

About the Author



Robert Unikel is a partner in Kaye Scholer's Intellectual Property Department in Chicago. He has tried patent and trade secret cases involving such varied issues as thin film transistors, LCD panels, vascular stents, baby strollers, minicell vaccines, anti-aging cosmetics and a method for implementing consumer rewards programs. He has also managed disputes involving various trademarks and has litigated numerous trade dress matters implicating product and packaging designs and nontraditional source indicators (including color and scent). In addition, he regularly counsels businesses and individuals on intellectual property development, protection and licensing strategies. He can be reached at robert.unikel@kayescholer.com

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Q&A With Kaye Scholer's Robert Unikel

Q: What is the most challenging case you have worked on and what made it challenging?

A: One of the biggest challenges I've faced was in 2010, defending Solo Cup Co. in the first of a wave of qui tam actions for false patent marking brought against various product manufacturers who failed to remove patent numbers from their products after the patents had expired. A qui tam action under the Patent Act (as it existed prior to 2012) allowed "any person" to obtain damages against a defendant found guilty of false patent marking, with the requirement that the person evenly split the award with the federal government. With a permitted damage award of up to \$500 per article on a total of over 20 billion articles (in Solo's case, the plastic lids that are placed on most coffee-shop drinks), Solo Cup was faced with a potential damage award exceeding \$10 trillion (no, that is not a typo).

Since the 1980s, the company had used molds having a Solo patent number to manufacture its coffee-cup lids. After realizing that its patent had expired, Solo sought legal advice regarding the marking. Prior outside counsel advised Solo that it would be best to remove the marking, but that it was not a necessity. In light of this advice, Solo implemented a policy wherein it would gradually replace damaged or worn molds with new molds that did not contain the patent number. Solo then turned to us when they realized this initial advice was inadequate. We had to convince the district court, and later the Federal Circuit Court of Appeals, that Solo had not acted with an "intent to deceive the public," as is required by the Patent Act for false marking liability. Fortunately, we succeeded.

Our victory not only averted a major financial crisis for Solo Cup, it also provided a roadmap for potential false marking defendants to follow to avoid potentially significant liabilities. Notably, the false marking provision was amended by Congress in 2012 to eliminate the ability of "any person" to bring a false marking action. Now, only a person or entity that has suffered "a competitive injury" as a result of false marking can sue, and then only to recover "damages adequate to compensate for the injury."

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

A: There needs to be greater uniformity in the way that district courts handle patent infringement and

invalidity cases. For example, while some courts require substantial infringement and invalidity contentions early in a case, other courts have no established or serious early-disclosure requirements. While some courts conduct early claim construction proceedings, other courts wait until discovery is closed to address potentially case-dispositive claim construction issues. Even the courts that have in recent years established “local patent rules” often apply those rules inconsistently or unpredictably. The variability of court schedules and approaches makes it very difficult for companies and/or lawyers to reliably predict the costs, the risks and the likely progression of specific patent cases. Such variability also encourages jurisdictional jockeying, with patent owners and accused patent infringers often spending significant time and effort to assure that a particular case is heard by a court with rules and procedures that are perceived to be more favorable to their respective side.

Of course, if greater uniformity in the handling of patent cases is not possible, then more legroom in coach-class airline seats would be nice.

Q: What is an important issue or case relevant to your practice area and why?

A: The forthcoming en banc decision of the Federal Circuit in *CLS International v. Alice Corp.* will have a major impact on patents and patent cases involving computer-assisted business methods. In that case, the entire Federal Circuit will be deciding whether Alice Corp.’s patents (which relate to a computerized trading platform that allows two parties to exchange obligations, such as stock trades, which are then settled by a trusted third party) capture more than an abstract idea — that is, “more than a fundamental truth or disembodied concept without any limitation in the claims tying that idea to a specific application.”

CLS (represented by my colleagues here at Kaye Scholer) convinced the district court that the Alice Corp. claims were, indeed, so abstract that they were patent-ineligible. A Federal Circuit panel reversed, concluding that the specific computer-related features called out in the patents prevented a finding that it was “manifestly evident” that the claims were directed to abstract ideas. This panel decision seemed to conflict with other Federal Circuit panel decisions — for example, *Bancorp Services LLC v. Sun Life Assurance Co. of Canada*, in which an invention relating to tracking the value of life-insurance policies was held to be patent-ineligible—and exacerbated the uncertainty that has existed for years as to whether and when computer-assisted inventions (including software) can be considered patentable subject matter.

Even if it does not fully and finally define the dividing line between those computer-assisted inventions that are patent-eligible and those that are not, the en banc decision in *CLS International* invariably will provide a more definitive guide for inventors, patent owners, accused patent infringers and lower courts to follow in assessing whether specific inventions involving the use of computers truly are patentable subject matter.

Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.

A: Aaron Kramer of Schiff Hardin was not only was my mentor, he was the most passionate and committed lawyer that I have ever known. He loved the law, loved the art of advocacy, loved his cases and loved his clients like they were his children. Aaron taught me, and every other lawyer he worked with, that it's possible to be a fierce and zealous advocate without compromising values, without creating enemies, and without playing silly games. I have always tried to practice according to Aaron's principles, even if my adversaries may not always feel that I have succeeded. He was one of a kind.

Q: What is a mistake you made early in your career and what did you learn from it?

A: As a young associate, I often was reluctant to give a partner or a client for whom I was working hard truths or contrary opinions. I was overly concerned that if I reported on a "bad" decision, if I questioned a strategy or argument that rang false to me (but appealed to the partner or client), or if I suggested an approach that was markedly different from the one preferred by the partner or client, that I would be perceived as difficult and not a "team player." But I came to learn over time that the ability to recognize and address head-on the hard arguments, the bad cases and the questionable strategies separates the real "lawyers/counselors" from the mere "advocates." Clients and teammates need to hear honest advice and occasional bad news in order to make the best decisions. As the judge for whom I clerked, Hon. George Marovich, used to say, a lawyer needs to be able to tell his client (and his colleagues) when it is "time to wake up and smell the Christmas tree!"