

CLE Materials

NYIPLA Sharpen Your Skills Series:

Have a Patent Infringement Complaint? Find Out What to Do After Service

Checklist for Patent Infringement Complaint Defense

Legal considerations

- I. Deadline to serve an answer
 - A. Within 21 days after being served with the summons and complaint. *See* FRCP 12(a)(1)(A)(i).
 - B. If the defendant has timely waived service under FRCP 4(d), within 60 days after the request for a waiver was sent, or within 90 days after it was sent to the defendant outside the United States. *See* FRCP 12(a)(1)(A)(ii).
 - C. The defendant may move for an extension of time. *See* FRCP 6(b)(1).
- II. Potential components of an answer
 - A. Patent ownership and standing
 - B. Defenses
 1. Invalidity
 - i. Presumption of validity. *See* 35 U.S.C. § 282.
 - ii. Patentable subject matter. *See* 35 U.S.C. § 101.
 - iii. Anticipation. *See* 35 U.S.C. § 102.
 - iv. Obviousness. *See* 35 U.S.C. § 103.
 - v. Written description and enablement. *See* 35 U.S.C. § 112.
 2. Noninfringement
 - i. Direct infringement. *See* 35 U.S.C. § 271(a).
 - ii. Induced infringement. *See* 35 U.S.C. § 271(b).
 - iii. Contributory infringement. *See* 35 U.S.C. § 271(c).
 - iv. Literal infringement
 - v. Doctrine of equivalents
 3. Equitable defenses
 - i. Inequitable conduct. *See* FRCP 9(b).
 - ii. Unclean hands

- iii. Misuse
 - iv. Laches
 - v. Equitable estoppel
 - vi. Waiver
 - 4. Express or implied license
 - 5. Patent exhaustion
 - C. Counterclaims
 - D. Crossclaims
 - E. Remedies
 - 1. Damages
 - i. Enhanced damages. *See* 35 U.S.C. § 284.
 - a. Willful infringement
 - ii. Attorneys' fees. *See* 35 U.S.C. § 285.
 - iii. Limitations of damages
 - a. Marketing and notice
 - b. Government sales
 - 2. Injunctive relief
 - F. Third party complaints
 - G. Jury demand
- III. Motion to dismiss
 - A. Lack of subject matter jurisdiction. *See* FRCP 12(b)(1).
 - B. Lack of personal jurisdiction. *See* FRCP 12(b)(2).
 - C. Improper venue. *See* FRCP 12(b)(3).
 - D. Insufficient process. *See* FRCP 12(b)(4).
 - E. Insufficient service of process. *See* FRCP 12(b)(5).
 - F. Failure to state a claim on which relief can be granted. *See* FRCP 12(b)(6).
 - G. Failure to join a party under FRCP 19. *See* FRCP 12(b)(7).

Practical considerations

- I. Accepting service
- II. Document retention

- A. Identifying stakeholders within the business
 - B. Identifying relevant business units
 - C. Identifying potential witnesses
- III. Initial workup
 - A. Identifying whether asserted patents are new or previously known
 - B. Identifying whether prior licensing talks took place
 - C. Identifying accused products
 - D. Identifying possible defensive patents
- IV. Estimating exposure
- V. Retaining outside counsel
 - A. Familiarity with technology
 - B. Expectation of trial or settlement
 - C. National counsel
 - 1. Request for proposal / solicitation of pitches
 - 2. Selection from existing stock of lawyers
 - D. Local counsel
 - 1. Request for proposal / solicitation of pitches
 - 2. Selection from existing stock of lawyers
 - 3. Recommendation from national counsel
- VI. Identity of plaintiff
 - A. Market size / scope
 - B. Direct competitor
 - C. Non-practicing entity
- VII. Communicating with plaintiff
 - A. Business-to-business communication
 - 1. Whether prior relationship between plaintiff and defendant
 - 2. Whether ongoing licensing talks
 - 3. Before or after retaining outside counsel
 - B. Outside counsel to outside counsel communication
- VIII. Identity of court and judge
 - A. Average time to trial

- B. Whether judge has active patent docket
 - C. Whether judge tends to grant motions to dismiss
 - D. Whether judge tends to grant stays, e.g., for *inter partes* review proceedings
- IX. *Inter partes* review proceedings
- A. Whether to file quickly or wait for one-year deadline
 - B. Identifying prior art
 - 1. Identifying internal prior art
 - 2. Identifying on sale prior art
 - 3. Conducting prior art searches
- X. Early discovery
- A. Early discovery to foster settlement
 - 1. For example, producing financial information early
 - B. Later discovery to lock parties into positions
 - 1. For example, requiring parties to file infringement contentions before discovery to narrow scope of accused products
- XI. Extension of time
- A. Whether better for case to move slowly or quickly