

The TianRui Group Company Ltd. v. U.S. International Trade Commission: A Powerful New Weapon for Combating Trade Secret Misappropriation Abroad

By Emily Miao and Chelsea Durgan

Trade secrets are often a key part of many companies' operations and intellectual property portfolios.¹ For U.S. companies doing business abroad that rely on off-shore manufacturing of their products, trade secret misappropriation by foreign entities, particularly China, is a serious concern.² If trade secret misappropriation occurs in the United States, the aggrieved trade secret owner may obtain relief through a state law trade secret misappropriation claim,³ a claim under the Computer Fraud and Abuse Act,⁴ or could seek prosecution under the Economic Espionage Act of 1996 (EEA).⁵ What if trade secret misappropriation occurs abroad and the misappropriated trade secret is used to manufacture products that are then imported into the United States to compete with the trade secret owner's products? Under the *TianRui* decision, a U.S. company doing business abroad may have recourse in the International Trade Commission ("ITC") under section 337 of the Tariff Act of 1930 ("section 337") to exclude the importation of products that embody a misappropriated trade secret, even when the trade secret theft occurred entirely outside of the United States and the U.S. company is not using its trade secret in its products.⁶

In its landmark decision, a divided panel of the Federal Circuit Court of Appeals ("Federal Circuit" or "Court") addressed the scope of the ITC's authority under section 337 to investigate trade secret misappropriation and prevent importation of products that are based on the misappropriated trade secrets. The Court held that: (i) the ITC has authority to prevent importation of products produced

with misappropriated trade secrets, even if the acts of misappropriation occur outside of the United States, (ii) that Federal common law, not state law, applies when dealing with section 337 investigations involving trade secret misappropriation and unfair competition, and (iii) that the domestic industry requirement in section 337 investigations involving non-statutory intellectual property (IP) rights does not require proof that the domestic industry practices the IP rights at issue. This important decision expands the role of the ITC in addressing the problem of international trade secret theft and provides a powerful new weapon for any U.S. company challenging imports into the United States that are based on misappropriation of its trade secrets.

Facts

Amsted Industries ("Amsted"), an Illinois-based manufacturer of cast steel railway wheels, owned trade secrets relating to wheel production processes, including the "ABC process." The ABC process was licensed to several Chinese companies, including Datong ABC Castings Company Ltd. (Datong). Amsted previously practiced the ABC process at its Alabama foundry, but abandoned that process in favor of a different proprietary process.⁷

TianRui Group Company Ltd. and TianRui Group Foundry Company Ltd. (collectively "TianRui") had sought to license Amsted's ABC process, but the parties ultimately failed to agree on the terms of the license. TianRui then hired nine Datong employees who were trained in the ABC process.⁸

continued on p. 2

Inside this issue:

1
The TianRui Group Company Ltd. v. U.S. International Trade Commission: A Powerful New Weapon for Combating Trade Secret Misappropriation Abroad

6
Conducting Efficient Patent Litigation Discovery

10
Post-Grant Review: A Double-Edged Sword

The TianRui Group Company Ltd. v. U.S. International Trade Commission: A Powerful New Weapon for Combating Trade Secret Misappropriation Abroad

continued from p. 1

Datong had previously notified those employees through a written employee code of conduct that information concerning the ABC process was proprietary and confidential. In addition, those employees had executed confidentiality agreements before leaving Datong. Despite having been advised of these obligations, those former Datong employees disclosed the ABC process to TianRui. TianRui began producing wheels in China using the ABC process.⁹

With its partner Standard Car Truck Company, Inc. (“SCT”), TianRui formed the joint venture Barber TianRui Railway Supply, LLC. (“Barber”). Both SCT and Barber marketed the TianRui wheels to U.S. customers and imported the TianRui wheels into the United States. Other than Amsted, SCT and Barber were the only companies selling or attempting to sell cast steel railway wheels in the United States.¹⁰

Amsted filed a complaint with the ITC to block the importation of TianRui’s wheels into the United States, alleging a violation of section 337 based on TianRui’s misappropriation of trade secrets.¹¹ After concluding its investigation and hearing, the Administrative Law Judge (ALJ) found a violation of section 337 under the Illinois trade secret law, general principles of trade secret law, and the Restatement (first) of Torts based on evidence that TianRui’s process was essentially identical to the ABC process and that TianRui misappropriated the ABC process.¹²

The ALJ also held that it was not essential for Amsted to prove that it used the ABC process in the United States in order to satisfy the domestic industry requirement of section 337. Rather,

all Amsted needed to prove was that its domestic industry would be substantially injured by the imported wheels.¹³

The ITC affirmed the ALJ’s initial determination without review and issued a limited exclusion order barring TianRui from importing the railway wheels into the United States for 10 years.¹⁴

TianRui appealed the ITC’s determination



The *TianRui* decision is significant because it expands the ITC’s authority to further protect U.S. domestic industries by holding that section 337 applies in cases where trade secret theft and unfair competition in connection with products imported into the United States occur entirely outside of the United States.

of a violation of section 337, raising two key issues before the Federal Circuit. First, TianRui argued that the ITC exceeded its authority under section 337 by applying Illinois trade secret law to find

a violation of section 337 based on acts of misappropriation that occurred entirely in China. Specifically, TianRui alleged that section 337 applied extraterritorially only with respect to patents and other statutory intellectual property and that there is no express language in section 337 authorizing the ITC to apply U.S. state trade secret law to conduct that occurs in a foreign country.¹⁵ Second, TianRui argued that the ITC erred in finding that the domestic industry requirement was satisfied because Amsted produces cast steel wheels by a different process. That is, TianRui asserted that the ITC misinterpreted section 337 to hold that a trade secret complainant seeking to enforce its IP rights need not practice the asserted IP domestically to establish the existence of a domestic industry.¹⁶

