

2017 EDITION

PRACTICE PERSPECTIVES: VAULT'S GUIDE TO

LEGAL PRACTICE AREAS

Edited by Matthew J. Moody, Esq.



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

Lestin L. Kenton Jr., Associate, and Michelle K. Holoubek, Director—Electrical Group

Lestin L. Kenton, Jr. is an associate in the electronics group. His practice areas include the preparation and prosecution of patent applications, *inter partes* reviews, covered business method reviews, infringement and validity opinions, and patent portfolio evaluations. Prior to working at the firm, Mr. Kenton was employed at a defense contractor as a software developer, performing research, design, and implementation of components and interfaces for complex radar simulation systems. He has a B.S. in Computer Science & Engineering from the University of Pennsylvania, and a J.D. from Widener.

Michelle K. Holoubek has a background in relativistic physics and specializes in software, digital healthcare, and optical technologies. In addition to the preparation and prosecution of patents to develop portfolios for startups and *Fortune* 100 companies alike, she has been counsel in over 50 contested cases for both patent owners and challengers. Having handled hundreds of software and business method patent applications at the PTO, patent-eligible subject matter (aka “§101”) is her special area of expertise. Michelle also leads the firm’s digital healthcare practice, with a focus in bioinformatics.

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

Lestin: I focus on patent procurement and enforcement on various technologies, such as imagery, web, telecommunications, geographic information system technologies, graphics processing, avionics, optics, database management systems, computer networking, communications protocols, and computer architecture. I counsel clients on different matters such as patent portfolio development and filing or defending post grant proceedings before the PTO.

Michelle: I work with clients on strategies to protect innovation they develop and clearing the field for commercializing their products. “Protection” involves working with inventors and in-house counsel to develop a patent application and guiding that application through the PTO, and identifying other ways to protect their innovation. This may include advising on what is “patentable” and establishing procedures to handle innovation. “Clearing” involves researching competitors that have patents in the client’s technology space and developing ways to avoid or mitigate existing patents so the client can proceed with putting their products on the market.

What types of clients do you represent?

Lestin: I’ve represented various companies ranging from start-ups to academic institutions, to some of the largest corporations in the world. While the majority of my work has

involved the electronic arts space, I have also worked with pharmaceutical and bio-technology companies.

Michelle: I represent companies at all sizes and stages, from 2-person startups to Fortune 100 companies such as Google and Apple. I work with clients in three technology spaces: software (all types), optics (for everything from imaging to data transmission to medical devices), and digital healthcare (such as bioinformatics and physiological sensors).

What types of cases/deals do you work on?

Lestin: At the beginning of my career, I focused primarily on patent prosecution, where I drafted patent applications and counseled clients on how to build patent portfolios that suited their business goals. My career has evolved, and now I work on a significant number of post-grant proceedings—representing either patent owners or petitioners. My prosecution and PTO litigation practices are intimately linked, as I’ve leveraged my PTO litigation experience for prosecution purposes and vice-versa.

Michelle: All my work involves the PTO—both drafting and prosecuting patent applications so as to gain issuance of a patent, and challenging or defending patents in contested cases at the patent office. I also work with international associates regarding counterpart patent applications filed in various countries around the globe. Additionally, I conduct in-depth reviews of patent portfolios for companies that are

being considered for investment or acquisition to determine any potential risks of investment.

How did you decide to practice in your area?

Lestin: As a college freshman, I met a patent attorney and immediately knew I wanted to be one too. Although, I was pursuing a computer science & engineering degree, I always had a general interest in law. Meeting this attorney opened up my eyes to the fact that I could combine both of my interests.

Michelle: I was a physics major focusing in astrophysics. I spent a lot of time in front of a computer, developing data analysis programs or modeling detector architecture. I didn't get to engage with others much and knew a lot about one small (but cool!) area of physics, but not a lot about other areas. So I came up with two non-academia professions where my physics background would still be useful—radiology and patent law. I didn't want to work in a hospital, but I love to read and write, so...patent law it was.

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

Lestin: I have a mix of post-grant proceedings and prosecution. Post-grant proceedings involve speaking with clients, co-litigation counsel, and experts about strategic, legal, and technical issues surrounding the defense or invalidation of a patent, in addition to research, review of technical and legal documents, taking and defending depositions, and preparing documents. For prosecution, I supervise other associates and technical specialists on applications, and this allows me to mentor and train, which I really enjoy.

