

Orrick Hires Silicon Valley Vet with International Credential

By Scott Graham

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Orrick, Herrington & Sutcliffe is bringing in Silicon Valley veteran James Pooley to help clients worldwide negotiate new federal and European trade secret laws.

Pooley recently served a five-year stint in Switzerland as a deputy director of the UN's World Intellectual Property Organization. Orrick is banking on robust demand for his expertise and international perspective as global companies sort out the federal Defend Trade Secrets Act, signed into law May 11, and the European Trade Secrets Directive, adopted by the EU Council two weeks later. The 67-year-old litigator joins the firm as senior counsel.

"We are ecstatic that Jim has joined Orrick," said Denise Mingrone, chair of the firm's intellectual property practice. "He will be a unique resource for our clients given his diplomatic experience, his academic



RETURN TO BIG LAW: James Pooley is back in the law firm fold after a stint as deputy director of the UN's World Intellectual Property Organization.

credentials, his prodigious scholarly output and his leadership in global IP platforms."

Pooley is a former president of the American Intellectual Property Law Association whose skills include patents, cybersecurity and international arbitration. But he's been writing books about trade secrets since 1982, starting with

"Trade Secrets: How to Protect Your Ideas and Assets."

In that era, guarding the photocopier and monitoring who entered and exited the premises put a lot of companies ahead of the game, Pooley joked in an interview last week. Now clients are asking, "How do we manage information in a world where we

have to share it with so many global partners?”

His latest book, published last year, sounds more 21st-century: “Secrets: Managing Information Assets in the Age of Cyberespionage.”

Orrick IP partner Neel Chatterjee said he reached out to Pooley last year after Pooley finished up his WIPO stint. Chatterjee got to know Pooley 20 years ago when Chatterjee was a judicial law clerk and Pooley was helping train the judiciary on IP law. The two have also worked together representing co-defendants in a complex patent infringement dispute.

“Jim is a legendary figure in IP circles,” Chatterjee said. “We are very fortunate to have him join our team.”

At first, Pooley wanted to stick with his solo practice and advocate for passage of the Defend Trade Secrets Act. Once the measure was signed into law, joining forces became irresistible, he said. Orrick has an established focus on trade secrets and recognizes the tie-ins to privacy and cybersecurity, Pooley said. Plus the firm has offices across Europe, including Geneva and Asia. Orrick estimates that 25 percent of its practice is outside the United States. “That really matters in being able to deliver on

what I developed during my time in Switzerland,” he said.

This is not Pooley’s first Big Law rodeo. He began practicing at Wilson Sonsini Goodrich & Rosati in 1973. He also has worked at Graham & James; Fish & Richardson; Gray Cary Ware & Freidenrich; Milbank, Tweed, Hadley & McCloy and Morrison & Foerster.

The Obama administration appointed Pooley to WIPO in 2009, where he managed international patents under the Patent Cooperation Treaty. He sparked some controversy when he filed a whistleblower complaint against WIPO Director General Francis Gurry in 2014. He and a senior adviser to Gurry testified before the House Foreign Affairs Committee earlier this year that Gurry had improperly approved shipments of IT equipment to North Korea. Five members of the committee subsequently called on the State Department to demand the UN make public an investigation into WIPO practices.

Pooley also testified before the Senate Judiciary Committee in December in support of the Defend Trade Secrets Act. “Today’s technologies and international markets pose threats,” he told the committee, “that cannot

adequately be addressed with inefficient state laws designed for a simpler and less risky time.”

Momentum has been building behind trade secret protection even before passage of the DTSA, Pooley says. Eight- and nine-figure verdicts have become more common over the last five years, even as federal courts have been dialing back the reach of patent damages.

In a trade secrets case, “there’s always some morality play” that carries the risk of a punitive award, he says, “because the conduct being proven is treacherous and traitorous.”

Pooley, who is also co-author of the Patent Case Management Judicial Guide, says he remains bullish on patents. He sees them as “core IP rights” because of their power to exclude. “But trade secrets,” he says, “are in ascendency.”

