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Phone: +1 212 537 6331 | Fax: +1 212 537 6371 | customerservice@portfoliomediamedia.com

Q&A With Edwards Angell's Kathleen Carr

Law360, New York (July 15, 2009) -- Kathleen B. Carr is co-chair of Edwards Angell Palmer & Dodge LLP's intellectual property litigation group. She has handled a wide array of patent, trademark and copyright cases and disputes for clients ranging from major pharmaceutical companies to startup companies and individuals.

Carr's patent cases have covered a variety of technologies including pharmaceuticals, biotechnology, mechanical devices, computers, business methods, printing machines, photocopiers and design patents. Her patent law practice includes providing opinions with respect to validity and infringement issues and patent prosecution. Carr is registered to practice before the U.S. Patent and Trademark Office.

Q: What is the most challenging case you've worked on, and why?

A: At the beginning of every new case, I am pretty well convinced that it is the most challenging case I've ever worked on, because at that stage, everything is new: new technology, new facts and new legal issues.

You really have to become somewhat of an expert on whatever the technology in each new case is, or whatever the subject of the intellectual property that you are addressing is. This is one of the greatest things about patent law: It provides the opportunity to learn about the inventions in each case, such as new medicines that help people, and new technologies.

Each new case also requires learning and understanding the particular business area as well, which has been particularly interesting in some of the trademark cases I have handled. Those have ranged from protecting a modeling agency mark to enforcing tradename rights against a seller of "homeopathic" products.

Overall though, I would say that the most challenging case I can think of is one that involved 29 patents. That was quite interesting. Imagine asserting 20 patents and defending

against assertion of nine others, all involving related technology and all in the same case. We were very pleased to have reached a favorable settlement in that case.

Q: What accomplishment as an attorney are you most proud of?

A: I am happy that I have been able to balance my case workload, commitments to my firm and commitments to my family. I think it is very important to make sure that all get the full attention they need. Each case comes with its own timing requirements, as do my firm responsibilities, including working as co-chair of our intellectual property litigation group, serving on our hiring committee, and assisting with personnel issues through my ombuds role.

I have worked very hard to make sure I am available for my family as well. I spent last July in a hospital room with my mother, and wouldn't have missed that for the world.

I still feel the need to clone myself on occasion, but as I have not yet been able to figure that one out, I am happy that I have worked as hard as I have at trying to make it all work together.

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

A: Patent reform needs reform. Over the past few years, several efforts at patent reform legislation have been launched taking aim at several aspects of patent law, including how damages are calculated, when and how recovery for willful infringement may be sought, and interlocutory appeals of Markman claim construction rulings. Many aspects of these reform efforts so far have been misguided.

Patent law cases are special, but not so special that general federal law precedent should not apply to them, as the U.S. Supreme Court appears to have recognized recently with respect to the standards for declaratory judgments and injunctive relief.

The proposed patent reform legislation, which thankfully has not yet gone through, needs substantial reform itself before it will be in any sort of form that would actually be helpful for my practice area of patent law or improve the law.

Q: Where do you see the next wave of cases in your practice area coming from?

A: Biologics litigation might be on our horizon. Right now, we have the Hatch-Waxman Act in effect, which provides a statutory scheme for new drug product market exclusivity and

later entry of generic pharmaceutical products under specified circumstances. No such set of rules governs biologics, which are drug products that are made by using living things such as tissues or microorganisms.

Last week, the FTC released a report indicating its views of market protection applicable to innovator biologics, suggesting that a period of market exclusivity generally is not necessary. It appears that if the FTC's approach is followed, that will leave the potential for market entry for follow-on biologics subject only to patent restrictions. That makes it likely that patent litigation related to such products would be substantially advanced in time as compared to the Hatch-Waxman rules applicable to ANDA litigation involving generic drug products.

While the FTC's report appears to have met initial resistance, and some legislative efforts are in the works with respect to biologics, it will be interesting to see the end result.

Q: Outside your own firm, name one lawyer who's impressed you and tell us why.

A: Bob Ciociola. Bob is one of the most wise, practical and smart lawyers I know, and has a great ability to maintain a classy and considerate approach to everything he does. As a talented and skilled trial lawyer, he is a credit to the profession, and as a kind and thoughtful person, he is a credit to our community.

Q: What advice would you give to a young lawyer interested in getting into your practice area?

A: Do it! It is a great practice area. I have had inquiries from young attorneys interested in intellectual property litigation concerning whether you need a Ph.D. or something along those lines to practice litigation in this area. The answer is: You do not. First of all, intellectual property litigation comprises several areas, including patent, trademark and copyright law.

Trademark and copyright litigation involve fairly complicated areas of law, but do not require science degrees. With respect to patent litigation, every case is so different, you really need to learn the technology for each case. A science degree is helpful, but not required to practice in the area of patent litigation. The key is to be able to explain the technology in the context of the applicable law to the jury or judge.

One thing I would recommend though is that if you qualify for taking the Patent Bar Exam,

you should do it. That adds experience and a perspective that is helpful for providing a broader base of knowledge and more perspective for the nuances of the issues that may arise during a patent litigation matter.

And finally, to all who are considering joining our area of practice, I would like to say: Welcome! The patent bar and intellectual property litigation attorneys in general are an eclectic mix of people from different and interesting backgrounds. I have heard that the perception of attorneys in our practice area has transformed from the "nerds" of the law into "techno cowboys."

I consider us to be just plain enthusiastic lawyers ready to embrace and dive into the next case. We generally are a welcoming sort who genuinely enjoy and are committed to the work that we do.

All aboard!

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