Michelle: Busy! As a supervisor, I read and edit other people's work. I'm involved in developing strategy for our clients to protect their innovation. I dive into matters that are complex from a legal and/or technological standpoint. I work with my partners on strategic opportunities, support the professional development and training of many of our timekeepers by reading/editing/finalizing draft documents on cases, do calls with clients, and meet with associates. There is also marketing and administration, and email—lots of email!

What is the best thing about your practice area?

Lestin: In my practice area, you can shape your career as you see fit. I have been exposed to various technologies and varied aspects of patent law. This has allowed me to identify and focus on areas I enjoy, such as post-grant proceedings. Taking on as much responsibility as you can handle can often lead to unique opportunities to engage in new kinds of work.

Michelle: I am constantly surrounded by super-smart people and cutting edge technology. There's so much exciting innovation happening in the digital healthcare space! Bioinformatics

and physiological monitoring is one of the fastest growing areas of technology, and it requires an interdisciplinary practice that can handle both life sciences and computer science aspects. Being at a firm whose attorneys have such a diversity of technical backgrounds means that we get to work with companies that are at the forefront of changing the world around us.

What is the most challenging aspect of your practice area?

Lestin: Over the past few years, post-grant proceedings have become a major area of patent law. However, the novelty of these proceedings presents challenges. For example, on the surface two cases may seem similar, but the outcome can be different due to a myriad of factors. Navigating the landscape of post-grant proceedings therefore requires keeping up with law, and balancing the changes in the law with the needs and expectations of our clients.

Michelle: Keeping up with email. Communication these days relies so much on email that it takes away from the "personal" nature of the business relationship. Plus, if you receive 300 emails a day, and assume you spend 1 minute on each email, that turns into 5 hours a day! You have to be very organized to balance the time spent between answering email and doing actual productive work.

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

Lestin: I would recommend taking writing classes and specifically persuasive writing classes. Most of our cases involve complex technologies and complex legal issues. The difference between success and failure is often dependent upon the ability to effectively present our positions in a clear and concise manner that is geared towards our audience. Other than writing classes, writing can be improved by reading materials from other good writers and continuous practice.

Michelle: I'd recommend two types of training: (1) time management training; and (2) persuasive writing training. Regarding (1), the most common issue I see from new timekeepers is the inability to stay on top of deadlines and within a budget. While some of that comes from getting up to speed on the job, a lot of angst could be solved by knowing how to be organized and manage your time wisely. Regarding persuasive writing training, see Lestin's answer above.

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

Lestin: When people think about patent law they usually believe that the job only entails acquiring patents and then

enforcing those patents through lawsuits. However, patent law is so much more. For example a client's business needs often drive strategic decisions that are made with respect to patent enforcement and licensing. Thus, a crucial part of our practice area requires us understanding our clients and their goals, and pursuing options that align with those goals.

Michelle: This is hard for me to answer, because I didn't know ANYTHING about patent law before I started working in it. So I had no misconceptions—in fact, no conceptions at all. I took a leap of faith, and it worked out (fortunately!).

What is unique about your practice area at your firm, and how has it evolved since you have been at the firm?

Lestin: Our firm is at the forefront of post-grant proceedings and this allows us to be creative when cases of first impression arise. The law is continually developing, and we have the ability to help shape the law. We also have great resources—individuals who have various advanced degrees or have worked in various industries—who all bring unique perspectives to any given case. This is invaluable in the ever-changing landscape of post-grant proceedings.

Michelle: We staff projects based on technology and merit. That allows our attorneys to speak in the same language and

at the same level as our clients. For a patent application, for example, a junior timekeeper will be involved right alongside a more experienced timekeeper, getting exposure and providing input when working with the inventors and client. We make sure that we get the technology right and explain it clearly, since that's usually the hardest part.

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

Lestin: I like to engage in activities that are fun (such as working out and salsa dancing), but also take me outside of my comfort zone. I've recently taken several improv courses, which is unlike anything I've previously done. I make these activities a part of my regular routine. If you are committed to certain activities, you will find the time for them.

Michelle: I love being outdoors with my family. I hike, am "camp mom" for my daughter's troop, and go to my kids' games. We camp and go on RV road trips. I've played piano since I was 8. I make time for personal events by scheduling them as immovable appointments, just as I would a client meeting. There has to be balance—sometimes work has to take priority, and other times family is priority. The trick is figuring out what the balance is that works long term.

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

“ I am constantly surrounded by super-smart people and cutting edge technology. There's so much exciting innovation happening in the digital healthcare space! ... Being at a firm whose attorneys have such a diversity of technical backgrounds means that we get to work with companies that are at the forefront of changing the world around us. ”

Michelle K. Holoubek, Director