

# Patents in Perspective

What to do *after*  
you get your patent

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# Thanks for Coming

- Go Penn State!



# Overview

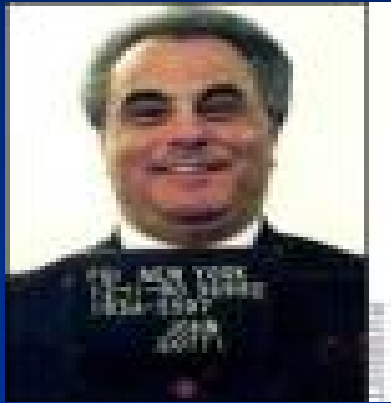
- You have your patent
- Turning patent from paper to profit
- What to do
- What not to do



# Proving Your Invention

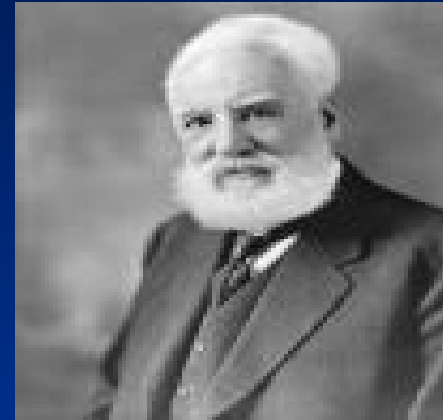
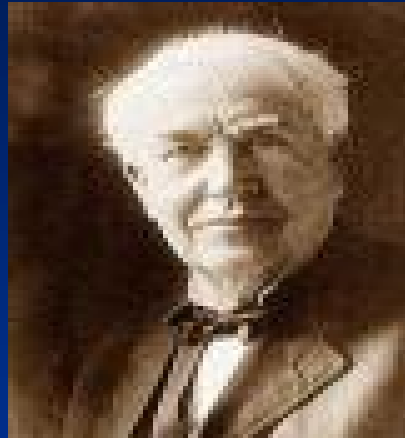
- Your patent is not enough!
- Must have records of inventive activity
- **CORROBORATION** IS KEY

# Corroboration – Criminal Law



- The word of a man convicted of 17 murders is sufficient to send a man away for life!

# Corroboration in Patent Law



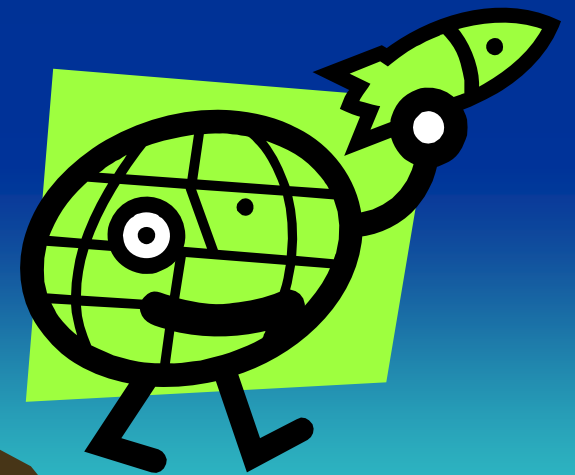
- Even if you were Thomas Edison or Alex. Graham Bell, your uncorroborated word is insufficient to prove invention
- “The case law is unequivocal that an inventor's testimony respecting facts surrounding a claim of derivation or priority of invention cannot, standing alone, rise to the level of clear and convincing proof.”

# Corroboration

- Bound lab notebook
- Contemporaneous entries
- Good data, good details
- Witnessed by someone else

# Must Maintain Records

- Treat them like a bank deposit
- Must show contemporaneously made and **MAINTAINED** thereafter
- “I lost them in a hurricane” does not cut it





# Collecting Evidence of Infringement

- Hunches and “I know it” **DON'T** work
- Go get proof
- Document your search
- Keep your lawyer in the loop and keep it confidential

# Market Intelligence

- Web sites
- Patent applications
- Trade shows
- Trade journals
- Sales material
- Other lawsuits
- Word-of-mouth



# Collecting Evidence



- Must be honest
- No illegal collecting of evidence
- No spying or fraud
- Can be aggressive, can't be dishonest
- Everything you do will be second guessed

# Analyze the Evidence

- Critically analyze evidence
- With valid scientific tests and methods
- Compare evidence with claims
- **MAKE A CLAIM CHART**



# Develop Your Proof

- Can your theory of infringement be clearly explained?
- If not, something is wrong
- Every element must be included



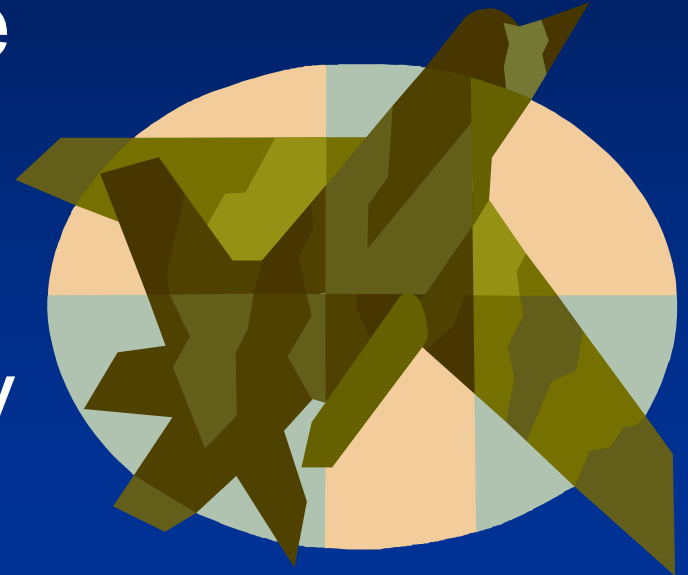
# To Threaten or Not?

- Once you have proof, you must contact the infringer
- If you send a threatening letter, you might invite pre-emptive suit
- Nice letters work better
- Lawsuit may be inevitable



# The Power To Enjoin

- Patent provides the right to exclude
- Greatest weapon is to stop adversary in tracks
- Brings people to bargaining table
- Blackberry case



# Greatest Weapon May Be Lost

- E-Bay found to willfully infringe patent, but no injunction
- Supreme Court reviewing E-Bay case
- Could change ball game





# Ending the Case

- If you settle, make sure the settlement papers are clear
- Disputes will arise after settlement
- Preserve all your rights
- Make patent stronger for next case



# What to Include in Your Settlement

- Which parties? Parents, subs, agents?
- Which product?
- Which patents, patent apps?
- Acknowledge validity of your patent
- Acknowledge that infringer will not challenge validity
- Jurisdiction of court for future disputes

# Thank You!

