



Albert Underhill

By Rebecca Larsen



© 2011 Andrew Paul Photography

One of Albert Underhill's most memorable cases was one he handled in the 1990s. He was defending Banner Engineering, a Minnesota firm accused of patent infringement involving a photoelectric sensing system Banner developed that could be used in manufacturing processes.

"The district court held in our favor, but the plaintiff appealed to the U.S. Court of Appeals for the Federal Circuit in D.C.," said Underhill, who now practices intellectual property

law in Phoenix. "We won the appeal, but we wanted an award of Banner's attorney's fees as well. The Federal Circuit did send the case back to the district court on the fee issue. In patent cases, getting attorney's fees was, and still is, a very unusual thing, but the court awarded about \$750,000."

Instead of putting the money back into his business, the company's owner, Robert Fayfield, used it to build a science and engineering laboratory at a Minneapolis high school.

"That case was always special to me because of that donation," Underhill said.

Over the years, he became a close friend of Fayfield, who gave him a special desk-top memento -- a "rock" shaped from Steuben glass that had a removable sword, just like Excalibur,

As a young attorney, he was mentored by a senior trial lawyer, Robert Edell, who had a great influence on his work. "He used to involve himself in every single aspect of a case from the very first day it was filed," Underhill said.

the legendary weapon King Arthur pulled out of a boulder.

"I worked with Al a lot, because people were always trying to get us in court," Fayfield said. "But the plaintiffs didn't know Al the way I do. We pretty much beat them up every time. We played off each other strategically during cases as if we were on a sports team together."

An accomplished litigator in intellectual property, Underhill has handled jury and bench trials in the courts and cases in Washington, D.C., before the U.S. International Trade Commission involving products imported into the United States.

Underhill became a shareholder in Merchant & Gould based in Minneapolis in 1982, served on the firm's board of directors for many years and served as chair of the firm's Litigation Practice Group. While he was there, the firm, which specializes in intellectual property, grew from about a dozen attorneys to more than 100 and went on to open offices in Denver, Seattle, Atlanta, and Washington, D.C.

But Underhill and his wife, Jane, developed a love for Arizona and eventually bought a home here. In 2007, when he was a senior vice president at Merchant & Gould, Underhill left the firm behind for Phoenix.

John Gould, now retired but previously managing partner of Merchant & Gould, said about Underhill: “His focus became litigation, and he was very good at it. We were sorry to see him leave. He served his clients well and as a result our firm became known for our success in intellectual property litigation.”

Upon relocating to Arizona, Underhill wasn’t ready to drop out of the law practice. In Phoenix, he joined Snell & Wilmer LLP, one of the city’s largest firms, as of counsel in its intellectual property group. Then in June 2010, after two and a half years, Underhill became a solo practitioner, still focusing on litigation, mediation, arbitration and counseling clients in intellectual property matters.

One reason why, he said, was to pursue a broader array of clients, including small businesses unable to afford the fees of larger firms.

“The fee structure of large firms may not be the best model for many potential clients and cases and may be an obstacle to some clients getting the legal services that they need,” Underhill said. “Now that I’m on my own, I can be very flexible on arrangements; I can structure fees to the case and what clients need, while still bringing my 30 plus years of experience to bear in resolving their problems.”

Underhill points out that “ Almost every business has some sort of intellectual property whether it be a patentable invention, a trademark, copyrightable subject matter, trade secrets or other proprietary information. I can help clients identify their IP and counsel them on how best to protect it.”

