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## Q&A With Latham & Watkins' Maximilian Grant

*Law360, New York (June 15, 2009)* -- Max Grant is partner in the Washington office of Latham & Watkins LLP and co-chair of the firm's global IP & technology group. He serves as trial counsel in patent infringement cases representing both patentees and defendants and provides strategic business counseling on intellectual property issues.

Grant also represents clients in matters involving trademark, copyright and trade dress infringement, as well as Lanham Act, unfair competition and trade secret cases. He joined Latham in 2002 after serving as deputy assistant secretary of defense and has served on the PTO's Patent Public Advisory Committee. Previously, he was an aide to Sen. John McCain, R-Ariz., and a Navy SEAL team leader. He is the co-inventor of two U.S. Patents.

### **Q: What is the most challenging case you've worked on, and why?**

A: The recent win our firm had in the *Goldfarb v. Gore* case for our great client C.R. Bard was by far the most challenging case I've had to date. In fact, I anticipate that even if my career goes another 30 years, this one will stay at the top of the list.

The patent in dispute was applied for in 1974 but didn't issue from the PTO until 2002. It was the subject of an 18-year-long interference proceeding, so you can imagine how complex the history was because many of the fact issues in the case went back more than 35 years.

In addition, there was a long history of related litigation. I remember preparing to cross-exam Gore's most important fact witnesses. He had been deposed five or six times and claimed some of his prior testimony (which supported our positions) was perjury.

The case was also expert intensive, if I recall, 13 different experts testified at trial, some several times. It was an arduous and complex case but the evidence went in very well. It was the first time I've ever tried a case when I didn't leave court at least one day during the trial feeling like we'd lost.

Although it was a hard trial, we had a world-class team, which made the result possible. Our inventor David Goldfarb was a kind gentleman, and the jury and judge finally gave him the recognition he had been fighting for over all these years.

My co-counsel Steve Cherny was brilliant and endlessly imaginative. The other lawyers and our team of experts were tireless and skilled. Most importantly, Bard's general counsel, Steve Long, and chief patent counsel, Charlie Krauss, were determined to see this through.

Charlie spent the entire six weeks on trial with us, helped to craft the opening and closing, worked with our graphics consultants, did examination outlines, etc. He was brilliant.

The court held a three-day bench trial immediately after the five-and-a-half-week jury trial, so we were literally preparing the bench trial opening simultaneously with the jury closing. The jury began deliberating as I conducted our opening in the bench phase.

The jury came in with a verdict in the second day of the bench trial, right in the middle of a witness examination. Although it was gratifying to have all 140 boxes on the 28-page verdict form checked in our favor, with all asserted claims found valid and willfully infringed, the judge was all business and only gave the lawyers a 30-minute break before we had to continue putting on witnesses in the bench phase.

We then worked through the night preparing for the final day. Although the team had to hold off celebrating until we finished the bench trial, when we finally got to it, it was quite a celebration.

I've found that the analytical process for trying cases is analogous to the mission planning that I did in the Navy. Essentially, you prepare for months, think through every contingency in the decision tree and envision the choices you'd make. Then, you put your feet on the ground and have to adapt on the fly to changing circumstances, a dynamic opponent and the vagaries of chance.

Its very, very hard to get it right. But the motivation doesn't come from the joy of winning as much as the fear of losing. There is also a strong similarity in the mentality of SEALs and trial lawyers, a warrior mentality.

**Q: What accomplishment as an attorney are you most proud of?**

A: I'm particularly proud of my small role in helping build Latham's IP & technology litigation group. We have a really talented group of partners and associates.

Unlike some great IP firms, there is no one lawyer in our group that is famous or who is the name that all our clients ask for. We're more like the Miami Dolphins' "no name" defense from the 1970s, relentlessly in pursuit of victory, but working as a team of equals.

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

A: Patent reform is a hot topic, but many of the reforms being considered are, in my view, a circuitous effort to address the problems from “nonpracticing entities,” more commonly known as “patent trolls,” such as apportionment of damages.

I think those types of “reforms,” if implemented, will reduce the value of patents and would be counterproductive to the economy. Small inventors have long been the spark in the U.S. engine of commerce and we shouldn’t undermine their incentives.

We do need to increase the quality of issued patents and help the PTO address the burgeoning number of patent applications. Most of the meaningful proposed reforms require patent applicants to provide more and better information to the PTO, such as identifying the relevant disclosure in the prior art.

To date, the chief opposition to such reform comes from the patent prosecution bar based on concerns of inequitable conduct. Based on everything I see, those concerns are totally overblown.

In addition, presumptively limiting the number of claims and requiring applicants to justify continuations not presented within two years of the initial application are good ideas intended to address quality and pendency.

**Q: Where do you see the next wave of cases in your practice area coming from?**

A: China. The Chinese patent office now handles more applications than any patent office other than the U.S., European Union, Japan and Korea, yet less than 2% of those Chinese applications have counterparts filed outside China.

Once counterparts to Chinese applications are filed outside China in the same proportions as other developed countries, a significant percentage of the issued patents in those countries will be owned by Chinese inventors.

**Q: Outside your own firm, name one lawyer who's impressed you and tell us why.**

A: Let me give you two practitioners — there is a judge who would be on the list but I should not say anything because the matter is still pending.

For patent litigation, Greg Arovos at Kirkland is a strategic thinker, talented lawyer and tireless advocate who keeps the business objective in mind.

For opinions, re-exams and prosecution, Mike Ray at Sterne Kessler is the man to see.

**Q: What advice would you give to a young lawyer interested in getting into your practice area?**

A: The amalgam of skills in this profession is quirky: you need to have a courtroom presence, litigate complex patent issues, understand complex technology, all while appreciating the underlying business objectives so that the legal “tail” isn’t wagging the business “dog.”

The best shot one has to develop these skills is to, early in your career, work with truly talented lawyers who are secure handling off real responsibility (or are so busy they have no choice). You must then aggressively seek that responsibility.

I owe much of my good fortune to the fact that I did two patent trials as a summer associate working with Fred Bartlit and his best lieutenant. That got me pointed in the right direction.