

Student Edition

Careers

Attorney Profile

Q&A with Intellectual Property Lawyer Robert Zelnick



**McDermott
Will & Emery**

If you are considering a career in IP law, you have many choices to make: Will you specialize in copyright, patents, or trademarks? Do you want to litigate disputes or handle IP transactions? Would you like to focus on a particular industry? And what environment will best suit you: large multi-practice firm, boutique IP firm, in-house or other?

For Robert Zelnick, a partner at McDermott Will & Emery, the choice was ultimately a full-service trademark practice at a large firm, with special focus on trademark enforcement, trademark litigation, trademark licensing, client counseling, false advertising, unfair competition and related sub-disciplines. Bloomberg Law asked Robert to share how he found his niche in the law and how he continues to develop his practice.

Q. How did you come to focus on trademark law and unfair competition among the areas of intellectual property? What excites you about this field?

After settling on IP law, I spent the first few years of my career working on patent litigation matters. It was great experience, in that I worked with a small office of very talented IP lawyers, and I had really excellent mentoring. I also had the opportunity to attend a month-long patent trial as a third-year associate, where I learned so much about the “big picture” (and the many small details) of trial work. We won, at both trial and on appeal to the Federal Circuit, and I was hooked

Shortly after that, I shifted my practice to focus on trademarks when a partner from my firm’s Chicago office moved to Washington, D.C. I really enjoyed working with her and learning yet another style of being a successful big-firm lawyer. I also had the luxury of working with some of the world’s most famous trademarks, which to me was a lot more fun than the very demanding technical aspects of patent litigation. I also really like that preliminary injunction motions are more common in trademark matters than most other cases, because reputations are at stake; preparing for and arguing those motions is a kind of a mini-trial at the outset of a trademark case, which can be very influential on whether a case settles after that motion is decided.

Ultimately, while I am grateful that I learned how to litigate a complicated patent case, I find trademark matters to be much more “user friendly.” The trademark field also taps into my non-technical creative side, and it allows me to leverage my knowledge of the law to find ways to help clients succeed in their business. And in the way that patent lawyers are among the first to know about new technologies through their work, I love knowing about the next brand extension, the next marketing campaign, the next celebrity spokesperson, and the next “big thing” (in a marketing sense) before everyone else does.

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Q. How important do you think social media is for attorneys today? Is it part of your own business development efforts?

In my practice, there are two sides of social media. I advise clients on the use of social media in advertising, which is rife with many kinds of legal and business issues. Some of those involve creating new law to deal with the on-line world, and others involve applying centuries-old principles to adapt to a new medium. Either way, social media has had—and will continue to have—a game-changing role in trademark and advertising law.

The second kind of social media I deal with is in more of a promotional or “self-branding” sense. I don’t operate my own blog or website, but I enjoy contributing content where I can. As a lawyer, you become not just a consumer—but also a producer—of knowledge, and I look for ways to accomplish that. Social media offers a great way to reach and interact with a wide audience quickly.

Q. How much time you spend on keeping up on business information relevant to your clients, actual legal work, and business development?

In a perfect world, I do all of those things simultaneously Seriously, I have been quite lucky in my career, in that I have had many long-term trademark clients, where I have been able to learn so much about their business over the years. In that way, I have come to learn a great deal about a client’s existing and future business, and I bring value insofar as I can offer recommendations with that kind of long-term insight.

Learning about a client’s business is essential to the lawyer-client relationship. In addition to the substantive work, I review industry publications, frequently visit a client’s website and social media pages, and always look for a client’s products in the marketplace. In addition, I find that the truly engaging lawyer-client relationships are those where I am genuinely dedicated to the brand. I speak with pride about the clients I represent, and, aside from my own stake in remaining their counsel, I really do want to see my clients do well in the marketplace. I think it would be hard to fake that sort of commitment, especially over time.

As for the time commitment, I think you have to be prepared to do what it takes to achieve a firm’s employer’s productivity and financial expectations, and also to cultivate a client base that grows over time. A great piece of advice I heard many years ago is to do at least one business development activity every day. That could be as little as forwarding an article of interest to an existing or prospective client, having lunch with a law school classmate, or commenting on a blog, for example.

Q. McDermott Will & Emery is a large multi-practice firm. What do you think are the advantages to working for a general practice firm as opposed to a boutique IP firm?

I have worked in both, with 6 years at an IP boutique firm, and the balance of my career in a large general practice firm. The boutique experience offers a full-time immersion in IP law, and a boutique offers great depth of expertise and specialization in many subsets of IP law.

However, a general practice firm opens the door to so many more client relationships. My opportunities to represent so many amazing brands came in many cases from my partners who had established relationships with the brand owners in some other way—as tax counsel, as estate planning counsel for their executives, as a fellow board member of the company, and so on. In my experience, practice at a general practice firm also offers a much more comprehensive view of a client’s larger business objectives, and how IP matters fit into major corporate transactions.

What is great about McDermott is that IP law has been a major practice area since my colleagues and I joined the firm in 1996. I would not want to practice law in a firm that merely dabbles in IP law, and it was always very important to us since we joined in 1996 that McDermott was dedicated to supporting a full-service IP practice. Ironically, with 200 or so IP lawyers, McDermott’s IP practice is bigger than the vast majority of IP boutique firms, so I don’t feel like I had to trade advantages to move here.

Q. What do you think the greatest opportunities in IP law will be within the next five years?

IP law awards protection for those who create something new. Novelty is something that is rewarded in both existing and new industries, whether as a new form of renewable energy, a new vaccine, a new video game, a new reality television show, or a new kind of mattress. All of those things have (or will have) a brand associated with them, whether as a “brand”-new name or as an extension of an existing brand. As long as we create new things, there will be a strong need across the IP spectrum.

Q. Any other advice for law students?

Be practical. More and more, clients want an ultimate recommendation that is informed by the law. Law is important in making a business recommendation, but remember that a client needs to make smart business decisions, too. The art comes in figuring out how to achieve both.

Don’t forget the fundamentals. You can have 100 cases that seem to be decided in favor of the principle you are advocating, but at the end of the day—and especially in trademark law—the result you are seeking needs to persuade the court under the facts of

that particular case. Trademark and unfair competition law are great fields to argue that your side is more “right” or more fair than the other.

Don’t be afraid to say “I don’t know.” But then also follow up to find out the answer.

Robert Zelnick is a partner in the Washington, DC office of McDermott Will & Emery LLP. From 2001-2010, Robert was head of the Firm’s Global Trademark Practice Group, where he grew the Firm’s trademark group to be a “top 10” ranked trademark litigation and trademark prosecution practice among general practice firms. He can be reached at rzelnick@mwe.com.