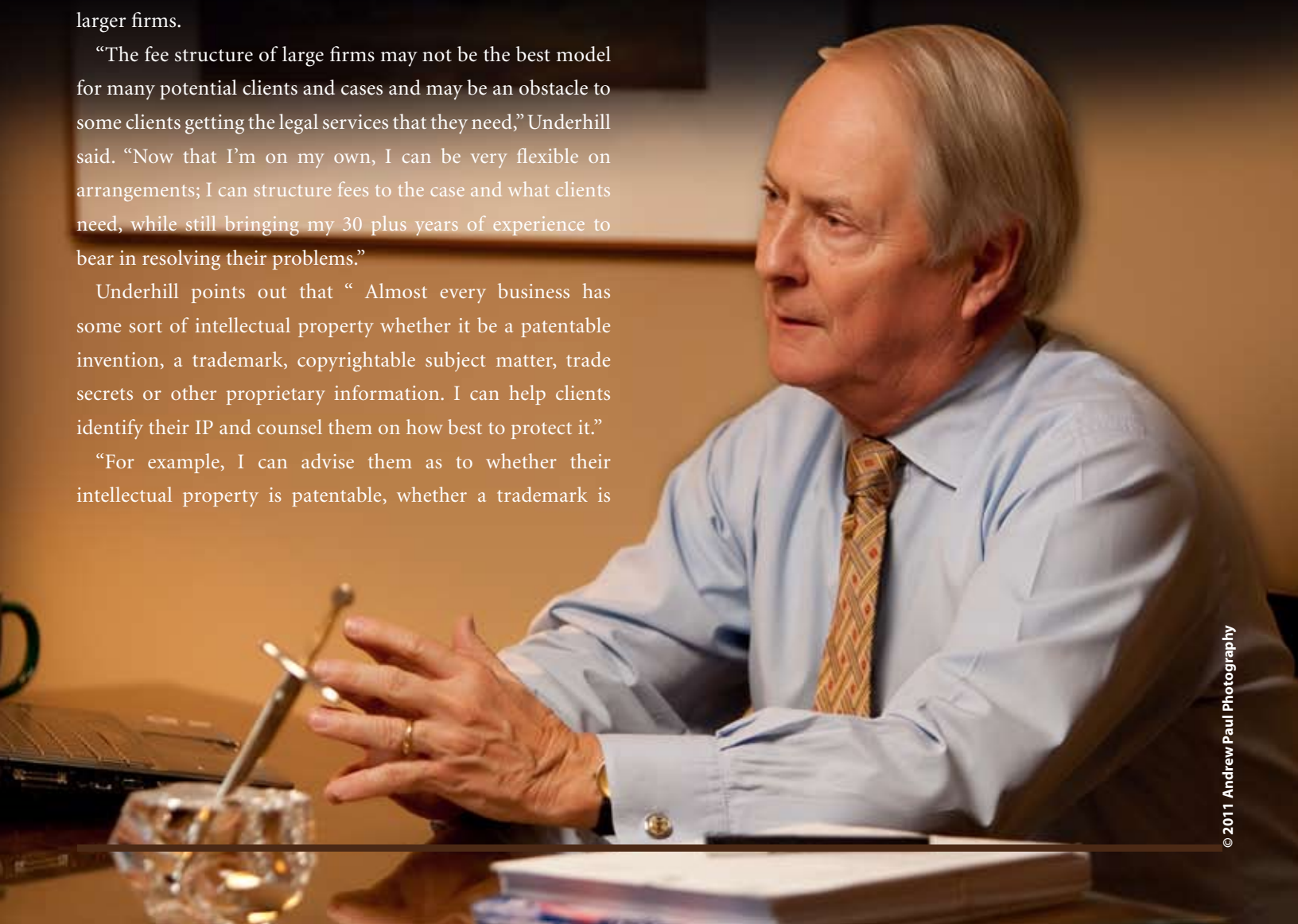
“For example, I can advise them as to whether their intellectual property is patentable, whether a trademark is

An accomplished litigator in intellectual property, Underhill has handled jury and bench trials in the courts and cases in Washington, D.C., before the U.S. International Trade Commission involving products imported into the United States.

available for use and whether a business has the freedom to operate in view of the patents and trademarks of others,” he said. Underhill also has extensive experience in representing clients in disputed matters in litigation, mediation, and arbitration on behalf of both plaintiffs and defendants.

In some instances he will handle cases on a contingency basis. “I can make that decision now when before I might have to go through several layers of management before the determination was made by my law firm,” he said.

He’s also developing relationships with attorneys who don’t practice intellectual property law but would like to partner



with him because of his experience to address their clients' IP needs.

