

LITIGATORS CORNER:

What Can Be Done to Improve Inventors' Depositions?



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What is it about inventors in depositions? Do they think they're sales agents, needing to convince everyone of the worth of their inventions? Or do they believe that the defendant is really good-hearted, and will see the error of its ways and settle the case once it realizes that it infringes? Or are they so angry they find it difficult to be rational? Or do they have bad lawyers advising them? Or have they simply not been prepared properly by their attorneys?

In all my years of litigating intellectual property cases, I have concluded that the answer is: *maybe all of the above*, and more. Let's face it. Unprepared inventors make terrible witnesses. They are almost always inexperienced in giving testimony, as well as being naturally biased. They feel wronged when an infringer refuses to see the value in their inventions. Add to this the outrage inventors feel after having struggled for ten or even twenty years so that their inventions will become successful, only to hear them called worthless.

Any reader who has ever been the victim of a crime, or the victim of someone's else's bad driving, can appreciate how personal these feelings can become. I was the victim of

drunken driving by an off-duty police officer over fifteen years ago. That brush with death made it difficult for me to -- as I was advised before my deposition -- "take it easy" or "stay calm" about my opinions of the drunk driver who had wronged me. Had he been there, I would have been happy to jump across the table and punch him. Whenever I think about the incident, I find I am still angry at him.

Likewise, inventors have a huge emotional investment in their inventions. Read the trying story of Chester Carlson, who patented the process that became the basis of the photocopy machine in 1938, but couldn't convince anyone of its worth until 1944 when -- after being turned down by more than twenty large corporations, including IBM, Kodak, General Electric and RCA -- a company finally agreed to contract with him to develop his process. But it wasn't until 1959 that the first fully automated Xerox machine was actually produced -- a total of 21 years from idea to product! Or take Howard Armstrong, who committed suicide after a life of battling his infringers. It can't get more intimate than that.

We've seen it over and over with our clients, particularly the solo inventors we represent in contingent fee cases. One of our clients immigrated to the United States and was so poor he had to walk to work. While still working at his full-time job, he spent 10 years setting up contraptions in his kitchen to perfect his invention. After all this work, he was rebuffed by one prospective licensee after another; some of whom stole his invention at the same time that they were telling him it was worthless. He finally got a licensee who tried to double-deal him. Another of our clients, a doctor I have described in previous columns, invented new instruments to make knee replacements work. Medical companies turned him down. It took him over ten years and three lawsuits to get infringers to recognize the value of his work. Yet another of our clients, an engineer, paid for his own patent application and negotiated a license with a Japanese company, which then squeezed every idea and improvement it could out of him, only to throw him away. All of these clients succeeded in getting rewards for their inventions -- but not without a long fight. These are real human stories, with struggle, strife, success and sometimes failure, too.

This kind of double-crossing happens with inventors employed by corporations, too. The inventor for one of our corporate clients had an idea for a new type of plastic film label. It took him more than six years to develop, per-

fect and market his inventions. Along the way, his company formed a whole new division to make the films. Other companies who had thought the invention not practical, or not economical, or not worthwhile, began to copy it. The invention has had extraordinary commercial success. But the infringers -- what is it with lawyers, anyway? -- have spent years trying to brand him as a cheat and a fraud who either stole the invention if there was one, or lied to the Patent Office to conceal the fact that the invention was already known. These disparagers had no ideas, except to destroy. The attack upon an inventor's integrity could not be more personal or vicious, and required a huge effort on the part of both the inventor and his company to defend themselves.

The point I am making here is simple, but not obvious. For litigators, depositions are everyday events, as common as a bank teller's cashing a check, though more complicated. But for the inventor, a deposition is a different ball game on a different planet. When you are representing an inventor who is being deposed, you are representing a person who has a tremendous personal investment, a person who is under attack personally and professionally, who is not a professional witness, and who is going to testify about a patent that is crammed with weird language that the Federal Circuit says is all as legal as any contract -- so purely legal that a court rarely if ever needs a witness to aid its interpretation of the patent. For the inventor, then, a deposition is a major and uniquely unsettling event.

WHAT CAN YOU DO TO HELP?

