

AA Thornton: the best of both worlds

At IP law firm AA Thornton, patent and trademark attorneys work closely alongside lawyers to provide clients with the best of both worlds, as *WIPR* found out.

Any company with a reasonably large intellectual property portfolio will undoubtedly require the services of patent/trademark attorneys and lawyers at some stage in their life, and the closer the relationship between the two, the better.

This is the view of Geoff Hussey, partner at AA Thornton, an IP law firm with offices in London and Munich.

“Clients are constantly becoming more sophisticated and more knowledgeable, so they know it’s essential to have very good attorneys dealing with the day-to-day work on the IP portfolio,” he says.

“The closer the attorneys are with the lawyers that eventually need to work with pieces of IP, the better the service you’ll receive from those lawyers.”

One way to do this is to combine the forces of attorneys and lawyers, and AA Thornton has been very successful at that, says Hussey.

There’s a broad mix of professionals at the firm, including UK, German and European patent attorneys, UK and European trademark attorneys, and IP solicitors.

Hussey adds that AA Thornton is not the only attorney firm bringing solicitors on board and that the trend of cooperation is intensifying.

He explains that where lawyers are required to defend an action or enforce IP rights, it’s very common for them to work alongside attorneys.

Cross-border litigation

This is particularly true where there is either a requirement to know the background of the

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IP right or there are ongoing proceedings in more than one country.

For UK patent litigation, it’s common for there to be parallel proceedings at the European Patent Office (EPO), according to Hussey.

If this happens, it’s important for the practitioners conducting the two actions to coordinate, ensuring they’re putting forward the best case in both forums as the two systems have their own intricacies and ways of dealing with cases.

“Where parallel proceedings occur, it’s vital to ensure that what you’re doing in one forum is not going to undermine something you’re doing in another,” adds Hussey.

This is the same principle attached to parallel litigation in multiple jurisdictions: combining the skills of attorneys and lawyers enables an improved and more consistent work product to the benefit of the client.

Hussey has a depth of experience in parallel litigation, working closely with UK patent attorneys who run parallel cases at the EPO.

“Issues can arise where lawyers look at a particular problem with the approach of courts in their jurisdiction in mind; whereas attorneys might see the problem differently, with the perspective of what the EPO or UK Intellectual Property Office might do” he explains.

Hussey warns that it’s not always the case that the same argument is going to work successfully in both places.

The key is to identify this potential concern early on in the process and, by working together closely, to build an outcome that is satisfactory in both forums.

“It’s essential to keep an eye on the other action that’s taking place, to make sure you’re not doing anything that could adversely affect its prospects.”

Traditionally, the skills of attorneys and lawyers have not been combined, although this is becoming more frequent as clients look for a more cohesive service for their portfolio.

Cooperation can also provide numerous benefits where there is a large piece of contentious work taking place.

Solicitors may be instructed in relation to specific pieces of IP, particularly patents, but



because they have not traditionally been involved in the process of obtaining the IP, they may not have the required background of the portfolio to advise the business in the best way.

Patent and trademark attorneys do have this knowledge, which should be taken into account alongside, and as part of, the legal advice.

Combining forces also allows the practitioners to identify other potential uses or claims that may be available to clients.

Overcoming obstacles

The concerted effort can be far from perfect and potential issues must be dealt with early on, Hussey warns.

“In certain circumstances, you can find that a particular argument will work well in one

tribunal, but not in another, in which case there can be some tension between the arguments that attorneys and lawyers acting in those tribunals want to put forward,” says Hussey.

Some arguments work better in certain forums than in others. The challenge is to first work out whether either of the cases is more important, and second, whether it is in the best interests of both cases overall to deploy any particular strategy or argument in either case.

Ideally, Hussey says, practitioners will find a compromise in their arguments, which results in a slightly different but yet consistent approach being applied before the courts and relevant IP offices.



He adds: "All of these decisions must involve the client, but ultimately they are looking for advice on the best course of action."

"When an attorney and solicitor don't agree, a client could be stuck with conflicting advice. But when practitioners work together they can present a joint view as to the best way forward."

To overcome this obstacle, Hussey believes it is essential to develop strong professional relationships between attorneys and lawyers.

"If they're on the same page, they are able to look frankly and objectively at the overall picture, without becoming overly focused on their own particular case at the expense of other cases," he explains.

Cutting costs

Underpinning all the work done by both teams is the aim of reducing the cost for the client.

Attorneys and lawyers working together in the same business, as at AA Thornton, means that it's easier to exchange information, allowing cost savings to be passed on to the client.

"When one of our lawyers picks up a contentious case that has already been worked on by one of our attorneys, we already have a good level of knowledge about the issue, the wider portfolio, and the client," says Hussey.

A third-party solicitor will not have this depth of knowledge and so will have to read into the matter to a greater extent before they start the work, costing time and money.

Hussey, who joined the firm in May this year, believes that AA Thornton is well recognised in the patent and trademark attorney field as a result of "the calibre and quality of the professional and support staff".

AA Thornton advises a wide range of groups, including individuals, start-ups, SMEs, universities and multinational corporations.

"We have excellent relationships with all of our clients. This is driven not only by the quality of the work we do for them, but also by the regular portfolio reviews we undertake and our frequent visits," explains Hussey.

Partners at the firm regularly visit clients across the globe, providing face-to-face interactions that clients value highly.

As part of its offering, the law firm undertakes regular IP audits for its clients. This helps to identify what IP the client has and what it may be able to use, along with any gaps in protection.

A consistent approach also makes it harder for the opposition to show that the force of the argument has been watered down by running different arguments in different forums.

In the trademark arena, validity actions can be filed at either the European Union Intellectual Property Office (previously the Office for Harmonization in the Internal Market) or the courts, so a choice must be made.

Attorneys will be predisposed to file actions at IP offices, while lawyers tend to look to the courts. There are pros and cons to both systems, and in order to arrive at the right decision for the client it is essential that a dialogue takes place between the practitioners, according to Hussey.

He adds: "An audit provides a health check on where a company stands in relation to all of its IP. Today, IP is vital in every business, with all companies using some sort of branding in order to build and maintain their reputation."

It's also very common for clients to simply continue with certain IP registrations and policies that may be out of date, he cautions, and this can be discovered through the audit.

By abandoning certain trademarks or other IP rights that are no longer useful, there may be a considerable cost saving for clients.

The firm's audits also touch on employee contracts, ensuring that IP protection is dealt with correctly in contracts and providing advice on how to deal with IP that has been created during the course of business.

"It's important for businesses to understand how IP is created and how to protect it before undertaking certain acts that can render the IP no longer registrable," says Hussey.

"An audit isn't simply a record of what IP a business has, it's about providing advice on what IP that business should have and how that business can better protect the IP it creates." ■



Geoff Hussey is a partner at AA Thornton. He is also an IP solicitor whose practice spans litigation and transactions. He has particular experience in UK patent and trademark litigation, and coordinating parallel actions in other jurisdictions. Hussey works closely with the firm's chemical, electrical, mechanical and trademark attorney departments. He can be contacted at: gdh@aathornton.com