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# Career opportunities – transitioning from in- house to private practice

**While they may appear to be two sides of the same coin, moving from an in-house trademark role into private practice requires proper consideration, with both personal and professional factors coming into play**

Speak to lawyers who have left an in-house role to go back into private practice and you inevitably hear a diverse range of reasons for the move.

For Barry Krivisky, sole practitioner and formerly of Altria Corporate Services, the turning point came when he declined an assignment to Switzerland for personal reasons and realised that he did not want to have to get to grips with another corporate culture after almost 20 years with Philip Morris (later Altria).

By contrast, Gregor Vos, a lawyer with Klos Morel Vos & Schaap, missed the diversity of IP litigation and found the prevailing structure at Unilever – where the IP function had been divided into specialised trademark, patent and marketing departments – too restrictive for his tastes.

The desire to work across a broader commercial spectrum was at the heart of Frank Politano's decision to leave telecommunications giant AT&T in 2006. Now a partner at K&L Gates, he explains: "AT&T had a great law department, where you did as much work in-house as possible. Of course, from time to time you hired external counsel, but it was essentially a department that did everything. I was there almost 20 years and just thought it was time to try something different.

"While I loved working in a corporation, it was focused on one industry and I wanted to try something different, and make the change while I was still relatively young. It is fun to now have clients that are in cosmetics and chemical products, as well as telecoms."

For Cantor Colburn LLP partner Curtis Krechevsky, meanwhile, the move from Reebok after more than 10 years in-house stemmed in part from the corporate culture in which he found himself: "At the time, it was quite unusual for someone who, to all outward appearances, had a very desirable in-house role to make that move. But I was the second most senior counsel and I was starting to feel a little stale. I knew my job backwards and I had a terrific staff, but I was having trouble visualising myself retiring from Reebok. It is a very youthful company and I could not see how I would stay into my 60s. Putting aside whether I had suitable training to assume that role and whether I would have the opportunity, I had no desire to

take up the position of senior counsel.

"In the meantime, my best friend from the Reebok legal department had left and joined a mid-sized firm in Boston with a mission to build its first IP department. The entrepreneurial aspect of building a department from the ground up was attractive to me, in addition to being able to work with my friend again. I also figured that if I stayed in-house any longer, it wouldn't make the move any easier, as a lot had changed in the practice of law while I was in-house."

## The myth of billing hell

Whatever the reason for returning to private practice, the one commonly cited activity that seems to strike fear into the hearts of the bravest lawyers is time keeping – or so the theory goes. But speaking to those who have faced up to this challenge, it would appear that in reality this turns out to be rather less troublesome than anticipated.

Natalie A Remien, principal at Remien & Associates, acknowledges that operating within a system in which time is tracked and accounted, instead of progress being measured through project completion or results, can take some adjustment. However, for Vos – who was not out of private practice for as long as some of his peers – accounting for time and billing came straight back to him: "These are just routines. A lot of people complain about timesheets and billing – and it isn't one of the best sides of the job – but it isn't such a burden that it bothers me. It is a benefit if you don't have to do it, but isn't that bad. When I drive my car, sometimes I have to stop to get gas or else I can't continue driving. It is as simple as that."

Krechevsky agrees: "A lot of people, when they heard that I was making the switch, said that I would hate returning to the life of keeping track of my time and making sure that I am meeting expectations in terms of billable hours. But that turned out to be a non-event for me. My feeling is, if you are an organised individual, spending a few additional minutes recording the time you need to bill a particular client isn't a big deal."

Indeed, for some – particularly those who have worked in companies where legal time and expenses are billed to internal business units – there will be little change at all.

But while tracking time may not require a revolution in one's daily practices, several other differences between the in-house and private practice roles can demand more attention. The first is adapting to the changes which occurred while the lawyer was in-house. Politano explains: "If you are familiar with the story of Rip Van Winkle, who fell asleep for 20 years and found many changes in his village when he



"My in-house experience has really allowed me to understand much more quickly what the client's perspective is and speak their language. I don't speak purely as an outside lawyer who has never done anything except work in a law firm, and I'm pretty confident that this has left me at an advantage."