You must prepare your client well by teaching him to anticipate the attack, without folding. Your client should hear all the tough questions from you. Unfortunately, most intellectual property lawyers seem to engage in two kinds of preparation. One is no preparation at all, which I have seen many times in depositions. The second is the kind in which the inventor is first told the usual shibboleths (e.g., "Take your time to answer," "Don't volunteer," etc.), followed by the inventor and lawyer spending a lot of time looking at documents, turning over one page after another, and talking about dates and the meanings of plain words, instead of the other side's theory of the case.

The second approach to preparation is better than nothing at all, but it can be improved upon. To improve yours and your client's preparation, however, you have to be a real lawyer, not just someone with a diploma and a law license; we have a lot of those practicing in our courts these days. You must put yourself into the other side's position, invade its mind, and figure out how it thinks about the evidence. You must understand and be able to articulate its best arguments. Once you do that, the hard questions will flow naturally. It will sometimes be scary and it is often hard for an advocate to do because we get wedded

to our own points of view. But if you don't do this kind of analysis, then you will never figure out the correct responses to the questions a well-prepared cross-examiner will ask your client. If those questions can't be answered adequately, then your client's infringement suit is a painful waste of everyone's time.

Once you have thought carefully about your adversary's positions, you will be prepared to grill your client with the lines of questioning the other side will throw at him. (Of course, your adversary may be what I call a paper-turner, who lets his questions be dictated by the stack of paper instead of the elements of his cause of action or affirmative defense, in which case the risk of thoughtful, probing questions to your witness is greatly reduced. But let's assume the other side has some idea of what a deposition is for.) Why didn't your client disclose the reference to the Patent Office? The statement is false, isn't it? The affidavit was under oath, but it's wrong, isn't it? You must challenge your witness into thinking about the answers to the difficult questions.

As a federal prosecutor, I sometimes had to put on witnesses who had been involved in the crime, and who were cooperating with the prosecution after pleading guilty or being immunized. In our federal district court in Chicago, we had defense attorneys who were pros – some of whom were former prosecutors themselves and most of whom had cross-

examined more witnesses than any patent litigator will ever deal with. They could rip an unprepared witness to pieces, particularly one with the baggage of culpability. We grilled these witnesses, sometimes for days, before they ever testified. They were ready, and had faced worse from the prosecutor than they ever would see from the defense attorney. To borrow from Mark Twain, they hit the stand with the buoyancy and confidence of a Christian holding four aces. *You can do that with an inventor, but only if you prepare and then re-prepare him or her.* In one of our contingent cases where the jury returned a verdict of \$50,000,000 (\$75,000,000 after appeal), one of my partners grilled the inventor for days. That preparation was the single most important reason our side won the case. The lack of preparation of the defendants' witnesses was probably the second most important reason.

You can't do this just once, either. Repetition is necessary. I have found that my answer to a question may change depending on the extent to which I've thought about the subject. The first time around, all the facts that bear on it may not have surfaced in my mind. On top of that, many questions in a deposition have a sub-text; a good example is whether something was "for sale." An inventor might say yes, not realizing that this is a legal as well as a factual question. Or the inventor

will not think about the differences that might exist between a version of a product that might have been sold, and a later variant that was the subject of a patent application. Or an engineer will often say in a self-deprecating and modest way that "anyone could have thought of this." But when that engineer thinks about the time, effort, skill and expense that went into his invention, what was obvious and easy isn't obvious and easy anymore. The repetition brings the relevant facts and thoughts to the fore. Second, it persuades the inventor that there are good answers to the hard questions, and it builds confidence.

There are many other aspects to good witness preparation that I haven't touched on here. We don't always prepare our inventors the way we should because of the pressures of time and expense. But if we do not, we run the risk that a good cause will be lost and that an inventor who deserves to win will instead lose. Confucius said that to lead an untrained people to war is to throw them away. The same is true of an inventor who is being deposed. Prepare yourself. Prepare your inventor-client. Realize you are representing a person who will feel that he is defending his life's work and his personal integrity in a deposition. Ask the hard questions, and ask them again and again, until you are sure that his answers will help you win your case. **IPT**