

Litigation Leaders: Desmarais LLP Founder John Desmarais on the Firm's Early Focus on Trial Strategy

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By Ross Todd
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Welcome to another edition of our Litigation Leaders series, featuring the litigation practice heads of the leading firms in the country.

Meet **John Desmarais**, the founding partner of intellectual property trial boutique **Desmarais LLP**, who is based in New York. Desmarais spent his early legal career at IP firm **Fish & Neave** before serving a three-year stint as an assistant U.S. attorney in the Southern District of New York then returning to the firm. In 1997 he joined **Kirkland & Ellis** as a partner. From 2004 to 2009 he served on Kirkland's management committee. In 2010 he founded the boutique that bears his name, which has grown to more than 70 lawyers focused on complex IP disputes, often in technology with offices in New York, San Francisco and Washington, D.C. Desmarais won Litigator of the Week honors back in 2018 for getting an \$82.5 million verdict from a Delaware federal jury for client IBM in a patent infringement case against Groupon.

Litigation Daily: Tell us a little about yourself — beyond what's in your law firm bio.

I'm married to my high school sweetheart and have two children, neither of whom was interested in law school because their dad works too hard. I was born and raised in Hartford, Connecticut. My parents divorced when I was young. We had some very economically challenging years in which my mom, sister and I were all working but still struggling to pay the family bills. I think that upbringing helps me when trying cases because I grew up as an everyday person, working, going to public schools, the first generation in my family to attend college. That background gives me perspective on how to talk with jurors and a better understanding of what motivates them. While patent cases



Courtesy photo

John M. Desmarais founding partner of Desmarais LLP.

are complex technically and legally, they must be presented to everyday people on juries in terms that make sense to them. I think many patent lawyers don't focus enough on that aspect of these cases.

How big is your firm and where are most of your litigators concentrated geographically?

We are over 70 lawyers now, all focused on technology and life sciences-related litigation or patent office post-grant procedures. Most are in New York City, but we have offices in San Francisco and Washington, D.C., both of which are growing.

Back when you left Kirkland and launched the firm, the scuttlebutt was you'd started a plaintiff-side shop. But as you told me then, much of your new firm's work was on the defense side for Boston Scientific, Cisco, GlaxoSmithKline, IBM, and Micron. What's the firm's docket look like now?

Those are some of our most loyal clients that have been with us from the beginning. And we still do both plaintiff-side and defense-side cases for some of them and others. We believe working on both sides makes us better lawyers. We don't get caught up in discussions about which side we're on. We simply focus on the merits and don't take meritless cases. When we started, we handled mostly defense cases. Over the early years, we built up the plaintiff's-side to about half of the firm's work. But with the patent law reforms that followed on issues relating to the availability of injunctive relief, damages reform, Alice, inter partes reviews, and so on, good plaintiff's-side cases became harder to find. So, over time, our proportion of defense work has again swung into the lead. Now, I would say that we have more defense-side cases than plaintiff-side cases, and I anticipate this trend will continue for the foreseeable future.

As head of the firm, what are some of your goals or priorities for the next year?

Our first priority these days is to figure out how to keep up both morale and training in the time of COVID shutdowns and working from home. We started out doing a lot of virtual events, and eventually as COVID restrictions eased, we tacked to in-person get-togethers, but with the Omicron variant, we again stopped our in-person events. It's hard to keep up the comradery and spirit when everyone is at home. So, I spend a lot of my time on that. Most of our trials have repeatedly been adjourned for COVID reasons, and that is getting folks a little down as well, since we are a trial shop. In light of that, my focus now is on building and maintaining team spirit and putting in place COVID-safe training programs as we resume our regular virtual happy hours.

Beyond COVID concerns and looking to the business side of things, we have successfully built out our life sciences and IPR teams, which are now top tier in the industry along with our tech practice. With that accomplished, my new focus is on our recently opened D.C. office and the development of our new International Trade Commission practice. That effort is off to a fast start. We brought in a few lateral partners, **Goutam Patnaik**, **David Shaw** and **Tuhin Ganguly**, and the business began to come to the firm almost immediately. My focus now is on building out the team under them in D.C.

What do you see as hallmarks of your firm's litigators? What makes you different?

What makes us different is that we are a firm focused on trying cases and training our lawyers at all levels to do so.

We have yearly mock trial training for all the associates, mock deposition training, mock argument sessions, and evidence seminars, among other offerings. We focus on making sure our associates know how to put a case together for trial, and we approach each matter as if it will be tried. So, when we field a team, from the first-year associate to the lead partner, every person is focused on setting the case up for a win at trial. The team we put on a matter at the beginning is the team you will have at the end, and everyone knows what the case is about and how we are going to win it. So, it's a more efficient approach for handling cases, and it translates into better outcomes for our clients. It also eliminates all the unnecessary work that large firms do because they're not focused on a winning strategy from day one. It doesn't mean every case gets tried. When you focus on winning strategies from the outset, though, often that will yield a victory at the motion to dismiss or summary judgment phase. By focusing on the trial strategy from the beginning, it allows you to put the case in a position to win or settle early on — and can drive a good result.

What's the hiring process like at your firm? Do you ever bring on lateral partners?

