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PRACTICE PERSPECTIVES: VAULT'S GUIDE TO  
**LEGAL  
PRACTICE  
AREAS**

Edited by Matthew J. Moody, Esq.

  
career intelligence

# Sterne, Kessler, Goldstein, & Fox P.L.L.C.

## DEBORAH STERLING, DIRECTOR—BIO/CHEMICAL GROUP; DANIEL BLOCK, ASSOCIATE—ELECTRICAL GROUP

Dr. Sterling is a director in the Bio/Chemical Group at Sterne Kessler. She has a B.Sc. in Biochemistry and a Ph.D. in Molecular and Cellular Physiology. Originally from Ireland, Dr. Sterling brings an international perspective to her work. Her intellectual property experience has been principally in technical areas such as biotechnology, pharmaceuticals, molecular biology, analytical instruments, agrochemicals and clean technology. In addition to her practice, she chairs Sterne Kessler's professional development committee.

Mr. Block is an associate in the Electrical Group at Sterne Kessler. Prior to working at the firm, Mr. Block worked as a software developer in the software-as-a-service space. He earned his law degree from University of Minnesota, and earned a B.S. in Computer Science from Rochester Institute of Technology.

### Please provide an overview of what, substantively, your practice area entails.

**DS:** My practice is focused in the biotechnology and pharmaceutical industries, where I am involved in all areas of patent procurement, exploitation, and enforcement. That means I counsel clients on a complete intellectual property strategy. That strategy can involve evaluating patent portfolios, e.g., for invalidity, non-infringement, freedom-to-operate, and due diligence; patent litigations, both in district court and in front of the Patent Office; and building strong portfolios.

**DB:** I work with both defendants in patent lawsuits and patent owners in district court litigation and post-grant proceedings at the Patent Office. Regardless of which "side of the v" I'm on, I always first perform a deep dive review of the technology at issue, which is always one of my favorite parts of a case. I've worked in a wide range of technologies, such as advanced network routing, semiconductors, and movie special effects. After I understand the technology, I work on the substantive case, which may involve filing or responding to post-grant proceedings, finding prior art, or preparing an infringement or non-infringement case.

### What types of clients do you represent?

**DS:** I've represented all kinds of companies, from start-ups to large multi-nationals, and across technologies too. For example, I have worked with pharmaceutical companies, animal grooming products, biofuels and other clean technologies, next-generation sequencing, biologics, agrochemicals, dental implants, 3D bio-printing, and lots of other exciting technologies.

**DB:** I've represented a wide range of clients, including some of the largest, and well-known companies in the world, ranging from auto manufacturers and software companies to leading edge start-up companies. For example, I recently represented a company that operated in a niche technology space: virtual-machine backup. The client has a great reputation for being innovative, and due to its success, raised the ire of a much larger competitor that sued for patent infringement. The case ultimately involved two district court litigations and 10+ inter partes review proceedings. In the end, the patent office invalidated all of the remaining asserted patents in the case, giving our client a complete victory.

### What types of deals and/or cases do you work on?

**DS:** My work varies based on client needs. For some clients, I will advise on building a patent thicket around an innovative technology. For others, we strategize enforcement on a U.S. and sometimes global scale. Recently, a lot of my work has involved challenging or defending patents in post-grant proceedings at the Patent Office, including handling appeals to the Federal Circuit.

**DB:** When I started out at Sterne Kessler, I worked primarily on patent prosecution, which is drafting, filing, and negotiating with the Patent Office for the grant of a patent. More recently, my practice has focused on post-grant proceedings at the Patent Office and district court litigation. I continue to work on some patent prosecution and application drafting with a focus on technology areas that I'm passionate about, such as 3D printing, home automation, and computer networking.

### How did you decide to practice in your area?

**DS:** I was, and still am, first and foremost a scientist. After getting my Ph.D., I considered staying in academia, but was concerned that I was becoming more and more focused on a very specific scientific field. I heard that patent law was a great way to stay at the forefront of science in many different areas. Not only that, practicing law requires similar skills as science—good research and creative problem solving. Once I realized that, I knew I was on the right path.

**DB:** Prior to law school, I had the opportunity to work on a class-action lawsuit as a consulting witness. In that case, I developed a program that helped calculate the damages. After this experience, I realized that someone with my skillset may be valuable in the legal field, and began to research different facets of a career in law. From this research, I was naturally led to patent law given my background as a computer scientist. This turned out to be a great choice for me. I am enjoying the unique intersection between law and science that you get with IP law.

### What is a typical day or week like in your practice area?

**DS:** I lead several teams, so I will check in with them frequently to strategize the next steps needed to best serve our clients. Some days I can be engaged in taking a deposition or doing an oral argument in a post-grant proceeding. Other days, I'm brainstorming with inventors about some cutting-edge innovation that they want to protect. When we are facing a big deadline, we can typically work very long days for one or more weeks. So it is important to make sure to take some downtime to recharge your brain after being in such an intense process.

