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Q&A With Mayer Brown's Alan Grimaldi

Law360, New York (June 20, 2013, 1:12 PM ET) -- Alan Grimaldi is a partner in Mayer Brown LLP's Washington, D.C., office and a co-leader of the firm's global intellectual property practice. He has decades of experience in patent and other intellectual property litigation, including mediation and arbitration, and has represented clients in the consumer goods, health care, chemical, electronics, defense and drug industries. He also has experience in all aspects of private and government antitrust and other complex commercial litigation, including nationwide class action litigation, multidistrict litigation in federal and state courts, federal and state administrative agency litigation, unfair competition, insurance coverage, products liability and litigation dealing with trade-related matters.

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

A: One of the most challenging cases I had was one where we were retained after discovery had closed and no ability to supplement the record. (Every lawyer wants to develop his or her own record for trial!) Plaintiffs had a successful product on the market covered by the patent. We had the developer of our product testify he was aware of plaintiff's patent and their products and that the product he developed operated differently. He had added several improvements and believed it did not infringe.

The issues of infringement and validity were not too complex, but getting the jury to understand some complex chemistry was a challenge. We had retained a world-class expert in catalysis who meticulously went through the evidence, explaining the differences between our alleged infringing product and theirs and why it did not infringe. He was knighted by the queen, so his "Sir" John title was impressive. (One juror even asked if she could have his autograph.)

We questioned the jurors after trial where they found no infringement to see how we could have "simplified" the case and technology. We were surprised to learn that they "got it." It was a run-of-the-mill, mostly middle class jury with only three jurors holding college degrees. They uniformly told us how impressed they were with our expert. The old adage that experts tend to "cancel" each other out did not hold up here — lesson learned. A likeable, well-prepared expert who is able to simplify your case is a great tool for success. (Being a "knight" with a British accent was a plus.)

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

A: One obvious area is damages — Congress punted on in this in the America Invents Act — Pharma vs. high tech could not reconcile differences. With some damage awards no longer in the tens of millions and approaching hundreds of millions, clear articulation of what the law will allow is a must. But the courts, led by Chief Judge Randall Rader's charge, are starting to grapple with tough issues surrounding lost profits, reasonable royalty, market shares, rules (25-50 percent of profits), and we are seeing "conjoint" analyses, surveys and other approaches emerging. Getting a reasonable return for one's invention is different from a windfall, especially with juries not being able to comprehend the pages and pages of jury instructions. Hopefully the jurisprudence will develop to be fair to all parties.

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

A: Consistent with my answer to the above area in need of reform all the "new" cases dealing with damages and a court's ability at pretrial to dispose of unreliable theories, expert reports that lack evidentiary and legal support with Daubert and summary judgment motions are helping shape damages issues. So Cornell, Lucent, Uniloc, IP Innovations are leading the way — hopefully to bring some clarity and sanity to this area of the law.

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

A: Recently, I was up against Jerry Reidinger at Perkins Coie in Seattle. While a great advocate for his client and always well prepared, his gentlemanly approach (in an era where we can use more of this) was much appreciated. He showed a willingness to compromise and offer solutions to resolve controversies. He always treated my team, senior to junior, with respect in and out of the courthouse.

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

A: I am sure I made my share of mistakes, but one that stands out is when I removed a phrase a client inserted in a brief in a case pending in the Maryland federal court. Client was Texas-based, and the phrase was "that dog don't hunt." Being an ex-New Yorker the phrase was foreign to me and I felt it was a bit contentious. Client was not too happy and insisted I put it back. The lesson learned (while I believe I was correct in removing a slang expression from a brief) is to teach associates who feel they can write better than anyone the following rule: If a client's suggestions is legally correct even though you believe you can express it better, keep it and let sleeping dogs lie — no pun intended.

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