

Your Lawyer And You

ACS National Meeting

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***“Our Patent Lawyer Called And Wants
Me To Help Evaluate A Competitor’s
Product To Determine Whether It
Infringes Our Patent”***

McAndrews
Held
Malloy



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What will we cover today?

- *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?*

What does it mean to infringe a patent?

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Where do we start?

- ***It's the claims, not the disclosure***
 - ***A patent is property – a claim is like a legal description***
 - ***The claims – not the specification – define the scope of protection***

A claim may define a product or a process

- *A molecule*
- *A composition*
- *A method of making a molecule or a composition*

The definition may

- *Specify what must be present*
- *Specify what must be absent*
- *Specify a particular order of process steps*
- *Specify a condition or set of conditions*
- *Parts of the definition*
 - *limitations*
 - *elements*

What do we have to prove?

- *Does the product or process meet the definition in the claim?*
- *Two-step analysis*
 - *Construe the claim to determine what the definition is*
 - *Examine the product or process to determine whether it meets the definition*

Every limitation counts

- *Is there a structure, ingredient, or component that corresponds to each limitation in the claim?*
- *Is there a step or condition that corresponds to each limitation in the claim?*

How can you help your attorney?

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Help your attorney interpret the claim

- ***What do the terms used in the claims mean?***
 - ***Ordinary meaning***
 - ***Does the term appear in accepted chemical dictionaries?***
 - ***Is there any special meaning in the field of the invention?***
 - ***Does the patent specification assign a unique meaning ?***

Help your attorney interpret the claim

(Continued)

- *What would you consider to be "equivalent" to materials or steps mentioned in the claims?*
- *What could be substituted while*
 - *performing the same function*
 - *in the same way, and*
 - *achieving the same result*

Help your attorney examine the product or process

- *Conduct a chemical, spectral, or other physical analysis of a composition*
- *Measure the performance or properties of a sample of material*
- *Review and analyze a process description or flow diagram*

How should you do the work?

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First – change gears

- *Recognize that everything you do will be subject to later scrutiny*
- *Treat the work as a separate project with its own rules and procedures*

Second – ask for detailed instructions

- *Be sure you know what is to be done*
- *When in doubt, always ask*

Third – do the work

Analyzing a compound or composition

- *Use the method specified by the patent specification or*
- *use a generally accepted method*
 - *ASTM or other industry-specific standards*
- *avoid deviations from specified materials, equipment, and standards*

Third – do the work

(Continued)

Analyzing a process

- *Study the available information*
- *Do you have enough facts?*
- *Call attention to other facts you need*
- *Identify and discuss every assumption*

What records should you create?

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Ask for guidance

- ***"Just the facts"***
 - ***Only make a record of opinions if asked to do so***
 - ***Don't speculate – remember, this isn't a research exercise***
- ***Ask your attorney about rules of evidence***
 - ***Chain of custody***

Create persuasive evidence

- *Your records should be*
 - *Clear and understandable*
 - *Minimize jargon and abbreviations*
 - *Complete*
 - *Contemporaneous*
 - *Permanent*
 - *Consult your attorney about electronic records*

With whom should you communicate?

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Why should I be concerned about communications?

- *Attorney work-product doctrine*
- *Attorney client privilege*
- *The general principle:*
 - *Limit communications to your attorney and those your attorney identifies*
- *Casual communication (even if in-house) can destroy the privilege*

How should I communicate?

- *Consult your attorney before creating a written record*
- *If there's a lawsuit, there will be discovery*
 - *Not only lab notebooks*
 - *Also*
 - *E-mails*
 - *Memoranda*
 - *Letters*
 - *Even Post-it notes*

Today's lessons:

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**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 lawsuit**



**Create only the records
you're asked for**



**Discuss your work only with
those who need to know
about it**



Questions??

- *For questions and/or comments about the topics covered and/or for copies of this presentation, contact:*



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