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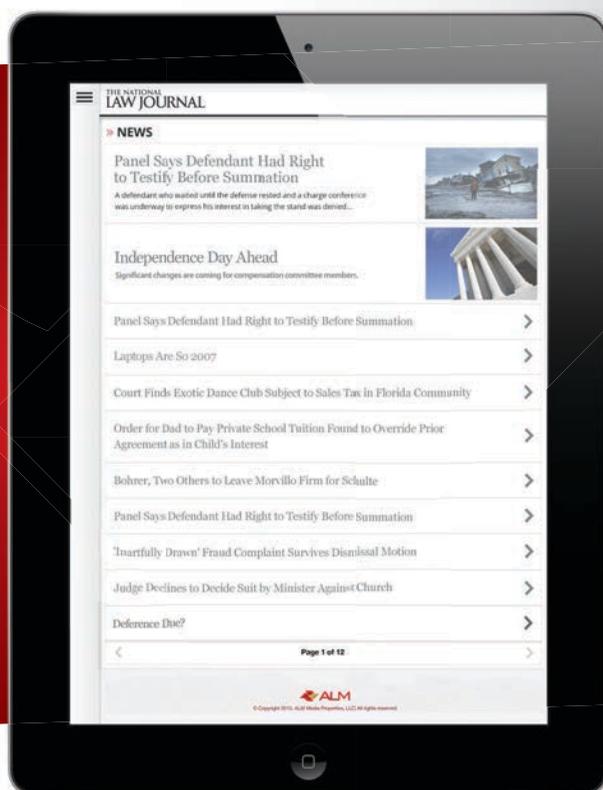
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Dear Readers,

At the *National Law Journal*, our goal extends far beyond simply covering news of national importance and the business of law. In a profession so integral to people and corporations worldwide, and with so many trends altering the legal landscape today, the *NLJ* is a voice of both analysis and interpretation for the industry and beyond.

Indeed, part of the important role of interpreting such a fast-moving, complex industry calls for us to periodically step back and recognize the contributions of those who are raising the bar in critical practice areas. With *IP Trailblazers & Pioneers*, the publishing arm of the *National Law Journal* celebrates the achievements of IP attorneys and others who are innovating in the field, helping to change the way copyright, patent, trademark or licensing law is practiced, or how IP is protected and managed.

Far from an exhaustive list, this year’s winners are a snapshot of success and extraordinary leadership in an area critical to innovation throughout the world. We hope you enjoy this special section and look forward to hearing from you with your nominations for next year’s list!

Congratulations again to this year’s honorees.

All the best,

Tom Larranaga
Publisher, *The National Law Journal & Legal Times*

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SALLY M. ABEL

FENWICK & WEST LLP

PIONEER SPIRIT After finishing law school, Sally Abel spent a year clerking before joining Fenwick & West, where she was immediately selected as fourth chair for a jury trial “on the theory that I had just finished a clerkship so I could write briefs at 3 a.m.” The dispute was over software patentability, and soon after the firm offered her the opportunity to build a trademark practice. One of her early clients was then-tiny Sun Microsystems, which she ended up representing for more than 20 years. “Sun and I grew up together.”

TRAILS BLAZED Abel got involved with the International Trademark Association’s Business Identifiers Task Force and first became aware of the Internet when it seemed the Task Force might take responsibility for it at INTA. She ended up chairing the Internet subcommittee, developing and chairing the Enforcement Committee, and she was INTA’s representative to the International Ad Hoc Committee, an early initiative to organize the assignment of top-level domain names and a predecessor to ICANN. As a result, she was asked to participate in the World Intellectual Property Organization’s First Meeting of Consultants on Trademarks and Internet Domain Names in Geneva in February 1997, and she still serves WIPO and the National Arbitration Forum as a neutral panelist in settling domain name disputes.

FUTURE EXPLORATIONS Abel believes that much of the current scuffling over the expansion of domain names is missing the point. “The point is apps. Domain names are not going to be as important as they have been over the past 20 years.” However, she foresees, especially in the technology space, the use and abuse of trademarks will only accelerate.



GREG AHARONIAN

CENTER FOR GLOBAL INNOVATION/PATENT METRICS

PIONEER SPIRIT In the 1980s, Greg Aharonian was working for a defense contractor and tasked with trying to find all the software the government owned. “This was before the Internet; I’d literally travel around the country and look in libraries.” He cataloged more than 20,000 programs, which allowed him to become a resource for prior art searches. He’s been working with law firms and companies analyzing software patents for more than 20 years. “The quality of software patents has not improved in 20 years. The U.S. Patent and Trademark Office can’t handle the quantity. They issue 3,000 new software patents per week, but how often do we see real innovation or new inventions in software?”

TRAILS BLAZED In 1993, Aharonian launched the Internet Patent News Service, which he says was the first public newsletter about the patent world. It still publishes daily. Last year, he launched Global Patent Quality at www.global-patent-quality.com as the largest resource for statistics on patent quality. And earlier this year, he announced a partnership with Intellectual Property Insurance Services Corporation to protect companies from patent litigation risks. “If enough people get protected with insurance that covers their defense costs, the trolls will go away, without legislation.”

FUTURE EXPLORATIONS Aharonian says that patent law has not really progressed at all. He has a copy of a letter from 1914 in which an engineer is asking why the USPTO and judges don’t know the first thing about electric motors. “If you take his letter and replace ‘electric motor’ with ‘software,’ it would look the same today. I don’t expect much until people get serious about patent quality.”

DAVID ALMELING

O'MELVENY & MYERS LLP



PIONEER SPIRIT After law school, David Almeling clerked at the U.S. Court of Appeals for the Eleventh Circuit before joining O'Melveny & Myers as an IP litigator specializing in patent and trade secret litigation. Early on, he recognized an important disconnect between the two fields. "There was an abundance of empirical data about patents and patent litigation, but not much about trade secrets."

TRAILS BLAZED Almeling and his colleagues spent "huge amounts of attorney resources compiling the largest empirical analysis of trade secrets litigation ever published." Almeling, three associates and the head of the firm's IP department read 3,500 cases and worked with statisticians to analyze the data. The end result was a study that answered—for the first time ever in a measureable way—key questions such as what type of trade secrets are litigated, what jurisdictions are most popular and who wins trade secret cases. "We published our results. But we kept the underlying database as a firm resource that we have used to serve our clients."

FUTURE EXPLORATIONS "One major finding from our research was that trade secret litigation has doubled over each of the last few decades." Almeling expects this trend to continue, and that trade secrets will become an increasingly important part of the IP landscape. This increase will be fueled "by continued technological innovation and employee mobility and by a rise in international threats."

JOHN A. AMSTER AND GEOFFREY T. BARKER

RPX CORPORATION



PIONEER SPIRIT John Amster and Geof Barker first crossed paths in 2006 at Intellectual Ventures, where they shared responsibility for the licensing strategy of the software portfolio. Amster had become an IP expert during stints as VP and secretary at InterTrust Technologies and managing director of patent auction house Ocean Tomo. Barker, in contrast, was a former investment banker turned tech entrepreneur as co-founder of the Cobalt Group, a digital marketing company.

TRAILS BLAZED In 2008, Amster and Barker joined forces with like-minded IP attorney Eran Zur to found RPX as the first defensive patent aggregation service. It was a simple concept: Use annual membership fees to buy patents before they could be acquired and used offensively by nonpracticing entities. RPX grew quickly and went public in 2011. In April, RPX partnered with Lloyd's to introduce the first NPE insurance policy, which is designed primarily for medium-size businesses, which represent 60 percent of the companies that are now spending approximately \$13 billion every year on NPE-related legal costs and settlements.

FUTURE EXPLORATIONS The co-founders believe the NPE problem can and should be solved by market forces rather than Congress. "Patents are assets, and the NPE business model is designed to monetize those assets," says Amster. "An efficient market can eliminate the waste involved in transacting any asset. Our approach has already significantly reduced the expense of NPE patent monetization for members of the RPX network, and we believe we're on our way to building an industrywide clearinghouse that can eliminate nearly all the financial risk now caused by NPE litigation."



DAVID H. BERNSTEIN

DEBEVOISE & PLIMPTON LLP



PIONEER SPIRIT While he never took any IP classes in law school, David Bernstein was exposed to three high-profile cases heard during his year clerking at the Massachusetts District Court. "It was amazing to be truly at the cutting edge of technology." Desiring a firm with both top litigation and IP practices, Bernstein joined Debevoise & Plimpton. "Starting at Debevoise was the beginning of my love affair with IP."

TRAILS BLAZED Bernstein likes solving his clients' business problems quickly rather than fighting for years, as IP matters don't tend to drag on and become document morasses. "IP matters tend to be high profile at the business. They don't like their IP to be ripped off or being accused of being an infringer." Bernstein has also done hundreds of domain name arbitrations through the World Intellectual Property Organization. "This topic burst onto the scene in the 1990s, and no one knew how the law was going to develop. We had to find a balance: A trademark cannot be a bludgeon to stop discussion about a brand." Bernstein also worked with the International Trademark Association to help revise the Trademark Dilution Revision Act. "On the wall of my office I have a framed copy with a thank-you note. It was a great opportunity to impact the law."

FUTURE EXPLORATIONS Bernstein expects big changes in the domain name space, as the ability to register dictionary words, such as .Microsoft or .London as domains will have a dramatic impact on the way the Internet operates. "It will also create massive new challenges in how brand names will be protected."

