

# Developing A Discovery Plan For A Patent Infringement Defendant

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## (A) Review Jury Instructions and Prepare a Proof Rubric

Determine what the plaintiff needs to prove and what the defendant would like to prove. Prepare a list of documents and testimony needed to support your case and refute the plaintiff's case. From this list, you now know what type of evidence to gather.

## (B) Propound a First Set of Written Discovery Requests

Ask questions to identify witnesses and to find out what documents exist. Seek information on inventorship (conception and reduction to practice), prior art, patent prosecution, and persons knowledgeable about these topics. Propound requests for admission to exclude factual issues for trial. Propound a global request for documents early, as you undoubtedly will encounter resistance requiring efforts to pry documents from the plaintiff.

## (C) Depose the Patent Prosecutor

In some jurisdictions, you may encounter resistance on deposing the patent prosecutor based on attorney-client privilege and the work product doctrine. Deposing the patent prosecutor may be quite valuable to establish findings related to patentability defenses.

## (D) Depose the Patentee Plaintiff Under 30(B)(6) (If a Corporation)

Depose the patent owner (inventor and/or assignee) as to bases for allegation of infringement, pre-filing investigation, allegations regarding accused products, and specific claims of the patent asserted. Inquire as to conception and reduction to practice. Determine which of defendant's documents have been

reviewed by plaintiff and which persons plaintiff consulted regarding infringement.

(E) Depose the Inventor(s)

If the inventor is separate from the assignee, then depose the inventor early. Inquire as to the same issues regarding the patentee plaintiff above.

(F) Depose the Plaintiff Under 30(B)(6) (If a Corporation)

Seek corporate structure, identify and authenticate key documents, and find out about secondary witnesses.

(G) Propound More Written Discovery Requests

Now that you have some documents, identified witnesses, and information from the first set of written discovery and deposing the plaintiff, follow up with more requests and discovery from third parties.

(H) Depose Third-Parties

After propounding discovery upon third parties, get them in a deposition. Authenticate documents, secure admissions needed; gauge how the witnesses will perform at trial. Depose key witnesses after less important witnesses, so that the key witnesses will be locked-in to the version of the truth provided by the secondary witnesses.

(I) Depose Key Witnesses

Depose the witness on specific issues, such as validity, infringement, willful infringement, and other infringement defenses. Review your proof rubric and shore up gaps in your evidence while reinforcing other evidence.

(J) Prepare Follow-Up Requests For Admission

Get necessary admissions nailed down. Get the defendant to admit that at least some of the claim elements are found in the prior art. Get admissions on the date of invention, contentions

regarding prior inventorship, first sale of accused device, and other issues.

(K) Depose Expert Witnesses

Investigate the expert's other testimony. Read everything that you can find authored by the expert or about the expert. Craft questions for which the only reasonable answer will be answers that help the defendant. In essence, prepare to use the plaintiff's expert to make admissions that help your case.

(L) Propound Final Written Discovery Requests

Review your proof rubric (which you should have been doing all along). What are you missing? Ask for it.

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