

## Technology Group Of The Year: Desmarais

By **Adrian Cruz**

*Law360 (February 4, 2020, 2:18 PM EST)* -- Desmarais LLP attorneys successfully defended Cisco Systems from multiple patent infringement claims seeking a combined \$475 million in damages, helping to earn the firm a spot among Law360's 2019 Technology Groups of the Year.

Desmarais is a boutique firm focused on defending major technology companies in patent litigation, with 56 attorneys located in New York and another five based in San Francisco.

Last May, it helped Cisco dodge \$400 million in claims brought by software company Egenera Inc., which accused the tech giant of infringing its patent for a virtual networking system.

In 2017, Egenera removed one of its employees from the patent in a decision approved by the Patent Trial and Appeal Board. In the end, Desmarais was able to convince a Massachusetts federal judge that this decision invalidated the entire patent.

"The inventors on the other side were being intellectually dishonest with how the technology worked," lead trial attorney Tamir Packin said. "They were trying to change who contributed what and how the technology worked, and in doing so, there were inconsistencies with their testimony and documents that we exposed to the judge at trial."

Packin said that representing Cisco since the beginning of his career has allowed him to become quite familiar with its technology, and this understanding has enabled him and other Desmarais attorneys to dig deeper into the issues in patent cases.

"With repeat clients, you're well-versed from on-the-job experience just like an engineer would be if he worked for a company for a long time," Packin said.

Desmarais attorneys also helped Cisco escape \$75 million in patent claims in January when the Federal Circuit ruled it didn't infringe Straight Path IP Group's patent for technology enabling internet voice and video calling.

And in October 2018, Desmarais led IBM to victory in its first ever trial as a patent plaintiff when Groupon was ordered to pay \$82.5 million to settle claims that it infringed a pair of e-commerce



patents that came out when the internet was in its development stages. The two sides eventually reached a \$57 million post-trial settlement instead of taking the dispute to an appellate court.

Groupon argued the decades-old patents being enforced by IBM weren't applicable to modern e-commerce as they were made for Prodigy, an early subscriber-based IBM-affiliated internet service that did not cover standard web technology used by modern websites. Yet the judge ruled all of the patents were being willfully infringed.

In an interview with Law360, founding partner John Desmarais said that instead of licensing patented technology, modern companies have developed the habit of ignoring the patents and making their own products using that technology.

"Things have changed," Desmarais said. "It used to be that with a patent portfolio like IBM's, they would just go out to people using them, offer a license and negotiate and buy a license. There's a new set of internet companies like Groupon, Priceline and Expedia that have no understanding of the patent system. They feel they can just take the current technology and use it to their own commercial benefit."

Speaking of the firm's success, Desmarais said specialization has been one of the main keys. Almost every attorney at the firm not only has a legal background, but an engineering or scientific background as well, which Desmarais said gives them the advantage of being able to really dive into the technical details of cases without having to rely on outside experts.

"We're a unique combination of trial lawyers with technical backgrounds. When we specialize in doing technology cases, we bring a real understanding to both the science and legal part of the matter," he said. "It helps the client get the result they're looking for."

On the legal side, Desmarais said the firm is constantly training its associates from the moment they join. Associates receive annual mock trial training, which he says ensures even the most junior attorneys have the experience needed to succeed when representing one of the firm's clients.

"Clients come to us when they have a problem that is likely to be tried because they know that not just the partners, but the associates as well have a lot of trial experience — either from actual cases going to trial, or because we've put everybody through this trial training," Desmarais said.

--Editing by Philip Shea.