

# **Patent Webinar Series: Part 3**

## **Enforcing your Patents**

March 28, 2018

**A GC3 Startup Network Webinar**



# What is the GC3?

- A cross-sector, full value chain business membership organization
- A convener of collaborations to advance green chemistry innovation & practice
- An advocate for government policy & funding that advances green chemistry R&D and innovation

**Mission:** To make green chemistry standard practice – **Mainstream** – in industry, for innovation, public health, and environmental protection



# More than 120 Members Across Sectors and the Value Chain





# GC3 Green & Bio-Based Chemistry Startup Network

*Creating an innovation ecosystem for green and  
bio-based chemistry technologies*

## Goals

- Support green and bio-based chemistry start-ups
- Introduce large strategics to new chemical technologies, partnership and investment opportunities

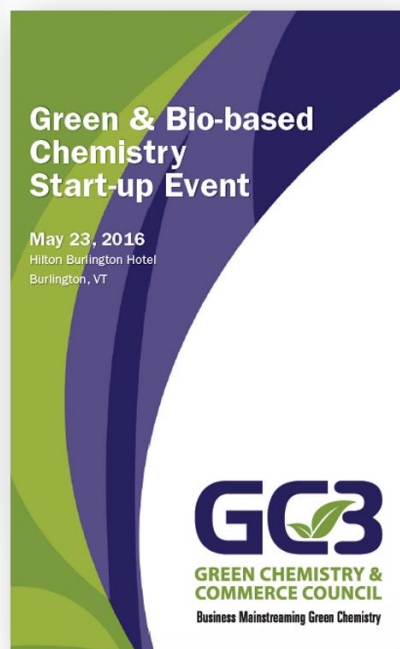


# Members of the GC3 Startup Network Include:



# GC3 Startup Network Technology Showcases

Workshop on Leveraging Partnerships  
to Accelerate Green & Bio-Based  
Chemistry Innovation



February 1, 2017

Hosted by

**LEVI STRAUSS & CO.**

<http://greenchemistryandcommerce.org/startup-network/>





# GC3 INNOVATORS ROUNDTABLE

May 8-10, 2018 • Kingsport, TN  
Hosted by  
**EASTMAN**



**13<sup>th</sup> Annual  
GC3 Innovators Roundtable**  
May 8-10, 2018

**3<sup>rd</sup> Annual Green & Bio-Based  
Chemistry Technology  
Showcase & Networking Event**  
May 8, 2018

*Registration is now open!*



# Ground Rules

- Due to the number of participants in the webinar, all lines will be muted
- If you have a question or comment, please type it in the “Questions” box located in the control panel
- Questions will be answered at the end of the presentation



# Today's Lineup

## Moderator



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## Presenters



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# FINNEGAN

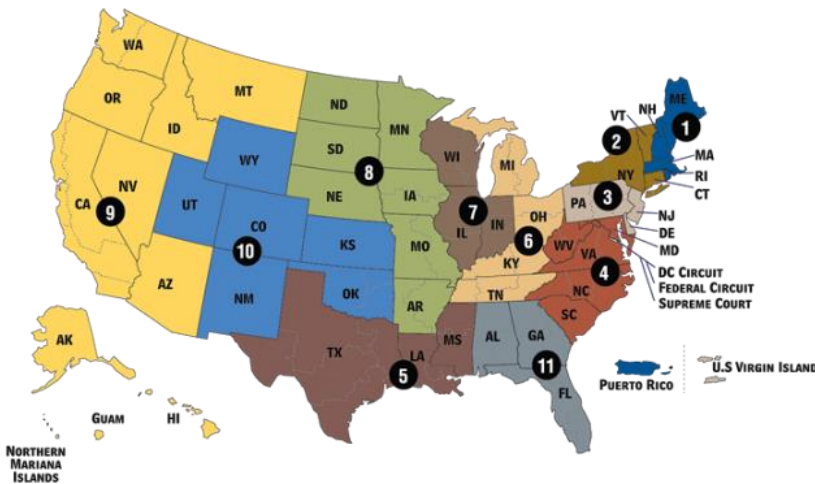
## Enforcing Your Patents

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# District Courts

- Our Constitution protects “writings and discoveries.” U.S. Const. art. III. The 94 federal district courts have original jurisdiction over patent disputes. The U.S. Court of Appeals for the Federal Circuit hears patent appeals, as does the U.S. Supreme Court on occasion.



