

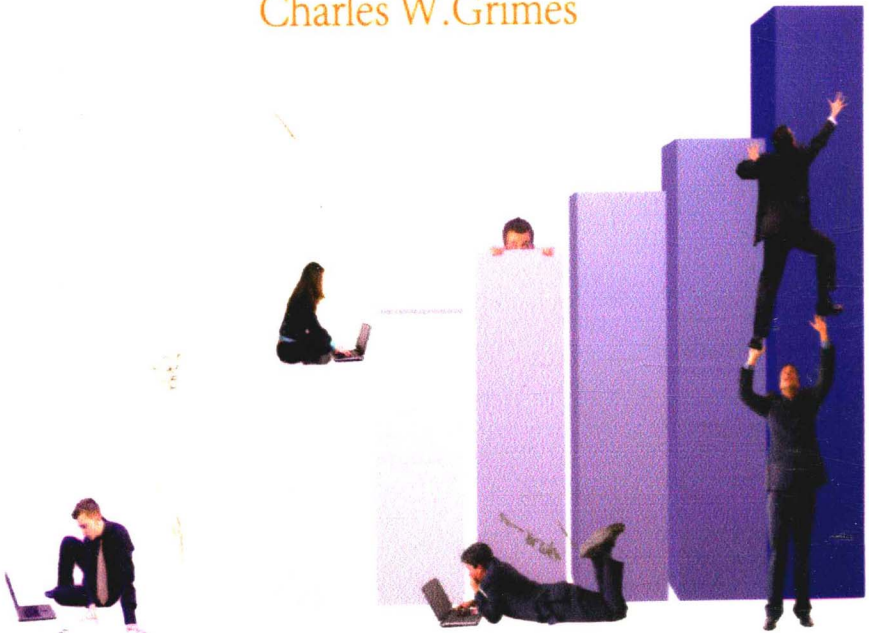
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PATENT DISPUTES

LITIGATION FORMS AND ANALYSIS

SECOND EDITION

Gregory J. Battersby
Charles W. Grimes



PATENT DISPUTES: LITIGATION FORMS AND ANALYSIS

Second Edition

Gregory J. Battersby
Charles W. Grimes

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Norwalk, Connecticut



Wolters Kluwer
Law & Business

2013 SUPPLEMENT

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Patent Disputes: Litigation Forms and Analysis

Second Edition

by Gregory J. Battersby and Charles W. Grimes

Patent Disputes: Litigation Forms and Analysis is an immensely practical resource, which provides the practitioner with a broad range of forms that can be used, at least as a starting point, for the preparation and eventual negotiation of a multitude of different pleadings related to the patent litigation process. This collection of forms and in-depth expert commentary will assist the practitioner by substantially reducing the amount of time required to draft a particular pleading.

Covering everything from initiating the action to motion practice to appeals, *Patent Disputes* mirrors the structure of an actual case, and each form in the book finds its genesis in an actual case. Also included are “Practice Tips” to assist the litigator in identifying the more important portions of the pleading and to provide some guidelines or suggestions about how best to draft them. These resources have all been thoroughly enhanced for the 2013 update, which incorporates analysis and commentary on the landmark Leahy-Smith America Invents Act (AIA). With contributions from authors practicing at the forefront of this dynamic and high-stakes litigation area, *Patent Disputes: Litigation Forms and Analysis 2 ed.* offers leading insights on how this groundbreaking legislation promises to reshape patent law and what it means for patent litigators and their clients.

Highlights of the 2013 Supplement

The 2013 update offers practitioners a timely overview of key changes to the statutory law governing patent prosecution and dispute resolution, in



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addition to detailed examinations of some of the most pressing developments occurring in various areas of patent law, including:

- A new chapter, surveying the impact of the America Invents Act one year after its inception. See Chapter 2.
- A break-out chapter covering issues and best practices in using expert witnesses. See Chapter 5A.
- Insightful commentary on tactical use of social media applications during discovery. See § 5.12.
- Practical and valuable guidance for utilizing pre-trial agreements to streamline litigation. See § 7.01A.

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*To Susan, Brenda and our children, whose love
and support make life worth living.*

PREFACE

As the recognition of the value of intellectual properties has increased dramatically over the past decade, so too have the number of disputes involving the ownership and infringement of such properties. In fact, intellectual property litigation has risen faster than virtually any other form of litigation.

While we now have almost sixty years of collective experience in the field, it does not seem that long ago that we were faced with the daunting task of drafting our first complaint for a patent infringement. That was, of course, in the “dark ages” of the practice—well before publishers such as Wolters Kluwer Law & Business had the foresight to publish forms books of the type that you now have in your possession. In fact, it was even before computers, and the IBM memory typewriter was still in the development stage.

So, what did we do in those early days? We are sure that some bright young first-year associate somewhere actually tried to draft the pleading from a clean sheet of paper. Similarly, we are sure that when that associate brought the work product to the senior partner, he or she soon learned one of the time-honored rules of the legal profession: “don’t reinvent the wheel.” The associate was quickly introduced to the firm’s archive of legal documents from which he or she would be able to select the most appropriate agreement and use it as the basis for the current assignment. Fortunately, we started with old line intellectual property firms (they were called “patent firms” in the dark ages) who had such an archive of old pleadings.