A divided panel of the Federal Circuit affirmed the ITC decision.¹⁷ The Court recently denied a petition for rehearing *en banc*.¹⁸

Federal Common Law, Not State Law, Governs Section 337 Investigations for Trade Secret Misappropriation

Before addressing the first issue relating to extraterritorial trade secret misappropriation, the Federal Circuit articulated important choice of law principles for section 337 investigations involving trade secrets. While the Federal Circuit affirmed the ITC’s authority under section 337 to exclude importation of products that embody a trade secret misappropriated abroad, the Court rejected the ITC’s application of Illinois trade secret law in its determination that the trade secret misappropriation that occurred was sufficient to establish an unfair method of competition under section 337.¹⁹ The Court held that a single federal standard, rather than the law of a particular state, should

be applied. The Court emphasized that protecting domestic industries from unfair competition is a distinctly federal concern with federal remedy, thus the reason for applying federal law is particularly strong.²⁰

For most states, the Court noted that the application of federal common law rather than state law is a difference without distinction.²¹ That is, federal trade secret law is based on the Uniform Trade Secrets Act (“UTSA”), the trade secret law of most states.²² The Court did not overturn the ITC decision due to reliance on Illinois trade secret law on the basis that the outcome of the case was not affected by the application of Illinois trade secret law since that law was based on the UTSA.²³

Section 337 Applies to Exclude Imported Products that Embody Trade Secrets Misappropriated Abroad

The Court affirmed that the ITC has authority under section 337 to exclude the importation of products into the United States where those products were made using a trade secret misappropriated abroad. While the Court acknowledged the Congressional presumption against extraterritorial application of U.S. domestic law in the absence of clear intent otherwise, the Court asserted that the presumption does not apply in this case for three reasons.²⁴ First, section 337 applies to “[u]nfair methods of competition and unfair acts in the importation of articles” into the United States.²⁵ Since importation is an inherently international act, “it is reasonable to assume that Congress was aware, and intended, that the statute would apply to conduct . . . that may have occurred abroad.”²⁶ Secondly, the Court pointed out that the ITC “does not purport to regulate purely foreign conduct.”²⁷ Rather, the “unfair” activity is only prohibited to the extent that it results in importing goods into the United

States and causing domestic injury. Thirdly, the Court determined that the legislative history of section 337 supports a statutory interpretation permitting the ITC to evaluate conduct that occurs extraterritorially since “Congress intended a . . . broad and flexible meaning.”²⁸

Finally, the Court pointed out that applying U.S. trade secret law would not improperly interfere with Chinese law since the ITC would not be regulating purely extraterritorial conduct and would not affect TianRui’s ability to sell its cast steel wheels in China or elsewhere outside of the United States.²⁹ In addition to importation into the United States, the Court noted that Datong’s employee agreements and the nondisclosure agreement between Datong and Amsted established grounds for the ITC to enforce the agreement between a Chinese company and a U.S. company.³⁰ The Court found that such provisions were important in establishing the elements of trade secret misappropriation, regardless of whether the misappropriation occurred in the United States or abroad.³¹

Section 337 Does Not Require that the Misappropriated Trade Secret Be Practiced in the United States in Order to Find Injury or Threat to the Domestic U.S. Industry

With respect to the second key issue, the Court affirmed that a trade secret complainant need not show that it practices the misappropriated trade secret in the United States in order to satisfy the requirement of injury or threat to a domestic U.S. industry under section 337.³² The Court, in applying the domestic injury requirement, distinguished between statutory intellectual property claims (section 337(a)(1)(B-E)) and those claiming non-statutory unfair practices (section 337(a)(1)(A)).³³ The Court noted

that “Section 337 contains different requirements for statutory intellectual property (such as patents, copyrights, and registered trademarks) than for other, non-statutory unfair practices in importation (such as trade secret misappropriation).”³⁴ For statutory intellectual property, it is necessary that an industry relating to the protected intellectual property exists or is being established.³⁵ In contrast, the Court held that non-statutory intellectual property such as trade secrets requires that the unfair practice threaten to destroy or substantially injure domestic industry, without expressly requiring that the domestic industry be based on the intellectual property in question.³⁶ Since the Court concluded that TianRui’s wheels could directly compete with Amsted’s wheels, it held that the domestic industry injury requirement was met.³⁷

The Dissent

The panel mainly diverged on the issue of extraterritoriality with respect to the relevant location of conduct for a section 337 analysis.³⁸ In a vigorously worded dissent, Judge Moore argued that the Court impermissibly expanded the reach of section 337 and asserted that:

The majority in this case expands the reach of both 19 U.S.C. § 1337 (§ 337) and trade secret law to punish TianRui Group Company Limited (TianRui) for its completely extraterritorial activities. As a court, however, we must act within the confines set out by the text of the law. Here, there is no basis for the extraterritorial application of our laws to punish TianRui’s bad acts in China.

The issue is whether § 337 authorizes the Commission to apply domestic

continued on p. 4

The TianRui Group Company Ltd. v. U.S. International Trade Commission: A Powerful New Weapon for Combating Trade Secret Misappropriation Abroad

continued from p. 3

trade secret laws to conduct which *entirely* occurs in a foreign country.

