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Q&A With Akin Gump's Dianne Elderkin

Law360, New York (May 15, 2012, 12:45 PM ET) -- Dianne Elderkin is a partner in Akin Gump Strauss Hauer & Feld LLP's Philadelphia office. A chemist by training and a registered patent attorney for more than 30 years, she has litigated patent infringement cases across a wide range of technologies. Elderkin has successfully tried cases to the bench and to juries, and she has represented clients at the Court of Appeals for the Federal Circuit and in numerous arbitrations. She is also a fellow in the American College of Trial Lawyers.

Q: What is the most challenging case you have worked on and what made it challenging?

A: Centocor v. Abbott, a patent infringement case we tried to a jury in the Eastern District of Texas that led to a $1.67 billion damages award. It was challenging because the case involved complicated recombinant DNA technology; the case got to trial quickly, meaning that a massive amount of discovery and pretrial activity was completed in a short time frame; and there were twists and turns that kept us constantly reviewing and altering our strategy. Unfortunately, our verdict was overturned on appeal because the Federal Circuit found an inadequacy in the patent disclosure, but I remain very proud of the work my team did on this case.

Q: What aspects of your practice area are in need of reform and why?

A: I am concerned about an anti-patent sentiment that seems to be driving some policy decisions and even underlying some court decisions these days. Rather than an appreciation that a strong patent system will drive innovation, there seems to be an undercurrent of belief that the system is somehow stymieing job development and that more and more hurdles should be erected to obtaining and enforcing patents.

Some of this has been fed by meritless lawsuits filed on questionable patents, and I think more and more district court judges are looking for new ways to ferret out these lawsuits and dispose of them quickly. I also applaud the leadership at the Patent Office for bringing in excellent people and working to transform how the agency does its work. There is still a lot to do to get the Patent Office back on track, however, and inadequate funding to get it done.

Q: What is an important issue or case relevant to your practice area and why?

A: It's hard to pick one. But since this is somewhat current, in view of SCOTUS' decision last month in Mayo v. Prometheus, I'd nominate the issue of promoting innovation in the area of personalized medicine. Personalized medicine — which seeks to customize health care to an individual patient — holds the promise of improving the quality of all of our lives and of helping us to rein in ballooning healthcare costs.

But decisions such as Mayo v. Prometheus and the Akamai joint infringement case (which is currently under en banc review by the Federal Circuit) have imposed real hurdles to obtaining meaningful, enforceable patent protection for inventions in this important area. I fear that it will not make business sense for even the most well-intentioned companies to devote research and development funds to this area if they cannot be assured of some period of exclusivity for their inventions.

Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.

A: This will seem like pandering because he is a client, but I've been saying this for years, even before he was a client — Phil Johnson, chief IP counsel for Johnson & Johnson. Phil is one of the smartest attorneys I know. I never come away from a meeting or discussion with him about a case without a good, new idea. He is also an amazingly quick study.

Q: What is a mistake you made early in your career and what did you learn from it?

A: In one of the first cases I tried, as an associate on the case, I naively put too much in a letter to one of our experts about our desired strategy. Of course, the letter was discoverable, and opposing counsel blew it up on a poster and referred to it repeatedly, to try to discredit the impartiality of our expert's opinions. We wound up winning the case anyway, but the experience was embarrassing, and I learned (a) a ton about work product waiver and experts and (b) to never underestimate how an opponent will try to twist the facts to make you or your case look bad.

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