JONATHAN H. BLAVIN

MUNGER TOLLES & OLSON LLP



PIONEER SPIRIT Jonathan Blavin first became interested in the intersection of law, technology and IP as a research assistant at Harvard Law's Berkman Center for Internet and Society. "I got firsthand exposure to some of the issues raised by 'Web 1.0,' such as the unlawful user statements, the Digital Millennium Copyright Act and the Communications Decency Act." After a year clerking, Blavin joined Munger Tolles in 2004.

TRAILS BLAZED Since joining the firm, Blavin has been involved in the "dramatic revolution in tech since the first days of the Internet," including mobile devices, social networking, the Internet of Things and big data. He's seen a shift from IP disputes to different issues and challenges, such as privacy and data security. For example, he represented LinkedIn on a case that raised fundamental issues surrounding balancing civil liberties against the government's need to protect national security. The company wanted to disclose the government's requests for user data in more detail in order to provide more transparency to its users. The government's position was to severely limit what could be disclosed to users and the public. "We filed an action in the Foreign Intelligence Surveillance Court, and the government did eventually voluntarily decide to change its rules."

FUTURE EXPLORATIONS Blavin expects to continue to represent highly innovative companies, and he sees his practice focusing even more on the intersecting areas of IP, data security and privacy. He says that too often laws passed by Congress 20 or 30 years ago are being applied to new technologies. "As technology dramatically evolves, the law has to play catch-up."

Congratulations

We salute all *The National Law Journal's* 2014 Intellectual Property Trailblazers & Pioneers, and we particularly recognize our partner David Kappos for his leadership and achievements in the intellectual property field.

CRAVATH, SWAINE & MOORE LLP



DAVID BROWN

THOMSON REUTERS INTELLECTUAL PROPERTY & SCIENCE

PIONEER SPIRIT Dave Brown started his career in IP in 1988, when he was assigned to manage the USPTO account for Dialog, then a leading online research service. Brown worked closely with its executives to understand their needs and the patent application and prosecution process. He was invited to participate in the USPTO's Patent Examiner's Initial Training as the only non-PTO employee. "I learned firsthand all about the patent examination and prosecution process."

TRAILS BLAZED Throughout his career, Brown has helped companies, law firms and government agencies worldwide to advance innovation and manage and protect IP. "I have had thousands of client interactions over the years, collaborating to develop IP strategies that protect and commercialize intangible assets. These experiences have enabled me to understand how innovation creates competitive advantage and drives commercial success." Brown's career quickly expanded into content development and then general management. Brown was also the visionary behind the Thomson Reuters Top 100 Global Innovators program, based on a series of proprietary, objective metrics that qualify, rank and recognize innovation-based activity. "The Top 100 Global Innovators is referenced by global media and IP leaders as showcasing the important role IP plays in innovation and in connecting IP to financial performance."

FUTURE EXPLORATIONS When Brown started in IP, the field was viewed more as a defensive function relegated to the purview of the legal department. However, "boards and CEOs now understand and strive to capitalize on IP's commercial value." Brown suggests that IP will continue to grow as a financial asset, underscoring the vital role it plays.

GREGORY A. CASTANIAS

JONES DAY



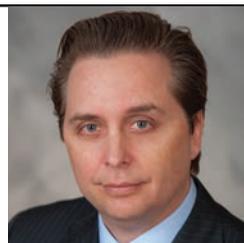
PIONEER SPIRIT With no science or IP background, Greg Castanias joined Jones Day's new Issues and Appeals practice directly after an appellate clerkship, and one of the first big cases he worked on was *Exxon Chemical Patents, Inc. v. The Lubrizol Corporation*. "I was able to help because I did the work necessary to understand the complex chemistry so that I could write and talk about it in simple declarative sentences."

TRAILS BLAZED Most patent appellate cases are heard in the U.S. Court of Appeals for the Federal Circuit, which was created in 1982. Castanias was one of the first to "break into the club" and bring general appellate practice to the Federal Circuit. There are a number of advantages: "Generalists are more like the judges that are deciding the cases, who are not necessarily technical experts. We also understand appellate procedure." Appellate lawyers also tend to write briefs that are more responsive to the way appellate courts work, rather than just attempting to retry a case.

FUTURE EXPLORATIONS After many years without many IP cases, in the last term six of the approximately 70 cases heard by the U.S. Supreme Court were from the Federal Circuit. Most of the reversals have been less favorable overall to IP rights. "It's an attempt to readjust to many years when the Federal Circuit effectively set its own precedents. The Court is communicating that IP law is still subject to Supreme Court jurisprudence and courts must focus on what Congress says in the statute."

YAR R. CHAIKOVSKY

MCDERMOTT WILL & EMERY



PIONEER SPIRIT Yar Chaikovsky's father was an engineer with Hughes Missile Systems, building missiles to be shot at what was then the USSR, which got him interested in technology. He got a B.S. in computer science and engineering and, after a stint at Hughes himself, delved into his interest in patent law at UCLA law school. He almost immediately started working with Baxter Healthcare in a major infringement case against McGaw, Inc. "I wish all associates could have such an opportunity. I saw the case through from preliminary injunction to trial in only about two years."

TRAILS BLAZED As nonpracticing entities built up their businesses in the 2000s, Chaikovsky focused his attention on defending companies such as Yahoo, Twitter, eBay, Amazon and Newegg—some of the most aggressive players in the anti-troll movement. "One strategy we employ is putting pressure on the trolls by fighting and making it clear that we will fight and fight." Newegg and Yahoo, for example, are not getting sued as much anymore because of their success in court.

FUTURE EXPLORATIONS Chaikovsky does not expect to see new anti-troll legislation soon. "We just had the America Invents Act—it took 10 years plus. Legislative reform might be 5+ years away." But Intellectual Ventures is laying people off. A few years ago trolling seemed like a good business model, but NPEs have not had a good record in court. "The key is having clients who are willing to be aggressive and making trolling more expensive with a real risk of loss."

I. NEEL CHATTERJEE

ORRICK, HERRINGTON & SUTCLIFFE LLP



PIONEER SPIRIT Neel Chatterjee first became aware of copyrights while running a radio station at Dartmouth. “We got into a copyright dispute with ASCAP and BMI, and I thought those issues were interesting.” After law school, he wrote a law review article addressing music distribution on the Internet (“whatever ‘the Internet’ meant in 1995”) and clerked for Patricia J. Trumbull in the Northern District of California from 1995 to 1997, where he wrote a number of briefs for IP cases. In 1997 he joined Orrick’s then-new IP practice, where he has been able to address some “important and groundbreaking IP and Internet law questions.”

TRAILS BLAZED At Orrick, Chatterjee has handled a number of high-profile cases. These have included a matter in which Adoption Media did not allow a same-sex couple to advertise on its adoption.com website. “There were all kinds of complex issues on Internet law and gay rights.” He also defended Facebook in the famous Winklevoss case and led the defense of NVIDIA Corporation in a series of patent and antitrust disputes with Rambus, Inc. “I got my name in the paper a lot. It’s not me—it’s the case. But a lot of these cases have been of interest to the media, which adds to the complexity.”

FUTURE EXPLORATIONS Chatterjee expects to see a lot of new laws about patent damages and injunctive relief. He also expects more hostility toward “quasi-software, quasi-business method patents.” Chatterjee is on the lookout for another round of copyright litigation focusing on “interoperability and creative uses of technology.”

Congratulations to the

***National Law Journal’s* Top 50 IP Trailblazers & Pioneers!**



CHRIS OTTENWELLER
cottenweller@orrick.com



NEEL CHATTERJEE
nchatterjee@orrick.com

Orrick congratulates Silicon Valley partners Chris Ottenweller and Neel Chatterjee for being recognized among *The National Law Journal’s* Top 50 IP Trailblazers & Pioneers. Orrick salutes your proven track record and dedication to client success.



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LEE CHENG

NEWEGG



PIONEER SPIRIT Soon after Lee Cheng became general counsel at online retailer Newegg in 2005—after stints at three major law firms and two startups—it was targeted by nonpracticing entities. “The truth is I’m not a patent lawyer. I’m not an IP litigator. I became one because I had to.” The NPEs were suing based on common concepts such as menus and cash registers. “I knew from my days at startups that those patents were junk, but they were threatening our core business model.” He also knew that they would be serially targeted and vowed to not follow the same settlement strategies as other retailers.

TRAILS BLAZED Cheng was confident that if Newegg could cost-effectively defend itself there would be an astounding ROI because the suits would dry up. “All we had to do was what the herd didn’t do, which was fight.” Cheng’s strategy is to get to the appeal stage at the lowest possible cost and with a jury award of less than what he’s accrued. “Trial court can be crapshoot, but we are confident we can win on appeal.” The results have been good and established a reputation that Newegg is a company not to sue. It has also started seeking fee awards in cases it wins in order to send a message: “If you come after Newegg seeking an ‘extortion settlement,’ you’re going to lose money.”

FUTURE EXPLORATIONS Under Cheng’s direction, Newegg is building a recoveries practice to pursue claims on behalf of the company, for example by making sure the company participates in any actions for which it is eligible, sometimes opting out to maximize the benefit. “We became a profit center for Newegg last year.”