While TianRui is certainly not a sympathetic litigant—it poached employees to obtain confidential information—none of the unfair acts occurred in the United States and, as such, there is no violation of United States law which amounts to an unfair trade practice under the statute.³⁹

The dissent argues that there is no clear indication of congressional intent in either the statute or the legislative history to extend the reach of section 337 to wholly extraterritorial unfair acts. The dissent determined that “unless there is the affirmative intention of Congress clearly expressed to give a statute extraterritorial effect, we must presume it is primarily concerned with domestic conditions.”⁴⁰ Judge Moore determined that section 337 can only cover unfair actions in importation and thus can only cover trade secret misappropriation that occurs in the United States, in contrast to the majority’s assertion that Congress “clearly intended to create a remedy for the importation of goods resulting from unfair methods of competition.”⁴¹ As such, the dissent concludes that section 337 “does not reach the misappropriation and use of trade secrets in China, even if the product of the misappropriated process is ultimately imported into the United States.”⁴²

Conclusion

The *TianRui* decision is significant because it expands the ITC’s authority to further protect U.S. domestic industries by holding that section 337 applies in cases where trade secret theft and unfair competition in connection with products imported into the United States occur entirely outside of the United States. *TianRui* also announced

the existence of new law—federal common law—governing trade secret claims brought under section 337, leaving the elements of that law to development in subsequent cases. Furthermore, *TianRui* reminds foreign importers that importation of their products into the U.S. market requires compliance with section 337, and that their overseas conduct may result in a finding of trade secret misappropriation in the ITC.

Finally, the Court’s opinion in *TianRui* is not the only authority addressing the increasing threat of trade secret misappropriation to the United States. Congress has acknowledged the increasing danger to the U.S. economy and national security caused by trade secret theft of U.S. technology and has decided that further protection is needed.⁴³ Legislation has recently been introduced in Congress to further enable U.S. companies to combat trade secret theft, including the ability to seek redress in federal courts, rather than having to file suit in individual state courts, and to enhance criminal penalties for corporate espionage.⁴⁴ It is possible that some or all of the *TianRui* decision may be codified as law in the event that Congress takes further action.

Endnotes

- 1 See Emily Miao, *Trade Secret Basics: What Every Business Owner Needs to Know*, SNIPPETS, Vol. 8, Issue 1, Winter 2010, at 1, <http://www.mhbh.com/files/FirmService/e2dd2878-641d-44cd-8041-d4920608aa6e/Presentation/ceSnippetIssue/Snippets%20Vol%208%20Issue%201%20Online.pdf> (providing an overview of basic trade secret law).
- 2 18 U.S.C. § 1831 (1996); Steven E. Feldman & Sherry L. Rollo, *Extraterritorial Protection of Trade Secret Rights in China: Do Section 337 Actions at the ITC Really Prevent Trade Secret Theft Abroad?*, 11 J. MARSHALL REV. INTELL. PROP. L. 523 (2012). See OFFICE OF NAT’L COUNTERINTELLIGENCE EXECUTIVE,

FOREIGN SPIES STEALING U.S. ECONOMIC SECRETS IN CYBERSPACE: REPORT TO CONGRESS ON FOREIGN ECONOMIC COLLECTION AND INDUSTRIAL ESPIONAGE i (Oct. 2011) (stating that “Chinese actors are the world’s most active and persistent perpetrators of economic espionage” and that six of the seven cases that were adjudicated under the EEA—both Title 18 U.S.C. §§ 1831 and 1832—in the Fiscal Year 2010, involved a link to China).

- 3 See Miao, *supra* note 1, at 5.
- 4 18 U.S.C. § 1030 (2008).
- 5 18 U.S.C. § 1831; Feldman & Rollo, 11 J. MARSHALL REV. INTELL. PROP. L. at 525.
- 6 *TianRui Group Co. v. ITC*, 661 F.3d 1322, 1324 (Fed. Cir. 2011).
- 7 *Id.*
- 8 *Id.*
- 9 *Id.*
- 10 *Id.* at 1324-1325.
- 11 *Id.* at 1325.
- 12 *Id.*
- 13 *Id.* at 1326.
- 14 *Id.*
- 15 *Id.* at 1325-1326.
- 16 *Id.* at 1326.
- 17 *In the Matter of Certain Cast Steel Railway Wheels*, USITC Inv. No. 337-TA-655, 2009 WL 2350640 (ITC Feb. 27, 2009).
- 18 *TianRui Group Co. v. ITC*, 2012 U.S. App. LEXIS 4790 (Fed. Cir. Feb. 1, 2012).
- 19 *TianRui Group Co.*, 661 F.3d at 1327.
- 20 *Id.*
- 21 *Id.* at 1327-1328.
- 22 A handful of states have not adopted the UTSA. NAT’L CONFERENCE OF COMM’RS ON UNIF. STATE LAWS, A FEW FACTS ABOUT THE UNIFORM TRADE SECRETS ACT, <http://www.uniformlaws.org/Act.aspx?title=Trade%20Secrets%20Act> (last visited Oct. 25, 2012).
- 23 *TianRui Group Co.*, 661 F.3d at 1328.
- 24 *Id.* at 1329.
- 25 19 U.S.C. § 1337(a)(1)(A) (2004).
- 26 *TianRui Group Co.*, 661 F.3d at 1329.
- 27 *Id.*

