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Q&A With Sheppard Mullin's Paul Garrity

Law360, New York (July 18, 2011) -- Paul W. Garrity is a partner in the New York office of Sheppard Mullin Richter & Hampton LLP. He is a litigation partner and a member of the firm's intellectual property and business trials groups. He has litigated a wide range of intellectual property matters including trademark and trade dress infringement and dilution, false advertising, Internet and domain name law, anticounterfeiting, copyright infringement, right of publicity, misappropriation, trade secret and patent infringement matters.

Garrity also counsels clients on the establishment, exploitation and maintenance of their intellectual property portfolios, including domestic and foreign trademark clearance and prosecution.

Q: What is the most challenging lawsuit you have worked on and why?

A: Defending Perrigo Company in a false advertising litigation brought against them by Rexall Sundown Inc. in the Eastern District of New York. Perrigo is the leading manufacturer of store-brand products in the United States, and was sued for using a "compare to" statement on a dietary supplement. The trial involved competing constructions of the Lanham Act, together with extensive expert testimony on consumer perception and competing testimony on the efficacy of the products.

Underlying the suit was a veiled attempt to cast the store-brand manufacturers as bottom-feeders harming competition. We needed first to gain the confidence of the jury in the store-brand product category, and to then proceed to establish that the mere use of a comparison statement on a product label did not communicate that the store-brand product contained the identical ingredients as might be found in the national-brand product.

We succeeded on both tasks. Ultimately we not only secured a complete defense verdict on the plaintiff's claims, but also won a judgment for Perrigo on its counterclaims in the case.

Q: Describe your trial preparation routine.

A: Full immersion. In the period leading up to a trial and throughout the trial I stay at the office. I run 5 miles each morning and work through openings, cross-examinations and upcoming arguments. I eat meals with my trial team and with upcoming witnesses. While I miss my family a great deal, I believe that the pretrial investment of time and intense focus exposes the strengths and weaknesses of a claim.

A trial, while it can be a rewarding professional experience, is a difficult undertaking. As a result, my trial preparation routine is to immerse myself in the suit in an effort to ensure that it is not possible to be better prepared for the proceedings and the contingencies which arise out of the testimony and rulings during the trial.

Q: Name a judge who keeps you on your toes and explain how.

A: Judge Joseph Tauro in the District of Massachusetts. We were before the judge in a jury trial defending our client from copyright infringement involving very complex software. Judge Tauro has very severe limitations on discovery and did not permit expert discovery. I had to develop my cross-examination of the plaintiff's experts while they were on the stand.

Q: Name a litigator you fear going up against in court and explain why.

A: The only person that I fear is my 88-year-old mother, who still reminds me each day to make my bed.

I have been privileged to have litigated against a number of first-class litigators and respect many of them as excellent advocates for their clients. I have the utmost respect for Bruce Keller of Debevoise & Plimpton, who remained a consummate professional from start to finish in connection with an interesting trade dress case.

Q: Tell us about a mistake you made early in your career and what you learned from it.

A: As a young lawyer, I was in charge of preparations for a Markman claims construction hearing in the defense of a patent infringement suit. The case involved a mechanical patent directed to cutting polystyrene foam sheet. The partner in charge asked me to prepare demonstrative materials, including a model, that might be used at the hearing. My mistake at the time was not to ask enough questions about the task that was assigned to me.

As a result, I did not understand what the partner intended to do with the model, which was to attempt to replicate the operation of the machinery (which was quite large). I worked with a model maker and created an excellent rendering of the tooling — that was the size of a banker's box.

When we arrived at the hearing, I found that our adversary had a model the size of a newspaper kiosk. It was moment straight out of the movie "This Is Spinal Tap." During the arguments, when the judge could not see a feature on our model, my partner was forced to rely on the plaintiff's model.

Ultimately, I watched in horror as my model slipped from the partner's hands and broke into dozens of pieces on the floor. After the judge finished laughing, we succeeded in securing an excellent claims construction, which ultimately allowed us to prevail in a summary judgment motion in the case. But that was not until I learned to ask enough questions of a client or colleague to always ensure that I understand the scope of any task at hand.