**DB:** My work focuses mostly on litigation and post-grant proceedings. I may spend my day searching for prior art, talking with experts, reviewing technical documents, and preparing documents, such as Markman briefs, IPR petitions, or Patent Owner Responses. For example, I recently spent a day tracking down a telephone that we could use as prior art in a litigation. Ultimately, I found it in a museum in California, and we were able to have them make copies of the phone's manual and take pictures of the phone. They sent them to us, and those documents ended up being an important part of our case.

### What is the best thing about your practice area?

**DS:** It is constantly changing—both the law and the science. You need to be as innovative with legal arguments as scientists are with their inventions. It is also satisfying when you see a product that you work with displayed on the shelf in the supermarket, or to see pharmaceutical products that you handled matters for advertised on television. The best feeling, though, is when your team makes a client happy. Helping a client achieve a goal is really what we're all about.

**DB:** Learning about the technology. I absolutely love learning new things, and it is really neat to get paid to become very knowledgeable in a particular subject matter. It is also amazing to interact with people who are true subject-matter experts, such as inventors and experts. Brainstorming litigation strategies with other associates and partners is also pretty fun. It is certainly satisfying to know you played a role in a strategy that got a great result for a client.

### What is the most challenging aspect of your practice area?

**DS:** Life has become quite frenetic with email and smartphones making you constantly accessible to clients. Patent law is not one-size-fits-all, so it isn't the type of law where you can have a guaranteed answer at the tip of your fingers. Most cases are quite nuanced. It can be hard to think through all aspects of a case when people are demanding quick, almost instantaneous answers. But you need to figure out how to do that; your client is relying on you.

**DB:** Patent law has changed dramatically in a number of ways over the last four years. With the ever-changing landscape, it can be difficult to keep up with all of the changes. That said, it also provides new opportunities to get smart and become an expert on new laws that affect existing and emerging technologies.

### What training, classes, experience or skills development would you recommend to someone hoping to enter your practice area?

**DS:** Writing is a critical skill. Take writing classes—both legal and creative writing. And read books and articles written by great writers. Oral communication is another key skill. One thing that can be fun that wouldn't necessarily come to mind as a professional development opportunity is an improv class. This is a fun and effective way to improve your confidence and will help you learn to think on your toes too.

**DB:** I would recommend taking a course on patents. It's good to have a solid base of some of the major cases that have been decided in patent law. I also suggest taking the patent bar exam during law school. It can make things less stressful during your first year as an associate, and it is nice to have the credential under your belt when you are looking for your first job. Finally, have fun! For example, I took a Reiki healing class in law school, and I've been just fine.

### What misconceptions exist about your practice area? What do you wish you had known before joining your practice area?

**DS:** That IP is boring. It isn't! Think about it—intellectual property rights surround some of the most important aspects

of our daily lives: from Apple's patents, to Coca-Cola's trade secrets, to Lego's trademark, to David Bowie's copyrights. We get to work with cool things all the time.

**DB:** I agree! It is a misconception that IP is boring and slow-paced. First of all, underlying any patent work is technology, and that is dynamic and ever changing across so many areas from computers, to health care, to consumer products. Secondly, there are aspects of patent law that likely appeal to most lawyers. For example, if you are interested in transactional work, there is patent licensing. If you are interested in administrative law, there is post-grant work at the Patent Office. And, if you are interested in litigation, there is patent litigation, which is often highly contentious and complex across every conceivable industry and business sector.

### What is unique about your practice area at your firm?

**DS:** I have always been involved in inter partes work; that is work where two parties are fighting over a patent right. At the Patent Office, that work has included interferences, inter partes reexaminations, and now, the new post-grant proceedings that arose with the passage of the America Invents Act (AIA) in 2012. While the underlying premise is similar, the proceedings have evolved, bringing a new set of exciting challenges.

**DB:** As noted, the patent law landscape has changed dramatically since I've been at the firm. Since the passage of

the AIA, Sterne Kessler has been at the forefront of the new proceedings, and most associates are involved at some level in these proceedings, whereas prior to the passage of the AIA, these proceedings didn't even exist. It has been a great way for me to get hands-on experience working with clients and senior directors while handling depositions, arguments, and other work that my peers at other firms don't necessarily get to do at this stage of their careers.

### What activities do you enjoy when you are not in the office, and how do you make time for them?

**DS:** I'm an adjunct professor, teaching PTAB litigation at George Mason University School of law. So I get to meet new, upcoming patent lawyers every year. I have two kids and two dogs that keep me busy. I also like to run—I've run several marathons and ultra-marathons—and I hike. I make some pretty fine chocolate and stout ice cream too! Making time to get it all in is tough, but I've started adding my fun activities to my calendar as must-do appointments, so that I can make sure that important aspect of my life gets the attention it deserves.

**DB:** Beside keeping up with colleagues and former law school classmates at bar and alumni functions, my hobbies tend to be more "nerdy." For example, I've recently installed a home automation system in my house, which allows me to control my house from anywhere in the world. I also contribute regularly to open source software projects.

## STERNE, KESSLER, GOLDSTEIN, & FOX P.L.L.C.

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Practicing law requires similar skills as science—good research and creative problem solving.

*Deborah Sterling, Director*

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