- 28 *Id.* at 1330-1331.
- 29 *Id.* at 1332. The majority claimed there was no conflict between the trade secret laws in the United States and China, and concluded that the absence of conflict supported granting “relief based on extraterritorial acts of trade secret misappropriation relating to the importation of goods affecting a domestic industry.” *Id.* at 1333. In her dissenting opinion, Judge Moore pointed out the majority’s failure to recognize the conflict of laws issue presented by TianRui. The majority eagerly affirmed the Commission’s decision by extending the reach of section 337 to apply extraterritorially. In doing so, the majority failed to acknowledge that U.S. law provides no express cause of action, and given that a violation of Chinese law occurred, the remedy should come from the Chinese courts. *Id.* at 1343.
- 30 *Id.* at 1333.
- 31 *Id.*
- 32 *Id.* at 1337.
- 33 *Id.* at 1335.
- 34 *Id.*
- 35 19 U.S.C. § 1337(a)(2).
- 36 19 U.S.C. § 1337(a)(1)(A).
- 37 *TianRui Group Co.*, 661 F.3d at 1337.
- 38 In addition, Judge Moore pointed out in her dissenting opinion that absent a clear intent by Congress, statutes do not have extraterritorial application. Given that section 337 does not expressly include the authority to apply its provisions to acts occurring abroad, Judge Moore reasoned that section 337 does not apply to the misappropriation of Amsted’s trade secrets that occurred in China. Judge Moore distinguished trade secret law from other areas of intellectual property law—namely, process patents—where Congress has clearly indicated the statute’s extraterritorial scope. “Congress could have legislated generally to grant extraterritorial application to any “unfair acts” in section 337, but did not. Congress only changed the statute to create a remedy for extraterritorial use of process patents. This delicate legislative touch indicates that Congress intended to give special treatment solely to process patents, and not to other categories of
- ‘[u]nfair methods of competition and unfair acts in the importation of articles.’” *Id.* at 1339-1341.
- 39 *Id.* at 1337-1338.
- 40 *Id.* at 1338-1339.
- 41 *Id.* at 1339-1340.
- 42 *Id.* at 1342.
- 43 In recognition of the growing importance of trade secrets and trade secret enforcement in the U.S. market, Congress, in enacting the EEA, expanded intellectual property protection to trade secrets, expressly recognizing that “proprietary economic information” is “an integral part of America’s economic well-being” and of “growing importance.” See H.R. REP. No. 104-788, at 4 (1996).
- 44 In July 14, 2012, Senators Kohl and Coons introduced legislation entitled “Protecting American Trade Secrets and Innovation Act of 2012” (PATSI) to expand the legal options for victims of economic espionage and trade secret theft, and to create a private cause of action under federal law for trade secret violations. Prior to PATSI, Senator Kohl sponsored legislation entitled the “Economic Espionage Penalty Enhancement Act of 2011,” which increased criminal penalties for persons committing economic espionage. The Act passed the Senate Judiciary Committee with amendment, and is presently under consideration by the full Senate and House of Representatives. See *Protecting American Trade Secrets and Innovation Act of 2012*, S. 3389, 112th Cong. (2012). Text as of Jul 17, 2012, available at <http://www.gpo.gov/fdsys/pkg/BILLS-112s3389is/pdf/BILLS-112s3389is.pdf>.

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MBHB to Exhibit at 2013 BIO International Convention in Chicago

McDonnell Boehnen Hulbert & Berghoff LLP will be participating as an exhibitor at the 2013 BIO International Convention (“BIO”) set for April 22-25 in Chicago. We invite you to visit us at Booth #3763 in the exhibit hall to meet our attorneys, learn more about our services and enter our raffle. Billed as the largest global event for the biotechnology industry, 2013 BIO is organized by the Biotechnology Industry Organization. The organization represents more than 1,100 biotechnology companies, academic institutions, state biotechnology centers and related organizations across the United States and in more than 30 other nations. BIO members are involved in the research and development of innovative healthcare, agricultural, industrial and environmental biotechnology products.

2013 BIO covers the wide spectrum of life science innovations and application areas. Drug discovery, biomanufacturing, genomics, biofuels, nanotechnology, and cell therapy are just a few of the industries represented at the BIO International Convention. More than 15,000 leaders from over 65 countries are expected to attend 2013 BIO. The key elements of the event are education, networking, partnering and the 1,800 companies showcasing the latest technologies, products and services in the BIO Exhibition. View complete details at <http://convention.bio.org/>.

Emily Miao, Ph.D., an MBHB partner, has broad experience in all aspects of intellectual property practice, including patent, trademark and copyright procurement and portfolio management; client counseling on validity, infringement, freedom-to-operate (FTO), due diligence reviews, and patent strategy matters; and licensing/secretcy agreements.

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Conducting Efficient Patent Litigation Discovery

By Kurt W. Rohde

The costs associated with discovery, and particularly electronic document discovery, in patent litigation can be effectively controlled with upfront planning, preparation, and coordination between in-house and outside counsel. Presented in this two-part article are some practical considerations for conducting efficient document collection and review. In this first part, early collection activities and agreements with opposing counsel are discussed. In the second part, developing and implementing a collection plan and reviewing documents will be discussed.

Early Collection Activities

Discovery cost control and efficiency planning start well before document requests ever arrive. Through active planning, in-house and outside attorneys can coordinate to reduce the crush of activity that accompanies the arrival of initial document requests. In almost every patent case, there are activities you can begin prior to the start of discovery to prepare for anticipated document collection. For instance, creating a list of key terms, creating a patent and critical event history, pre-collecting certain documents and investigating relevant international collection impediments can all be accomplished prior to the arrival of the first document request. Each can serve to set you on the path to a more efficient collection and review effort.

Develop a List of Key Terms

Of all the early collection activities, creation and maintenance of a key term list is perhaps the most crucial. Key terms serve a variety of roles and are important to identify early in the discovery process. They can serve to help identify critical documents during collection and review, to filter large volumes of documents during

e-discovery, and to help train reviewers and outside contract attorneys who have to get up to speed quickly.

On the other hand, failure to identify key terms early can lead to repetitive (and consequently costly) document collection and review down the road. Compounding the problem, re-review of documents can create problems with sequential document production. This occurs when previously non-responsive or unidentified documents are later found and produced long after their familial neighbors were produced. Not only will opposing counsel potentially take issue with this, but it can make later preparation for depositions and trial more time consuming.

Consider developing a master key term list at the very beginning of discovery. This list should be a “living” document shared amongst all litigation and review team members and should be updated regularly as new information is learned. Distributions of dated list copies should be disseminated whenever changes are made. Not only does this apprise team members of new information relevant to collection and review, it can also serve as a reminder to add any new information they may have discovered.

Certain key terms should be identified as early as possible. For example, for marketed products covered by a patent-in-suit, there will frequently be development project nomenclature, such as project name and/or numbers. By identifying that nomenclature early, plus that of any related or precursor projects, it will simplify later collection and review of documents. Similarly, marketed product names and competitive product names are also important terms. Patent numbers, patent application numbers, and patent prosecution docket numbers are

additional common terms that should be identified early.

