

They're Infringing Our Patent!

How You Can Help Your Attorney Prove It

by **Herbert D. Hart III**

Imagine that one of your colleagues has spotted a news item announcing the launch of a competitor's new product, and your company has a patent on what it believes is the same technology. If your company is like most companies, the news item would cause quite a stir — even some excitement. But how would you react if your company's patent attorney called to recruit you to help figure out whether that new product actually infringes the patent? Would you know what would be expected of you?

Armed with some background knowledge, a few definitions, and some basic guidelines, you should be able to tackle the task, if not with confidence, then at least with no undue anxiety. In fact, the answers to a handful of questions should provide you with the basic knowledge you will need to do something that may at first seem foreign to you. Specifically, you need to know

- What does it mean to infringe a patent?
- How can you help your attorney?
- How should you do the work?
- What records should you create?
- With whom should you communicate?



COMPOSITE BY CHRISTINA PRIER STEFFY USING IMAGES FROM PHOTODISC (WWW.PHOTODISC.COM)

The answers to some of those questions may surprise you, so let's dig right in.

WHAT DOES IT MEAN TO INFRINGE A PATENT?

Let's start with this fundamental question. If you've ever read a patent, you may have noticed that it has two distinct sections: the description of the invention (the *specification*) and, at the end of the specification, some numbered sentences that follow the words "We claim:" (the *claims*).

The claims, not the specification, are the focus of an infringement investigation. Why? A patent is property. Specifically, it's a species of what is called *intellectual property*. It gives its owner the

right to exclude others from making, using, or selling an invention.

So how do you know what the *invention* is? Quite simply, the invention (which can be a product, device, or process) is what's defined by the claims. In that respect, a patent claim is much like the legal description in a deed for real estate: It defines the scope of the rights conferred by the patent.

As I mentioned, a patent claim can define a product, a device, or a process. It may, for example, define a molecule or a composition or a method of making a molecule or composition. The claim can take several possible forms: It can specify what must be present, what must be absent, a particular order

of process steps, or a condition or set of conditions. The long-standing convention is that a claim consists of a single sentence, however long and unwieldy it may have to be to constitute a definition of the invention.

A patent claim — the definition of the invention — is, in turn, made up of parts called *limitations* or *elements* that do the work of identifying what must be present (or absent) for a product, device, or process to meet the definition.

Now that we know what a claim is, how is it infringed? Specifically, what will your company's attorney have to prove to show that the competitor's product, device, or process infringes the claim? The simple answer is that it infringes if it meets the definition in the claim.

Determining whether a product, device, or process meets the definition involves a two-step analysis. First, we need to construe the claim to determine what the definition actually is. Second, we need to examine the product, device, or process to determine whether it meets the definition.

In this analysis, every limitation counts. So what we are doing is determining whether (in the case of a product or device) there is a structure, ingredient, or component that corresponds to each limitation in the claim, or whether (in the case of a process) there is a step or condition that corresponds to each limitation in the claim.

HOW CAN YOU HELP YOUR ATTORNEY?

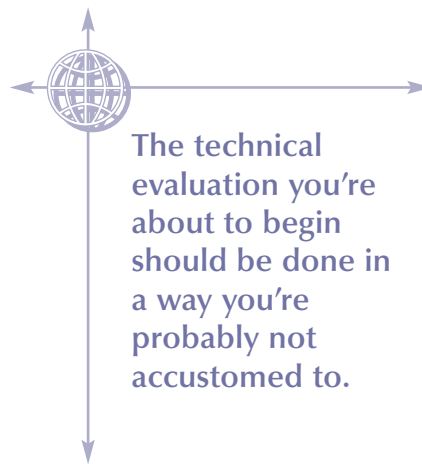
Your job in an infringement inquiry is likely to be twofold: Help your attorney interpret the claim, and help your attorney examine the product or process.

Interpreting a patent claim ordinarily requires, as the first step, determining the meaning of the words used in that claim. The general rule is that a term should be given its ordinary meaning. By *ordinary meaning*, we don't use a lay person as a reference point but a hypothetical person "of ordinary skill in the art to which the

invention pertains." The ordinary meaning to such a person is the benchmark for interpreting a claim unless the inventor has made it clear in the specification that he or she is using the term in a unique way. So your attorney will be asking you whether, for example, the term appears in accepted chemical dictionaries or whether the term has a special meaning as it's used in the field of the invention. Your attorney, with your help, may also study the patent specification to determine whether the inventor has chosen to assign a unique meaning to the term.

Once you've helped your attorney determine the meaning of terms in the claim — and therefore determine what the claim covers — he or she will ask what you would consider to be "equivalent" to the materials or steps mentioned in the claims. In this context, *equivalent* refers to materials or steps that could be substituted for those defined in the claim while still performing the same function in the same way and achieving the same result.

Finally, having examined what the claim defines and determined what equivalents exist, you and your attorney will examine the competitor's product or process. That task will be much more familiar to you because it will involve, for example, conducting a chemical, spectral, or other physical analysis of a composition, determining a sequence, performing an assay, measuring the performance or properties of a sample of material, and/or reviewing and analyzing a process description or flow diagram. With the information you collect, you'll help your attorney determine whether the competitor's product or process fits the definition set out in the claim. If the product or process fits the literal language of the definition, it is an infringement. If it is an equivalent of what's in the definition, it might be an infringement — subject to some rather complicated legal principles.



