

# 10 Steps to Consider Before Filing a Patent Infringement Lawsuit

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Planning to sue someone for **infringing** your **patent**? Do you know that if you are not careful in preparing for your suit, you could end up being ordered to pay the attorney fees of the defendant? Review these steps and consult an attorney for guidance in relation to your particular facts. No legal advice provided and no attorney-client relationship created in this publication.

## **(1) Identify your business goals**

Are you seeking money (lost profits, reasonable royalty)? An injunction (court order stopping infringer from infringing). Do you want to send a message to your competitors? Do you want to negotiate a license? What can you accomplish before litigation that you cannot do after litigation starts?

## **(2) Get Analysis of Infringement Issues and Invalidity Issues**

Must be in writing. Determine strengths and weaknesses of your patent. Should use independent law firm (not one taking case) for unbiased assessment. Does defendant have patents on the product? What are the weaknesses and strengths of those patents?

## **(3) Determine competitive position of invention**

Can defendant easily design around (or redesign) your patent? What are commercial advantages of the invention? (sales, cost of manufacture, potential for future sales). What are the products/services that compete with the invention? Does the invention make money “by itself”? Or is the invention more successful due to marketing, lever from company position, etc.?

## **(4) Compare Products**

If practicing the invention, are you losing or gaining market share? Do consumers like your product/service? How does your product compare with other products in marketplace? How does your product compare with defendant’s product?

## **(5) Damages**

Calculate damages. Products marked with patent number? What are your lost profits? What is a reasonable royalty? Insurance coverage? Advertising injury?

## **(6) Litigation Costs**

Estimate legal fees, costs, experts. Travel (where will you sue?). What is the extent of discovery to be produced on your side? What kind of discovery do you need from defendant? What is the litigation personality of the defendant? (“scorched earth”, “settle promptly”, fight some, settle some?).

### **(7) Size Up the Defendant**

Google is not enough. Dun & Bradstreet Previous patent litigation. How important is the product to defendant? Who are the potential witnesses for the defendant? Did they publish anything? Is the lawsuit more important for you or the defendant? If you win, will you end up closing down the company? Will they go BK? Who are their usual litigation attorneys?

### **(8) Review Your Evidence**

Gather all documents. Anticipate documents to be requested by defendant in discovery. (Product brochures, advertisements, lab notebooks, invention disclosures, patentability searches, prosecution history). Review patent prosecution attorney's files. Electronic information? Interview key witnesses. (Inventor, technicians) Interview likely witnesses. What trade secrets are likely to be revealed in litigation? Are relevant documents marked as confidential? Is information kept secure to maintain trade secret protection? Any best mode problems?

### **(9) Retain Expert Witnesses**

Analyze credibility, previous work, publications, Ask expert about defendants' likely experts

### **(10) Make a Litigation Plan**

Budget for litigation costs. Plan discovery, motions, summary judgment, anticipate defendant's likely motions. Identify which aspects of your case pose non-routine issues (e.g., software, medical procedures, divided infringement, inequitable conduct).