Develop a Patent Family Tree

Also consider developing a patent family tree for all patents-in-suit. This serves not only to identify key terms, but also to give document reviewers and litigation attorneys a quick reference sheet when they are evaluating the significance of a date, docket number, or other prosecution item. A useful patent tree document should include all docket numbers (and any shorthand variations thereof), filing dates, issue dates, continuity claims, inventor names, serial numbers, and, if relevant to assertions of inequitable conduct, prosecuting attorney names.

Develop a Key Event Timeline

By starting a key event timeline early in the discovery process, all team members may easily record knowledge they gain while conducting employee interviews or reviewing documents. A key event timeline can serve as a master record of how the inventive process occurred, testing proceeded, ownership was transferred, and licensing occurred. It is supremely useful for helping to determine conception and reduction-to-practice dates, and for evaluating asserted prior art. A key event timeline should have, at a minimum, a date field, an event description field, and an evidence identification field (e.g., a document Bates number, an interview summary, or some other source identifier for the event described).

Pre-Collect Documents

It is not necessary to wait until the start of formal discovery to collect documents. There are some documents that are almost always requested through initial document requests, or are otherwise useful for investigating the facts of the case. Good

candidates for pre-collection include:

- Invention records and assignments
- Internal patent docket files
- USPTO certified patent file histories
- Current and historical document retention and destruction policies
- Current and historical organizational charts
- Contractual agreements involving the patented product, including development, testing, sales, supply, licensing, and assignment
- Patented product sales and profit/loss summaries

International Collection Preparation

Finally, during the early collection activity period, it is important to identify whether documents and e-discovery must be collected from international locations. If international collections are required, you should determine as early as practical the applicable discovery and privilege rules for those countries.

As an example, e-discovery in Europe is much less common than in the U.S. and is much more restrictive. Throughout much of Europe, employees have an expectation of privacy relating to personal use of their company computer. Therefore waivers may have to be obtained from each employee from whom e-discovery is sought. Further, each employee may have the right to review all data collected from their electronic devices. This can be a time-consuming and expensive process and thus should factor into early negotiations with opposing counsel and decisions surrounding discovery scope.

Agreements with Opposing Counsel

Prior to the formal start of document collection and e-discovery, or during its very earliest stages, it is important to consider

continued on p. 8

MBHB Favorably Ranked in 2013 Edition of *U.S. News-Best Lawyers* “Best Law Firms”

McDonnell Boehnen Hulbert & Berghoff LLP (“MBHB”) is highly ranked in three distinct intellectual property-related practice areas within the 2013 edition of *U.S. News-Best Lawyers* “Best Law Firms” at the national and metropolitan levels. Overall rankings are based on a rigorous evaluation process that includes the collection of client and lawyer

evaluations, peer review from leading attorneys in their relevant practice area(s), and a review of additional information provided by law firms as part of the formal submission process. Rankings are presented in tiers one through three both nationally and by metropolitan area or by state (with Tier 1 being the highest level). MBHB is ranked as follows:

National Level

- Patent Law (Tier 2)
- Litigation – Intellectual Property (Tier 2)
- Litigation – Patent (Tier 2)

Chicago-Metro Level

- Patent Law (Tier 1)
- Litigation – Patent (Tier 1)
- Litigation – Intellectual Property (Tier 1)

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Conducting Efficient Patent Litigation Discovery

continued from p. 7

reaching stipulated agreements on certain areas of discovery. Limiting scope and defining production expectations early can lead to higher efficiencies and lower costs during later collection and review.

Scope

The scope of document collection is acutely important in the current age of e-discovery. Barring local discovery rules or general orders governing patent litigation e-discovery, there are certain issues ripe for stipulated discovery agreements that can minimize collection and review time.

First, consider a scheduled exchange of filter terms. Filter terms are key words used to identify potentially responsive electronic documents from raw sources such as cloned hard drives, network shares, email servers, etc. Remember that master key term list discussed earlier? This is a good time to trim that list down to the fewest and the narrowest terms that can be used to identify responsive documents. If you have not put significant effort into developing an accurate key term list early in the process, you are in danger of having to perform multiple, expensive iterations of document filtering and re-review. Plus, you may have to disclose revised filter term lists to opposing counsel, thereby shining a light on any newly added terms.

While a filter term list cannot remove your obligation to produce responsive documents, it can set the basis for culling much of the chaff from the review. Consequently, the list should be scrubbed of generic terms and should make significant use of Boolean terms (e.g., "<inventor name> AND <project number>"). If possible, it should also be run through a pre-screening program on a subset of collected documents in order to

determine which filter terms are generating too many false positives.

Second, consider agreeing to forgo collection from PDA devices such as mobile phones, tablet computers, etc. PDA e-discovery is an expensive process and, for most patent litigation cases, it is only a productive effort when there is specific evidence contained in unique documents or information that are located only on PDA(s) and nowhere else.

Likewise, consider agreeing to forgo collection from archived backup data. Absent specific evidence of unique documents or information that are not otherwise obtainable, retrieving, filtering, and reviewing archived data is generally more burdensome on the document producer than it is beneficial to the document requestor. Exceptions to PDA and archive document collection can be written into any stipulation, but consider starting with the initial anticipation that no documents will be collected unless specific cause requires such collection.

Finally, consider agreeing to the production of summarized data in lieu of raw documents for certain types of requests. This is, of course, tempered with the caveat that the underlying data or certain specific categories of those documents will be produced upon request.

Summary productions are particularly useful when secondary considerations of non-obviousness are argued. These secondary consideration assertions tend to open the flood gates to subsequent document requests that are directed to broad swaths of marketing, sales, and financial information relating to the commercial success of a patented product.