The technical evaluation you're about to begin should be done in a way you're probably not accustomed to.

HOW SHOULD YOU DO THE WORK?

Now that the mission is clear, you need to know some very important things about how that mission is to be accomplished.

First, and this is quite important, you need to change gears: The technical evaluation you're about to begin should be done in a way you're probably not accustomed to. Everything you do will be subject to later scrutiny, both by your own attorney and, if there is litigation, by attorneys representing the competitor. For that reason, you'll need to treat the work as a separate project with its own rules and procedures.

Second, be sure to ask for detailed instructions, and be sure you know exactly what is to be done. After all, this isn't a basic research project or a product development effort, and you need to do exactly what your attorney asks you to do — not more, not less. When in doubt — concerning materials, procedures, or any other issue — always ask.

Third (and last!), you must actually do the work you've discussed with your attorney.

When analyzing a compound or composition, be sure to use the method specified by the patent specification or, if none is specified, a generally accepted method such as an ASTM standard method or an industry-specific standard. It's critical that you avoid deviating from specified materials, equipment, and standards, because doing so can seriously undermine the

reproducibility and credibility of your results. Unfortunately, deviations in procedures and materials can become big issues in the midst of litigation, often after your company has spent large sums of money that can't be recovered.

When analyzing a process, be sure to first study the available information, and then ask yourself whether you have enough facts. If you don't, promptly call to your attorney's attention the other facts you need. Moreover, take care to identify and discuss with your attorney every assumption you've made.

WHAT RECORDS SHOULD YOU CREATE?

Creating the proper records is another key part of the task you'll be doing, although again, you'll need to approach it in a different way than you may be accustomed to. Be sure to ask your attorney for guidance about what kinds of records you should — and importantly, should not — make and keep during your work. In general, you'll want to record just the basic facts: identifying the exact subject of your inquiry (a sample of a fluid or another substance, for example), the materials and methods you use, and the data you acquire. Make a record of your opinions only if you're specifically asked to do so. Avoid making a record of your speculations. Remember, this isn't an exploratory exercise, and it's unlikely that your attorney is expecting you to chart a new avenue for research.

Although it probably goes without saying, you should make every effort to create persuasive evidence that lay people such as a judge and jury will find believable. You can lend credibility to your records by making them clear and understandable, free of jargon and abbreviations, complete, contemporaneous, and permanent.

Many laboratories have sophisticated systems for storing and communicating information, and each has its own protocol for

ensuring the accuracy, security, and permanence of that information. Accordingly, you should consult your attorney (perhaps with the assistance of a member of your company's information technology staff) about the electronic records ordinarily made and stored on your system. You can then obtain your attorney's advice about the best methods of generating evidence that will be admissible and persuasive in court.

WITH WHOM SHOULD YOU COMMUNICATE?

Another aspect of your work that will be quite different from your everyday research or development efforts is communications — not only what you should communicate, but with whom.

Why should you be concerned about communications? As I mentioned earlier, everything you do and every record you make will be subject to later scrutiny. The same may be true of everything you *say* unless you take certain precautions. The discussions you have with your attorney and certain other communications (oral and written) may in many circumstances be protected from the prying eyes of your competitor's attorneys under what are known as *work-product immunity* and the *attorney-client privilege*. The precise limits of those protections is beyond the scope of this article, but your attorney can explain the legal principles and provide you with advice and guidance about how they may affect your work.

There is, however, one general principle: You should communicate only with your attorney and individuals he or she identifies. Casual communication (even with others inside the company) can destroy the protections of privilege and/or immunity, so be sure to ask for (and follow!) advice before discussing your work — and especially before discussing your conversations with your attorney — with anyone else.

You should be concerned not only about the persons with whom

you communicate, but also about the method you use to do so. Consult your attorney before creating a written record of your communications, because if there's a lawsuit, there will be what is called *discovery*. Discovery involves responding under oath to requests for information from your opponent's attorneys, and those requests are usually detailed and far-reaching. Subject to such requests are not only laboratory notebooks (paper or electronic), but also emails, memoranda, letters, and even Post-it notes. And — important from your perspective — the authors of such records are usually required to give testimony in any litigation.

TODAY'S LESSONS

So what are the take-aways from the topics we've explored? They're really quite simple:

- An infringement analysis is an important undertaking. There's usually a lot at stake.
- Always work under the close supervision of your attorney.
- Do your work as if you'll have to defend it in court — you'll probably be a witness if there's a lawsuit.
- Create only the records you have been asked for.
- Discuss your work only with those who need to know about it.

Now when the phone rings and it's a request for your help in an infringement investigation, you should be ready and able to make a hands-on contribution to the protection of your company's valuable patent rights. 🌐

Herbert D. Hart III is a shareholder and director at McAndrews, Held & Malloy, Ltd., 500 West Madison Street, Suite 3400, Chicago, IL 60661, 1-312-775-8000, fax 1-312-775-8100, hhart@mhmlaw.com. Mr. Hart specializes in patent interferences, litigation, and licensing involving biomedical and chemical technology.