Underhill has handled matters in a wide variety of technologies, including computer software, security camera

"The fee structure of large firms may not be the best model for many potential clients and cases and may be an obstacle to some clients getting the legal services that they need," Underhill said.

systems, semi-conductors, pharmaceuticals, photoelectric and light sensing systems, concrete delivery systems, chemical compounds, medical devices, reflective sheeting for highway barriers, and in-line skates.

Although many of his cases involved complicated technology, others were everyday consumer items.

"One of my accomplishments as a young associate is that I wrote the patent application for the Salad Shooter kitchen appliance, developed by National Presto in Wisconsin," Underhill said. "Years later in litigation, the validity of that patent was confirmed."

In the late 1990s, he handled an intricate case before the International Trade Commission for Rollerblade, a Minnesota business fighting back against importers of in-line skates that infringed on Rollerblade patents.

"There were 33 different defendants importing these products so managing the case was difficult," Underhill said. "But I accomplished that with a small focused litigation team and the case was successfully resolved. On the eve of trial in D.C., we ended up with a good settlement for our client."

His understanding of the complexities of various products probably rests in part on his having earned a bachelor's in electrical engineering degree at the Georgia Institute of Technology where the curriculum included physics, mechanics, chemistry, thermodynamics, calculus, and electronics.

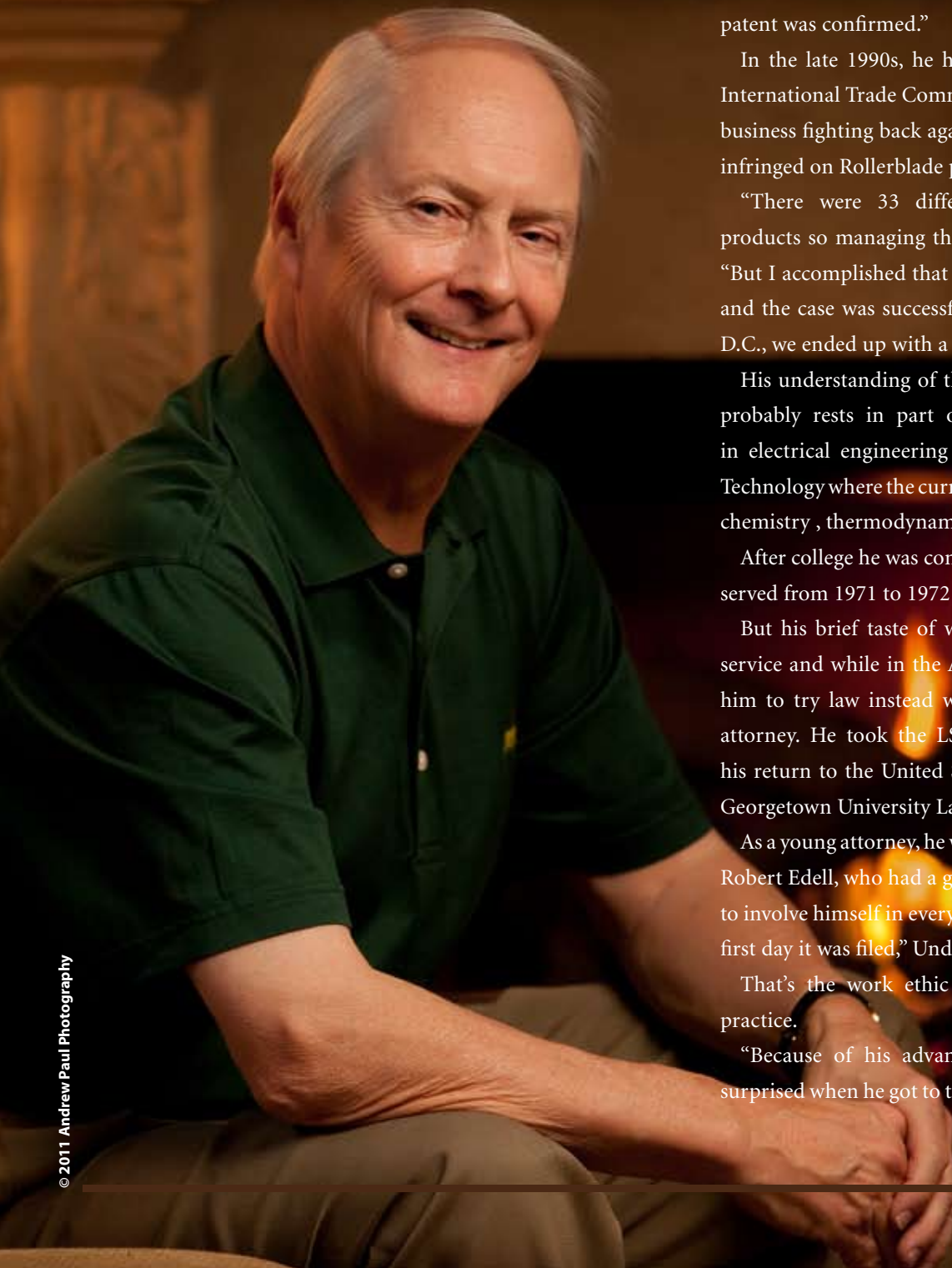
After college he was commissioned in the Army in 1969 and served from 1971 to 1972 in Vietnam as a captain.

