

LITIGATORS CORNER:

Preparing the Inventor for a Deposition: A Second Look



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An inventor's deposition is usually an uncomfortable experience for both the inventor being questioned and the attorney defending the deposition. The reason: more than any other witness, the inventor can adversely impact his or her own case. In November, 2000, ("What Can Be Done to Improve Inventors' Depositions?"), I wrote about how to prepare an inventor for a deposition. I said that the keys are preparation, preparation, and more preparation. In this article, I would like to give some concrete examples of HOW to help your client prepare for this extremely important event.

As the inventor's attorney, you will need to accomplish several goals during the preparation phase. First, the inventor should hear from you the hard questions the other side may ask later, in the deposition. This will enable the inventor to think about these questions beforehand, and therefore give better answers when it counts. It also will make the inventor more confident, and less nervous, when the defendant's attorney

asks the same questions in the deposition. Second, the inventor needs to learn that he cannot "win" the case in a deposition, and cannot persuade the defendant that it is infringing and should pay for the use of his invention. There is only one purpose in an inventor's deposition: to enable the defendant to destroy the case for infringement. Your job, and the inventor's job, is to give the defendant no more help than the law requires.

But doing this isn't enough. Inventors need even more help.

These days, of course, we live in the environment of Markman hearings. The court must construe the claims – a question of law – before applying the claims to the accused product or service, a question of fact. Only after both steps are completed can we conclude whether there is infringement of any of the claims in the inventor's patent.

Of course, an inventor's testimony is extrinsic evidence under *Markman*; that is, such testimony should not normally be used to interpret a patent or its claims. The preferred sources are "intrinsic" evidence, which are the materials accessible to the public: the patent and its prosecution history. *Vitronics* says the inventor's testimony should not be used to construe the claims:

Had the district court relied on the expert testimony and other extrinsic evidence solely to help it understand the underlying technology, we could not say the district court was in error. But testimony on the technology is far different from other expert testimony, whether it be of an attorney, a technical expert, or the inventor, on the proper construction of a disputed claim term, relied on by the district court in this case. The latter kind of testimony may only be relied upon if the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms. Such instances will rarely, if ever, occur.

But the Federal Circuit backed away from *Vitronics* in *Pitney Bowes*, where it said that an inventor's testimony may be

used to "ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field." In other words, the testimony is used, not to interpret claims, but to ensure that the interpretation is not at odds with common technical meanings. That is a distinction that is often difficult to apply in practice.

Pitney Bowes cautioned that the court might have gone a bit too far in *Vitronics* in downplaying the use of an inventor's testimony. It said: "This appellate perspective discounted the relevance and helpfulness of testimony from experts skilled in the art to determine the meaning of claims" and that "this appellate court, however, should refrain from dictating a claim interpretation process that excludes reliable expert testimony." But in a subsequent case, *Bell & Howell*, testimony by the inventor was rejected.

So it is not clear where we stand on what inventors should – and should not – testify about. The reality is that inventors are rarely, if ever, experts in patent law, or in the details of patent prosecution. Some have studied other patents to learn technical things from them, but many have not. No inventor is an expert in construing a patent. We all know that there is no final word on claim construction until the district court, and the appellate court, have spoken. Inventors sign a declaration when a patent application is filed, saying they understand the application; but they are, in fact, relying heavily on the attorney assisting them, much like a person buying a new home must rely on others for the accuracy of the description of the real estate.

All that being said, inventors get deposed. They are grilled about the interpretation of their patents, and even about the meaning of various prior art references. In a deposition the other day, one of our clients was even asked questions about authenticating, and then interpreting, an opinion of the Federal Circuit. Patents were plopped in front of him, one after another, and he was asked to interpret them. He was asked repeated questions about what specific terms in the patent meant, and what terms in the claim meant. He was asked why the defendant's product infringed. **All very difficult questions.** So how does an inventor prepare for this kind of questioning?