Unfortunately, there is no simple way to electronically filter and distill marketing and sales data. Plus, many documents that contain such data also may contain highly-confidential data for other products that are irrelevant to the case. This can lead to time-intensive redaction efforts, and those efforts are never 100% accurate or effective. Consequently, an early agreement to produce sales and profit/loss summaries (such as the ones you collected/generated in your early collection activities) in lieu of raw responsive documents can save substantial costs during e-discovery. Similarly, agreed stipulations regarding the production of summaries or exemplary documents concerning ancillary test data, market research, promotional efforts, organizational charts, etc., can markedly decrease the time required for document review and redaction.

Production

Document production formats and scope are sometimes not considered until after collection and review has begun. However, if you are able to reach consensus early in the process, it can help guide future collection and review activities. At a minimum, you should identify what, if any, of the following data will accompany a document production:

- Document custodian data (e.g., who/where it was collected from)
- Document metadata (e.g., date created, date modified, author, etc.)
- Red-lining history (e.g., Microsoft® Word's document review tracking feature)

Further, an agreement should be reached on each party's preferred document production format. Some questions to consider include:

- What is the image format – TIFF, PDF, or some other format?
- How are spreadsheets reproduced?

- Who has responsibility for OCR – the producing or receiving party?
- What format will the OCR be in – e.g., will it be paginated?
- What type of load file is acceptable?

Production of native files is another issue that should be decided early. This can have a significant impact on review time and on redaction efforts. Some questions to consider:

- Will native files be produced?
- If so, will all natives be produced or just on demand?
- Will certain file types, such as spreadsheets, always be produced in native format?
- How will redactions be handled for documents that are produced in native format?

Conclusion

In conclusion, by carefully planning and implementing early collection activities and agreements with opposing counsel, much of the burden and cost associated with the overall discovery process may be reduced. By proceeding carefully and thoughtfully early in the discovery process, counsel may reap many benefits at later stages of litigation.

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McDonnell Boehnen Hulbert & Berghoff LLP is pleased to announce firm partners Paul H. Berghoff, Daniel A. Boehnen, Kevin E. Noonan, Ph.D. and Leif R. Sigmond, Jr. were selected by their peers for inclusion in the *Best Lawyers in America*® 2013 edition. *Best Lawyers* is a highly respected peer-review publication that is widely regarded by both clients and legal professionals as a significant honor. The MBHB partners are listed in the following *Best Lawyers*-designated specialty areas:

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Post-Grant Review: A Double-Edged Sword

By Alan W. Krantz

The Leahy-Smith America Invents Act (AIA), signed into law in 2011, promises the most radical changes to U.S. patent law in over 50 years.¹ The act eliminates the first-to-invent system of granting patents in favor of a first-to-file system,² gives the U.S. Patent & Trademark Office (USPTO) the authority to set its own fees,³ and authorizes—indeed mandates—the establishment of USPTO satellite offices outside of the Washington, D.C. area.⁴

Another watershed change is the creation of a “post-grant review” (or “PGR”) procedure by which any member of the public can challenge the validity of an issued patent, on a variety of grounds, before a USPTO tribunal. Prior to the establishment of PGR, the grounds for challenging patent validity before a USPTO tribunal were generally limited to prior description of the claimed invention in a patent or publication. Challenges based on prior public use or sale were not permitted in the USPTO, but instead were allowed only in district court.⁵ Such restrictions limited the number of patent validity challenges before the USPTO. The AIA eliminates the old procedures and establishes PGR as a less-restrictive means for challenging patent validity. In addition to the greater number of grounds on which to challenge patent validity, PGR provides for limited discovery by both parties and an accelerated timeline for a decision by the tribunal. With these changes, the AIA endeavors to create a “quicker, lower cost alternative to district court litigation.”⁶

Yet with these relaxed restrictions come drawbacks. Chief among them are that the losing party in PGR is essentially barred from re-arguing validity of the patent in a subsequent district court action.⁷ This “collateral estoppel” created by a decision on patent validity in PGR is not

unusual. Indeed, the general rule in federal courts is that a valid and final judgment in favor of the plaintiff prevents the defendant in a subsequent action by the plaintiff from raising any defense that the defendant raised *or could have raised* in the first action, and judgment in favor of the defendant bars another action by the plaintiff against the defendant on the same claim.⁸

snippets.

Neither the AIA nor the patent rules explicitly define when evidence is “directly related” to a factual assertion, or how the addition of this limitation to the relevance limitation is intended to limit the scope of discovery.

But application of collateral estoppel by a district court subsequent to a PGR decision may prove problematic. Again, unlike previous procedures for challenging the validity of a patent before the USPTO, which limited the grounds for invalidity to description of the patent in a prior patent or publication, PGR is not so limited and allows challenges based on prior use, knowledge, or sale. Accordingly, factual issues are no longer limited to the text of the prior patent or publication, but extend

beyond its four corners to embrace issues such as specifics of the item used or sold, the scope of knowledge acquired by the public as a result of the item’s use or sale, and the credibility of witnesses testifying to the use or sale. The restricted discovery procedures in PGR may prevent a party from investigating these issues in a way that would otherwise be allowed in district court. Consequently, PGR tribunals and district courts could come to differing conclusions on the validity of the same patent.

While application of collateral estoppel is likely to give challengers pause before deciding to proceed with PGR, it could also usurp patent owners’ abilities to fully investigate a challenger’s bases for invalidity.

1. Estoppel in Post-Grant Review

The PGR estoppel provision of the AIA provides:

The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision . . . may not assert either in a civil action . . . that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that post-grant review.⁹

As discussed previously, the PGR estoppel provision is a statutory codification of the common-law doctrine of “collateral estoppel,” which treats a final decision in an action as the full measure of relief to be accorded between the same parties on the same claim or cause of action.¹⁰ Accordingly, the plaintiff cannot bring a subsequent action based on the same claim of a previous action, and the defendant cannot re-assert in a subsequent action any defense that was raised in a prior action. Importantly, the estoppel extends

to all issues relevant to the same claim between the same parties, *whether or not raised in the proceeding*.¹¹ The purpose of claim preclusion is thus to avoid multiple suits on identical grounds between the same parties and thus redetermination of identical issues.¹²

Common law provides for exceptions to the application of collateral estoppel. One such exception is that collateral estoppel will not apply in a subsequent proceeding if the party otherwise to be estopped was not allowed a “full and fair” opportunity to litigate the issue in a prior proceeding. The U.S. Supreme Court stated that application of collateral estoppel in a subsequent action may be improper if a party “in the first action was forced to defend in an inconvenient forum and therefore was unable to engage in full scale discovery or call witnesses.”¹³ Thus, there is a tension between PGR and statements of the Court.