Our process is the same as most top-tier firms: we start with on-campus interviews like everyone else, but we make much fewer offers as we only hire from the very top of law school classes. We are a great place to work, the associates really love our focus on training, we pay more than the big firms, and we provide a very generous benefits package — above and beyond what other firms do — so we usually get who we want. But there aren't that many scientists/engineers who went to top law schools and achieved top grades, and also want to be trial lawyers, so our growth is metered by the number of such quality candidates. We'd rather turn down business because we don't have enough great lawyers to handle extra cases, than lower our standards to hire lawyers simply to allow us to take on more work. As for lateral partners, we do sometimes bring them aboard, as we recently did in our new D.C. office, but mostly when it's someone we know well, someone we've had a good deal of positive experience with, and someone whom we're confident will fit into our culture. So, we do it, but not often.

What were some of your firm's biggest in-court wins in the past year, and can you cite tactics that exemplify your firm's approach to success?

During the past year, due to Covid concerns, we had several jury trials adjourned. For example, the biggest case I was working on in the last 12 months was *ViiV & Shionogi v.*

Gilead. The trial was adjourned three times due to COVID. It was last scheduled for January 2022, and we thought that date would hold, so we moved into the trial hotel in Delaware, only to have the case adjourned once more due to Omicron. It was publicly announced on February 1 that the case settled. (Editor's note: The announcement ran in Scott Graham's Skilled in the Art briefing under the headline "Desmarais and McCarter Guide Glaxo to \$1.25 Billion Settlement With Gilead"). It was a fascinating case involving the novel application of the doctrine of equivalents to a drug molecule patent claim. We had two very significant in-court wins, defeating Gilead's motion to dismiss and later its motion for summary judgment in which they argued that the doctrine of equivalents was legally precluded for specific molecule claims.

In other cases, we had several in-court wins at the Court of Appeals and on motions in the district courts, as well as on IPRs before the Patent Trial and Appeal Board. Probably our most significant win after the Gilead case was in *Straight Path v. Cisco* on appeal before the Federal Circuit. In that case, Straight Path was seeking damages of more than \$40 million from our client Cisco. In addition to winning summary judgment of non-infringement, the court ordered the plaintiff to pay our attorneys' fees of \$1.9 million. It was significant because we do not bill by the hour and there is Supreme Court precedent with broad language that fee awards, in other contexts, are to be calculated by the hourly rate, loadstar method. So, this case was the opportunity to clarify that, in the patent context, the loadstar method was not required. We won that issue at the District Court level, and that decision was then summarily affirmed by the Court of Appeals.

We also prevailed before the Federal Circuit on two mandamus petitions this year – one for our client Apple in *In re: VoIP-Pal.com, Inc.* and the other for our client Google in *In re: Google LLC*. Meanwhile, on the defense side, we significantly narrowed a case for our client Cisco in Massachusetts District Court by winning on summary judgment on the issue of pre-suit damages and on various patent claims in *Egenera v. Cisco*. In another defense victory, we significantly narrowed a case for our client Auris (a Johnson & Johnson subsidiary) in Delaware District Court by winning summary judgment of no lost profits across all patents in *Intuitive Surgical v. Auris Health*. And on the plaintiff's side, we won a summary judgment for our client Avanos against Medtronic's affirmative defenses in the

Western District of Tennessee, defeated their motions for summary judgment, and excluded their only non-infringement defense, which set the case up for a very favorable settlement in *Avanos v. Medtronic*.

All these cases highlight the firm's unique approach to prioritizing how we can win the trial in the early stages of the case, which helps us focus in discovery on gathering the evidence and admissions we need to set up summary judgment motions. Because of this trial focus, we view depositions not simply as fact-finding exercises, but as opportunities to use a large portion of each deposition to obtain admissions that will allow us to either win at the summary judgment phase or, failing that, to execute a strong cross-examination at trial.

Additionally, our IPR group, which also does both petitioner side and patent-owner side work, had a strong year at the PTAB. For instance, we successfully defeated Medtronic's IPR challenge in the Avanos case when the Board found that all challenged claims were patentable. And we were able to successfully prevent institution on a number of IPR challenges for our clients IBM, Monterey Research, Gigamon, and Ravgen in cases where the opposition included Zillow, Nanya, Apcon, and Quest Diagnostics. While, on the petitioner's side, we successfully invalidated all challenged claims for Samsung and successfully advanced re-exams for both Unified Patents and Auris Health.

Where are you looking to build or expand in the next year?

We're looking to expand our teams in the San Francisco and D.C. offices. Last year, we added our first lateral partner on the West Coast when **Gabrielle Higgins** joined the firm bringing extensive experience as a trial lawyer and a career handling more than 130 IPRs. Now our goal is to build out the team in San Francisco around Gaby and the other partners in that office, and we plan to hire several associates and counsel there by the end of the year.

As mentioned earlier, we also had three new ITC-focused partners join the firm as lateral hires last March, helping to launch our D.C. office. That office, led by **Justin Wilcox** who's been with the firm for nearly a decade, has seen its workload expand quickly, partly benefiting from the uptick in ITC cases filed in recent years. We're looking to add junior lawyers there who can support these partners as we continue to see an influx in these cases. We're confident this will be a growth area and prove fertile ground for the firm in the future.