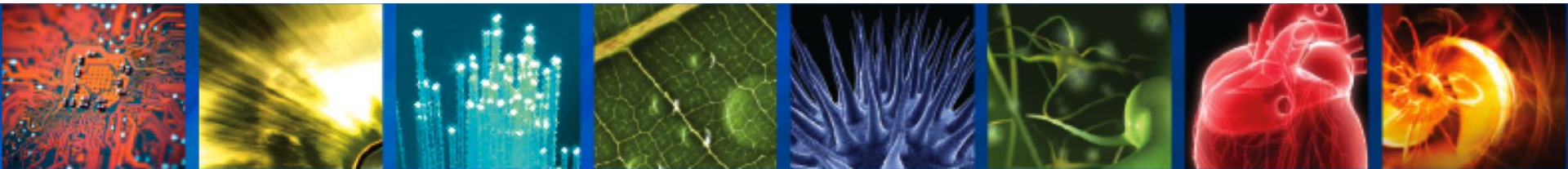


Class 4: The Meaning of Patent Infringement and Litigation


TVE2 IP Series

Thursday, May 23, 2013

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TVE2 Intellectual Property (IP) Series

- **Class 1:** "What intellectual property is, and why it may be important to your startup"
 - ~~Class 2:~~ "How to enter the patent world strategically and economically"
 - **Class 3:** "How to file for a patent"
 - **Class 4:** "The meaning of patent infringement and patent litigation"
 - **Class 5:** "How to use copyrights, trademarks, and trade secrets to your advantage"
 - **Class 6:** TBA (probably continuation of Class 5)
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- B.S. Electronics Engineering Technology
- Specializes in patent prosecution, legal opinion work, and licensing
- Experience in telecommunication systems, computer architecture, computer software, Internet business methods, and mechanical devices



Scott Cromar

- Patent Agent for 3 years; Patent Attorney for 1
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- Specializes in IP counseling and patent preparation and prosecution
- Experience with software, computers, electronics, and semiconductors



Disclaimer

- **This presentation is for information purposes only and does not constitute legal advice.**
- **This presentation does not establish any form of attorney-client relationship.**

Today:

- **Something Different:**
 - **Top 10 Questions & Answers About Patent Litigation**
- **Quiz to follow!**

Top 10 Q's & A's About Patent Litigation

1. Can I Infringe a Patent If I Am Not Aware of It?

- YES
- Lack of knowledge and/or intent are not defenses
- Infringement = make, use, sell, offer to sell, import
 - During term of patent
 - Without authority
- Beware willful infringement

2. How Do I Tell Whether a Patent is Infringed?

- Compare the **claims** of the patent with the accused **product or process**
- Literal Infringement:
 - Each claim limitation identically present in the product/process
- Doctrine of Equivalents Infringement:
 - Insubstantially different from claim limitations

Novelty/Validity vs. Infringement Analysis

- Novelty/Validity (“Is the patent valid?”)
 - Comparing **claims** to knowledge existing at time of application filing – referred to as “**prior art**”
 - Includes patents, patent application publications, website, products, articles, sales presentations, discussions, etc.
- Infringement (“Is my product infringing?”)
 - Comparing **product** that launched after patent issued to **claims** of the patent

Claim Interpretation – Infringement Analysis

- Infringement only if a claim “reads” on device/process
 - Device/process must exhibit **at least** each of the claim’s features
 - Device/process includes all claim features = infringement
 - **Even if** device/process includes additional features
- If device/process **does not** include all claim features = probably not infringing
 - **Unless** infringing under doctrine of equivalents

Infringement Example

- **Claim:**

An apparatus comprising:

a seating platform; and

at least four legs supporting the seating platform.

- Does a chair with five legs infringe this claim?
- Does a stool with three legs infringe this claim?
- Does a four legged chair **with a back** infringe this claim?
- Does a chair with four **wheels** infringe this claim?

Design Patent Infringement

- Infringement if:
 - In the eye of an ordinary observer, giving such attention as a purchaser usually gives [and in light of the prior art], the two designs are substantially the same.

