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Is Your Patent Ready For Litigation?

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Filing a patent infringement action puts the asserted patent under intense scrutiny. The accused infringer undoubtedly will investigate the patent and its prosecution history in the hope of proving that the patent is invalid or unenforceable. Taking the necessary steps in advance to ensure that the patent is ready for litigation will reduce the possibility of unexpected surprises during litigation and likely also reduce litigation costs.

Here's a checklist of the steps you need to take:

- Confirm that the patent is still in force and all maintenance fees are up to date.
- Confirm that the patent is properly assigned and that the plaintiff has the right to enforce it throughout the time period of the infringement.
- Confirm that inventorship is correct.
- Confirm that any priority claim was perfected.
- Become familiar with the prior art and make sure that all material prior art known during prosecution has been cited.
- If necessary, consider a post grant procedure, such as supplemental examination or reissue, to have any newly discovered prior art considered by the U.S. Patent and Trademark Office.

Let's take them one at a time. First and foremost, confirm that the patent is still in force and that all maintenance fee payments are up to date. For utility patents, maintenance fees are due at 3.5 years, 7.5 years and 11.5 years after the issue date. The PTO provides a 6-month grace period to pay each maintenance fee, after which the patent expires. If it is discovered that the patent has expired for failure to pay a maintenance fee, it is possible to reinstate it by submitting a petition to the PTO.

Provided all maintenance fees are paid, utility patents generally have a term of 20 years from the earliest U.S. priority date (excluding provisional application priority). However, for applications filed before June 8, 1995, the term is the longer of the 20 years from the earliest U.S. priority date or 17 years from grant. Be sure also to check if a terminal disclaimer was filed during prosecution, which may shorten the term, or if the patent term was extended by the PTO due to delays during examination or regulatory review.

Second, to assert a patent, the plaintiff must have standing at the time the complaint is filed. Standing typically resides with the owner of the patent or, in some circumstances,

with an exclusive licensee. A lack of standing at the beginning of the case cannot be cured after filing and the suit must be dismissed, so it is very important to confirm in advance. In one case, the U.S. Court of Appeals for the Federal Circuit affirmed the dismissal of a complaint for patent infringement over three years after filing—and even after a trial and finding of infringement—because the plaintiff did not own the asserted patents on the day the complaint was filed. *Abraxis v. Navinta* (Fed. Cir. 2010).

It also is important to confirm that the plaintiff has the right to enforce the patent during the relevant time period in which the infringement occurred. For patents transferred or acquired after issuance, make sure that the assignment includes the right to sue for past infringement. Provided these issues are found in advance of filing the complaint, they often can be remedied by a corrected assignment.

Third, investigate and confirm that inventorship of the patent is correct. Rather than find out during fact discovery that the sole named inventor actually conceived of the invention with another, do some due diligence to confirm inventorship in advance by reviewing copies of any development documents and interviewing the inventor(s), if available.

The file history of the patent also may provide clues as to whether any inventorship issues may arise during litigation. Because inventorship is determined based on who contributed to the conception of the claimed invention, there is a risk that joint inventorship may be incorrect when subject matter was added to the claims or claims were cancelled. Look for and investigate any significant changes in the claimed subject matter during prosecution that could be a red flag during litigation.

Incorrect inventorship often is not fatal to the patent and can be corrected before or even during the litigation. However, resolving any inventorship issues early allows time to ensure that an assignment can be obtained from any previously unnamed inventors. Absent an agreement otherwise, each joint inventor has an equal right to the patented invention. Discovering a new inventor who refuses to sign an assignment, or worse was not under any obligation to assign rights to the plaintiff at the time of the invention, can be a serious problem. For instance, a previously unnamed inventor could grant a license to the accused infringer rendering the action moot.

Fourth, if the patent claims, or was intended to claim, priority to an earlier filed patent application, check to make sure that the priority claim was perfected in the file history. If not, it may be desirable to fix this before filing suit, particularly if there is potentially invalidating prior art in the intervening period between the priority application date and the U.S. filing date. The failure to perfect a claim of priority may be cured by filing a reissue application or, in some circumstances, by filing a request for a certificate of correction.

Finally, familiarize yourself with the prior art cited in the patent, and any other prior art that is likely to come up in litigation. Review internal prosecution and invention records, and the prosecution files of any foreign equivalents to the patent, to see if there is any prior art that was not cited to the PTO during prosecution of the patent. In some cases, a prior art search may be advisable to see what else is likely to come up in an invalidity challenge.

Should you discover any relevant prior art that was not cited to the PTO, determine whether there was an obligation to do so. Investigate when someone with a duty to disclose first became aware of it and determine its bearing on the validity of the claims. If the prior art was in the possession of the patentee before the issue was paid, and it was material to the patentability of the claims and noncumulative, it likely should have been disclosed.

To have new prior art considered by the PTO, a patent owner may file a reissue application or a request for supplemental examination. A reissue application generally is the cheapest alternative; however, it requires the patentee to admit that there is a defect in the patent rendering it partly or wholly inoperative or invalid. Reissue also can be a very lengthy process, with an average pendency of five years. On the other hand, in supplemental examination, the PTO must respond to the patentee within three months and either issue a certificate indicating the new prior art does not raise a substantial new question of patentability or order a reexamination of the patent.

A significant benefit of filing for supplemental examination is that, if filed before an allegation of inequitable conduct is made, it can immunize the patent from an inequitable conduct challenge during litigation. Thus, if you want to foreclose any challenges during litigation based on a failure to disclose material prior art to the PTO, a supplemental examination may be the best solution to achieve this in a timely manner.

An ex parte reexamination also may be filed directly without first filing a request for supplemental examination. Although this may save some money up front, ex parte reexamination differs from supplemental examination in that it is limited to prior patents and printed publications and does not offer the same statutory immunity from inequitable conduct.

Now that you've gone over everything, review that checklist one more time—just to be sure.

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