

## Icon Of IP: Sterne Kessler's Robert Greene Sterne

By Kelly Knaub

*Law360, New York (June 17, 2016, 5:28 PM ET)* -- As a young kid growing up in the suburbs of Washington, D.C., during the Cuban missile crisis, Sterne Kessler Goldstein & Fox PLLC's Robert Greene Sterne became fascinated with short wave radios, recalling the adrenaline rush of putting on his headphones and listening to Radio Moscow.



The electrical engineering fanatic, whose most memorable radio contact was tapping in Morse code at 13 years old to someone in Tasmania after finishing his paper route one morning, eventually earned two engineering degrees at Tufts University and a law degree from the University of

Maryland and went on to create what has become one of the top five largest intellectual property firms in the nation.

Sterne founded Sterne Kessler at the age of 26 with just one other partner who had a Ph.D. in molecular biology from Harvard. The firm now has 130 attorneys, plus about an additional 60 IP professionals, including technical specialists, patent agents and paralegals, with 50 of the 180-strong team holding Ph.D.s and 55 to 60 holding masters of science degrees.

The budding attorney — now a top patent lawyer in the nation who helped draft the America Invents Act — got the idea to start the high-technology electronics and cutting-edge biotech firm, which has grown 100 percent organically over the past four decades, following a stint at a law firm office in Tokyo not long after he earned his law degree.

It was in Japan where Sterne discovered his real love was representing U.S. companies that are at the cutting edge of electronics, which he had previously done while working as outside counsel for Communications Satellite Corp., which was the leader of satellite communications in the world at the time.



Robert Greene Sterne

"I realized in Tokyo that the Japanese were about to kill us, technologically, and that I didn't want to just be a glorified copy editor of Japanese-originated U.S. patent applications," Sterne told Law360. "So I came back from Tokyo all energized because the Japanese economy was on fire, and they were going to take over the world, which they did for a while in electronics, and I decided, to the amazement of everybody including my own family, that

I'm going to quit my job and start my own law firm a year out of law school."

Sterne has since been at the forefront of some of the most notable patent cases in U.S. history.

The IP pro tends to work on high-profile, big-dollar cases involving patents that are being licensed or enforced in "bet the company" cases, in which the loss of the litigation would be catastrophic for the company.

"The reason that I'm brought in is because of my high profile on the issue of what's going on in the intellectual property world," Sterne said. "I call it the new global patent landscape, which I've worked on extensively with [Former Chief Judge of the Federal Circuit Paul R.] Michel and others over the last couple of years, so I focus on what's happening globally, and I'm able to advise the board of directors and the CEOs and C-level executives, as well as the in-house counsel."

For one, he played a key role as co-counsel for patent owner Teleflex Inc. in an infringement case it brought against KSR International Co. over a patent covering an adjustable gas pedal linked to a throttle control with an electronic sensor that made its way to the U.S. Supreme Court. The case is considered to be one of the most significant Supreme Court cases in the past five decades because it clarified the definition of obviousness, which is a question that arises in nearly every patent dispute.

Sterne also successfully served as patent re-examination counsel for patent owner i4i Ltd. Partnership in a suit against Microsoft Corp., in which the Supreme Court held that Section 282 of the Patent Act requires an invalidity defense to be proved by clear and convincing evidence.

In another landmark case, Sterne served as lead counsel for IBM Corp. at the Federal Circuit in *In re Beauregard*, a case in the 1990s that resulted in the U.S. Patent and Trademark Office's issuance of its software patent guidelines, which expanded the scope of patent protection for software.

Michel, who is Sterne's mentor and has known him for about 25 years, told Law360 that what distinguishes Sterne from other patent litigators is his sense of the big picture of how all the users of the patent system have roles to play and how those roles interact with one another.

"He has a keen sense of the role and perspective of investors, an understanding of the role of the business clients of lawyers and of all the decision makers, whether they're patent examiners or Patent Trial and Appeal Board judges or federal district judges or International Trade Commission administrative law judges," Michel said. "He understands how all the different users and players depend on the system and how the different parts of the system fit together."

Aside from litigation, Sterne helped draft the AIA when Joe Matal, a former Judiciary Committee counsel to Sen. Jeff Sessions, R-Ala., and former Sen. Jon Kyl, R-Ariz., called on him in 2011. The legislation, which shifted the U.S. patent system from a "first-to-invent" to a "first-to-file" system and created a process for determining the validity of issued patents, marked the most significant change to the U.S. patent system in nearly six decades.

After the law went into effect in 2012, Sterne and colleagues from the firm wrote the book "Patent Office Litigation," which is a two-volume handbook offering an in-depth examination of the newly created patent validity proceedings at the Patent Trial and Appeal Board, as well as analysis and advice.

As a result, Sterne and his colleagues were asked by the American Bar Association in 2014 to author,

along with ABA litigators, a chapter titled "Patentability Challenges at the U.S. Patent and Trademark Office," for the Fourth Edition of "Patent Litigation Strategies Handbook."

Phyllis T. Turner-Brim, vice president and chief IP counsel of Sterne Kessler client Intellectual Ventures, told Law360 that Sterne provided the highest level of anticipatory service regarding AIA proceedings to the company, offering information and guidance as an early scholar of the new proceedings.

"Being at the forefront of what's going on in the patent arena and advising clients accordingly is one of the key attributes and something that we rely on heavily from Rob and his firm," she said.

Sterne has primarily done prosecution work for IV, as well as re-examination and AIA post-grant proceeding work, including inter partes reviews, according to Turner-Brim.

Sterne's educational background in both the technical and legal areas is also a great foundation that helps him relate to the IP challenges facing innovators, according to Jeff Parker, chairman and CEO of Parker Vision, where Sterne serves on the company's board of directors.

"Having an appreciation for the science and an understanding of the legal system that affords innovators the opportunity to protect their inventions allows Rob to bring a holistic approach to helping clients understand what's required to capture IP rights and maintain a state-of-the-art portfolio," Parker said. "Rob also believes in the benefits to our overall democracy by encouraging the individual to innovate and be an active participant in one of the areas that makes the U.S. economy the envy of the world."

Sterne was the chief architect and strategist of the prosecution of Parker Vision's patent portfolio, consisting of more than 250 U.S. and 75 foreign patents, which primarily cover radio frequency and wireless innovations, according to Parker.

The IP expert said the immediate and long-lasting attractiveness of being a patent attorney for him has been and continues to be the opportunity to work with the leading thinkers and doers in many of the most advanced technologies in electronics, communications, software, medical devices, nanotechnology and other fields.

"No other professional area offers such cutting-edge diversity in technology, business models and individuals," Sterne said. "I consider myself to be one of the lucky ones to be able to counsel and represent a world class innovator like ParkerVision and Jeff Parker. I love my job and my profession."

--Editing by Christine Chun and Kelly Duncan.

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