Avoiding Infringing The Patents Of Others

- Consider conducting a “right to practice” search/analysis before launching new feature or service
- Avoid discussing competitors’ patents in writing (even via informal email communications)
- Promptly respond to possible infringement problems
- Consider purchasing or licensing patents

3. What Does an Infringement Notice Letter Mean?

- Oftentimes written as an offer to license
- Someone thinks you may infringe their patent
- Take it seriously and investigate
- Talk to a patent attorney!
- Should You Save Your Documents and Emails?
 - If involved in lawsuit or anticipate litigation:
 - YES
 - Applies to all relevant records of company
- Consider Declaratory Judgment action (in preferred jurisdiction)

4. Will My Adversary See My Confidential Docs?

- During litigation, you may be required to produce confidential information to opposing attorneys
- “Protective order” may restrict access to certain persons, and only for the lawsuit

5. We Have Insurance; What Do We Do?

- Promptly review all insurance and determine whether a portion of legal fees may be reimbursable
- Promptly obtain legal advice from insurance attorney

6. Can I Challenge the Validity of a Patent?

- Issued patents are **presumed** valid
- But, that presumption can be overcome with clear and convincing evidence of invalidity
 - Show the invention is **not new** (“anticipation”)
 - Each element of claim is in a single prior art reference
 - Show the invention **would have been “obvious”**
 - PHOSITA would have readily been able to make invention with existing knowledge
 - One or multiple prior art references

7. Why Do Most Cases Settle?

- 95% of IP lawsuits are resolved before trial
- High cost of litigation incentivizes early settlement
- May not make economic sense given amount at stake
- Business distraction
- Customers may be drawn into dispute
- May cast a cloud of uncertainty over business

8. What is Claim Construction?

- Claims are the most important part of a patent
 - Define the scope of the protected invention
- Claim construction = determining the meaning and scope of the claims (“construing”) in litigation
- Determined by a court, which looks to:
 - Claim language
 - Patent specification
 - Prosecution history

Claim Construction Example

- **Claim:**

An apparatus comprising:

a seating platform; and

at least four **supporting members** supporting the seating platform.

- What does “supporting members” mean?

9. What Is a Summary Judgment Motion?

- A written request that a court decide an issue without need for a trial
- Usually addresses questions of infringement and validity
- Typically filed after discovery and claim construction
- “No genuine dispute as to any material fact”

10. Where Can I Get More Info. About IP Litigation?

Your friendly neighborhood patent attorneys!

Quiz: Myth or Truth?

Quiz: Myth or Truth?

No. 1:

“Once a patent application has been filed, no one else can legally use the invention.”

Myth!

No. 2:

“If I get a patent on an invention, then I don’t have to worry about infringing someone else’s patent.”

Myth!

Quiz: Myth or Truth? – Cont.

No. 3:

“Any invention can be patented if no one else has yet filed for a patent on it.”

Myth!

No. 4:

“If I describe the invention in too much detail in my patent application, the patent will be too narrow and easy to get around.”

Myth!

Quiz: Myth or Truth? – Cont.

No. 5:

“I can get a patent and still leave out important details which I can continue to protect as a trade secret.”

Myth!

No. 6:

“It’s better not to obtain patent protection because patents are very expensive to defend.”

Myth!

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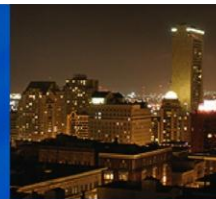
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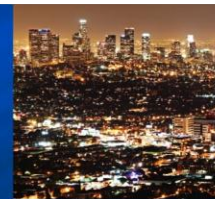
San Diego



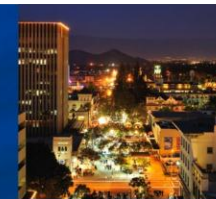
San Francisco



Silicon Valley



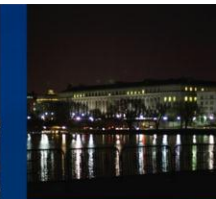
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