Times have not changed that much over these past thirty years, and firms still maintain archives (either formally or informally) of legal forms. So, if that is the case, why a litigation forms book? The reason is simple: even the largest and most prestigious firms have only a microcosm of the types of pleadings that are used in the industry today—particularly with the explosion of litigation in the intellectual property area. Many well-established litigation firms simply do not have

the depth of experience in this area and, as such, a work that contains some of the best tried-and-true forms is helpful.

That is the purpose of this book: to provide the practitioner with a broad range of forms that can be used at least as a starting point for the preparation and eventual negotiation of a multitude of different pleadings. We hope that the collection will assist the practitioner in this area and substantially reduce the amount of time required to draft a particular pleading. That is one of the reasons why a companion computer disc is provided—to help reduce time.

It should be appreciated that many of the forms contained herein come from litigations that our firm has worked on with the names and details changed to preserve confidentiality. In addition, we have obtained other forms from colleagues who regularly work in the subject area. Finally, we conducted extensive research and attempted to collect and assemble here some of the more prominent pleadings that have become public. Again, all of these documents were modified to preserve client confidentiality as well as to provide a uniform look and feel. Finally, there are a number of pleadings that were drafted specifically for this volume.

The help we received from some other members of the patent litigation bar was no less important and greatly appreciated. The contributors to various portions of this book read like a “Who’s Who” of the intellectual property bar and include the following:

1. Steven M. Amundson of Frommer Lawrence & Haug, New York City
2. Brian Coggio of Orrick, Herrington & Sutcliffe, LLP, New York City
3. Timothy Demasi of Weil, Gotshal & Manges, LLP in New York City
4. Edward V. Filardi of Skadden, Arps, Slate, Meagher & Flom in New York City
5. Donald F. Frei of Wood, Herron & Evans in Cincinnati, OH
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20. Bryan J. Mechell of Robins, Kaplan, Miller & Ciresi, LLP

Clearly, this volume would not be possible without their excellent contributions.

No preface would be complete without expressing our appreciation for the contributions of certain special individuals who assisted us in the preparation of this work. Two of our partners, Russell Dize and Jessica Elliot, were very helpful in compiling the forms used in this volume. Our own internal editor, Robert Gessinger was similarly helpful in keeping us all on track and making sure that the final product was something more than a collection of unrelated forms and could be easily read.

Finally, a special word of thanks to our publisher, Wolters Kluwer Law & Business, and, in particular, to its acquisitions editor and managing editor, Michelle Virzi and Patrick Iraca, for believing in us and the value of this work. We are extremely fortunate to have found this dynamic pair with whom we have now collaborated on a host of different publications. Their confidence in us and their patience when we miss seemingly countless deadlines are greatly appreciated. More importantly, their vision for what the legal profession wants and their execution of the plan to accomplish it set them apart in the legal publishing world.

October 2012

*Gregory J. Battersby
Charles W. Grimes*

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Gregory J. Battersby holds an A.B. (chemistry and biology) from Seton Hall University and a J.D. from Fordham University School of Law. He is a member of the New York and Connecticut Bars and is admitted to practice as a patent attorney before the United States Patent and Trademark Office.

Charles W. Grimes holds a B.S. (engineering mechanics) from Pennsylvania State University and a J.D. from the University of Denver School of Law. He is a member of the Illinois, New York and Connecticut Bars and is admitted to practice as a patent attorney before the United States Patent and Trademark Office.

Messrs. Battersby and Grimes are co-founding partners of the Connecticut law firm of Grimes & Battersby, LLP, 488 Main Avenue, 2nd Floor, Norwalk, CT 06851-1008, (203) 849-8300, which specializes in patent, trademark, copyrights, unfair competition, antitrust and corporate law and licensing with a particular emphasis on the merchandising, multimedia, entertainment, edutainment, toy, animation and publishing industries. They have authored *The Law of Merchandise and Character Licensing*, *Multimedia and Technology Licensing Agreements: Forms and Commentary*, *License Agreements: Forms and Checklists Licensing Desk Book*, *Licensing Royalty Rates (2000-2012)*, *Licensing Update (2000-2012)*, *A Primer on Technology Licensing*, *The Toy & Game Inventor's Guide*, *Patent Disputes: Litigation Forms and Analysis*, and *Trademark & Copyright Disputes: Litigation Forms and Analysis*. They also serve as Executive Editors of two regular monthly publications issued by Wolters Kluwer Law & Business, *The Licensing Journal* and the *IP Litigator*. They are regular columnists to publications such as *The International Licensing Directory* and *The Association of Collegiate Licensing Administrator's Bulletin* as well as a score of other business and legal publications. They are recognized as the leading experts on the subject of merchandising law.

Mr. Battersby remains a guest lecturer at the Franklin Pierce Law School Advanced Licensing Institute, is counsel to the International Licensing Industry Merchandiser's Association ("LIMA") and has been a Vice President and Board of Director's member of The New York Intellectual Property Law Association. Mr. Grimes is an Adjunct Professor at Sacred Heart University where he teaches intellectual property law and served on the Editorial Board of *The Trademark Reporter*. They have moderated the legal seminar at the Licensing Show for many years and continue to lecture and write on a variety of intellectual property issues.

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