**Curtis Krechevsky**, Cantor Colburn LLP



"It is fair to say that lawyers have a reputation of being cocky or can be seen as arrogant. It is good to have been in-house, as you know better what your clients want—and that your role for that company is not as highbrow as you may have thought."

**Gregor Vos**, a lawyer with Klos Morel Vos & Schaap'

woke up, that was how I felt. There had been a lot of technological changes in the practice of law from when I left it in 1984 to when I picked it back up in 2006. The biggest is the unbelievable ways that data now can be instantly manipulated. Another is the predominance of the Internet and communications, with legal research now carried out at your desk. When I left private practice, people didn't have computers on their desk – there was one in the accounting department, I think, and secretaries had word processors, but they were little more than that. That technology was a big change for me and really illustrated how much more efficient lawyers had become."

### Trading in-depth knowledge

Another big change is the shift from working for a single company – immersed in its corporate culture and knowing exactly how it functions – to servicing clients across a wide spectrum of industries. Krechevsky elaborates: "One of the advantages of being in-house is that you have one client base which is all related – although if you are with an international conglomerate, you may have a range of different internal clients. Going back to private practice, you do trade off the intimate knowledge of one client to learn the various industries and needs of your clientele. After being in-house for so long, that variety really agreed with me and I have enjoyed branching out."

However, one side effect is that you essentially become disconnected from the internal decision-making process, oblivious to the diverse forces that may be influencing the company's actions. Krivisky advises: "The thing to realize is that corporate decisions are made on many levels and for many reasons, and as outside counsel you have to learn when to try to persuade the client to follow your recommendation and when to accept the client's instructions to the contrary."

"Because Philip Morris had deep pockets, I almost never got asked what something would cost. In private practice, particularly in today's economy, that is the first question. Clients want to know how much it costs and often decide not to take action. Whether that is the smart thing to do or not is not a question for outside counsel to answer. It is a business question."

"In addition, the answer is not always budgetary. There are times when multiple stakeholders are involved in making decisions, so you may recommend taking a course of action and have the client not accept your recommendation without fully knowing why. I saw this at Philip Morris – a major competitor's chief executive declared that they were going to teach us the morality of the marketplace and the battle went on for almost a decade. The dispute made no sense and eventually settled, but it was personality taking the lead. People don't get appointed as chief executive because of their rationality

– they need a driving force and sometimes you have to go with it."

On top of internal politics, industry developments can shape the decision-making process and external counsel thus need to keep a finger on the pulse of the diverse sectors in which their clients operate. While at AT&T, Politano found himself dealing with regulators and even testifying in Congress on issues such as database protection – a result of being able to focus in depth on a single industry. When moving back into private practice, while you will not be engaging with policy and industry regulations to the same degree, there is still a need to understand the factors that play in different sectors.

Krivisky expands: "Philip Morris faced a lot of issues by virtue of the type of products it sold. It was almost never a pure trademark question – you would also have to take into account public relations and government regulation aspects. When you work for a company that is selling, say, nuts and bolts, you probably won't have these health issues, government regulation or advertising restrictions to consider; but we did."

"For example, when I was there we did not register our marks in countries where use was not a requirement or where you could file in classes and get a registration as long as no one challenged you for non-use. So we didn't file for tobacco marks in the toy class, say, even though it would have helped us to prevent other companies from adopting similar marks on children's products."

"This was because if we did register our marks for toys, the anti-tobacco lobby would say, 'Here is proof that Philip Morris is intending to market products to children.' In fact, we would be doing it to prevent others from using our trademarks on products for children, but we just couldn't. The negative press would not allow us to explain to the public why we were doing it. We would fight aggressively against people using our marks on children's products, but we would always start with one hand tied behind our backs, because we didn't have registrations in those classes."