MORGAN CHU

IRELL & MANELLA



PIONEER SPIRIT Morgan Chu had been practicing law for one year when a client insisted he take over a patent case as lead counsel. The case went to trial, and he was successful. Chu’s practice grew as he became known as an expert in software patents. “As software became more important commercially, people started to see the value in protecting it.”

TRAILS BLAZED In the first software patent case ever to go to trial, *Candle Corporation v. Boole & Babbage, Inc.*, Chu was successful in invalidating Boole & Babbage’s patent on behalf of alleged infringer Candle Corp. Later, Chu secured a verdict—and a permanent injunction—for Stac Electronics in a patent infringement case against Microsoft Corp. “The cumulative profits of Stac at that point were only \$8 million. We took this to trial in less than a year and secured a \$120 million verdict.”

FUTURE EXPLORATIONS Chu believes that we must focus on “our delicate innovation ecosystem.” The United States has always recognized the importance of patents ever since becoming the leader in technology back in the 1800s. “This ecosystem includes the world’s greatest universities, a capital system that allows people to invest in risk and a world-class patent system that balances innovation against competition.” The current debate in Congress is between those who want to strengthen and those who want to weaken patents, but “the most important thing is that we protect the delicate ecosystem that has performed well for 200 years.” Chu thinks it will continue to be the powerhouse for the future.

BILL COUGHLIN

FORD GLOBAL TECHNOLOGIES



PIONEER SPIRIT With a degree in electrical engineering and his JD, Bill Coughlin joined Harness Dickey, the biggest IP firm in Michigan, and made partner in four years. Ultimately, he was the youngest managing partner they had ever had. After a few years, he took the chief trademark counsel job at Chrysler and became chief IP counsel a year later. "I was the second Chrysler person sent to Stuttgart after the merger with Daimler." He came back and got a job with Ford, which "attracts people trying to build a better world."

TRAILS BLAZED As CEO of Ford Global Technologies, Coughlin can provide seed funding for projects that would be difficult to get started immediately otherwise. "We are able to provide nimbleness to the innovation process at Ford." For example, he read about San Jose's TechShop, which allows members open access to tools and equipment, and convinced them to open in Detroit. "Since then, we have doubled the number of inventions. Last year we set all-time records for patents applied for, awarded and patent revenue. All while cutting processing time in half." Coughlin also helped bring to life Ford's Open Source Software (Open SC) and led the acquisition of local software development startup Livio. He was named "Entrepreneur of the Year" by Michigan-based technology business association Automation Alley in 2013.

FUTURE EXPLORATIONS Coughlin says Ford is reinventing urban mobility. "Henry Ford's vision was to open the highways for all. In urban areas, this is an increasing problem." Coughlin sees an opportunity to reinvent all that. "I feel like a kid in a candy store."

ELIZABETH ELTING

TRANSPERFECT TRANSLATIONS INTERNATIONAL, INC.



PIONEER SPIRIT Liz Elting has loved languages ever since she can remember. She lived, studied and worked in five different countries and landed a job in the translation industry. After a few years in production and sales, "I saw a gap in the industry as far as quality and service." After receiving her MBA in 1992 and with "globalization coming," she launched TransPerfect. In the first several years, most work was for law firms; legal became a specialty. "We realized that IP was a necessary offering to serve law firms."

TRAILS BLAZED TransPerfect created the TransPerfect Linguist Certification (TLC) Program, which has since become the industry standard for linguist certification. Before a project is assigned to a particular translator, that individual must qualify by taking one or more of over 80 subject-specific tests. Since patents can be quite technical, in addition to a general patent test, there are several subject-specific patent tests, including for automotive patents, chemical patents, engineering patents, IT patents, pharmaceutical patents and semiconductor patents. TransPerfect's IP-related business has experienced 1,000 percent growth over the past 10 years.

FUTURE EXPLORATIONS Elting points out that as business has become more global the legal industry supports that. "Our clients expect things faster, and they expect technology to be incorporated."

RANDAL L. GAINER

BAKERHOSTETLER



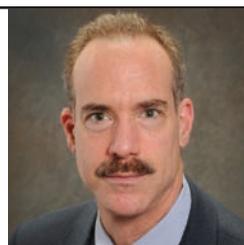
PIONEER SPIRIT In 1995, while working as a litigator focused on contract disputes related to software, Randy Gainer wrote an article on the risk of fraud for credit card holders on the Internet. "It was clear that cards were going to be the Internet's payment mechanism of choice, and it just seemed obvious that there was going to be a fraud problem." By the mid-2000s, Gainer had undertaken more proactive work with clients to strengthen data security, much of which was put in place to prevent theft of IP.

TRAILS BLAZED After doing several such risk assessments, Gainer got accredited as a Certified Information Systems Security Professional (CISSP), which provided him a platform to encourage people to take security seriously and improve their data security posture. "One of the primary targets of state-sponsored hackers is IP; they steal from Western companies in order to move ahead. There are also others who sell it on the black market."

FUTURE EXPLORATIONS Gainer says that the challenge for U.S. and European companies is that it is going to take several years of work from commercial organizations, nonprofits and governments to improve security enough to keep people out. "The criminals' skill level is often quite high, but it doesn't even need to be because security is weak." The good news, according to Gainer, is that improvements can be made: The best organizations have substantially shored up their security. "It takes attention and budgeting, but it's being recognized as something that must be done."

MATTHEW GOODWIN

UNILEVER



PIONEER SPIRIT Matt Goodwin took a classic route for a patent attorney: He has a degree in chemical engineering and worked as a process engineer for five years before going to law school. "As a patent attorney, you are at the forefront of technology and science." He has focused his career in the corporate setting, where "you have the opportunity to partner with the scientists, engineers and business leaders." He started at Dow Chemical and was with Johnson & Johnson for 17 years.

TRAILS BLAZED Goodwin started working for Unilever in 2009. "When I joined the company, all the patent files were paper." With the patent group split between the United States, Europe and a planned Shanghai office, the operating situation was unsustainable and unreliable. Over the last several years, Goodwin has led the transformation to an entirely digital, cloud-based approach. "When we launched in Shanghai, we could access patent files immediately from anywhere in the world." Unilever had to transfer more than 20,000 live patent cases, plus another approximately 5,000 design registrations and design patents.

FUTURE EXPLORATIONS Goodwin says that IP will continue to be critical for economic prosperity and the America Invents Act is the most significant change in the past 50 years. He anticipates a Unified Patent Court in Europe, and Chinese companies are starting to think about monetization of their IP as they seek to become a powerhouse. "The doctrines and interpretation will evolve over the next decade and longer, which represents an opportunity for developing attorneys to leave a mark."



FRANCIS GURRY

WORLD INTELLECTUAL PROPERTY ORGANIZATION

PIONEER SPIRIT Francis Gurry was working toward a Ph.D. at Cambridge; his dissertation was on the “legal and economic impact of trade secret protection.” He then went back to Australia and taught and practiced law until in 1985 he was hired by WIPO. “At that time, IP was a relatively obscure specialization. Since then it’s been on a journey from the periphery to the center of the economic system.”

TRAILS BLAZED Gurry has worked in a variety of positions at WIPO, including as legal counsel for arbitration and mediation, where in 1994 he established the organization’s Arbitration and Mediation Center. The center administers the uniform Internet procedure for domain names, as designed by WIPO and adopted by ICANN. “It now handles more than 2,800 domain name disputes per year.” Gurry was named director general in 2008 and recently helped finalize two major international treaties: the Beijing Treaty on Audiovisual Performances in 2012 and the Marrakesh Treaty in 2013, which improves access to published works for the visually impaired. “We needed to address the so-called ‘book famine,’ where 250 million visually impaired people only had access to 5 percent of the world’s printed materials.”

FUTURE EXPLORATIONS Gurry believe that IP will only become more important economically and therefore more contentious politically. Also, China is already the world’s second-largest investor in research and development and third-largest filer of international patents. It is following a strategy from “Made in China” to “Created in China.” Gurry expects economic competition will be fiercer, but with “China’s rise we will finally bridge the divide between developed and developing countries.”



MELISSA HARRUP

MONDELÉZ INTERNATIONAL

PIONEER SPIRIT Melissa Harrup grew up in Australia, Malaysia and the U.S. She studied biology and art at Grinnell College in Iowa before returning to Melbourne for law school. “Law school allowed me to weave my interest in both disciplines.” Harrup worked on two high-profile IP cases during her first year in private practice, including a trademark case over Cadbury’s color purple. In 2003 she was recruited by Cadbury Schweppes and relocated to Singapore to set up the company’s legal team in Southeast Asia and China.

TRAILS BLAZED Propelled by having “embraced a moment when fear and opportunity collided,” Harrup held a number of different positions during her time in Singapore, straddling corporate and IP law. “Eight years in Asia Pacific provided the opportunity to study cross-cultural communications. You could see where cultural differences were creating unique challenges in transactions. In law school, we are taught to be advocates, but sometimes it’s better to be quiet and listen.” This lesson proved valuable when she became chief counsel, global trademarks for the newly created Mondelēz International in 2012. “The trademark team had been assembled over time through different acquisitions.” To achieve organizational efficiencies, Harrup reorganized the department, and with her global team established centers of excellence and consolidated five different databases into one “in record time and under budget.”