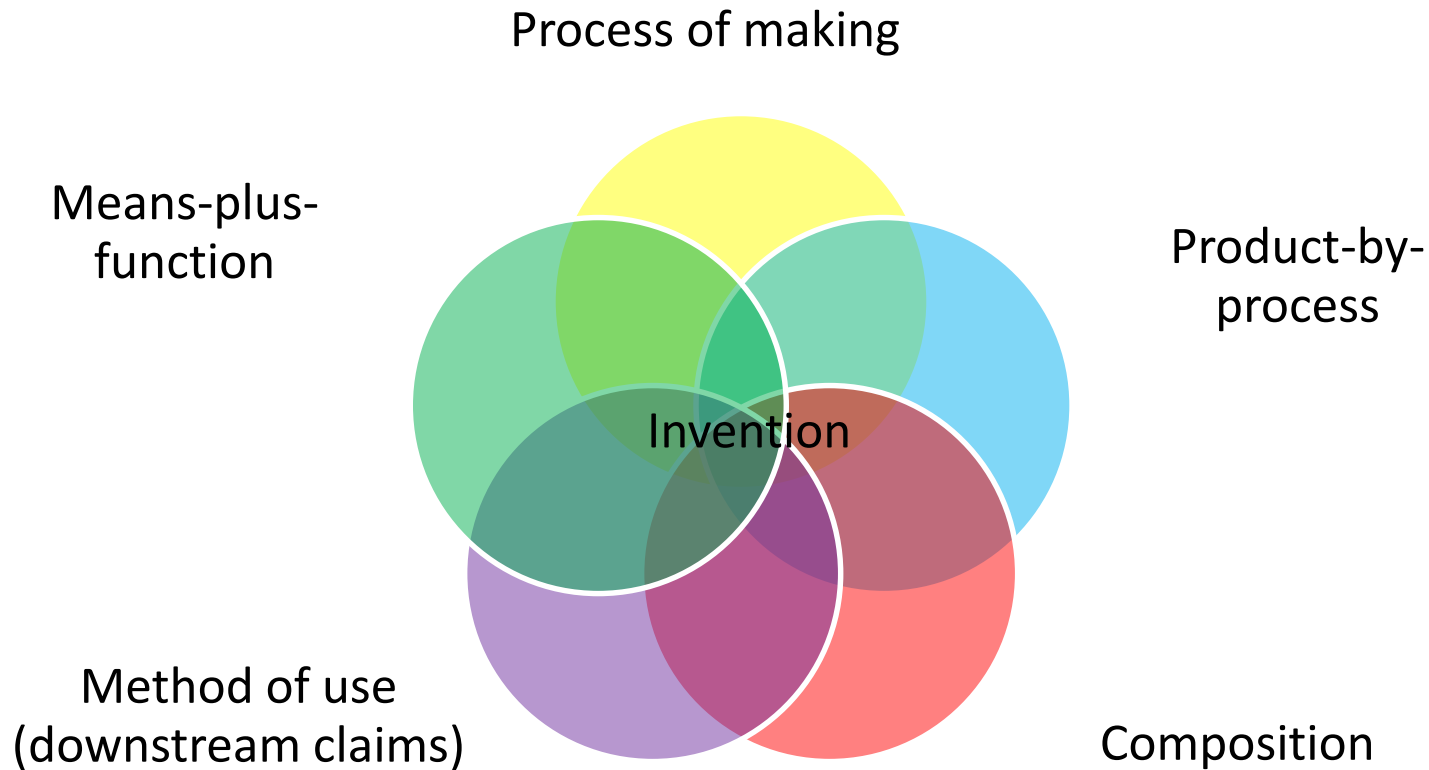


- The U.S. ITC has jurisdiction over imported products. It protects U.S. industry from unfair competition by foreign entities. The ITC follows the patent law but has additional domestic industry requirements.

