The Metropolitan
Corporate Counsel®

www.metrocorpcounsel.com

Volume 13, No. 6 June 2005

An Intellectual Property Practice Hits Full Stride

*The Editor interviews **Jon A. Baumgarten** of the Washington, DC office of Proskauer Rose LLP and **William M. Hart** of the firm's New York office.*

Editor: Would each of you gentlemen tell our readers something about your background and professional experience?

Baumgarten: I have been practicing in the intellectual property area for most of my professional life, which now exceeds 30 years. After graduating from law school in 1967, where I came under the wing of Prof. Walter Derenberg, then the dean of the American Copyright and Trademark Bar, I started practicing in this area, and as my practice intensified I gravitated even more toward the copyright and trademark areas. In 1976 I became General Counsel at the United States Copyright Office, a position I held through 1979. That was a particularly exciting time because we were in the final stages of a wholesale change in the law governing copyrights, and the Copyright Office was engaged in revising every circular, regulation and form for the policies and practices governing copyright law. In 1980 I returned to a private practice focused principally on copyrights.

Hart: I have been fortunate to work with some of the best IP lawyers in the field, including Jon and Alan Latman, a reknowned copyright scholar. Although I started in a boutique, I was one of the early converts to a bigger firm practice and as a result, developed interdisciplinary skills in diverse areas – music, software, Internet, IP, bankruptcy and commercial licensing, much of it in the international sphere. Those skills are invaluable to me, and clients, today.

Editor: How did each of you come to Proskauer?

Baumgarten: When I left the government I was looking to stay in Washington for family reasons. Washington also, I thought correctly it turns out, looked to be an interesting location for copyright practice, given the location of the Copyright Office, Congress, the FCC and other agencies and institutes that would be affected by copyright, and the presence of national trade associations for the entertainment and technology industries. Proskauer was looking to expand its Washington presence at that time and offered me a national base and strong litigation capability and reputation.

Jon A. Baumgarten

William M. Hart

Hart: I was at a large international firm and in the midst of a jury trial in San Jose involving a computer hacker when the opportunity to join Proskauer arose. The resources that Proskauer could offer to a practice like mine made the opportunity very attractive, and I did not hesitate about accepting the offer.

Editor: Would each of you give us an overview of your practice? How has it evolved over the years?

Baumgarten: My practice has a definite national scope. I spend as much time in our New York, Boston and Los Angeles offices as I do in Washington. Over the years, my practice has included both working with our litigators in major copyright cases where we have achieved a notable record, and a great deal of counseling, particularly in the areas of new media and new technology. I have spent an increasing amount of time leading teams of lawyers, business people and technologists in cross-industry efforts aimed at developing technical solutions to a variety of legal problems. That has been of particular significance in the motion picture industry, as it evolves into digital media and other new forms of capturing and redistributing content.

Hart: I began my career at a time when clients still seemed receptive to the idea of their lawyers doing a complete analysis of the impact of some issue on their overall position, which meant that a young associate – even a team of associates – would engage in research over many days, and the firm

Please email the interviewees at jabaumgarten@proskauer.com or whart@proskauer.com with questions about this interview.

would draft a comprehensive memorandum on the matter. Those days are gone. The clients want clear and accurate answers to their inquires, and they want them quickly. This makes training young lawyers a more difficult proposition than it was in the past. Today I spend my time in counseling activities, in transactional matters and in litigation and strategizing litigation. I am grateful that I was able to receive my youthful training under different circumstances.

Editor: Over the course of your careers, IP has become a mainstream discipline connected with every other practice of the law. How has this affected what you do?

Hart: At the start of my career I was part of a boutique practice called upon by the large general practice firms – which did not possess IP capability in those days – for our expertise. When I moved to a general practice firm myself, the barriers between my area and other disciplines began to come down. Today, I find that IP expertise is required in just about every area of the firm's practice. We work in interdisciplinary teams, and the connections must be seamless.

Baumgarten: I would echo much of that. The changes we have seen in our practices over the course of our careers parallel the changes our society has experienced. We belong to a society that places premium value on the products of the mind and on the ways in which those products are communicated to people, both individually and collectively.

Editor: Mr. Hart, for the past ten years or so, you have been involved in almost all of the leading "Internet content" cases. Would you tell us about this experience? What are the implications here?