### Getting competitive

While moving to private practice means leaving behind the in-depth knowledge of a particular industry and appreciation of a company's internal dynamics, this insider experience nonetheless represents a major competitive advantage.

An understanding of exactly what clients are seeking, how they analyse and treat bills, how work must be cleared before time is spent on it and how different factors can influence a course of action is invaluable in cultivating the client-attorney relationship – both in making the initial pitch and in ensuring that the

The decision to move into private practice goes beyond a consideration of working habits nature of the legal work undertaken.

For Remien, the factors that need to be weighed up when considering the change include “levels of fulfilment, the desire to advance, compensation/benefits, workload, interest in the work, burnout, the ability to expand one’s skill set, autonomy or lack thereof and/or opportunities for pro bono work”.

The question of autonomy is key. Vos argues: “You have to appreciate being independent – I work harder now, but am more relaxed as I enjoy what I am doing and like being independent. However, if you know that you are happier in a staff role and having a well-balanced private/working life, industry may be more suited.”

This creates a very different dynamic in terms of client relationships. He adds: “Being in-house teaches you a lot about your role as an external adviser. I think it is fair to say that lawyers have a reputation of being cocky or can be seen as arrogant. It is good to have been in-house, as you know better what your clients want from an external lawyer – and that your

role for that company is not as highbrow as you may have previously thought. You are essentially an external supplier – and that’s fine, but you need to recognise that.”

This external adviser role also means that you are detached from wider business questions: your remit is restricted to purely legal matters. Therefore, it is important to consider how important this aspect of your role is. Politano admits: “I do miss being involved in making decisions. Even though in-house lawyers are looked upon to provide legal advice, they have a wealth of knowledge and history of the client, company and product lines – perhaps more so than management, who get moved around a lot. So I would be involved in high-level decision making. The clients would look to us to give, in addition to legal advice, practical business advice, which was almost always taken. I do miss that closeness to the client and involvement.”

For some, the desire to retain this closeness can be seen as a useful way to add value to the attorney-client relationship. Krechevsky explains: “The kind of intimate personal and professional

relationships that you can build through working with and supporting the same people every day are not easy to achieve as an outside practitioner, but I have used that experience to try to cultivate relationships with certain clients that come close. For example, we have one large client which is not located in my geographical location, so I visit them several times a year, spending a few days at their offices, essentially holding office hours. If there is nothing related to that client’s matters to take up my time, then I spend the time working on other client matters. But being physically able to sit there as one of the team is an invaluable thing if the client welcomes it. In this case it has worked well, and in an emergency, if the lead is unavailable, it means that other team members feel comfortable contacting me in that person’s absence. I welcome that and am glad they feel that comfortable with what we bring to the table – and that I am viewed as an extension of their team.”

With client generation so crucial to the external counsel role, a distinct commercial drive is also required. Politano suggests: “It is all about your personality. If you like being entrepreneurial and going out to

sell yourself and your firm, then an in-house role is perhaps not for you. If you like doing a wide variety of work, in a variety of fields, it is great to be a specialist in a general practice law firm. I get exposed to everything and it has been great for my overall development as a lawyer.”

Reviewing the various factors that should be assessed, Krivisky concludes that personal motivators should be prime considerations: “There are pros and cons in all decisions. On the one hand, you have a bit more leeway in your daily functions in an outside role, as you aren’t part of the internal organisation. There is benefit to that as you don’t have to mould yourself to a corporate culture. On the other hand, you lose the camaraderie and teamwork aspect of the corporate environment; and I mean ‘team’ in terms of both the trademark department and the multiple teams in the corporation – the marketing department, the sales force and so on. You lose that to some extent going outside. In terms of the work itself, traditionally people see it as a different type of work inside and outside, but I really haven’t found that to be the case.”

continuing relationship is a fruitful one.