2. Post-Grant Review Procedure

The discovery allowed in a district court patent-validity proceeding is broader than that allowed in PGR. Admittedly, both proceedings require that the sought evidence be “relevant.”¹⁴ But district courts apply a relaxed standard for relevancy during discovery. Rule 401 of the Federal Rules of Evidence provides that “[e]vidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.”¹⁵ Yet the U.S. Supreme Court has stated that relevancy “has been construed broadly to encompass any matter that bears on, or that reasonably could lead to other matter that could bear on, any issue that is or may be in the case.”¹⁶ Further, “discovery is not limited to issues raised by the pleadings, for discovery itself is designed to help define and clarify the issues . . . or is

discovery limited to the merits of a case, for a variety of fact-oriented issues may arise during litigation that are not related to the merits.”¹⁷ Moreover, the Federal Rules of Civil Procedure state that the discovery sought need not be “directly” related to a claim or defense raised in a given action:

For example, other incidents of the same type, or involving the same product, could be properly discoverable under the [Federal Rules’ discovery] standard. Information about organizational arrangements or filing systems of a party could be discoverable if likely to yield or lead to the discovery of admissible information. Similarly, information that could be used to impeach a likely witness, although not otherwise relevant to the claims or defenses, might be properly discoverable.¹⁸

In contrast to the broad scope of discovery allowed in district court proceedings, discovery in PGR is further limited to “evidence directly related to factual assertions advanced by either party in the proceeding.”¹⁹ The “Office Patent Trial Practice Guide” also prescribes that the name of each individual likely to have discoverable evidence, along with the location (or a copy) of documents that the party may use to support its claims or defenses, must be disclosed “unless the use would be solely for impeachment.”²⁰

Neither the AIA nor the patent rules explicitly define when evidence is “directly related” to a factual assertion, or how the addition of this limitation to the relevance limitation is intended to limit the scope of discovery. One possibility is that the “directly related” limitation is no limitation at all: as long as a party makes a factual assertion regarding

an issue, whether or not that issue is relevant to a claim or defense, then the party is allowed discovery on that issue. Accordingly, a party could obtain evidence to impeach a witness’s testimony by making a factual assertion that the witness is a liar, for example.

But such a broad interpretation of “directly related” is unlikely to be adopted by the Patent Trial and Appeal Board at the USPTO. Such a reading would allow for discovery broader than that allowed in a district court, since the AIA does not require that the evidence be relevant to a “claim or defense,” but only a “factual assertion,” and the statute does not purport to limit those factual assertions in any way. Further, Congress intended that the scope of discovery in PGR be narrower than that in district court: “The legislative history further states that it was anticipated that the Office would be conservative in its grants of discovery due to the time deadline constraints on the proceedings.”²¹ Thus, discovery in PGR is limited “due to concerns over imposing costs and potential delays upon a party desiring a quicker, lower cost alternative to district court litigation.”²² Moreover, that evidence used solely for impeachment is not generally discoverable suggests that not just any “factual assertion” will give license for discovery regarding issues to which that assertion relates. It seems unlikely then that the Board would adopt any interpretation of “directly related” that would allow for as much (or more) discovery in PGR than in district court.

Thus, evidence that is clearly relevant may not be discoverable in PGR. Impeachment evidence is just one example. The credibility of witness testimony could prove decisive

continued on p. 12

Post-Grant Review: A Double-Edged Sword

continued from p. 11

in a proceeding challenging patent validity on the ground of prior use, knowledge, or sale. The importance of witness credibility is evidenced by the Federal Circuit's noting that "[g]enerally, oral testimony of prior public use must be corroborated in order to invalidate a patent."²³ The patent owner may be denied discovery of impeachment evidence in PGR, even though such evidence is relevant to the witness's credibility, and though witness credibility can be so important.

Additionally, the time allowed for discovery and trial preparation in a district court patent validity proceeding is generally longer than that allowed in PGR. The average time to trial for a patent infringement action in district court is 2.5 years.²⁴ Some district courts allow each party as much as nine months of fact discovery, and other districts may allow more time.²⁵ In contrast, the PGR rules provide a one-year timeframe from a decision to institute trial to a final decision, with up to a six-month extension for good cause.²⁶ The patent owner is allowed only three months of discovery, extensible upon a showing of good cause.²⁷ Thus parties in a district court action might be afforded twice as much time for discovery (or more) as is allowed in PGR, and twice the amount of time to prepare their cases prior to trial.

3. The Upshot

There seems a strong argument that PGR is not a "full and fair opportunity" to challenge the validity of a patent. As noted above, the scope of discovery allowed in PGR is almost certainly narrower than that in district court. A liberal discovery procedure would be at odds with the intent of Congress to provide a "quicker, lower cost alternative to district court litigation." And impeachment evidence is just one example of relevant evidence that is not

generally discoverable in PGR that would be discoverable in district court.

Moreover, the time allowed for discovery and trial preparation is much shorter in PGR than in district court. The one-year target for completing PGR provides parties less time to prepare briefings and motions as compared to the average 2.5 years in district court to prepare such pleadings.

snippets.

