



5 Tips For Landing New Intellectual Property Work

By Erin Coe

Law360, San Diego (October 26, 2015, 12:44 PM ET) -- In a fiercely competitive market for intellectual property work, attorneys have to be proactive and tactical about how they go after new business.

Although patent and other IP matters used to be the domain of specialty firms two decades ago, that model has been challenged as general practice firms have moved into the practice area, according to David Enzminger, co-chair of [Winston & Strawn LLP's IP](#) practice and head of the firm's Silicon Valley office.

"IP work has become much more commoditized," he said. "Nearly every general practice firm now does IP, which was not true 20 years ago. If you have more people doing something, it puts price pressure on everyone and makes it harder for individual partners to stand out. As a result, IP attorneys have to work harder."

Here, IP lawyers share best practices for landing new clients and keeping them happy.

Tailor Your Pitch

When attorneys are seeking business from a prospective client, they can put their best foot forward by preparing a presentation that is customized to the company's technology, its competition and its needs and goals, according to Les Bookoff, one of the managing partners of [Bookoff McAndrews PLLC](#), a patent counseling and prosecution services boutique.

"The presentation should also have concrete proposals and strategies to moving forward," he said.

The 18-lawyer boutique beat out two multinational firms to win the prosecution and counseling work at a large software company earlier this year, according to Bookoff.

"We tailored the presentation by first studying its existing patent portfolio and its business, and its competitors and their portfolios," he said. "The presentation then included an honest assessment of the relative size and strength of the portfolios, areas where it could improve its patent position and areas where patenting was not needed."

Bookoff and his team also discussed aspects of patent practice that affected the software company's portfolio, especially the challenges caused by Section 101 after the [U.S. Supreme Court's landmark Alice decision](#), which made it easier for district courts to invalidate patents for claiming abstract ideas, and how to address them.

In addition, attorneys need to demonstrate how their firm is different from the competition.

For instance, Bookoff, who left [Finnegan Henderson Farabow Garrett & Dunner LLP](#) with Roland McAndrews to start their boutique three years ago, tries to pitch to potential clients that they are receiving high-quality work like they would at a large firm but at a great value like they would at a small firm.

“It’s easy to distinguish ourselves from large firms because of cost, and we distinguish ourselves from smaller IP boutiques because of the quality of work we do and the breadth of our counseling services,” he said. “A lot of small IP boutiques are mainly doing prosecution work. They don’t do due diligence and opinion work or practice before the Patent Trial and Appeal Board, but we do all of that ... and that’s one of the ways we distinguish ourselves.”

Build Your Network

Attorneys should think of business development as a marathon, not a sprint, and know that winning over major clients doesn’t happen overnight. It tends to be a slow and steady process.

“My biggest clients were developed after years of me being patient and persistent,” said Dyan Finguerra-DuCharme, a partner at [Pryor Cashman LLP](#). “People don’t just wake up and say they are going to transfer everything over to you. That rarely happens. For the most part, in my experience, it’s been me doing a couple of things here or there, producing quality work, not being overly pushy, and then I’ve had potential clients transfer large amounts of work over to me.”

Attorneys need to stay in contact with prospective clients so that they are top of mind when a problem arises, according to Enzminger.

A few years ago, Enzminger met a general counsel of a gaming company for dinner, and the in-house attorney mentioned issues with the company’s engineering group — a casual conversation that later led Enzminger to represent the company in a multimillion-dollar trade secrets suit.

“In this instance, we weren’t discussing a legal problem, just some curious goings-on,” he said. “But the general counsel remembered our conversation and called me up a month later when those issues ripened into a problem, which we resolved successfully for the company.”

New business can come from unexpected places. One of Finguerra-DuCharme’s clients is a paralegal she worked with more than a decade ago at a former firm who now has a consulting business in the cryptocurrency industry and relies on her for advice on trademark and copyright matters.

“The life lesson is to do high-quality work, be kind and have people like and respect you,” she said. “You don’t have to be their best friend. But if you are respected for the kind of legal work and services you provide, that’s a way to generate new work.”

