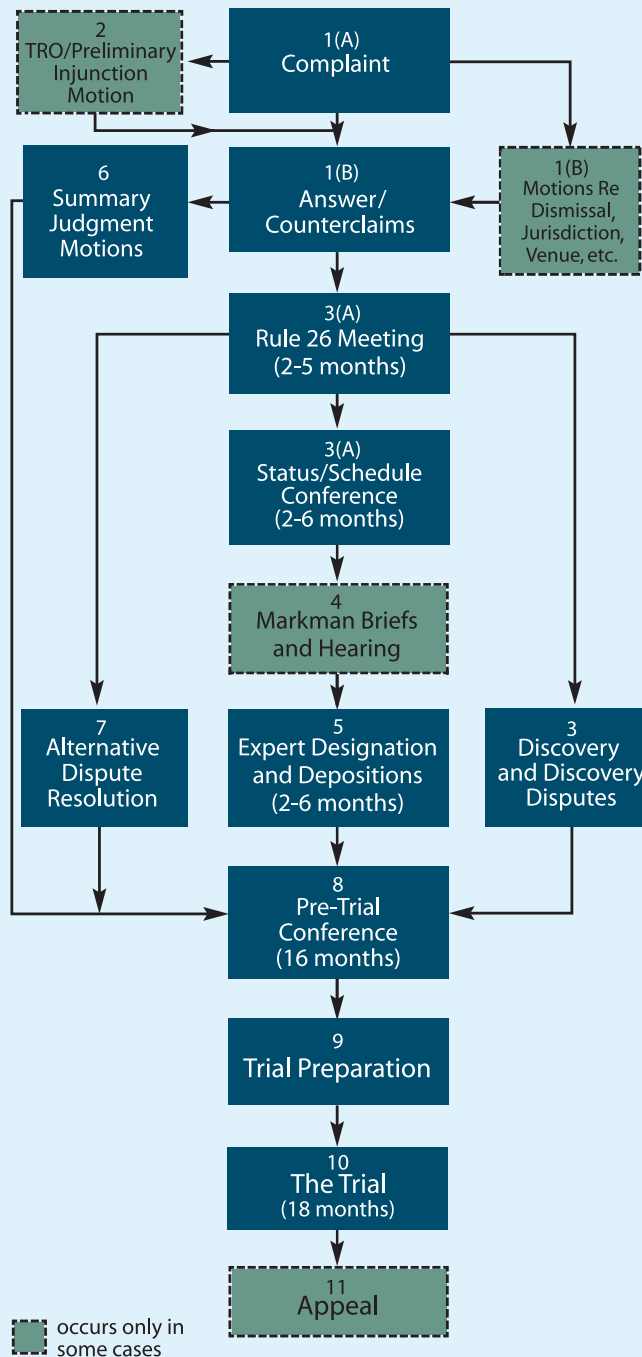


The Life of an Intellectual Property Case



The Life of an Intellectual Property Case

This outline describes many of the events that may occur in an intellectual property lawsuit in federal court.

1. Pleadings

A. Complaint

A lawsuit commences with a complaint. The complaint states the alleged wrongful conduct of the defendant, or in the case of a declaratory judgment complaint, that the plaintiff did not violate any rights of the defendant.

B. Responses to the Complaint

A defendant might respond to a complaint by:

1. Answer

The most direct response to the complaint is an answer. An answer admits or denies the allegations in the complaint, and sets forth specific defenses.

2. Counterclaim

A defendant frequently asserts affirmative claims against the plaintiff by way of a counterclaim. Often one of the counterclaims is a declaratory judgment claim that the defendant did not violate any rights of the plaintiff.

3. Third-Party Claims

A defendant can assert claims against other parties in the form of cross-claims or third-party complaints.

4. Motions Attacking the Complaint

Before, or simultaneously with filing an answer, the defendant can file motions to attack the complaint. One motion can attack the forum where the lawsuit has been filed. Also, the complaint can be attacked on the grounds that it does not adequately state a viable claim.

C. Responses to Defendant's Pleadings

Whenever a defendant asserts affirmative claims, each of the defendant's claims is akin to a complaint. The opposing party must respond to the defendant's affirmative claims by answer or motion.

2. Preliminary Relief

A. Temporary Restraining Order

At the outset of the case, the plaintiff can request that the court issue a temporary restraining order ("TRO") such as an order preventing infringement for a short period of time.

B. Preliminary Injunction

Whether or not a TRO is sought, the plaintiff can ask for a preliminary injunction preventing certain conduct during the pendency of the lawsuit.

3. Discovery

Discovery is the process whereby the parties obtain information relevant to the case.

A. Status/Scheduling Conference

Early in the case, the attorneys have a "Rule 26" meeting to discuss the issues, propose a schedule for the case, and exchange basic information, including identification of key witnesses, documents, and other evidence. The court then conducts a scheduling conference to set dates for completion of discovery and filing motions, and preliminary dates for trial and pre-trial proceedings.

B. Depositions

Depositions are usually taken. These include depositions of the parties and third-party witnesses.

C. Document Production

The parties are entitled to obtain copies of relevant documents from each other by notice, and from third parties by subpoena.

D. Interrogatories

Each party can submit written questions to the other side which are to be answered under oath.

E. Requests for Admissions

Each party can request that the other side admit certain facts are true.

F. Protective Orders

Because of the sensitive nature of documents and other information that the parties are required to produce, it is common to have a protective order issued by the court limiting the persons who have access to the sensitive information, and the use that can be made of the information.

G. Discovery Motions

Often there are disputes regarding appropriate discovery. If not resolved by the parties, discovery disputes are the subject of motions.

4. Markman Hearing (patent cases only)

In patent cases, the court normally conducts a "Markman" hearing. The purpose of the hearing is to interpret disputed patent claim language. A Markman hearing can be hotly contested because the court's claim interpretation can greatly affect who wins.

5. Expert Witnesses and Discovery

Several expert witnesses can be involved with respect to such topics as technical, legal, and economic issues. Expert witnesses prepare written reports and are usually deposed after all non-expert discovery.

6. Summary Judgment Motions

Each side normally files at least one motion for summary judgment or summary adjudication. Such a motion asks the Judge to decide as a matter of law that the moving party is entitled to win the case or at least one issue in the case.

7. Alternative Dispute Resolution

Most courts require that the parties engage in alternative dispute resolution ("ADR"), usually in the form of mediation. This can occur early in the case, but sometimes ADR occurs close to trial. Representatives of the parties with settlement authority are required to attend.

8. Pre-Trial Conference

A pre-trial conference is conducted shortly before trial. The lawyers are usually required to file numerous documents, including proposed jury instructions, motions in limine (e.g., a motion to exclude certain evidence from trial), witness and exhibit lists, and a proposed pre-trial conference order.

9. Trial Preparation

Trial preparation includes preparation of exhibits, witnesses, trial briefs, and documents.

10. Trial

Typically trial occurs about 18 – 24 months after the complaint is filed. In most intellectual property cases, the parties are entitled to a jury trial; however, the parties can waive a jury.

After trial, the parties can file post-trial motions. For example, a party can file a motion requesting that the Judge set aside or alter the jury's verdict. The prevailing party might file a motion asking the court to award its litigation costs and attorneys' fees.

11. Appeal

Either side might appeal. An appeal can be taken from the result of a trial; intermediate decisions as well as post-trial rulings can also be appealed.



100 CORSON STREET, THIRD FLOOR, PASADENA, CALIFORNIA 91103-3842 • (626) 796-4000 • www.usip.com