Another watershed change is the creation of a "post-grant review" (or "PGR") procedure by which any member of the public can challenge the validity of an issued patent, on a variety of grounds, before a USPTO tribunal. Prior to the establishment of PGR, the grounds for challenging patent validity before a USPTO tribunal were generally limited to prior description of the claimed invention in a patent or publication.

Nonetheless, a PGR petitioner's argument that collateral estoppel should not apply in district court is almost certain to fail. The petitioner has its choice of forum—the USPTO (by way of PGR) or district court. The court in a subsequent action is unlikely to sympathize with petitioner's choice to proceed in a forum with restrictive and accelerated discovery.

Accordingly, a would-be challenger must choose its forum carefully, since it is allowed only one shot to challenge patent validity. On one hand, the challenger could proceed in the USPTO. Though discovery is limited and timing accelerated, the total cost of challenging patent validity is almost certain to be lower than a challenge in district court—precisely because of the limited discovery and accelerated timeline. On the other hand, the challenger may be willing to accept the higher cost of district court litigation in exchange for broader discovery.

Patent owners fare worse than challengers, however. A challenger could prevent the patent owner from proceeding with district court discovery by filing for PGR. The patent owner would then have to proceed with the abbreviated discovery of PGR and, if the challenge to validity is successful, have its patent claims narrowed or cancelled altogether. Once the claims are narrowed or cancelled, the patent owner may have no redress in district court.

Endnotes

- 1 See generally Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).
- 2 *Id.* § 3. A more precise characterization is a "first-inventor-to-file" system. See, e.g., Changes To Implement the First Inventor To File Provisions of the Leahy-Smith America

- Invents Act, 77 Fed. Reg. 43,742, 43,742-43 (July 26, 2012).
- 3 Leahy-Smith America Invents Act § 10.
 - 4 *Id.* §§ 23-24.
 - 5 35 U.S.C. §§ 301, 311 (2010).
 - 6 Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,637 (Aug. 14, 2012).
 - 7 See Leahy-Smith America Invents Act § 6, 125 Stat. 284, 308 (codified as 35 U.S.C. § 325(e) (Supp. 2011)).
 - 8 Restatement (Second) of Judgments § 18-19 (1982).
 - 9 Leahy-Smith America Invents Act § 6(d), 125 Stat. 284, 308 (codified as 35 U.S.C. § 325(e) (Supp. 2011)).
 - 10 See *Kremer v. Chemical Constr. Corp.*, 456 U.S. 461, 466 n.6 (1982).
 - 11 *Id.*
 - 12 See, e.g., *Kaspar Wire Works, Inc. v. Leco Eng'g & Mach., Inc.*, 575 F.2d 530, 535 (5th Cir. 1978).
 - 13 *Parklane Hosiery Co. v. Shore*, 439 U.S. 322, 331, n. 15 (1979)
 - 14 35 U.S.C. § 326(a)(5) ("The Director shall prescribe regulations... setting forth standards and procedures for discovery of relevant evidence...."); F.R.C.P. 26(b)(1) ("Parties may obtain discovery regarding any nonprivileged matter that is relevant to any party's claim or defense....").
 - 15 Fed. R. Evid. 401.
 - 16 *Oppenheimer Fund, Inc. v. Sanders*, 437 U.S. 340, 351 (1978).
 - 17 *Id.*
 - 18 Advisory Comm. on Evidence Rules, Proposed Amendments to the Federal Rules of Evidence, H.R. Doc. No. 106-225, at 227 (2000) (reprinted in 192 F.R.D. 340, 389 (2000)).
 - 19 Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680, 48,731 (Aug. 14, 2012) (codified at 37 C.F.R. § 42.224).
 - 20 77 Fed. Reg. 48,762 (Aug. 14, 2012).
 - 21 Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,636-37 (Aug. 14, 2012).
 - 22 *Id.* at 48,637.
 - 23 *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 737-38 (Fed. Cir. 2002).
 - 24 2012 PATENT LITIGATION STUDY: LITIGATION CONTINUES TO RISE AMID GROWING AWARENESS OF PATENT VALUE 25 (2012). http://www.pwc.com/en_US/us/forensic-services/publications/assets/2012-patent-litigation-study.pdf.
 - 25 See, e.g., Northern District of Illinois Local Patent Rules, <https://www.ilnd.uscourts.gov/LocalRules.aspx?rtab=patentrules> (last visited Nov. 1, 2012).
 - 26 Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680, 48,690 (Aug. 14, 2012) (citing 37 C.F.R. 42.200(c)).
 - 27 *Id.* at 48,730-31.

Alan W. Krantz, an MBHB associate, prepares and prosecutes patent applications, conducts legal research, and provides technological advice in support of validity, infringement, and patentability analyses, patent application preparation and prosecution, and litigation matters in the computing field.

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Wednesday, December 12, 2012

10:00-11:15 a.m. CT
Live Webinar via WebEx

With all the time we have had to get ready for the final phase of the America Invents Act ("AIA"), one would think that just about everyone had made all the adjustments necessary by now. Have you? If you have, great! Consider this a checklist to make sure that you have the bases covered. If not, now's the time to consider them.

In this presentation, we will discuss some of the things that you can do while you still have time before the March 2013 deadline:

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- Assess commercialization/trade secret strategies
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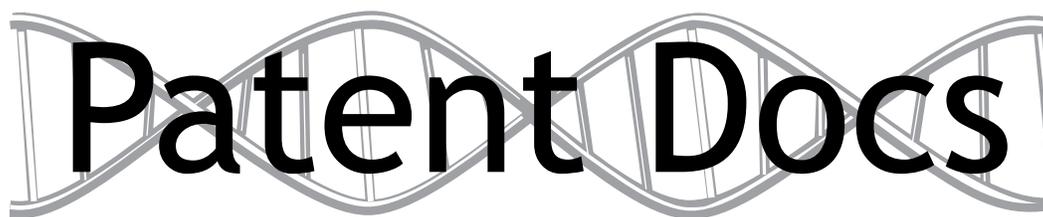
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