- Obtain the best patent claims possible
- Steps before suing
  - Pre-litigation investigations
  - Developing and maintaining litigation themes
  - Effectively managing communications

# Obtain Best Patent Claims Possible

- Number one priority!
  - Do this first...and diligence later is much easier
- Obtain claims of varying type and scope
  - Claim the commercial embodiment
  - Claim potential variations thereof
  - Claim potential variations of those variations
  - Use claim variety to protect your invention from potential infringers
  - Maintain continuing or pending applications



# Pre-litigation Due Diligence

- Institute document hold
- Identify and retain potential expert witnesses
- Identify and interview key witnesses
  - Inventors
  - Declarant(s) (if a declaration submitted during prosecution of patent(s) at issue)
  - Technical people having knowledge of technical aspects of subject matter in patent(s)
  - Attorneys who prosecuted patent(s)



# Pre-litigation Due Diligence

- Locate and review key documents
  - Invention records
  - Support for working examples or declarations (lab notebooks, reports, etc.)
  - Inventor publications
  - Product literature
  - Regulatory filings
  - Patent prosecution files, both foreign and domestic
  - Correspondence between the attorney and the client
  - Documents bearing on validity (e.g., opinions)
  - Documents bearing on enforceability

# Potential Challenges from Accused Infringer



- Validity
- Enforceability

# Preparing for Validity Challenges

- Further develop validity positions over prior art cited during prosecution
  - Further develop scientific arguments made during prosecution
  - Was the law argued during prosecution consistent with current law? *KSR, Nautilus, Alice, Myriad, etc.?*
- Consider other elements of validity
  - Written description and enablement
- Consider potential IPR and PGR challenges

# Preparing for Enforceability Challenges

- Questions to consider:
  - Did the inventors or others significantly involved with the patent know of material prior art that was not cited?
  - Were patent examples relied on?
  - If so, were they actually performed and accurately reported?
  - Were any statements to PTO unclear or capable of being misconstrued?
  - Did representations to the PTO directly conflict with representations to other patent offices or agencies?

- Questions to consider:
  - Inventorship correct? Any inventorship disputes?
  - Assignments executed and recorded?
  - Small entity vs large entity status correct?

# Opportunities to Correct

- Reissue patent
  - Can broaden within two years
  - Can draft narrower claims that are more likely to survive a validity attack or newly found art
  - Put new art before examiner to negate “but for” materiality
- Continuation Applications

# Developing the Invention Story

- Develop story of the invention
  - Efforts within and outside company to develop the invention
  - Long-felt need for invention
  - Unpredictability of field; failures of others; skepticism of others
  - Uniqueness of invention; surprising or superior results of invention
  - Acclaim or surprise upon publication
  - Success of invention (commercial or otherwise)
  - Copying by others (including defendants)
- Blood, sweat, and tears!!

# Developing the Infringement Story

- Develop story of defendant's infringement
  - Defendants are seeking to capitalize on your success
  - Consider public statements by defendants
    - Do they tout the benefits of the infringing elements in their products?
  - Consider actions by defendants
    - Are they seeking patents in this same area?
    - Have they attempted to pursue similar products/methods?
    - Have they attempted to design around?



- Ensure coordination among departments and in all activities by company
  - Ongoing concern
  - For pharmaceuticals, conform labeling and scope of patent protection
  - Accuracy of scientific data and descriptions in examples, declarations, publications, product literature, regulatory filings
  - Consistency of factual positions during U.S. and foreign prosecution
  - Consistency in foreign litigations

- Coordination: Patent and Marketing
  - Publications
    - Premature disclosures
    - Inaccurate development histories
    - Inconsistent conclusions

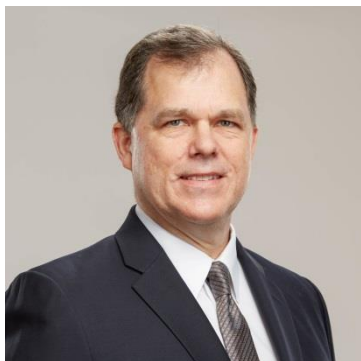
- Manage internal communications
  - Minimize unhelpful communications
  - Control flow of information
  - Maintain privilege where appropriate

# Ask Your Attorney



- Attorney-Client Privilege
- Attorney work-product in anticipation of litigation.
- Discovery of facts versus legal theories.

# Thank you



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# Disclaimer

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# Question & Answer

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# Thank you for joining us!

For more information about the GC3:  
[www.greenchemistryandcommerce.org](http://www.greenchemistryandcommerce.org)