FUTURE EXPLORATIONS Harrup sees that the legal and IP functions in all industries are under constant cost and service-delivery pressures. “To keep ahead of the curve, it is critical to foster an environment where team members can be agile change agents with enough mental space and confidence to encourage divergent thinking.”

DAVID L. HAYES

FENWICK & WEST LLP



PIONEER SPIRIT As a master's student in engineering, David Hayes became aware of a key question about whether compiled software code could be copyrighted or if it was part of the machine. "I realized this issue was being litigated by lawyers who didn't understand the technology and engineers who were not familiar with the legal system. When I went to law school, there were maybe two out of 500 with technical backgrounds. I was one of the earliest members of a generation of lawyers who called themselves 'computer lawyers.'"

TRAILS BLAZED Hayes led the way as the law tried to catch up with innovation. For example, in the early days, software could be protected as trade secrets, because it ran on enterprise systems and there needed to be a way to license by the millions. Hayes helped develop the "shrink-wrap license," which basically deemed consumers as agreeing to the terms by simply opening the package. "No one knew if it was enforceable, but everyone started using them and they were eventually upheld." Hayes later applied the concept to the Internet with so-called "browse-wrap" agreements, where users can click to indicate acceptance. Hayes has been on the cutting edge of user interfaces, open source software and other copyright issues related to digital media. "I've always tried to understand both the legal issues and the technology pushing the law."

FUTURE EXPLORATIONS Hayes sees technology pushing new issues around increased exposure of online information, privacy issues, virtual currencies and cross-border law questions. "How do you protect IP rights when information can move throughout the world at the speed of light and be in all countries simultaneously?"

DAVID J. KAPPOS

CRAVATH, SWAINE & MOORE LLP



PIONEER SPIRIT In 1983, David Kappos' then newly minted lawyer brother-in-law suggested that the new Court of Appeals for the Federal Circuit would cause a resurgence of the patent system. An engineer at IBM, Kappos went to law school full-time, but after each semester he worked part-time as an engineer and part-time in the legal or patent department. Following law school, he stayed with IBM and worked as an attorney in San Jose, Tokyo and New York before becoming chief IP lawyer in 2003. In 2009 he left IBM to become director of the USPTO.

TRAILS BLAZED IBM was the world leader in patents and licensing during Kappos' entire stint there. "A highlight was obtaining, licensing and finding progressive ways to use patents so we could gain value from our IP portfolio." During his tenure, IBM also made the first "patent pledge," where it promised the free use of 500 of its patents toward the development of open source software. When Kappos arrived at the USPTO—a \$3 billion agency with about 10,000 employees—it ranked low among places to work in the Federal Employee Viewpoint Survey. In 2012, it was in the top five. During the interim, Kappos led the agency through implementation of the America Invents Act, "the biggest change in many decades," and engineered the first major international treaty on copyright in a generation. In 2013, Kappos entered private practice at Cravath.

FUTURE EXPLORATIONS "We went through the industrial age and the information technology age. We are now in the innovation age." He says that the legal system that incentivizes, carries and protects innovation is the IP system. "We need to be positioned where law intersects with innovation."



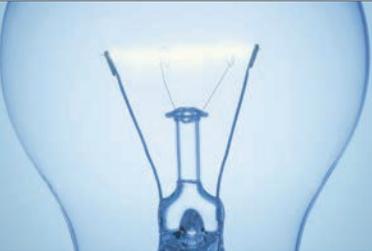
MARK J. ITRI

MCDERMOTT WILL & EMERY

PIONEER SPIRIT Mark Itri was an engineer at Sperry in Phoenix, when it was bought by Honeywell, “who had a reputation for firing older engineers.” He left for law school, where an upperclassman advised him to become a patent attorney; there was high demand and he’d get paid more as an engineer. “Everything he told me happened.” Itri stayed at an IP boutique for a dozen years and made partner, but ultimately wanted something more entrepreneurial. He moved to McDermott Will & Emery in 2002 to help it build its IP practice on the West Coast.

TRAILS BLAZED By 2012, the practice had grown to more than \$17 million per year, all in transactional work. “In this type of work, clients expect fixed budgets, fixed fees and not-to-exceed figures. Our clients are telling us what they’ll pay. They are in the driver’s seat.” Itri worked with the firm’s IT team to develop Quantum Tracker, which automatically notifies the billing attorney as certain thresholds of the budget are reached, ultimately not allowing the entry of more time. “The last thing a client wants is to be surprised because you’ve blown the budget.”

FUTURE EXPLORATIONS Itri believes that it’s increasingly important to think outside the box and use technology to be more efficient, proactive and transparent. He is working on an application that will provide more insight into what different types of matters cost and another that will flag issues for clients early on. “We already work hard enough. This is about working smarter.”



Congratulations.

McDermott Will & Emery congratulates Mark Itri, Yar Chaikovsky and their fellow Intellectual Property 2014 Trailblazers & Pioneers, as noted by *The National Law Journal*.

McDermott has one of the largest concentrations of patent, trademark and copyright prosecution, licensing and litigation services worldwide. The Firm understands that technological innovation and name recognition are fundamentals to succeed in the competitive global marketplace, and it has taken the lead in offering comprehensive, cross-border intellectual property services to clients.

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SUSAN M. KAYSER

JONES DAY



PIONEER SPIRIT Susan Kayser started as a general commercial litigator. In some of her cases, when she asked herself “what are they really fighting about here?” she realized it was often the trademark. “Brands have power.” She worked at a number of firms before joining Jones Day in 2011, where she does a lot of work for brand owners, both in litigation and transactions. “The real value for many companies is their trademark.”

TRAILS BLAZED Since the 2010 *Tiffany Inc. v. eBay, Inc.* decision, it has been considered necessary to show that an online marketplace had knowledge of trademark infringement in order to earn a judgment against it, and the way to show this was to send the site a notice and takedown request—the evidence they had knowledge was the fact that the trademark holder informed them. Kayser broke new ground in *Chloe SAS et al. v. Sawabeh Information Services Co.* by instead running a yearlong undercover investigation to show that Sawabeh knew about the counterfeiting taking place on its TradeKey marketplace. “We had our investigator sign up and tell them he was intending to sell counterfeits, and the rep told him, ‘TradeKey is one of the few sites that still allow replicas.’” The investigation continued in order to show the problem was endemic, and ultimately the judge entered a summary judgment against Sawabeh.

FUTURE EXPLORATIONS Kayser believes that to fight counterfeiting, consumer attitudes must change. She is working with the International Trademark Association to educate teens that “knowingly buying counterfeits really is theft.”

MICHELLE K. LEE

UNITED STATES PATENT AND TRADEMARK OFFICE



PIONEER SPIRIT Michelle Lee never thought she’d be a lawyer. Born and raised in Silicon Valley “where every dad on the street is an engineer,” Lee went to MIT, but ended up fascinated by some of the issues that came out in the copyright infringement battles between Apple and Microsoft. “I saw some complicated and new legal issues and realized that a lawyer who understood technology could be really valuable.” Instead of pursuing her Ph.D. in computer science, she enrolled in Stanford Law School.

TRAILS BLAZED After clerking for judges in both U.S. District Court and the U.S. Court of Appeals for the Federal Circuit, Lee represented a number of individual investors and technology companies before being recruited to be the first head of patents and patent strategy at Google. “We had only a few patents, but by the time I left, we held more than 10,000.” In 2012, Lee moved on to launch the USPTO’s new Silicon Valley office. “The opportunity to build something from scratch that will have a lasting impact was attractive. The region is critical to the U.S. economy, and the office provides an advantage.” In early 2014, she became deputy director of the USPTO in Washington, D.C.

FUTURE EXPLORATIONS “The importance of IP to innovation will continue to grow as the economy continues to rely more on intangible assets.” Lee also expects to see greater harmonization of laws worldwide, which she says is a priority for the secretary of commerce. “IP is more international and more important, so we must provide greater transparency and quality in order to meet the needs of those who innovate.”

DOMENIC A. LEO

ITIP PROFICIENCY



PIONEER SPIRIT Dom Leo was bored working in-house at a bank, when he answered an ad for “an attorney who was knowledgeable in software and technology.” The job was at Master Data Center. “I was brought in to help them better connect with their clients; to help them understand what they wanted and deliver these messages to the development team.” After almost two decades at MDC, Leo assisted DataCert in building its IP e-billing business and in 2012 joined entrepreneur Tom Quinn at ITIP, a patent cost management service.

TRAILS BLAZED When Leo started, he was 29 years old and going to IP conferences by himself. “I was one of the first attorneys to work for a vendor as a subject-matter expert. I had to go out, network, gain trust and understand our clients’ needs to figure out what we could commercialize.” While at DataCert, Leo spent two years leading a subcommittee to develop the first IP code set under the Uniform Task-Based Management System. “That helped solidify the market for the electronic billing of IP work by allowing measurables into a service business.” At ITIP, Leo focuses on ways to bring normalization and efficiencies to the patent annuity process. “All along the way, I’ve dedicated my career to developing solutions and tools to reduce costs and find a method to derive greater benefit from the services and software.”

FUTURE EXPLORATIONS Leo sees an opportunity in increased transparency in cost and process, and that those that add efficiency to the patents and trademarks process will succeed. “IP counsel must be more efficient—and prove it—because firms like ITIP are the wave of the future.”

