

LITIGATORS CORNER:

Preparing the Inventor for Deposition, Part 3, or How to Keep the Lion from Eating the Christian



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As we all know, patent litigation can be legally and factually complex. We have a patent lawsuit involving a parent patent, a continuation-in-part patent, and a reissue of the continuation-in-part. The first patent application was filed nearly fifteen years ago. Ancient history is common to patent cases. So are continuations and continuations-in-part. The latter, as most of you already know, adds something to the patent application that resulted in the parent patent. There will be additional language in the specification, sometimes a sentence or two, and sometimes a great deal of new material. The new information may be in one place in the specification, or in different places. In our case, the continua-

tion-in-part was filed about fourteen years ago, and the new information is substantial: there is most of a claim that is new, and there are other changes scattered through the rest of the specification. New claims were added, too.

Our case is even more complicated. The continuation-in-part was not the end of the prosecution. While the continuation-in-part was pending, the inventor filed a patent infringement suit on the original parent patent. A dozen or more individuals were deposed in that battle. Even the inventor's family got deposed — his wife, his daughters and his sons-in-law. At least they didn't notice up the family dog. One term in the claims in that lawsuit was construed by the district court, and the single construction led to a summary judgment of non-infringement.

I cannot help but interject here that one of my partners recently was reading a summary of rulings on appeals from summary judgments by the Federal Circuit. The reversal rate was **fifty-one** percent. The results seem perfect in their randomness. Summary judgments are only supposed to be granted when a court can say that it's clear-cut; summary judgment must be denied unless there is no disagreement about anything that matters to the court's decision. So why are district judges reversed half the time? I will touch on this in a future column.

Back to our story. The summary judgment against our client was affirmed. During the suit, he and his original attorneys realized that there was more to his invention; his claims were too narrow. He took his continuation-in-part patent back to the Patent Office over ten years ago, to get his claims broadened to reflect the real scope of his inventions. The reissue process went on for five more years. During that time, the inventor and his prosecuting

attorney filed five declarations. One was 183 pages long. After the reissue was completed successfully, there was no further prosecution, and everyone's memory of years of work began to fade.

When the inventor became our client, he filed another lawsuit on the reissued patent. Some of those deposed in the first case were deposed again in the second case.

The defendant alleges in the new suit that the original patent, the continuation-in-part, and the decision construing the original patent all are relevant to whether its three different types of products infringe various sets of claims in the reissue patent, which contains over fifty claims. The depositions, too, are all relevant — even two depositions from the same person saying much the same thing. Our client supplemented his interrogatories, too. There were many claims asserted, and the responses totaled well over one hundred pages. There is even an interference claim brought by the defendant under § 291. Thus, fifteen years of history, the actions of two courts, the duplicative testimony of witnesses, and the actions of three examiners are in the murky puddle we must now deal with.

We had a claim construction hearing and argument a few months ago. Everyone used demonstrative aids or exhibits to assist in testifying or in arguing. The defendant's lawyer used large charts and a projector. We used an overhead projector. The experts who testified had their reports. We were all taking notes to help us remember what had been said and to aid us in rebutting each other's arguments. The judge was submerged in paper. Nobody was flying blind. Everyone wore night-vision goggles.

But flying blind is what inventors have traditionally done in depositions. They go into a deposition about as well protected as a Christian facing an unfed lion in the Coliseum. They are assured that their testimony will not be misused; then the opposing party goes right ahead and misuses it — often because a busy court finds it easier to admit everything and sort it out later.

These are just some of the reasons that caused me to conclude that an inventor who testifies is entitled to some help, too. In June, 2002, I wrote about preparing an inventor for his deposition. Claim constructions are supposed to be questions of law, but there is room for inventor testimony to

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leak through into the process because of the Federal Circuit's decision in *Pitney Bowes*.

It is usually even worse for the inventor than we imagine. The defense attorney cross-examining him has had time to dream up attacks and carefully cull the documents that will be shown to the inventor, so that those documents support only one side. We might as well smear the Christian with beef fat, just in case the lion isn't hungry enough.

So what did we do to help our client? Before the inventor was deposed again, we got together and prepared, as I described in my previous column. We tried to go over the hard questions. We thought about the history of the prosecution of the patents. We considered what the inventor had already said in his discovery responses.

We did one more thing, too. We jointly worked on and prepared a notebook for the inventor to use, if necessary, at his deposition. The notebook included only things which we had already provided to the defendant: the lengthy interrogatory responses, with extracts from some of them dealing with topics we expected to be raised in the deposition; copies of the patents highlighted to show what had been added in the continuation-in-part and in the reissue application; a glossary of terms in the patent; and reduced size patent drawings, because the drawings in the patent were split in half on separate pages. The book was tabbed and indexed. It provided the details that are impossible to remember: for example, the meaning of a word, the numbers of the claims in which

the word appeared, the identification of the column and line numbers where the word was mentioned in the specification, which of the specification references were more significant, the identification of dictionaries and other reference works, and the location where the word or phrase was discussed in the massive file history. We gave a copy to the defendant's attorney, too, even though everything in it had already been produced.

But you must not simply hand your client such a book to carry into the deposition. The client must help prepare and put it together. Doing so reacquaints him with the case, and gives him some ability to know the difference between facts and law — that is, what he can answer and what is beyond him. If you prepare the materials without him, then your inventor will learn nothing. And, if he says at his deposition that he did no work on the book, it will make him look like a mouthpiece for his lawyer. Our client testified that he spent more than two full weeks preparing and working on its contents, followed by two or three days with his lawyers.

Two good results followed from the preparation: our inventor was as well prepared as he could possibly be, particularly since many of the events could no longer be recalled. The second benefit was that the inventor had what he needed in order to testify accurately. He did not have to rely on some selection of documents the cross-examiner chose to put in front of him, or chose to keep from him.

There is no doubt that the law permits a witness to use testifying aids when it is reasonably necessary to do so. As a U.S. Attorney, I handled a number of criminal cases where an agent would have to rely on some document to testify accurately about a complex set of events, such as dates, times, telephone numbers, and so forth. Lawyers are permitted to use summary charts of the testimony of witnesses who have testified during a trial. In other words, the lawyer is not compelled to argue without such an *aide-memoire*, even though the assisting document concerns testimony occurring in the very recent past — that is, in the past few days. See for example *United States v. Johnson*, 54 F.3d 1150 (4th Cir. 1994). Juries can see and use exhibits, and these days are permitted to take notes. They use them to recall events that occurred the day before, but no one questions them for relying on such notes. The jury is quite likely to have a book of some kind in our case, too; they will need one. It is silly to deny an inventor some assistance on the ground that he might be biased.

So I am an advocate of the view that an inventor is entitled to no less assistance than any other witness. The complexity of the subject, the age of the events, the importance of dates, and the value of the property at stake mandate that the inventor not be required to fly blind. Just because the defendant would like your client to crash into a hillside does not mean you and your client have to do so. Your client has to prepare anyway; don't let him fly blind. **IP**