

Trials Group Of The Year: Desmarais

By **Daniel Siegal**

Law360 (January 13, 2020, 2:26 PM EST) -- By securing a victory for Cisco Systems in a rival's \$400 million patent infringement suit, Desmarais LLP maintained its standing as a go-to firm for companies trying to win an intellectual property battle, earning it a spot among Law360's 2019 Trials Groups of the Year.

In the past year, a Desmarais team headed into Massachusetts federal court for a three-day bench trial on software company Egenera's claim that Cisco infringed its virtual networking patent.

The lead trial attorney, Tamir Packin, said the case posed a unique challenge because Egenera claimed to have invented the technology underlying the patent years before filing. This meant the trial centered on decades-old events, and whether Egenera removed Peter Schulter — one of the inventors of the technology — from the patent to try to make the timing work. Schulter had joined the company after Egenera claimed the tech was invented.

"It was unusual for a patent case. ... All of the fact witnesses were Egenera witnesses who were trying to rewrite history," he said. "The goal was really to repeatedly expose the inconsistencies in their story."

Packin said the Desmarais team was able to do this by poring over internal documents dating back to when the technology was invented, which showed Schulter had previously been given credit for his key work — before he and the other inventors changed their tune amid litigation.

"We impeached them repeatedly and showed that what they were saying was inconsistent with the contemporary documents," Packin said. "The judge said explicitly in his order that these inventors were trying to rewrite history."

After the January bench trial concluded in May, U.S. District Judge Richard G. Stearns issued a ruling invalidating Egenera's U.S. Patent Number 7,231,430, agreeing it had improperly removed Schulter.

In a noteworthy development, neither John Desmarais nor any other founding partners were part of the trial team on the Cisco case. Instead, the first chair was filled by Packin — who joined Desmarais in 2010 as part of the first crop of attorneys that followed John Desmarais from Kirkland & Ellis LLP when he



launched the firm. He was joined by another pair of partners who were roughly a dozen years out of law school: Jonas McDavit and Peter Magic.

Packin noted that John Desmarais was still available as a resource, and that the team bounced ideas off of him and the other founding partners throughout the trial. But when the lights went on, the younger partners were running the show.

“Partners at Desmarais LLP really are trial lawyers — partner is not just a title like it is at a lot of places,” he said.

In fact, Desmarais was in the gallery at the trial.

“I felt like a father watching his kid; it was fantastic,” Desmarais said. “I never felt like, ‘I should be up there,’ or I had to take over. I just sat there with a smile on my face ... the firm’s developing beyond me.”

He said that seeing younger partners like Packin step up and obtain great trial results, as happened here, is part of what he’s been aiming for in building the firm.

“It’s not easy when the firm has my name on it, but my partners are very talented trial lawyers,” he said. “My goal is to make sure they can develop client relationships and get opportunities they should be getting based on their talent.”

The firm also followed up on its win for IBM this past year, securing an \$82.5 million verdict in the tech giant’s first patent trial as a plaintiff — which led to a \$57 million post-trial settlement — by winning two rulings from the Federal Circuit that upheld the patents at issue.

Karim Oussayef was part of both the trial team and the appeal team in the case, and said a big part of training at Desmarais emphasizes keeping appellate and patent courts in mind from the moment a case is taken on.

“I think that it kind of reflects the way the firm thinks about trial work in general, which is you always have a lot of audiences whether you’re litigating a case before an administrative body or a trial court,” he said.

Desmarais said his firm is trying to grow organically, rather than through mergers or lateral hires, so that it maintains its unique culture. He said it now has 61 lawyers, up from 54 a year ago.

Packin added that an advantage of working at a boutique firm is that it draws attorneys who are truly interested in the firm’s work, and who will stick with it for the long haul. As a result, Desmarais invests in its associates and other attorneys, he said.

“As opposed to associates who want to go to a big firm to get that experience and then move on to whatever else they originally wanted to do,” he said. “The fact that the people who come here are self-selecting and want to do what we do gives us a huge advantage because we can invest in them early and invest a lot in their training.”

--Editing by Philip Shea.