

THE RECORDER

For 80-Year-Old San Francisco Firm, IP Is a Family Tradition

A portrait of a man wearing thick, black glasses and a half-smile hangs beside an ornate grandfather clock that belonged to him and his father, ticking steadily.

A. Donham Owen gave up his patent practice shortly before his death four decades ago. But the firm he started in 1933 lives on with his son and grandson, who display his heirlooms in the lobby of San Francisco's Owen, Wickersham & Erickson.

Through three generations, the intrigue of intellectual property work -- and the satisfaction of practicing in their own small shop -- has never faded for the men of the Owen family.

"A lot of lawyers burn out early," said A. Donham's son, Melville, 80, who was at the helm for nearly a half-century before passing control of the firm to his son, Gregory. "But with trademarks, you are dealing with something new and protecting it and watching it grow."

Owen, Wickersham & Erickson has become something of an anachronism. The corps of classic San Francisco firms with which it emerged have gone global or extinct, with few exceptions. Yet as it celebrates its 80th anniversary, the nine-lawyer shop carries on, serving a mix of startups and Fortune 500 clients and regularly rejecting merger overtures from large national firms

looking to plant a flag in San Francisco.

Its survival, coupled with its heritage, sets it apart. Although there have been a number of prominent examples of family-owned firms in the Bay Area -- including the Law Offices of Joseph L. Alioto and Angela Alioto and Hersh & Hersh -- IP lawyers are hard-pressed to name another clan like the Owens in their space.

There are lineages to be found in the histories of several native San Francisco firms, such as the Sutros of what was then Pillsbury, Madison & Sutro or the Townsends of the firm formerly known as Townsend and Townsend and Crew. But the anti-nepotism rules that became popular later in the 20th century have cut some of those family trees short. Lawrence Townsend, counsel at Owens, Wickersham & Erickson, is a fourth-generation IP specialist, but he could not join his family's firm, Townsend and Townsend and Crew. His office, like Gregory "Greg" Owen's, is furnished with his grandfather's desk.

The Owens have practiced IP law since before the term was coined,



Gregory Owen, Melville Owen and Noel Cook of Owen, Wickersham & Erickson

Greg noted, and their firm brought one of the field's defining cases. In 1980 name partner Robert Wickersham argued *Diamond v. Diehr* before the U.S. Supreme Court, winning a 5-4 ruling holding that a machine controlled by a computer program could be patented. The ruling is often cited in modern-day cases before the U.S. Court of Appeals for the Federal Circuit and the Supreme Court as justices wrestle over what is patentable, said Michael Jacobs, co-founder of Morrison & Foerster's intellectual property practice group.

As Edward Reines, an IP partner at Weil, Gotshal & Manges, puts it: "Their firm was at the forefront of patent litigation before everybody got involved in patent litigation."

Today, the firm's clients range from wineries to artists to national brands like CooperVision and Sherwin-Williams Co. Aided by its younger lawyers, the firm is also pursuing more work with startups, said principal Noel Cook, who leads the firm with Greg.

"From art to high-tech to toys ... we have a real variety in our client base that hedges against trends," Noel said.

A patent shop was a natural fit for A. Donham Owen, an inventor with several patents to his name. One of his inventions was "A La Orange," which slices citrus into eight even pieces. Melville, who goes by "Mel," uses the device every day.

Mel wrote just one patent application, for a french frying machine -- "absolutely dull and uninteresting," he recalls. He favors trademarks, and his father was happy to cede him that side of the business when he graduated from law school. The firm now does only trademark and copyright work -- known these days as "soft IP," Greg notes.

"Is that the term?" his father asked incredulously. "I had not heard that."

Mel still practices. And he is quick to crack a joke. He is never without a hat or his golden harmonica, which he retrieves from his breast pocket during a lull in the conversation to play "Hail to the Chief." His son, 53, has not adopted either custom.

But Mel and Greg say they are the same class of lawyer, both pragmatic and eager to resolve disputes. After years of collaboration, they have a finely tuned working relationship -- Greg refers to his father as "Mel" in meetings with clients and colleagues

and "Dad" in one-on-one conversations. The pair has held many successful negotiations aboard their boat, Pat Pending, a classic cruiser that has been in the family since 1940.

"We threatened to throw the other side overboard, and they settled," Mel explained.

Humor is not only Mel's manner but a tool he has used to resolve disputes. One longtime client, "Peanuts" distributor United Feature Syndicate, received a cease and desist letter from the Boy Scouts of America when they produced a Snoopy dog dressed as a Beagle Scout. He wrote to United Feature Syndicate's counsel that the dog consulted with his lawyer before joining the club and would not have enrolled if he didn't think it was "honest, trustworthy and legal."

The opposing lawyer was persuaded to drop the matter. "Good grief, I think you're right. Sigh," he wrote in response, Mel said.

Snoopy and other characters that the firm has defended are on display in the office that Gregory inherited from his father, arranged to train the eye in the subtle differences between the genuine and the knockoff. Many of the products, still outfitted with exhibit tags from trial, contain technology that was cutting edge at the time, such as a teddy bear that murmurs when spoken to. When Cook joined 23 years ago, the stuffed animals gave him insight into the firm's atmosphere.

"It's a tremendous combination of excellence and friendliness that is quite hard to find in the legal world," he said.

And some of the brands require constant vigilance. Japanese company Sanrio has been a client for 35 years, and the firm strikes down some sort of Hello Kitty infringement each day, Cook said. Searching for an example, Mel reaches under the couch to produce a skateboard that features the signature cat with a bullet hole in her forehead. "Bye Bye Kitty," the board reads. It didn't stay on the market for long.

"We keep kitty out of trouble," Mel said.

The three men laugh, and the teddy bear murmurs in response.

Having grown up playing with these trademarked toys, Greg always knew he would follow Mel into the law. One of Greg's sons wants to be a dramaturge, but the other is contemplating a career as a lawyer. Will he be the next to lead Owen, Wickersham & Erickson?

"As long as he is a good lawyer," Greg begins.

"And is willing to work for a reasonable price," Mel interjects.