

On the Use of Experts for Patent Enforcement and Defense

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Patent attorneys are experts in IP (intellectual property) law and are also engineers or applied scientists/mathematicians. While patent attorneys are generally very knowledgeable about law and particularly patent law, they tend to vary in their technical abilities or the time they can devote to working in their technical field. In litigation, most often key elements of the litigation team are not patent attorneys and may have somewhat limited technical understanding as compared to an experienced Ph.D. in a particular technical field.

To augment the capabilities of an IP centered legal team, it often makes sense to complement the team with a technical expert. In an ideal world, one would seek a technical expert who is experienced in patent law, but is first and foremost an accomplished technical expert. An engineer holding at least a Bachelor's degree can take the USPTO patent bar exam and become a registered patent agent (if an attorney passes the same exam, he becomes a registered patent attorney). When an experienced Ph.D. engineering technical expert passes the USPTO patent bar exam, he can become a valuable asset to a legal team. It is especially desirable if the expert has written patents and is the inventor and author of many of his own patents; the more the merrier. While practicing, such an expert will be continually getting feedback and coaching from attorneys, reading legal briefs, testimony, judgments, responses, and other expert reports. In short, he will pick up the case law aspects of the law and quite potentially become a valuable team player. The mental attitude of such an expert needs to be a listener and a learner. He needs to constantly listen and learn from the attorneys and eventually understand how to formulate bullet proof technical/legal arguments. While not engaged in legal activities, the expert is preferably involved in research and development and is writing up his new inventions as new patent applications.

The first analysis task of an expert in the patent areas is to interpret the claims at issue. The expert will typically prepare a claim chart by parsing the claim language into several rows down one column. In a column to the right the expert will write a short, understandable interpretation of each portion of the claim language. In another column to the right of that, the expert will have a wider column where he cuts and pastes text and figures from the patent to prove that his interpretation is correct. In practice the third column is written before the interpretation column and drives the interpretation. A good expert uses this technique to dissect a claim and writes it in a clear, sometimes tutorial form. This, plus a clear and candid verbal explanation is how the expert orients the other team players to the technical arguments that will hold water, and leads the legal team to develop a sound winning strategy.

There are various other columns that can be added to the claim chart, such as a column for infringement analysis. A new column is added to the right, and this column discusses the accused device. When done properly, it will be clear to the reader that the

accused device contains all of the claim limitations. In a well constructed chart, the infringement column will follow the claim interpretation column rather closely. There will also be references to product literature and possibly endnotes that provide added product details that would otherwise crowd and distract from the chart.

Another type of claim chart is called an invalidity claim chart. Instead of adding a column documenting an accused device, the added column provides cites and figures from a prior art reference such as a published technical article or a prior patent. When the chart is completed, the last column will show that the prior art reference taught or suggested all of the claim elements, and therefore the patent is invalid.

While claim charts are an essential tool for a legal team and provide a medium to formulate offensive or defensive legal strategies, the expert can go a step further and convert the claim chart to a PowerPoint presentation. The claim language is parsed, but instead of being inserted into a column of a chart, it is parsed across a set of slides in a slide show. Figures and text are cut and pasted into the slides from the patent and the accused device's product literature. Red arrows are drawn pointing from the claim language snippets to the portions of the product literature that infringe that portion of the claim. Highlighting is used, or red circles are drawn around the portion of interest. Such a slide show is useful to take to an opponent during licensing negotiations or to graphically simplify the logic to convince a lay judge or jury.

With an expert on the team who is well versed in patent law, attorneys can give commands like: "prepare an infringement claim chart," "do a 35 U.S.C. 112(6) analysis of the means-for elements and outline our options for defense," "search the client's patent portfolio and the target's web site to and identify a short list of patents we might be able to assert against the target," "evaluate this computer source code obtained in discovery and develop a PowerPoint presentation showing where and how each of the claim elements are practiced by the source code" or "search patent and technical articles databases, find a good 35 U.S.C. 102B reference, and write up an invalidity claim chart." Preferably the expert is also a patent agent, so if a continuation is still pending, another favorite command is: "evaluate the target's product information (or standard, or software listing), and email me a proposed set claims; also write up a claim chart and identify where 35 U.S.C. 112 support can be found in the patent specification for the claims, and definitively show infringement of the target device with your proposed claims."

The technical expert with a deep understanding of patent law can help an attorney in many more ways than just litigation support and expert witnessing. For example, while the patent attorney tends to his work load, the technical expert can be aiding in any of the following ways:

1. Portfolio mining: Searching a target company's web site and evaluating its product literature, and comparing all the products to the patents in the client's patent portfolio.

2. Patent Acquisitions: Searching one or more target company's web sites and evaluating their product literature, and searching the patent-databases to identify to the client a set of target patents to acquire.
3. Researching international standards to see which claims of a client's portfolio read on an international standard.
4. Reading software code listings and showing that the software is practicing a claim.
5. Searching for prior art to invalidate a patent, and writing the claim chart.
6. Identifying and/or researching product details and writing new claims to read on the device for a patent with a pending continuation application.
7. Evaluating a letter alleging infringement and writing a noninfringement claim chart to show why there is no infringement.
8. Writing a claim chart as background to an infringement or invalidity opinion which will be written by an attorney.
9. Writing claim charts for claim construction analysis, infringement analysis, validity analysis, and invalidity analysis.
10. Preparing PowerPoint presentations with arrows indicating where in a target company's product literature each of the claim elements are practiced.
11. Providing a range of technical information, research and advice to help the team understand the technical issues and to thereby guide strategy.
12. Providing claim interpretations and technological tutorials to help the attorney or legal team understand the technical issues.

An IP-attuned technical expert can act as a valuable assistant to a patent attorney. The technical expert is best used to address the more technical problems, and to work with the attorney(s) to put together air tight technical arguments on which to found the legal arguments that will carry the day.