But his brief taste of work as an engineer before military service and while in the Army prior to his Vietnam tour, led him to try law instead with the goal of becoming a patent attorney. He took the LSAT while serving in Vietnam. On his return to the United States, he earned his J.D. in 1976 at Georgetown University Law School.

As a young attorney, he was mentored by a senior trial lawyer, Robert Edell, who had a great influence on his work. "He used to involve himself in every single aspect of a case from the very first day it was filed," Underhill said.

That's the work ethic that Underhill brings to his new practice.

"Because of his advance preparation, Edell wouldn't be surprised when he got to trial by something that had happened





© 2011 Andrew Paul Photography

along the way,” Underhill said. “That’s the way I like to do things, and that’s easier to do in a smaller firm. As a solo practitioner, I don’t worry about something happening during discovery where I wasn’t involved because I am there from beginning to end.”

Contact information:

Underhill Law Office PLLC
7907 N. 16th Drive, Phoenix, Arizona
85021; 602-388-4020, phone and fax;
aunderhill@underhilllaw.net.

At a Glance

Focus of the Firm:

The Underhill Law Office PLLC handles intellectual property law including patents, trademarks, copyrights, trade secrets, unfair competition and related licensing and contract issues. The practice includes litigation, mediation and arbitration and counseling clients generally on intellectual property matters such as identifying, acquiring, and protecting IP as well as opinions on the IP of a client’s competitors.

Practice of Law:

Underhill practiced with Merchant & Gould PC in Minneapolis from law school graduation in 1976 until 2007. He became a shareholder in 1982 and was a senior vice president when he relocated to Phoenix in 2007. He was chair of the Merchant & Gould litigation practice group and was on the firm’s board of directors for many years. He served as adjunct professor at the University of Minnesota Law School teaching its patent moot court program. In 2007, he joined Snell & Wilmer LLP in Phoenix as of counsel. In 2010, he opened his practice in Phoenix.

Education and Military Service:

J.D. from Georgetown University Law School in 1976; B.S.E.E. magna cum laude from the Georgia Institute of Technology in 1968. Underhill served in the Army from 1969-1972, including a tour of duty in Vietnam. He left the service with the rank of captain.

Court Admissions:

Arizona and Minnesota Supreme Courts; U.S. Court of Appeals for the Federal Circuit; U.S. Court of Appeals for the Fourth Circuit; U.S. District Courts for District of Arizona, Minnesota, Nebraska and Eastern and Western Wisconsin.

Family and Personal:

Underhill’s wife, Jane, is a watercolor artist who has won awards in national and local shows. She is also vice president of the Arizona Watercolor Association. The couple has a combined family of five children, four in Minnesota and one in Hawaii, and three grandchildren. The Underhills are former members of Hazeltine National Golf Club in Minnesota where he was on a tournament committee for the 1991 U.S. Open and the 2002 PGA Championship. Underhill volunteers with the First Tee program at Desert Mirage in Phoenix coaching golf and life skills with children ages 7-17.