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## Q&A With WilmerHale's Donald Steinberg

*Law360, New York (May 22, 2009)* -- Donald R. Steinberg is a partner with WilmerHale in the firm's Boston office and chair of the firm's intellectual property department. His practice focuses on advising clients on IP matters, obtaining patent and trademark protection, and intellectual property litigation.

Steinberg works with technology clients in a variety of fields, including analog and digital devices; computer architecture; semiconductor manufacturing; operating systems and software applications; networking and communication systems; electromechanical devices; Internet-based applications; computer security; consumer electronics; and medical devices.

He is also a member of the Software and Business Methods Committee of the Intellectual Property Owners Association and speaks regularly on issues of patent law, strategy and protection.

**Q: What is the most challenging case you've worked on, and why?** A: One of the first International Trade Commission cases on which I worked involved seven patents relating to optical, control and mechanical systems that our client was accused of infringing. The complainant had spent years getting ready to spring the action on our client, and the case threatened its entire product line.

The technology was varied and complex, and we spent the first months "catching up" as the case progressed. The combination of the high stakes, fast pace of an ITC case, difficulties in getting to understand the technology and accused products, and challenge of developing defenses against patents at least partially written to target our client's products, made the case particularly challenging.

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

A: In the "challenging case," we prevailed in the ITC on all seven patents, and the case subsequently settled. To accomplish that, we relied on a combination of

noninfringement, invalidity and inequitable conduct arguments, tailored to the specifics of each patent, and developed the necessary supporting evidence.

From when the case commenced — and prevailing on all seven patents seemed very unlikely — through trial where we believed we had developed a strong case, we had accomplished a lot. Moreover, we had done this with a large team from multiple offices that worked very well together, with everyone knowing what they had to do and doing it.

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

A: Patent reform has, of course, been a topic for many years, and the latest legislation is working its way through Congress. The current proposals, however, do not fully address the problem of people easily being able to assert patents against technologies and products very different from what the inventor actually contributed. The ability to draft claims years after filing a patent application that are much broader than any invention actually identified in the application, is one aspect of this problem that should be addressed.

Also, claim construction remains only loosely tied to the specification in the patent that describes the invention. Tying claim construction more closely to what the inventor described as the invention would further address the over-breadth of patents and difficulty in determining what the claims cover.

Other areas that are also in need of reform include:

- inequitable conduct law. Lots of actions and inactions that represent, at most, mistakes, do not affect the integrity of the patent or the process, and can be addressed in other ways, remain the subject of claims of inequitable conduct.

- the law of willful infringement, even despite the recent Seagate decision. The standards for when infringement is considered willful and the circumstances when a company needs to obtain an opinion remain unclear. Similarly, with respect to knowledge of infringement, the law regarding what constitutes indirect infringement and when a belief that a patent is not infringed avoids indirect infringement remain unclear.

- the patenting process. For example, patent examiners are unable to spend sufficient time on particular applications, the process takes too long, and there often appears to be a significant disconnect among the meaning of the claims from the examiner's perspective, the meaning of the claims from the applicant's perspective, and the meaning of the claims when asserted in litigation.

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

A: From a patent application perspective, patents directed toward the development or use of alternative energy (or reduced use of energy), directed toward a wide range of

medical devices and products, or directed toward wireless technology, are likely to be sources of lots of activity. The resulting patents likely will lead to patent litigation.

In terms of issues, cases addressing patentable subject matter with software, business methods, medical diagnostics and possibly other areas are likely to be numerous in the aftermath of *In re Bilski*.

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

A: There are, of course, lots of impressive lawyers, with a wide range of impressive accomplishments. Jonathan Zittrain, a professor at Harvard Law School and co-founder of the Berkman Center for Internet and Society, is teaching, having an impact at the policy level and practicing law.

His work on the intersection of the law and the Internet, computer security, copyright law and other areas is important as the Internet, digital media and computers pervade so many aspects of our lives, and the legal issues cannot be cleanly or easily divided up into different areas or addressed by looking at just one legal discipline.

**What advice would you give to a young lawyer interested in getting into your practice area?** A: First, I would suggest that the lawyer learn IP law deeply and stay on top of the law as it develops. In particular, he or she should learn the statutes, the case law and the rules, and understand the logic underlying the law. Really knowing the law makes you more valuable as a lawyer and makes the work more interesting.

Second, I would stress the importance of gaining significant exposure to a range of tasks, even if the lawyer's end goal is to have a very focused practice. For example, in patent law, work on patent prosecution, patent advice and patent litigation — not just a little, but enough to gain an understanding of how work in each area is done. Even if you don't continue to work in that area, you will learn a lot and it will make you better in those areas in which you focus.

Third — and this is not specific to a young lawyer, but to any professional starting out his or her career — it is critical to continuously expand your network of contacts. The people you meet now and with whom you develop a professional relationship — within your organization, at law firms, at companies and in academia and other organizations — will be a source of work, jobs and information as you continue in your career.