



## Patent Resources Group

### Patent Infringement Litigation Course Syllabus

- I. PREFILING CONSIDERATIONS: GENERAL**
  - A. Understanding and Establishing Litigation Objectives
  - B. Pre-suit Investigations and Opinions
  - C. Coordination Between Inside and Outside Counsel
- II. PREFILING CONSIDERATIONS: STRATEGY AND TACTICS**
  - A. Standing - Who Can Sue?
  - B. Identifying and Selecting the Potential Defendant(s)
  - C. Personal Jurisdiction
  - D. Contacting the Potential Defendant(s)
  - E. Declaratory Judgment Actions
  - F. Selecting the Venue
  - G. Drafting the Complaint
- III. THE DEFENDANT'S INITIAL CONSIDERATIONS**
  - A. Evaluation of Risks, Rewards, and Options
  - B. Change of Venue
  - C. Responding to the Complaint
  - D. Opinions of Counsel
- IV. INITIAL MOTIONS: WINNING EARLY**
  - A. Temporary Restraining Orders
  - B. Preliminary Injunctions
- V. INITIAL PROCEDURES**
  - A. The Rule 16 Pretrial Conference
  - B. Court-Ordered Alternative Dispute Resolution
  - C. Mandatory Disclosures Under Rule 26
- VI. DEVELOPING THE CASE THEME**
  - A. Making It Simple, Understandable, and Clear
  - B. Testing the Theme with Focus Groups
- VII. WRITTEN DISCOVERY**
  - A. Overview of Rules and Procedures
  - B. Formulating a Discovery Plan
  - C. Interrogatories and Document Requests
  - D. Inspections and Requests to Admit
  - E. Discovery of Electronic Information
  - F. Expert Discovery
  - G. Foreign Discovery
  - H. Discovery Disputes
- VIII. DEPOSITIONS**
  - A. Rules and Procedures
  - B. Witness Preparation
  - C. Defending Depositions
  - D. Inventors, Executives, Marketing VP
  - E. Use of Depositions in Motions and at Trial



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- F. Use of Video Tape and Real Time Court Reporting
- IX. REMEDIES \*(New for 2009)\***
  - A. Starting the Damages Clock
  - B. Reasonable Royalty
  - C. Lost Profits
  - D. Permanent Injunctions
- X. SELECTING AND WORKING WITH EXPERT WITNESSES**
  - A. Introduction - Importance of Expert Testimony in Patent Cases
  - B. Different Types of Experts and Their Uses
  - C. Selecting the Right Expert for the Issue
  - D. Rule 26(a)(2) and Expert Reports
  - E. Foundation for Opinions
- XI. CLAIM CONSTRUCTION AND MARKMAN**
  - A. Basic Claim Construction Concepts
  - B. Intrinsic and Extrinsic Evidence
  - C. Means-Plus-Function (or Step-Plus-Function) Claims
  - D. Conducting Markman Proceedings
  - E. Strategy and Technique
  - F. Written Submissions
  - G. Argument and Testimony
  - H. Live Demonstration of a Markman Hearing**
    - 1. Identification of Claim Construction Issues
    - 2. Strategy and Technique
    - 3. Attorney Argument
    - 4. Question and Answer
- XII. INFRINGEMENT**
  - A. Literal Infringement
  - B. Doctrine of Equivalents
  - C. Direct Infringement
  - D. Inducement and Contributory Infringement
  - E. Infringement Under §271(f) and (g)
  - F. Willful Infringement
- XIII. PLAYING DEFENSE**
  - A. Prior Art Defenses
  - B. The On-Sale Bar
  - C. Section 112 Defenses
  - D. Inequitable Conduct
  - E. Laches and Equitable Estoppel
  - F. Noninfringement
- XIV. WINNING WITHOUT TRIAL**
  - A. Substantive Pre-Trial Motions
  - B. Summary Judgment Motions



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#### **XV. PREPARATION FOR TRIAL**

- A. Pre-Trial Proceedings and Submissions
- B. Fact Witnesses
- C. Expert Witnesses
- D. Motions in Limine
- E. Jury Instructions and Interrogatories

#### **XVI. TRIAL**

- A. Jury Selection -- Real Life Jury Pools
- B. Streamlining and Focusing the Presentation
- C. Opening Statements
- D. Witness Examination and Objections
- E. Closing Arguments
- F. Bench Trials -- Submitting Findings of Fact/Conclusions of Law
- G. Demonstrative Evidence in the Modern Courtroom

#### **XVII. POST-TRIAL PROCEEDINGS**

- A. FRCP 52(b) Amendments to the Findings
- B. FRCP 50 and 52(c) Judgments as a Matter of Law
- C. FRCP 59 Motions for New Trial or Amendment of Judgment
- D. FRCP 60 Proceedings, Requirements for Relief from Judgment
- E. Stays of Execution
- F. FRCP 74 Appeals from Magistrate Judge to District Judge
- G. Standards for Overturning the Jury's Verdict