ALLEN LO

GOOGLE



PIONEER SPIRIT During his senior year as an engineering student at Ohio State, Allen Lo’s father suggested some alternative careers and introduced him to a patent attorney, who recommended he become a patent examiner at the USPTO, go to school at night and then go to work for a patent law firm. Lo started as an examiner, but halfway through law school he left for Finnegan Henderson in Washington, D.C., where he stayed after graduation. He volunteered in 1997 to help open the firm’s California office, “which satisfied my interest in building something.” In 2000, he moved in-house at Juniper Networks and in 2012 shifted over to lead the patent team at Google.

TRAILS BLAZED At Google, Lo’s team manages 50,000 patent assets, defends against patent trolls, negotiates licenses, drives patent reform and more. “We try to provide some value and follow a common agenda.” Lo has also led a new collaborative initiative to defend against trolls, called License on Transfer. The nine companies in the LOT network have agreed that if they sell off their patents, all other members automatically get a license, so each is protected from any infringement claims by the buyer. “Our members range from large to small and are in diverse businesses and geographies. We try to find the right balance.”

FUTURE EXPLORATIONS Lo sees a sharp increase in the level of discourse and awareness around how well the patent system is working to promote innovation. “What is generally believed is that the patent system is working well in some places, but not in others. Industry really has a responsibility to make sure the patent system works for all types of stakeholders.”

JAMES E. MALACKOWSKI

OCEAN TOMO, LLC



PIONEER SPIRIT Jim Malackowski had planned to go to law school but ended up joining a litigation accounting firm instead—on the day they got their first patent infringement damages case. “I volunteered simply because the alternative would have meant six months away from home. Then they kept coming to me, and I’ve spent my whole career in IP valuation and strategy.”

TRAILS BLAZED After a few years of dispute accounting, Malackowski was asked to appraise a patent for a transaction, which wasn’t the focus of the firm. “So at age 25 I started the country’s (if not the world’s) first IP appraisal and valuation firm, IPC Group.” IPC grew to 300 professionals in 11 years. After selling out and a stint in private equity, he formed Ocean Tomo as a merchant bank in 2003. “If you think of all the large banking firms today, such as Goldman Sachs or Morgan Stanley, they all started as a specialist in finance around a given asset. We started Ocean Tomo around IP as the asset class.” Some of the company’s innovations include being the first IP auction marketplace (IPXI) and building an international ratings platform on the quality of patents in the United States and Europe.

FUTURE EXPLORATIONS Malackowski sees maturity and global reach for his field. He envisions a truly global marketplace for IP, with IPXI as the cornerstone. “We also look at the 90 percent of people who live on \$5 a day, and we are focusing on developing the market for humanitarian technology transfer to help the less advantaged.”

FLOYD A. MANDELL

KATTEN MUCHIN ROSENMAN LLP



PIONEER SPIRIT Floyd Mandell finished law school and took an associate position at a trademark/copyright litigation boutique firm. When he moved to Katten three years later, he was the only attorney at the firm who had any IP litigation experience. He did some trademark work for Sears (and affiliates Allstate and Coldwell Banker) and other clients, including a lawsuit protecting the name of the once-popular music group, the Buckingham.

TRAILS BLAZED Mandell was one of the early leaders in defending celebrities against cybersquatters, who would grab domain names before trademark owners could. “The key interest is not just protecting the trademark owners; it’s also ensuring that the public is not being confused or deceived.” Mandell has also pioneered the use of mediation in trademark cases. “In most trials, you have a winner and a loser, but in trademark cases, oftentimes there is a resolution where one side doesn’t necessarily win or lose. I say, ‘Give peace a chance.’”

FUTURE EXPLORATIONS Mandell expects that top lawyers will continue to be in high demand because “it is so important to every business; it always was, and it always will be.” He also believes that “the world will continue to get smaller through the globalization of the economy, and IP law will be more and more important to protect global businesses and to protect consumers from confusion or deception.”

MIKA MAYER

MORRISON & FOERSTER LLP



PIONEER SPIRIT Mika Mayer first learned about patents as a child, when she tried to invent a travel toothbrush and, “being from Ohio,” pitched the idea to Procter & Gamble. “They sent back a letter with a blue slip, which I assumed was a check for a billion dollars. Instead it was a coupon, and the letter said they wouldn’t talk to me unless I had a patent attorney.” During a college internship at Motorola, Mayer met one of the patent lawyers. “I quickly realized this was a great job for someone who likes to be on the cutting edge but also likes discrete projects.” She went to law school and joined Morrison & Foerster in 2002.

TRAILS BLAZED One of her mentors at the firm was frequently approached by venture capitalists to ask what he thought about certain investments; he often brought Mayer in to do the work. “At that time, IP due diligence wasn’t very sophisticated; it was more like box checking. We did a serious analysis of the market, regulatory, management and product risks.” Mayer now leads the firm’s Venture Intellectual Property Group (VIP). Her team collaborates well and then presents its results from a business perspective. “Lawyers hate to be asked ‘if it were you’ or ‘on a scale of one to ten...’ but that’s what investors want.”

FUTURE EXPLORATIONS Mayer is seeing a convergence between life sciences and technology. “Right now, more 80 percent of our IP due diligence is focused there.” She believes that, as a result, practitioners will have to push their boundaries to know all the law. “Life sciences lawyers never needed to really understand software patents. But now there are implications in that area.”

MICHAEL J. MCKEON

FISH & RICHARDSON P.C.



PIONEER SPIRIT Mike McKeon studied engineering at the University of Connecticut, even spending a summer at a submarine facility in Groton before seeking “a more self-defining career path.” When he graduated, he went to work as a patent examiner at the USPTO while going to law school at night. One of his first cases—and infringement suit between an American brake manufacturer and a German company—was heard at the U.S. International Trade Commission. The ITC has been a focus of his practice ever since.

TRAILS BLAZED McKeon has handled more than 30 ITC cases, often with billions of dollars in commerce at risk. “The ITC is fast, but the stakes are high.” Should a company be found to be infringing, the ITC will issue an “exclusion order” to bar it from bringing the item into the country, enforced by U.S. Customs and Border Protection. “If you are on the losing side, it can really cripple your business and mess up your supply chain.” Despite the high stakes, the number of cases heard by the ITC is growing. “In the 1990s there were maybe 10 cases a year; now there are more than 70.”

FUTURE EXPLORATIONS McKeon is a little concerned about growing anti-patent sentiment, some of which has been generated by nonpracticing entities. He believes it may go so far as to weaken the patent system. “It’s bad for the U.S. economy and for innovation.”

SCOTT A. MCKEOWN

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, L.L.P.



PIONEER SPIRIT After he got out of engineering school, Scott McKeown got a job in Atlantic City investigating cheating at slot machines and making sure the games were in compliance, “meaning random and fair.” When one of the machine manufacturers added high-quality sound but was sued for patent infringement, “I saw the power of patents.” He went to law school at night and worked at some law firms as a tech advisor and then as a patent agent. In 2001 he joined Oblon Spivak.

TRAILS BLAZED By 2005, McKeown was seeing nonpracticing entities in action. “You could look at the prosecution history of their patents and know that they were not as broad as they claimed, but it was expensive and risky to litigate.” McKeown ended up exclusively working in this inter partes review, and “when the America Invents Act was proposed, I knew that if it passed it would be a game changer.” He positioned himself as a specialist by becoming chair of the ABA Intellectual Property Law Section Committee 104 (Post Grant USPTO Proceedings) and starting the firm’s *Patents Post-Grant* blog. “The NPE business model has been seriously eroded, especially if you have business method patents.”

FUTURE EXPLORATIONS The future in this area depends on the USPTO. There will definitely be growing pains. “The new process was devised as anti-troll, but there are some real technology companies whose patents are getting thrown out.” The Patent Trial and Appeal Board is trying to come up with a balance. “Early on it was being called a ‘death squad,’ but as long as it continues, it will be a significant mover going forward.”

OBLON SPIVAK PTAB Trailblazers

OBLON SPIVAK’S Post-Grant Patent Practice handles all aspects of USPTO post issuance proceedings, including practice before the Patent Trial & Appeal Board (PTAB), and appeals to the Court of Appeals for the Federal Circuit (CAFC). Oblon Spivak’s post-grant practitioners are some of the most experienced in the country and the group has settled more IPR proceedings than most other firms have filed.



Congratulations

SCOTT MCKEOWN

on being named to

National Law Journal’s Top 50 Intellectual Property Trailblazers and Pioneers

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MATTHEW JOHN MOORE

LATHAM & WATKINS LLP



PIONEER SPIRIT Matt Moore was a lacrosse player at Syracuse University, where he won three national championships and earned a degree in electrical engineering. After a stint as manager of software development at General Electric, he went back to law school and became an IP lawyer. "I'm a competitive guy; IP litigation provides me with the thrill of competition. Connecting with a jury or nailing an oral argument is like scoring a winning goal."

TRAILS BLAZED Moore was the first to use Section 101 of the U.S. Patent Act to get cases dismissed. "Great trial wins are the thrill of the job, but clients are best served if you can get them out of cases early." Section 101 deals with whether patents cover patentable subject matter. He saw that some patents for abstract concepts could be thrown out as a legal issue. "I thought the judges would be interested because it would be dispositive of the entire case, and clients would be happy because a motion to dismiss is granted before discovery—with all its expense—begins." Moore has used this approach repeatedly since 2010, including in *Intellectual Ventures LLC et al. v. Capital One*, the first significant win against Intellectual Ventures.