Anyone who has been through a trial and seen any testimony by, for example, a damages expert, knows that no expert can



testify coherently without using written aids such as charts, spreadsheets, calculations, and the like. In fact, everyone in the courtroom uses some sort of crutch. The questioning lawyer probably uses a written outline to insure that the right questions are asked. The opposing lawyer is scribbling notes to use during cross-examination, and probably already has an outline and some exhibits assembled to use in cross-examination. The judge and the jurors are probably looking at copies of exhibits. The judge is taking notes. The jurors are taking notes. During deliberations, the jurors have instructions on the law and verdict forms. During a bench trial, a judge has a trial memorandum, and proposed findings of fact and conclusions of law. Everybody has notes, documents or exhibits to help them remember and analyze the issues. So why shouldn't the lonely inventor get some similar help when he is being beaten over the head in a deposition?

But traditionally, inventors get nothing to help them in depositions. They are often not designated as experts; defendants frequently oppose allowing them access to the defendant's technical information. Yet inventors are questioned as though they are experts – experts in how to read and interpret their own patents and even patents of others. The Federal Rules are broad about asking questions; witnesses are generally supposed to answer any question that does not seek privileged information or work-product. Inventors must therefore respond – somehow – to questions about the prior art, about conception, about reduction to practice and about claim interpretation — and to do it all with nothing but the carefully selected document or documents put in front of them by the defendant's attorney. On top of that, they are frequently asked questions that have multiple meanings; one is a legal meaning, which the inventor does not perceive. The inventor thinks he understands the question, but does not. The risk of an inaccurate answer is high, and the defendant will “spin” it for all it is worth.

Here is what I mean. When an inventor – for example, an engineer – is asked about what was “on sale,” the engineer-witness usually thinks “product,” not “claimed invention.” He is trained in the world of drawings and products, not patents. He will usually believe in a loose, rather imprecise correlation between a product and a patent. Because of his lack of understanding of legal intellectual property terms, he will all too easily – and incorrectly – agree that the invention was on sale. From there, it is a

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Similarly, when an engineer is asked about “conception,” he answers with no idea of the legal meaning of the term. When asked about “reduction to practice,” he has no idea that the filing of a patent application can be a reduction to practice. Even worse, when most inventors are presented with strange patents and asked to interpret them, many conscientiously try to do so without even having had a chance to read the patent in a quiet setting and think about it for a time. Trying to cram all the necessary legal knowledge into the head of a nervous engineer who has never before been deposed is nearly impossible. The result is unreliable testimony.

The answer is obvious: **the inventor must have more help.** Though I have mixed feelings about the patent rules for claim construction in the Northern District of California, one thing I do like about them is that the inventor-witness can respond to any question about claim construction by referring to the claim construction statements. Those rules really reduce, if not eliminate, the excuse to waste a lot of time by questioning the inventor about the meaning of his patent. Pilots don't fly without checklists; neither should inventors.

There are other ways to help the inventor, too.

One possible way is to **provide the inventor with a book to use during his deposition.** The first component of such a book should be the verified responses to the defendant's interrogatories. That is another reason why boiler-plate responses to interrogatories may not be a good idea: not only do you fail to educate the other side; you also fail to educate yourself. More detailed responses make you think through the issues, identify weak points, and develop your arguments. Remember that you can always supplement interrogatories to

improve your answers, so you are not wedded to the very first response you give, especially before you have the benefit of discovery from the other parties to the case. Other components of the book can be claim charts, or the patents analyzed in the interrogatories. The book can be indexed and tabbed. During his deposition, the inventor can then refer repeatedly to the information provided in the interrogatories.

This kind of preparation gives an inventor confidence, too. After all, the inventor worked with you, the lawyer, in preparing the responses to the interrogatories. Analyzing the necessary documents is a mix of legal and technical work. A conscientious job on the interrogatories allows the inventor to rely on them, and to say that these represent his best possible answers at this time, because he had his lawyer's help in preparing them – just as he had a great deal of help from his lawyer in writing and prosecuting his patent.

There's another benefit. When the defendant springs something on the inventor, like a prior art reference that the defendant didn't identify in its interrogatories, the inventor can quite properly say he cannot answer because he hasn't had any chance to think about this reference, nor have his lawyers. In other words, you now have a tool to stymie the sneak attack. The defendant's failure to disclose or analyze this reference thus boomerangs on the defendant.

So, the next time your inventor/client must be deposed, remember that preparing him or her correctly is crucial. Complex testimony needs support. The inventor shouldn't be the only one in the case without some written aids to assist him. **IPT**