For junior attorneys, sometimes they just need to find ways to get their feet wet, according to Peter Sloane, chair of [Leason Ellis](#)’ trademark and copyright practice. His first client was his

sister, who needed a trademark for a computer program for managing solar energy.

“I did that as a first-year lawyer,” he said. “It’s never too early to bring in new business, even if you’re doing it for your family and friends and not charging them — as long as your firm’s OK with that. It starts to develop your skills to bring in bigger business down the line.”

Keep in Touch

Attorneys also should be thinking of how to keep their clients and prospective clients up to date on important legal developments and court decisions that could affect their business without bombarding them with mass emails.

“It doesn’t do much good to add every client to an email blast list,” Finguerra-DuCharme said. “I find it’s better to send a personalized email ... that says ‘here’s why you should pay attention to this case, here’s how it affects your industry and here’s why it’s important.’ It shows clients you understand them and their needs.”

The primary driver of new business is to take good care of clients when attorneys are representing them in litigation or on a deal and then staying in touch when they are not, according to Enzminger.

“Much of it is keeping on top of a client’s industry and sending articles on developments in the law that may be of interest,” he said. “You should know what the client might find interesting, rather than just blanketing everyone with information.”

For instance, Enzminger said he tried to keep clients in the loop after the Federal Circuit issued contrary decisions on divided infringement earlier this year.

In May, the Federal Circuit [held](#) that [Limelight Networks Inc.](#) didn’t infringe an [Akamai Technologies Inc.](#) Web content patent since it performed only some steps of the patent while its customers performed the rest, affirming a decision overruling a \$45.5 million jury verdict against Limelight. But the Federal Circuit [restored the jury verdict](#) in an en banc ruling in August, finding that Limelight controlled its customers’ performance of some steps of Akamai’s patented method, such that all steps were attributable to Limelight.

“Some clients were interested in how to structure their business following the first decision, and it required different business strategies after the second decision came out in order to protect innovation, and on the other side, to make sure they didn’t find themselves in hot water,” he said.

He said generating business often comes down to being a trusted adviser to clients and prospective clients before a lawsuit is filed.

Look for Your Cross-Selling Window

Attorneys also can bring in new business by examining their existing client base to see if their clients have any unmet legal needs.

“The most efficient way to generate new work is to look at things holistically and spot related issues when you deal with clients,” Sloane said. “If a client comes to me and talks about a new brand, I’ll often ask if it will use the brand outside the U.S. The client may have only thought about U.S. trademark rights, but by my spotting of a foreign issue, it could lead to work filing foreign trademark applications.”

Or if a client approaches Sloane about a trademark issue, and he sees that there is technology behind the product, he may suggest that the client talk to one of the partners at his firm about patent protection.

“It’s not just an opportunity for new work; it helps clients fully protect their rights,” he said.

Be Responsive to Your Current Clients

Lawyers may be excited about seeking out new clients, but if they become too consumed by the thrill of the chase, they may be neglecting the clients they already have.

Attorneys shouldn’t spend too much effort on unrealistic pitches, such as making cold calls to a company that has just been sued, according to Enzminger.

“Every lawsuit filed now is sent out on news services to every law firm in the country, so every case might draw the interest of 30 to 40 firms,” he said. “There needs to be a reason for why a company would hire you as opposed to another firm, and blanketing the marketplace based on filing reports is a waste of time.”

When lawyers do good work for their clients, they are often rewarded with additional business, according to Sloane.

“Looking at new clients is a low-yielding endeavor,” he said. “It may be fun to pitch for new clients, but at the end of the day, you’re better off working with existing clients and doing a good job for them.”

The best practice of all is for attorneys to deliver impeccable client service when they have a case, because, without doing that, everything else is pointless, according to Enzminger.

“That means living the client’s problems, being responsive to the client, making sure the bills are reasonable and fair and making sure the client is getting value for your service,” he said.

--Editing by Jeremy Barker and Emily Kokoll.