FUTURE EXPLORATIONS Moore believes that the world economy is driven by innovation. Protecting and defending IP are increasingly important, but efficiency is required. "In the future even the top firms will have to do so more efficiently. Project management will be a top priority."

JASON MUDD

ERISE IP P.A.



PIONEER SPIRIT Soon after receiving his B.S., Jason Mudd decided engineering wasn't for him and, thinking back on his high school debating days, saw that "law school was the natural fit. And IP law was appealing because it allowed me to combine my interests in science, technology and the law." He practiced patent litigation at a large litigation firm and in 2012 helped to found patent boutique Erise IP.

TRAILS BLAZED Mudd represented GPS technology provider Garmin in the first-ever inter partes review before the Patent Trial and Appeal Board, which provides for a hearing before three administrative patent judges skilled in the law and technology. "We believed it would be a very thorough and fair process to challenge the validity of a patent." The Garmin matter was the first to be filed, among the first to be instituted and the first to go to oral argument. "It was a packed house. A highlight of my professional career." The result was a favorable claim construction ruling with all claims under review being held invalid.

FUTURE EXPLORATIONS Mudd thinks the new IPR and covered business method review processes will be integral to patent litigation going forward. "Defendants will likely continue to focus their invalidity challenges in the patent office rather than district courts because of the speed and lower cost. I think it's been a positive development for the patent system."

NATHAN MYHRVOLD

INTELLECTUAL VENTURES



PIONEER SPIRIT When Microsoft purchased his startup, Dynamical Systems, in 1986, neither company held any patents to speak of. Microsoft had two patent applications. As he began to realize the importance of doing more advanced R&D for Microsoft's future, the more consistently he began to push for IP protection. "I knew the 'spark' of invention—going from nothing to something—held the highest concentration of value." After retiring from Microsoft in 2000, Myhrvold founded Intellectual Ventures, which invests in patents and generates revenue by licensing its portfolio, launching spin-off companies, divesting assets and participating in joint ventures.

TRAILS BLAZED Myhrvold founded Intellectual Ventures because he saw patents as a vastly underdeveloped market, starved for private capital and too dependent on federal financing for universities and government agencies. "As an inventor myself, I was convinced we could find a more efficient way to create high-quality inventions." He structured Intellectual Ventures to be a scalable invention company not dependent on any one person, any one idea or any one product. "We believe today's complex problems can best be solved by getting brilliant people from different disciplines together to tackle problems in a systematic fashion."

FUTURE EXPLORATIONS While he is optimistic when it comes to technology's ability to solve the world's biggest problems, Myhrvold feels that we need to embrace the risk that accompanies such reward. "Like Thomas Edison said, 'I have not failed. I've just found 10,000 ways that won't work.' Inventors need to get comfortable with that risk, just as investors do."

CHARLES B. ORTNER

PROSKAUER ROSE LLP



PIONEER SPIRIT After studying to be a molecular biologist, Chuck Ortner became a lawyer to "save the world" during the civil rights era. That did not work out, but Ortner's love of music and background in science led to his bridging both worlds. Recognizing that innovators share many attributes, Ortner has represented technology companies such as Grumman Aerospace, many of the most successful recording artists, including Lady Gaga, U2, Madonna and Michael Jackson, every major record company and music publisher and the Grammy organization. He also serves as a trustee of the Kennedy Center in Washington.

TRAILS BLAZED Ortner's experience in technology and music came to bear in a copyright case against LL Cool J. "A kid from the neighborhood claimed that he recorded an album in LL's basement, gave a copy of the tape to LL who, in turn, gave it to Def Jam Recordings which released it as LL Cool J's first album, *Radio*." Ortner knew from his tech work that a code number on the purported "original" tape likely tied to its manufacture date, and he proved at trial that the tape itself was manufactured four months after the album had been released and was simply a copy of the commercially released album. Ortner's success has often come from combining knowledge of copyright law, technical expertise and a litigator's doggedness.

FUTURE EXPLORATIONS Ortner says that piracy remains a big threat to the economic survival of the music, motion picture and broadcast industries. "How do you protect IP without stifling innovation? We need to find an acceptable balance between the rights of creators of content and the technology world."

CHRIS R. OTTENWELLER

ORRICK, HERRINGTON & SUTCLIFFE LLP



PIONEER SPIRIT Chris Ottenweller moved to Silicon Valley in the early 1980s and almost immediately started working for many of the pioneers: Intel, Apple, Sun, etc. “By the 1990s, we saw a great proliferation of filings by patent trolls.” He had some early success in that area and still holds an unbeaten record against nonpracticing entities in court.

TRAILS BLAZED Ottenweller has developed a number of strategies to fight back against NPEs. For example, many NPEs buy their patents from other entities, and these companies often keep an interest to share in the expected recoveries. Sometimes those strings allow for a defect in the NPE’s standing. In another example, in one matter it was found that the individual who applied for the patents excluded his co-workers for the filing. “We challenged the validity of the patents in the Eastern District of Texas and won.” One of the more effective weapons is seeking sanctions and fees against the NPE’s law firm after securing victory. In one case, Ottenweller got more than \$1 million and put the NPE into bankruptcy. Having clients willing to take a stand is critical. “If your client is not willing to fight, then the lawyers do not have the opportunity to use their entire arsenal.”

FUTURE EXPLORATIONS Ottenweller believes there is too much patent litigation in the United States, and not just from NPEs. “Legal developments will make it more difficult to get patents and pursue the enforcement of patents; many should not have been granted in the first place.” He is also hopeful that it will become easier for courts to spot merits quickly and expects to see further use of attorney fee awards against those who file baseless suits.

GORDON PETRASH

GPPIAM



PIONEER SPIRIT As an R&D director for Dow Chemical in the 1980s and 1990s, Gordon Petrash helped develop a regimented method for intellectual asset management. “We treated it like a portfolio. We were getting licenses and royalties and suing people.” Dow saw the value and tapped Petrash to build a program companywide. “At the time patents were not really valued very highly and not looked at by legal systems as very strong.”

TRAILS BLAZED Petrash developed a process across more than 20 business units, managing more than 20,000 patents and untold trade secrets. “We saved the company tens of millions in renewal fees and also helped it realize more than \$100 million in value over 10 years.” By 1994, Dow and Petrash had gained some prominence, including a cover feature in *Fortune* magazine in 1994. “Over next 5 to 10 years many companies realized that IAM was a big part of corporate strategy.” In 1998, Petrash left Dow to build an IAM consulting practice at PwC Consulting, before stints in-house at IBM spin-off Delphion and Cargill. In 2011 he opened his own consulting shop, GPPIAM.

FUTURE EXPLORATIONS “Today’s litigious environment takes a toll, and governments are still developing their rules about patents. The rules are changing, and it’s going to be a moving target.” Petrash expects companies to get more cooperative and pool more resources. “It will happen by necessity. Any successful patent is going to get litigated. Anything that valuable is going to have some claims. But these pools could help manage that.”

MARSHALL PHELPS

ARTICLE ONE PARTNERS AND IPCREATE INC.



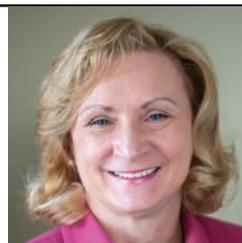
PIONEER SPIRIT Working for IBM in the early 1980s, Marshall Phelps was sent to Japan to help run IBM Asia. When he got there, he saw Japanese computer manufacturers “basically copying IBM’s operating system for their mainframes, then competing with IBM. The importance of nonphysical assets started to dawn on me.” A few years later, Phelps became a vice president at IBM, helping to manage and monetize its IP. “We got very good at it, making more than \$2 billion annually in the 1990s.”

TRAILS BLAZED After a stint as a venture capitalist, Phelps joined Microsoft, not so much to monetize its portfolio as to build relationships with other companies. He helped the company build a world-class portfolio and leverage it to build relationships with other companies through joint ventures, joint licensing agreements, etc. “I’m a big believer in making your IP strategy serve your business—not be the business.” Since leaving Microsoft, he’s started and worked with a number of IP-related companies, including Article One Partners, which crowdsources patent research using 35,000 external sources in 11 languages.

FUTURE EXPLORATIONS Phelps argues that in many cases no one does the work to find out if an invention is really novel, which causes massive problems. “We cannot allow patents to be issued that shouldn’t be or misused by people who assert them blindly because patent-holders can’t afford to argue.” He is hopeful that patent quality can be improved. “Poor-quality patents in the wrong hands are a bloody disaster. It’s an existential risk.”

TERESA “TERRY” STANEK REA

CROWELL & MORING LLP AND C&M INTERNATIONAL, LTD.



PIONEER SPIRIT Terry Rea was working as a pharmacist when she decided to go to law school at night, “except for one year when I worked midnights in a hospital so I could go during the day.” The hard-core science required for patent law appealed to her. “As a patent attorney, you get to be on the cutting edge, without having to stay in the lab.” After law school, she went in-house at specialty chemical company Ethyl Corp. She later moved to Washington, D.C., eventually landing at Crowell & Moring. In 2011 she left the firm to serve as acting and deputy director of the USPTO, returning in 2013.

