowering the costs of patent litigation will allow more patent owners to enforce their property right.

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

A: In patent circles, there is a lot of talk surrounding nonpracticing entities, sometimes pejoratively referred to as trolls. There is a view that enforcement of patent rights should be limited to those patent owners who are actually practicing the patented invention. According to some, the patent system should be reformed to preclude an NPE purchaser of a patent from enforcing it, or to significantly limit the ability of the NPE purchaser to do so. I disagree with this view. Companies that are built on innovation have a responsibility to their stakeholders, including their shareholders, to extract maximum value from that innovation. The duration of a patent's value should be dictated by the 17- or 20-year life of that patent at a minimum, not the duration of the inventor's use of the invention.

Consider Nortel. The vision and persistence of the bankrupt company's IP proponents directly resulted in the $4.5 billion sale of IP — a significant amount of money for the company's creditors and shareholders. The purchasers of that IP have to be able to enforce the rights associated with it. Otherwise, there will be no incentive to purchase, which, in the case of Nortel, would have severely limited or destroyed the value of that IP to Nortel's creditors and shareholders. In other words, limiting enforcement rights to the original inventor/assignee of a patent limits the value that the original inventor/assignee can extract from the patent.

Instead of focusing the conversation on practicing versus nonpracticing entities, I believe the conversation should be focused on improving the mechanism through which patents issue, so that stronger and better patents issue. And the owners of those stronger and better patents — whether the first, second or third owners — should be allowed to extract from those patents whatever value the market will allow.

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

A: Doug Lumish at Latham was opposing counsel in a case I tried to a jury in 2011. The litigation was intense, and each side zealously advocated for her or his client. We had "knock down, drag out" battles in depositions. But beyond the advocacy, Doug maintained the professional civility that is, unfortunately, all too rare in opposing lawyers. I respect Doug's abilities as an advocate and I respect his professionalism.

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

A: Early in my career, there were occasions when I recognized potential pitfalls in cases that the client either minimized or refused to acknowledge altogether. And I didn't always push the client on those issues. Predictably, those potential pitfalls sometimes played out as actual pitfalls, just as I feared they might. Those experiences have increased my confidence in my ability to spot issues, and they have also changed the way I communicate with my clients. I've learned to diplomatically but assertively push my clients to address and adjust to difficult issues in advance. I explain that my job early on is to poke as many holes in our case as possible, and then figure out how to plug — or avoid — those holes. My clients appreciate this approach and recognize that their cases will ultimately be better in the long run.

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