Hart: In the 1994-1995 period the Internet was like Dodge City with no sheriff. While most practitioners believed that the traditional principles of copyright law would work pretty well in that environment, there were very few cases we could look to for guidance. I became involved with a client having serious trouble concerning its content being posted on the Internet, and that turned into a six-year campaign on the responsibilities to be borne by the Internet Service Provider. In the Northern District of California the court ruled that once the ISP is on notice that there is a copyright infringement, they have a duty to take action. There was considerable controversy about this case, and it resulted in the enactment of the so-called notice and take down provisions of the copyright statute. A similar case is currently pending before the Dutch Supreme Court. I see this particular issue as the focus of a great deal of attention over the next few years, both here and in the international arena.

Editor: Proskauer Rose has been celebrated for many years as an employment and labor law firm. Of course, it has addressed many other areas of the law, and with great distinction, but this is not generally known. Would you tell us about Proskauer's IP practice?

Baumgarten: Bill and I are both knowledgeable in other areas of IP law, but in my case the copyright issues tend to be at the center of my practice. The firm has a vigorous and growing patent practice, an important presence in e-commerce and Internet law, and very active trademark and false advertising practices as well. We also have a significant trade secrets practice, which includes an allied specialty dealing with the problem of key employees leaving and joining other companies. Of course, there is considerable interface with the employment and labor practice in that particular area, as well as in our sports practice and other areas dealing with ownership of IP rights among employed and commissioned parties and multiple participants. I do not think there is any area of IP law that we do not address with considerable expertise. We have a very deep IP bench, and it is resident in Boston and Los Angeles as well as in New York and Washington. We staff our IP projects from all our offices as appropriate, and we have access to the personnel and expertise of all of the disciplines and practice areas of the firm as well, wherever they may reside. And of course, our very well-known trial and appellate litigators are a critical component of our copyright practice, as they are to our trademark and patent and related practices as well. It was one of the things that attracted me to Proskauer, and has proven itself repeatedly over the years in successful precedent-setting cases that have fundamentally affected the development of copyright law.

Hart: I think it is a little difficult to pin down the number of IP lawyers we have with any precision. Proskauer has a renowned sports practice, for example, and this is an area where IP issues frequently arise, but I would not characterize this practice as an IP area. Similarly, our corporate people – and our trusts and estates people, for that matter – handle a considerable amount of work for some noteworthy composers, choreographers and other artists, but I do not think they consider themselves IP lawyers. What we have is a large group of lawyers who cover a wide range of IP issues, some on a full-time basis, others in connection with related – and sometimes not-so-related – practice areas. At the end of the day, these resources add up to an ability to address just about any IP issue that might arise.

Editor: What are the issues that you, as IP practitioners, expect to address over the next few years?

Baumgarten: The promise of technology – and more specifically the public perception of that promise – is a challenge most IP owners give a great deal of thought to these days. The public is interested in immediate gratification, and there are times when the rights of copyright owners are thought – shortsightedly – to get in the way of such gratification. I think most people and policymakers are beginning to understand the individual, domestic and international values of a sound copyright system, but that recognition may not be evolving at quite the same pace or with the same excitement as the technology and its promise, and that raises complex legal and business issues that we are closely involved with in the courts, in the agencies, and in the business councils of our clients, and I expect these will continue to grow.

Hart: Until the 1976 statute, copyright law was pretty straightforward. The statute was barebones and judges created law; now, the statute reads like the tax code. And with the tremendous impact that technology is having on this area of law, I think we are going to see the enactment of even more detailed provisions governing copyrights, and this at an ever accelerating pace.

Editor: Where would you like Proskauer's IP practice to be in, say, five years?

Baumgarten: We are heading in the right direction. We have a terrific group of lawyers working in allied areas and with regular contact and, if it is possible, I would hope that our expertise and involvement in important issues will in five years be as exciting as it is today.

Hart: I'd like to see us expand the international dimension of our copyright practice to capitalize on our know-how in other countries. In Europe, IP tends to be the province of specialty firms – as it was here in the past – and I think that is going to change. The key to success involves the delivery of value to the client, and I believe that Proskauer is very well placed to do precisely that.