TRAILS BLAZED Rea was the senior official responsible for the Obama administration’s formulation and implementation of the America Invents Act. “We consulted with Congress to make sure we could do what was necessary.” Some aspects needed implementation within one year, which required a huge surge of rulemaking. “I was able to offer the PTO the outside practitioner’s perspective. I understood how corporations, risk officers and law firms look at things.”

FUTURE EXPLORATIONS Rea believes that IP will continue to be an essential component of the economy for every country in the world. “We will see more countries looking to innovate more than ever before. They are putting a greater value on IP. Their courts and IP systems are becoming more sophisticated.” In the United States, she believes that we are likely to see some changes to reduce pressure on the economy from nonpracticing entities. “We will see some targeted limited specific legislation—and some rule changes—in 2015.”

W. KARL RENNEN AND DOROTHY P. WHELAN

FISH & RICHARDSON P.C.

PIONEER SPIRIT Neither Karl Renner nor Dorothy Whelan started their law firm careers as an attorney. Whelan was a disaffected engineer pursuing a master's at MIT when she took a job at Fish & Richardson as a paralegal/clerk, a job where "I could still work with scientists." Renner started in the computer department at a Boston law firm. After they each got a law degree, they teamed up at Fish & Richardson and now co-chair the firm's Post-Grant Practice Group.

TRAILS BLAZED Whelan began in IP litigation, transitioned to counseling and planning and eventually focused on inter partes reviews, "which is quasi-litigation." Renner followed a similar path, and the practice grew. By the time the America Invents Act was under discussion, they were already "elbow deep" in IPR. "By day we worked at our regular practice, and by night we focused on new regulations and rules." The result is an accelerated process managed by the Patent Trial and Appeal Board with limited discovery and a hearing in front of three experts. "It's much quicker and cheaper than litigation," says Renner. Since passage of the AIA, Renner and Whelan have focused on providing information on post-grant proceedings, including through development of a free mobile app that provides resources for practitioners. "We try to provide what people need to know through a means they find convenient to access," says Whelan.

FUTURE EXPLORATIONS Whelan believes that the forum for challenging patent delivery is shifting. "Post-grant tools are proving to be fast and cost-efficient means," Renner adds, "This is shifting before our eyes."



KEVIN G. RIVETTE

3LP ADVISORS

PIONEER SPIRIT Kevin Rivette was practicing at a patent firm in the early days of Silicon Valley, where he did some patent work for telephone switch manufacturer ROLM. He realized there was a market for management systems for these switches and built a company to do that. He sold it, and then he built another company that put patent data into a database and sold that, too. Then in 1999 he wrote the book *Rembrandts in the Attic: Unlocking the Hidden Value of Patents*.

TRAILS BLAZED *Rembrandts* sold 120,000 copies in seven languages. "I had read a number of books, but they'd get bogged down in legal nuance. Because of my business background, I knew the real issue is not the law. It's 'How well does the c-suite understand what these assets can do for them?'" Rivette then started working in Boston Consulting Group's Global IP Strategy practice before running IBM's IP strategy on the business side. In 2008, he started 3LP Advisors to consult with clients on their central IP issues. "We have very large clients all the way down to startups."

FUTURE EXPLORATIONS Rivette believes that the America Invents Act, with its opportunity for parties without any interest to have a patent examined multiple times, is problematic. "Even if you have real quality patents, if you are a small company, you are going to have to fight. It costs too much, and the result will be big companies with monopolistic power, which become not innovators but integrators." He does believe the system will rectify itself, but expects it to take some time, and in the interim, "there is a new normal coming, and people aren't going to like it."



RALPH G. SCHROEDER

HYPERION RESEARCH



PIONEER SPIRIT Even while in law school, Ralph Schroeder was more interested in business. "I was in the law library poking around, and I found an article about IP audits. It got me thinking about IP as a business asset and not just a legal right." Schroeder started collaborating with the Licensing Executives Society and made a lunch presentation around the notion of IP portfolio management. "All the major consulting firms expressed interest in starting in that business." Schroeder joined PricewaterhouseCoopers in 1997 to help build its intellectual asset management practice.

TRAILS BLAZED Around this time, IAM started on a big upswing, and PwC was a leader. Schroeder focused on IP systems. "We built Microsoft's system the 1990s. They had maybe 100 patents, but they wanted to gear up. We helped them construct a huge customized system." He left PwC in 1999 to join a series of early stage IP technology companies, ending at research and advisory firm Hyperion in 2010.

FUTURE EXPLORATIONS Schroeder cites a recent survey of senior IP managers, almost half of which responded that IP is not important or not very important to their companies. "On one hand you read headlines like 'Google Acquires Motorola for IP,' and yet 48 percent of companies feel like it's only kind of important." Schroeder believes that the key is showing impact on revenue and creating awareness on the part of the market, which will have a direct impact on shareholder value. "Either companies will get better at delineating the value of IP, or it will continue to be a cottage industry within companies."

RONALD J. SCHULTZ

ROBINS, KAPLAN, MILLER & CIRESI LLP



PIONEER SPIRIT Ronald Schultz earned an engineering degree on an ROTC scholarship and then attended law school. He joined the Judge Advocate General's Corps, where he tried 20 jury court-martials, including a murder case in which he got his client acquitted. "Everything I have done since has been built on the foundations I formed in the military. The subject matter is different, but a trial is still about advocacy and facts." When he got out of the Army, his first job was for a large IP boutique where he practiced patent litigation. "But I wanted to play on a bigger stage, so I came to Robins Kaplan in 1987."

TRAILS BLAZED Schultz is a big believer in alternative fee arrangements. In his first big patent infringement case, he sued General Electric and Hitachi on behalf of a small company called Fonar Corp. "We had this on a contingency fee because Fonar could not afford to bring suit unless we leveled the playing field." The firm ended up earning \$52 million. "This was a multiple of our time investment, and we got to vindicate the rights of a small company." Since then, the firm has handled many more matters on a contingency basis as well as ones for large corporations with an incentive-laden fee agreement.

FUTURE EXPLORATIONS Schultz says it is now standard practice for defense lawyers to file an inter partes review with the Patent Trial and Appeal Board, and too often the patent is killed. "Things have swung too far." Schultz worries about the impact on innovation, especially for startup companies, as venture capitalists and others will be reluctant to invest "if the barriers to entry are patents that are increasingly difficult to enforce."

PETER SEWELL

CPA GLOBAL



PIONEER SPIRIT CPA Global, then known as Computer Patent Annuities, was founded in 1969 in Jersey as a back office operation to handle patent renewals. Peter Sewell was recruited in 1999 to change the management structure and grow the company. "I recognized great potential, but we needed a more professional structure." He served as chief executive officer until taking on the role of chairman in March 2014.

TRAILS BLAZED Under Sewell's leadership, the company grew both organically and by acquisition. In 2001, it acquired Memotech Interface Systeme and its IP management software for corporations, and in 2002 it took on Maxim Technology and its IP management software for law firms. There were other acquisitions as well, following a strategy of combining software with services. "Integration between software and services enables us to be more efficient. It has allowed us to work more closely with our clients. When they use the software, the result has been that they also need more services." Sewell has added offices "in all the world's IP centers" and built individual teams to serve major clients, both of which have helped the company stay closer to its clients and better understand their expectations.

FUTURE EXPLORATIONS Sewell predicts big geographic trends. "We are starting to see China and Southeast Asia grow." He also expects the business to become more specialized, as companies in different industries will increasingly have different needs. "The opportunity is around really working closely with clients and providing them with expertise and quality people to support their businesses."

TYRON STADING

INNOGRAPHY



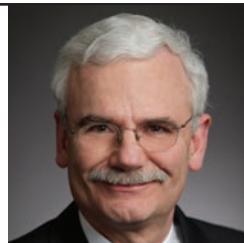
PIONEER SPIRIT Tyron Stading was working at IBM. They were building something new and wanted to protect it immediately, rather than waiting the five years for a patent to become effective. "We thought IBM might already have some patents that covered what we were doing." This drove a big "patent to product" mapping task, which ultimately failed to protect the new product. "A company that makes billions in licensing fees with tens of thousands of patents should be able to do this."

TRAILS BLAZED In 2006, Stading left IBM to address the problem. "Patent owners do not necessarily tie their patents to litigation or financials. I asked, 'How can I get the data connected to gain tremendous insights into how to use it?'" Stading says that he's never met a company that actually knows what it owns. "It's shockingly complicated. There's a lot of subtleties." The solution, says Stading, is using artificial intelligence and machine learning to make connections and determine who owns what and how it links to everything else. Stading's product, Innography, is now a standard in patent licensing. "We've been a part of every major transaction in a significant way."

FUTURE EXPLORATIONS Stading says there's an opportunity to redefine the entire space by connecting stakeholders and streamlining workflow. In the longer term, it is interesting to look at IP as a financial instrument. "There's no securitization. A lot of what you take for granted in the stock and bond market does not exist here. Insurance companies are starting to get involved in quantifying risk around IP."

THOMAS J. SMEDINGHOFF

EDWARDS WILDMAN PALMER LLP



PIONEER SPIRIT After a short career as a computer programmer, Tom Smedinghoff finished law school and went looking for a firm that would let him practice “computer law.” Finally he found one that had done some work for Control Data Corp. and told him he could develop a practice there. He started working with computer software (“Was it copyrightable? Protectable as a trade secret?”) and wound up writing one of the first books on software law, *The Legal Guide to Developing, Protecting and Marketing Software*. Smedinghoff moved to what is now Edwards Wildman in 2006.

