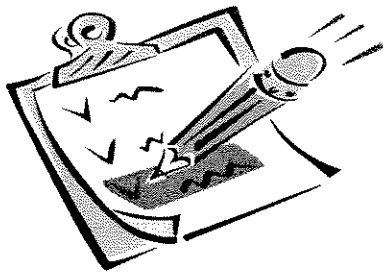


# Intellectual Property Litigation

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## MESSAGE FROM THE CHAIRS



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**W**e need to start thinking about programs for next years annual meeting. The 2004 Litigation Section Annual Meeting will be at the Phoenician in Phoenix, Arizona.

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**Visit the Committee's Website at**  
[www.abanet.org/litigation/committee/intellectual/subcomm.html](http://www.abanet.org/litigation/committee/intellectual/subcomm.html) **to keep up with all of our exciting activities.**

## YOU DON'T SAY:

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**When is practicing the prior art a defense to infringement . . .**

**L**ast November, I led a team of lawyers from Wallenstein & Wagner in a patent infringement jury trial in Milwaukee, Wisconsin. We faced capable opposing counsel and we expected a tough battle. It was a large and complicated case.

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The views expressed in this publication are those of the authors and do not necessarily reflect the position of the American Bar Association, The Section of Litigation or the Intellectual Property Litigation Committee. Contributions to this Journal may be sent to Bradford P. Lyerla, Marshall, Gerstein & Borun, 233 South Wacker Drive, 6300 Sears Tower, Chicago, Illinois 60606, 312/474-6300 or via the Internet to [blyerla@marshallip.com](mailto:blyerla@marshallip.com).

**Message from the Chairs, continued from page 1**

Please start thinking about possible programs that we can submit for the Phoenix meeting. We welcome any program ideas you may have. In addition, if you would like to collaborate with others to put together program ideas, we can assist identifying other members for you to work with. Just contact us by phone or e-mail. As a tip from past Annual meeting program selections, programs with a broader focus than just IP have had better success in being selected. We will be following up on your program ideas as the deadline for submission approaches.

Make sure your calendars are marked for the ABA Annual Meeting is in San Francisco August 7-10, 2003 at the Westin St. Francis. The IP Committee will be having its Breakfast Meeting on August 8 or 9. We have a great program planned. The speakers will be Christian E. Mammen and L.J. Chris Martiniak, both of Heller Ehrman White & McAuliffe LLP, San Francisco, CA. The title of the presentation is "What You Should Know Before Filing a Patent Infringement Suit." Recent Federal Circuit authority has reiterated the obligations of counsel to conduct an adequate pre-filing investigation before filing a patent infringement suit. Mr. Mammen and Mr. Martiniak will go through the scope of an adequate pre-filing investigation, as well as difficult issues for particular technologies and situations.

We are continuing to look for ideas and content to make our Committee Website more valuable and useful to our members. As we have previously indicated, we want your input and assistance. If you have any thoughts or ideas, please contact either one of us. In addition, if you are interested in participating on our subcommittee that will have responsibility for the website content and format, let us know. We have not yet appointed a chair for this important sub-committee and are looking for capable candidates and welcome any suggestions. The potential for our Committee members to access really useful and timely information is there, but we have not taken advantage of it to the extent possible. A dedicated hand to that end would serve us all well.

Our Roundtable Program continues to be abundant and successful. We urge you all to participate in the Roundtables taking place in your city. For the most up to date information, visit our website to find the most current Roundtable information including the participating cities, the hosts and specific dates and times. You can find the host roster at [http://www.abanet.org/litigation/committee/](http://www.abanet.org/litigation/committee/intellectual/roundtable.html)

[intellectual/roundtable.html](http://www.abanet.org/litigation/committee/intellectual/roundtable.html). In March, we had 22 Roundtables scheduled. The May Roundtables completed the 2002-2003 season. We would like to thank of all of the volunteer hosts for taking their time to make the program successful.

In addition, our Women in IP sub-committee had four networking events this spring in Chicago, Los Angeles, Silicon Valley and New York. These events provide a great forum for hundreds of women across the country to meet and exchange ideas and experiences as women in the IP profession. Look for further information on each of these events in our monthly Listserv message.

Have a great Spring. As always, let us know your comments and suggestions regarding our Committee's activities. We want to make sure we address everyone's interests in the activities and information our Committee provides.