Pondering on how her in-house experience has helped in her current role, Remien is quick to highlight the commercial nous that you develop in-house as a real asset: “As associate counsel, I was tasked with gathering discovery evidence, generating necessary reports from different departments of the business and reviewing outside counsel’s bills, among many other things. Business sense is invaluable when making the move to outside counsel, because the attorney has already seen the client’s perspective, its practice habits, demeanour and bills. In the outside counsel role, I was then able to capitalise on my first-hand knowledge of the types of pressures that an in-house attorney faces and leverage that knowledge to provide a better service.”

Putting this to practical use, she notes: “One of the most important things that external attorneys can learn from in-house attorneys is the attitude and/or risk level of the company. By getting a flavour for the culture and risk tolerance, an outside counsel can gain valuable insights as to how best to negotiate and/or litigate for that specific client’s needs.”

Krechevsky agrees: “Moving to private practice, my in-house experience has really allowed me to understand much more quickly the clients’ perspective and speak their language. I don’t speak purely as an outside lawyer who has never done anything except work in a law firm, and I’m pretty confident that this has left me at an advantage. I spent so long in-house that when I get the opportunity to pitch prospective clients, they can see, ‘Here is someone who gets it – who knows what they need and can deliver

advice in a user-friendly, pragmatic, business-friendly sense,’ rather than providing a long legal review that covers all the ins and outs, but not actually giving advice on what they should do.

“The best legal advice is cogent, tight and allows the client to ask for more detail if they want it, but doesn’t assume that they want it. If there are options that the client should select from, then rather than just listing them, giving your assessment of which is preferred or ranking them is a highly desirable way of delivering advice.”

An understanding of how cost is approached is particularly useful. Krechevsky now routinely provides an approximate cost of what each option will likely entail if selected, even if he is not asked to do so. Similarly, he provides an idea of likely success: “A practice I learnt at Reebok was to ask outside counsel to put the risks of each option in percentage terms.

‘When I first started asking for this, it was like pulling teeth – counsel would say, ‘It is more likely than not.’ But I wanted to know how much more likely. Fifty five percent? Seventy five percent? It wasn’t that I thought the percentages had any magic about them or I would hold the firm to them, but it gave me a better ability to communicate to other in-house businesspeople. I could say, ‘We have a one in three chance of winning here’ and, in terms of the money at stake, we could decide whether that was a good risk to take. Quantifying risk – even on the understanding that it is a rough estimate at best – is a very good thing to do.”

### Taking the lead

Any competitive advantage that can be leveraged is crucial, since

client generation is central to the private practice role. In many corporate structures, the in-house counsel is often the first person called when a legal query arises. In private practice, this all changes; and lead generation is duly cited as one of the biggest challenges that accompanies the move into private practice.

Politano notes: "You have to work to get work. When you are in a corporation, everyone calls you all the time because they are not paying for your services. In private practice, you have to develop clientele. They don't call you unless there is something really important. It is a big change."

One expectation when leaving the in-house role might be that the relationships which you have forged with outside counsel around the globe, and the instructions you have placed with them, may result in work flowing to your new practice. However, external counsel would suggest that the reality is rather different.

Reflecting on the relationships he developed while at Reebok, Krechevsky says: "I did have the opportunity to place a significant amount of work with a large number of international firms both inside and outside the United States. My expectation was that I might see some return business as a favour to me, but that really did not happen. As far as having people whom I considered to be friends and colleagues in firms around the world, many just didn't have the work coming into the United States to send.

In addition, what I hadn't thought through as much as I should have is that even where firms are located in large domestic markets with a sophisticated clientele that would send work to the United

States, they had a number of pre-existing, longstanding business relationships with other firms. Just because they personally thought the world of me, it was not necessarily enough to interfere with those prior relationships."

Ultimately, there is no checklist that will fit all individuals and circumstances, but the decision to transition from an in-house role is one that needs to be fully thought out, encompassing both personal and professional considerations.

The former certainly should not be taken lightly, as Krivisky muses when asked what he really misses about working in-house: "What do I miss? The team atmosphere, with everyone working for the same goal. That, and the fitness centre and management dining room..." **WTR**

**Trevor Little**, *World Trademark Review*



HUMAN ATTITUDE TO PARTNERSHIP

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