TRAILS BLAZED As his career progressed, Smedinghoff focused on piracy, often collaborating with federal authorities, and then electronic data interchange, the processes that businesses were using to buy and sell goods electronically. “Then the Internet came along and brought with it a whole host of issues.” He wrote another book called *Online Law*, which was an early look at how the law applies to activities on the Internet, and soon wound up simultaneously chairing the Illinois Commission on Electronic Commerce and Crime, advising the Uniform Law Commission on the Uniform Electronic Transactions Act and participating in the United Nations Working Group on Electronic Commerce. “The work we did in Illinois was the starting point for many standards and laws nationwide and worldwide.”

FUTURE EXPLORATIONS Smedinghoff sees no shortage of challenges from the cloud, mobile technology and commerce, digital currency and online authentication and more innovations. “So many new things will deliver significant economic benefits, but the challenge is to continue to adapt the law to these new technologies. That’s my space.”

Edwards Wildman would like to congratulate our partner, **Thomas J. Smedinghoff**, for being recognized as a *National Law Journal* “IP Pioneer and Trailblazer.”

Bravo, Tom, and congratulations to all of the Pioneers and Trailblazers.



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PIONEER SPIRIT Rob Sterne founded his firm one year after law school. “I was blissfully ignorant of what I was getting myself into.” Sterne Kessler is now the seventh-largest IP firm in the United States (according to IP360) and the youngest firm in the top 10. The firm’s location in Washington, D.C., puts it in direct contact with the Court of Appeals for the Federal Circuit, the International Trade Commission and the USPTO. “We also probably have more attorneys with advanced degrees than any firm in the country. We have emphasized technology expertise from day one because that’s what we had to sell.”

TRAILS BLAZED Sterne is editor in chief of *Patent Office Litigation*, a two-volume set focused on contested proceedings under the America Invents Act, which is considered the definitive guide on post-grant and inter partes reviews. He is also chairperson of the editorial board of the PTO Litigation Center. The firm works for both patent owners and challengers. “We are not a firm that only ‘kills patent trolls.’ I fight for the system.”

FUTURE EXPLORATIONS While Sterne believes there are some patents that should not be asserted or even been granted, “it’s crazy to say that all patent owners who assert their rights are trolls. Not all patents are good; not all are bad.” He feels that legitimate innovation should be protected, but innovation that is in the public domain should not. “And it’s not easy to balance.”

PETER J. TOREN

WEISBROD MATTEIS & COPLEY PLLC



PIONEER SPIRIT Peter Toren was working in the general litigation section of the criminal division of the Department of Justice when he volunteered to be one of the original five prosecutors in the Computer Crime Unit. He ended up focusing on theft of trade secrets and intellectual property, including prosecuting a case of trade secrets theft from Whirlpool. The defendant was acquitted “largely because there was no statute that fit the crime,” and the case was cited by Congress in support of the Economic Espionage Act of 1996.

TRAILS BLAZED Toren’s work at the DOJ included one of the first cases under the Economic Espionage Act, in which Four Pillars Enterprise Co. was convicted of stealing trade secrets from Avery Dennison. Since he left for private practice, he’s been working with companies to get them to refer cases to the DOJ for criminal prosecution. He has also worked on one of the biggest trade secrets cases in history, in which Hilton paid damages and signed a deferred prosecution agreement for stealing trade secrets related to SPG’s luxury brand.

FUTURE EXPLORATIONS About 40 percent of prosecutions brought under the Economic Espionage Act have some Chinese connection, and Toren expects this to continue. Also, “trade secrets probably will take on an increased importance in protection of IP as there have been limitations placed on patents to fight trolls.” Toren is also hopeful that Congress will pass a Civil Trade Secrets bill. “They’ve been considering it for the past 10 years. Maybe in the next session there’s a chance.”

MICHAEL R. WARD

MORRISON & FOERSTER LLP



PIONEER SPIRIT Mike Ward has worked with plants forever. He had a vegetable garden as a kid and did plant breeding in high school. He has a Ph.D. in plant physiology from the University of California, Davis and did postdoctoral work at Harvard Medical School. He took a position at an IP boutique, and “they immediately asked me to go to Davis and do some work for Calgene. In my first week I was working on plants.” In 2000, he joined Morrison & Foerster, where he founded the firm’s Plant Intellectual Property Group. “Now it’s a destination practice. When people have questions about protecting agricultural IP assets, they find MoFo.”

TRAILS BLAZED There are two main areas of research in plants. One deals with GMO and engineering plants to make them grow differently, but the majority is classical plant breeding—“Gregor Mendel stuff.” Anything that grows asexually is protectable by plant patents. In contrast, if there are flowers, they lead to seeds, which are protected by utility patents. There are major differences overseas. “It’s complicated, but if it’s green, we can help you.” In one matter, Ward’s client R&D Agriculture developed a type of broccoli that grows in hotter environments. “We were not only able to protect the plant, we were able to protect ‘heat tolerant broccoli’ as a trait, which is much broader.”

FUTURE EXPLORATIONS Over the last few years, the drought in California has spurred more research on crops that will grow with limited water. “We are also seeing a lot of new investment. There are lots of mouths to feed, and it’s getting harder to grow food.”

SETH P. WAXMAN

WILMER CUTLER PICKERING HALE AND DORR LLP



PIONEER SPIRIT As an associate in a small litigation boutique, Seth Waxman was engaged by a San Francisco firefighter who was selling his family’s barbecue sauce in specialty food stores and was sued by food giant Noxell for trademark infringement over use of terms such as “2-Alarm.” “Noxell showed up with about five different IP law firms, but we won.” Waxman became aware that, while IP litigation might seem specialized, “it’s no more obscure than any other area of federal law.”

TRAILS BLAZED Later as solicitor general, Waxman was responsible for deciding which cases warrant appeals to the Supreme Court. He got a recommendation for an IP case, but a deputy solicitor general suggested that the Supreme Court would not be interested and that the Federal Circuit is effectively the Supreme Court in IP cases. “I viewed that like a bull views a red cape.” So he authorized a petition, got the Supreme Court to hear the case, and ultimately they reversed. This seemed to open the floodgates for the increase in number of IP cases being heard by the Supreme Court. When he left government, Waxman remained intrigued by IP litigation. “I don’t have a tech background, but very few federal judges do either. I think it puts me at an advantage.”

FUTURE EXPLORATIONS “IP is in large part all that we make in this country. It’s really the foundation of the U.S. economy.” Waxman believes that getting IP policy right is extremely difficult. For example, Internet technologies have low barriers to entry and a short useful patent life, while pharmaceuticals have high barriers and a long life, yet the same system protects both. “I expect an exceptionally interesting era of litigation, legislation and rulemaking.”

CHRISTOPHER WOLF

HOGAN LOVELLS



PIONEER SPIRIT Chris Wolf was a generalist litigator when he took a pro bono case on behalf of Tim McVeigh, a homosexual sailor whom the U.S. Navy discharged under its “don’t ask, don’t tell” policy. The Navy had confirmed McVeigh’s identity by contacting AOL and posing as his friend. As a result, McVeigh was the first to win a court case under “don’t ask, don’t tell,” and Wolf gained the attention of corporations, which engaged him to assist with their data privacy issues.

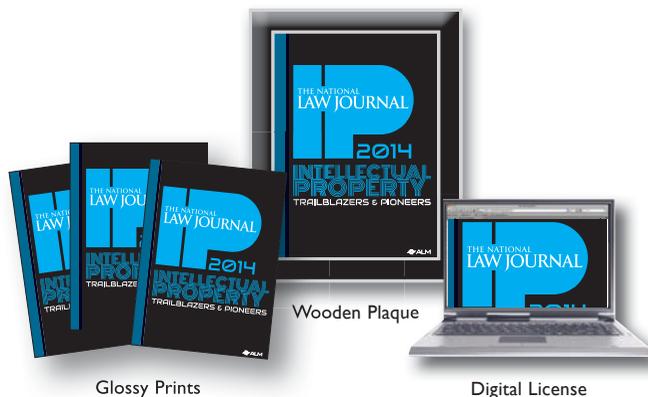
TRAILS BLAZED In addition to building the global privacy practice at Hogan Lovells, Wolf founded the leading think tank on privacy, the Future of Privacy Forum, which he still co-chairs. He also created the first privacy law treatise for Practising Law Institute and is one of the founders of the Coalition for Privacy and Free Trade. “Cross-border data flow is critical to the world economy, so protecting that data is critical.” Along with Anti-Defamation League National Director Abe Foxman, he co-authored *Viral Hate: Containing its Spread on the Internet*, which looks at how the shield of privacy online promotes trolling and hate.

FUTURE EXPLORATIONS “Due to the Snowden leaks and how we see it in our daily lives, data use has now risen to top the nation’s consciousness.” Wolf suggests that there will be an even greater focus on the appropriate use of data, especially as it is collected as part of the Internet of Things. “There will be greater vigilance over the use of data.”

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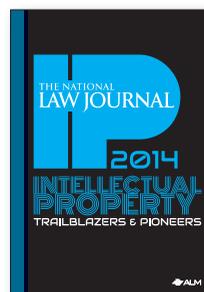


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