**You Don't Say, continued from page 1**

Generally, I think the plaintiff enjoys an advantage in such circumstances. But I had a case theme that I loved. I believed that if we picked a good jury, free of bias, then we would win for the defense with this theme.

The trouble was that some of my team did not like my theme. And they had a good reason. Even if accepted by the jury, my theme did not constitute a defense to literal infringement.

I wanted to argue that our client could not be guilty of infringement because it was practicing the prior art. But almost every time I brought this up, I met opposition from team members who reminded me that the Federal Circuit has said more than once that practicing the prior art is not a defense to literal infringement. E.g., *Baxter Healthcare Corporation v. Spectramed*, 49 F.3d 1575 (Fed. Cir. 1995); *Tate Access Floors, Inc. v. Interface Architectural Resources, Inc.*, 279 F.3d 1357 (Fed. Cir. 2002); and *Ecolab v. Paraclipse, Inc.*, 285 F.3d 1362 (Fed. Cir. 2002).

Before I tell you how we honored the rule that practicing the prior art is not a defense, but still used my case theme, let's look at the rule. The thing that I notice first about this rule is that it is counter-intuitive. After all, it is not possible to use only technology that was known

before the patented invention and yet nonetheless infringe the patent. Well then, if it is not possible to practice the prior art and also infringe, then why not simply say that practicing the prior art is a defense? What would be wrong with such a defense?

In most cases, there would be nothing wrong with a practicing the prior art defense. And if anyone cares what I think, then I am in favor of adopting the defense as the law. The defense would simplify the jury instruction and at the same time would be very useful to lawyers advising clients. Indeed, I suspect that there are a fair number of lawyers out there who already think that practicing the prior art is a defense.

So why then does the Federal Circuit say that it is not a defense? I have two observations about this that may be helpful. First, it is not entirely clear that *Baxter, Tate* and *Interface Architectural* are the final word on the question. That is, there are procedural and factual artifacts in those cases from which one can argue that the Federal Circuit has not decided whether practicing the prior art is a defense with finality. Second, the best argument against the defense may be that it threatens to confuse the burdens of proof. We know that the patentee must prove infringement by a preponderance of evidence. And we know that the accused infringer must prove invalidity by clear and convincing evidence. But when the defense is that we don't infringe because we practice the prior art, then who must prove the fact that the accused's activities are within the prior art and by what standard must this be proved?

The Federal Circuit's response seems to be "don't even start down that path." The Federal Circuit seems to say that when considering literal infringement, the analysis must be the traditional analysis of comparing the accused device or method to the patented invention element by element. If all the elements are met, then there is literal infringement. If, on the other hand, all of the elements are in the prior art, then the claim is invalid. By treating the issues separately in this way, confusion as to burdens of proof is avoided.

So how did we deal with this in our trial? We took a three-pronged approach:

First, because the patentee was arguing doctrine of equivalents infringement in the alternative to literal infringement, we relied on *Wilson Sporting Goods* and other cases to say that practicing the prior art is a "safety

zone" against DOE infringement. If one is practicing the prior art, then one is in the "safety zone" and cannot be guilty of infringement under the doctrine of equivalents.

Second, we used "practicing the prior art" as a defense against willfulness. Our client's patent counsel had advised the client that if the client was doing nothing differently from what the client had done before the patent, then the client was not infringing a valid patent. We supported this with expert testimony that the opinion was competent and a reasonable opinion for the client to rely on in the circumstances.

Finally, with regard to literal infringement, we conceded that "practicing the prior art" is not by itself a "safety zone" against literal infringement. We told the jury that, for purposes of determining literal infringement, they had to make a full comparison of claim elements to elements in the accused products. But I argued that they had to perform this comparison in view of all of the evidence. This last part was the key. I argued in opening and closing that the inventors told the world in their patents that if you use the prior art you cannot get the benefits of their invention. I said that this is an admission against the inventors' interests. I reminded the jury that they heard extensive evidence that my client was doing nothing differently than what was done before the patent. I said that these facts and the inventors' admission in the patent should be weighed heavily against the patentee when the jury considered whether the elements of the claims existed in the accused products. This theme combined with strong (though contested) technical evidence showing the absence of certain elements of the claims was well received by the jury. We obtained a verdict of non-infringement after only a two-hour deliberation. The verdict was not appealed.