

## Influential Women In IP Law: Cynthia E. Kernick

By **Bill Donahue**

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Winning this April's Highmark ruling at the U.S. Supreme Court might have been enough to earn Reed Smith LLP's Cynthia E. Kernick a spot among Law360's Influential Women In IP Law, but the ruling at the high court was only the latest success for the intellectual property litigator.

Kernick, a partner at Reed Smith's Pittsburgh home base, represented Highmark Inc. through more than a decade of contentious patent litigation with Allcare Health Management Systems Inc., which claimed the Steel City-based health insurer was infringing a patented system for integrated health care management.

Eventually, the district court ordered Allcare — which it described as a "patent troll" — to pay nearly \$5 million in sanctions for bringing "meritless allegations" and for "deceitful conduct" during the long-running case litigation.

In 2012, though, the Federal Circuit nixed part of those sanctions. A split panel of appellate judges said that sanctions rulings like the one against Allcare should be reviewed de novo, with no deference to the trial court's judgment.

Kernick took that decision to the U.S. Supreme Court, arguing that requiring de novo review on every such ruling would "make patent lawsuits more uncertain, more unpredictable and more expensive," all to the benefit of litigants that file dubious patent cases.

On April 29, the justices agreed, ruling that such district court findings were sufficiently rooted in fact that they should be reviewed only for an abuse of discretion, rejecting the Federal Circuit's blank-slate approach.

Kernick has decades of experience as an IP attorney, but taking a case to the highest court in the land was a whole new experience, "a different way of thinking," as she put it.

"As a trial lawyer, you're never thinking at the outset that this will never go to Supreme Court. You're



Kernick

focused on the facts," Kernick said. "When you get to the Supreme Court, now you're talking about policy, about the way that this fits into our entire system.

"To me, that was something that was fascinating to go through."

The career pinnacle that was the Highmark ruling was a long time in the making. Nearly 30 years earlier, Kernick was just an associate at Reed Smith, fresh out of Duquesne University School of Law, at a time when firms more often assigned associates work across a broad swath of practice areas rather than slotting them into a particular track.

One of the first that landed in Kernick's lap was an IP case on the exhilarating subject of a patent for subassembly of an underfloor electrical trench.

"I remember thinking, 'Oh, I hate this.' I never wanted to take IP law in law school," Kernick said.

To her surprise, though, she quickly found herself fascinated by the work. One IP case then led to several, including a trademark suit over Reymer's Lemon Blend, a Pittsburgh-area beverage institution. The case proved to be a watershed moment for Kernick.

After writing the preliminary injunction brief, she was surprised to learn that the partners handling it were due in court in a separate matter on the days of the injunction hearing. All of a sudden, she was a first-year associate handling every witness at a three-day trademark injunction minitrial in front of a federal judge.

"It was the most exciting thing I had ever done," Kernick said. "It was wordplay. As kids, we like puzzles; well, this was looking at the two words, trying to work them together. I was kind of in love. After that, I tried my hardest to take all of my work from the IP group."

A few years later, in 1990, that same kind of seize-the-opportunity situation is what led Kernick to one of her highest-profile cases.

Earlier that year, it had come to light that the Missouri branch of the Ku Klux Klan was targeting children with racist and homophobic telephone recordings designed to imitate "Mister Rogers' Neighborhood," the iconic children's program created by Fred Rogers, a Pittsburgh native.

When the case came into Reed Smith, the partner who might have taken it on wasn't available. Kernick, then a fifth-year associate, took over. Days later, she was standing before a federal judge, asking him to send U.S. marshals to seize tape recordings from the KKK on the ground that they were infringing Rogers' trademarks and copyrights.

The judge did sign a temporary restraining order requiring the Klan to hand them over. After a bit of negotiation, the group agreed to a permanent injunction. The victory was written up, among other places, in The New York Times.

"Here I am, a fifth-year," Kernick said. "I think a big part of being successful as a lawyer, particularly as a female lawyer, is recognizing when there are openings and then taking advantage of them."

That statement was particularly true when Kernick was starting out. Back then, she recalled, the female attorneys at Reed Smith in Pittsburgh would get together for a monthly dinner. The sad reality? "We

could all sit at the same table," Kernick said.

"I took a lot of cases that nobody else wanted because that's how I was going to get experience. Tough case, tough partner running it — I didn't care," she said. "The more experience I had, the harder I figured it would be to avoid having me on the team."

It certainly worked: Since those early years, Kernick has emerged as one of the top IP attorneys in the country.

She successfully represented American Eagle Outfitters Inc. in its long fight with a Scottish apparel maker over their similar eagle logos, for instance, and she won an injunction barring Trader Joe's from using packaging that mimicked the protected trade dress of the King Arthur Flour Co. Inc. She has also handled numerous cases for Pittsburgh's Andy Warhol Museum over a 25-year span.

And, following the KKK case, Kernick continues to defend the trademark and copyright portfolio of Fred Rogers on behalf of the McFeely-Rogers Foundation.

"Cindy knows the landscape better than anyone and she doesn't hesitate to protect our rights, whether it's something small or large," said James R. Okonak, the executive director of the McFeely-Rogers Foundation. "There's a certain comfort level for us, knowing that Cindy is watching the door. She just doesn't hesitate."

A career highlight for Kernick was a case she worked in the mid-1990s on behalf of Charles "Teenie" Harris, a famed photographer known for his work documenting Pittsburgh's black neighborhoods in the middle decades of the 20th century.

Thinking he was merely licensing them, Harris was induced into transferring his copyrights to a local businessman in the 1980s. After being alerted by another Reed Smith partner about Harris' ownership dispute over his photos, Kernick took on the case pro bono.

Kernick eventually won a jury verdict for millions in damages, which she parlayed into a settlement through which the businessman returned the photos. But by then it was too late: Harris, at age 90, died before the case was resolved.

According to Kernick, Harris made her promise that she would win back his treasure trove of historical photographs. After she did so, the negatives were handed over the Carnegie Museum of Art, which is preserving, digitizing and exhibiting Harris' huge body of work.

"I loved going to the Supreme Court. It was great, and obviously one of the highlights of career," Kernick said. "But being able to keep a promise to a man who left something in my hands when he was dying? I don't think it gets any better than that."

--Editing by Katherine Rautenberg and Jeremy Barker.