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The how-tos of trying a patent case

By Raquel F. Dachner and David R. Flyer

Patent infringement cases garner a lot of attention because of the high stakes involved. A patentee can win big, or he or she can have his patent invalidated. To minimize the risk many patent actions are brought near the end of the term of the patent.

In the U.S. Central and Southern Districts, only certain District Judges accept panel assignments for patents litigation. Patent cases usually involve more judicial and legal effort, so not all District Judges accept panel assignments.

Overview

Before taking on a patent case as a Plaintiff, you must first compare your client's patent to the accused product. Do any of the accused product's features fall within the asserted claims of the patent? If so, decide whether more than one patent claim and/or more than one patent in a family of patents has been infringed.

You should also explore other potential claims, such as violation of trade secrets by a former employee or former joint venturer, or a breach of contract or breach of license agreement may also be appropriate claims that can be included in the complaint based on pendent party jurisdiction under 28 U.S.C. §1367.

Drafting the complaint

Once you are satisfied that there is a claim for patent infringement, begin drafting the complaint. The first place you should always look, if in California, is the 9th Cir. Model Jury Instructions [which allow for following the Northern District of California Model Jury Instructions]. Instructions 3.1 and 3.4 are likely to be used.

Instruction 3.1., details the burden of proof:

I will now instruct you on the rules you must follow in deciding whether [patent holder] has proven that [alleged infringer] has infringed one or more of the asserted claims of the [ ] patent. To prove infringement of any claim, [patent holder] must persuade you that it is more likely than not that [alleged infringer] has infringed that claim.

Instruction 3.4a., the Doctrine of Equivalents, does not have a model instruction because "instruction on this subject is necessarily case specific. However, a means-plus-function requirement can be met under the doctrine of equivalents if the function is not the same but is equivalent."

Another helpful place before you start drafting the complaint is your local Federal Bar Association. If you attend meetings you can become familiar with the procedures and proclivities of your local bench officers.

Now that you are confident in the law, draft the complaint, starting with two claims:

(1) Direct Infringement; and (2) Doctrine of Equivalents. It is helpful to embed photographs of the accused product compared to the patent. Make sure that you find the best images to show infringement, as these likely will be relied on throughout litigation.

Federal jurisdiction exists under 38 U.S.C. §1338(a): "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trademarks." Venue is proper where the defendant resides, under 28 U.S.C. §1400(b).

Disclosures

After the complaint is filed and served, you will prepare disclosures of all of your supporting witnesses and evidence. Under Rule 26(a) you are required to disclose: (1) The name and contact information of each individual likely to have discoverable information – along with the subjects of that information, that you intend to use to support your claims, unless the use would be solely for impeachment; (2) A copy or a description by category and location, of all documents, electronically stored information, and tangible things that the disclosing party has in its possession, custody, or control, that you may use to support your claims, unless the use would be solely for impeachment; (3) A computation of each category of damages you claim, you must also make available for inspection and copying all documents or other evidentiary material, unless privileged or protected from disclosures, on which your damages computations are based; and, (4) For inspection and copying, any insurance agreement.

Later, you must meet and confer with opposing counsel to create a joint Rule 26(f) report with your facts, and evidence and defendant's facts and evidence. As Plaintiff, you will be responsible for drafting the report. Typically, you provide the report with your disclosures and have Defendant provide its disclosures to be inserted.

Finding an expert

An expert is crucial. Considerable time should be spent in selecting the best expert for your case. One place to look is the jury verdicts on Westlaw. Search for experts that have testified in cases similar to yours. Call the attorneys that have used them before as references. Most attorneys are collegial and will be pleased to make comments on their experiences with a particular expert. Make sure that the expert's qualifications are in the field of your patent.

Claims construction

Prepare charts for a *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996) hearing, which is a matter to be decided by the District Judge. Considerations include:

(1) purpose of charts is to explain complex patent language to demonstrate infringement to the jury;

(2) understanding of a person of ordinary skill in the field of the invention;

(3) impact of prior constructions of terms during patent prosecution;

(4) reliance on intrinsic and extrinsic evidence to interpret the patent claim;

The outcome of hearing on claim construction may decide liability. Some District Courts offer early neutral evaluation by the Magistrate Judge, which is an excellent opportunity to find out from an independent examiner the strengths or weaknesses of your claim.

Motions in Limine

Use these carefully. Most judges will be annoyed by overly broad, unfocused motions, i.e., to exclude all hearsay, all undisclosed evidence or witnesses, etc. Identify specific evidence or testimony that should not be admitted. If an expert is unqualified, do not wait for motions in limine to submit a *Daubert v. Merrell Dow Pharm., Inc.* (1993) 509 U.S. 579, 592-593, 113 S.Ct. 2786 motion. The *Daubert* motion should be set for hearing per the court's scheduling order.

Trial

Many federal judges will conduct voir dire examination without permitting the attorneys to ask questions. However, you may be asked to provide written input for the judge's consideration.

Visual aids prove to be critical. Like most folks, juries enjoy watching video clips and seeing demonstrations. Break up the monotony of testimony with short videos. For example, perhaps you have an expert who can show how a machine works and why the mechanics of the accused product are covered by your client's patent.

Remember your audience is the jury, trial judge and appellate court. While visual aids are important, obviously, an audible description needs to be made to preserve the record on appeal.

It is important to lock down the number of hours you will need before you get to trial, and make sure you stick to your time estimates!

Raquel F. Dachner *is a partner, and* **David R. Flyer** *is a registered patent attorney at Flyer & Flyer, PLC., and a member of the American Board of Trial Advocates.*