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How Best to Navigate Intellectual Property Litigation?

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September , 2024

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- Admitted to practice before: the U.S. Patent and Trademark Office; U.S. Courts of Appeals for the Federal and Ninth Circuits; All four U.S. District Courts of California; U.S. District Courts of Arizona, Michigan, North Dakota, New Jersey, Tennessee; and State Courts of California and New Jersey.
- Boston University, Bachelor of Arts, September 1984, Biology, Chemistry, Physics, and Medical Science.
- Iona University, Graduate School of Arts and Sciences, August 1987, Master of Science, Biology and Education.
- University of Pennsylvania, The Law School, Juris Doctor, May 1992.
- Has testified almost two dozen times as a retained Expert Witness and has served as a Special Assistant Attorney General.
- Advises manufacturers, distributors, and dealers in many industries: agriculture; home theater; furniture; jewelry; clothing; shoes; gloves; defense contractors; medical, dental, optical products; video games; tapestries; textiles; toys; robots; computer printers; and many more.

OVERVIEW

1. ANALYZING A SITUATION OF POTENTIAL INTELLECTUAL PROPERTY INFRINGEMENT
2. PRE-LITIGATION STEPS
 - a) Preparing and Sending a Cease and Desist Letter
 - b) Conducting a Pre-Filing Investigation
3. STARTING THE LITIGATION
 - a) Decide where to file the Complaint
 - b) Draft, file, and serve the Complaint
4. DISCOVERY PHASE
5. MOTION FOR SUMMARY JUDGMENT
6. GOING TO TRIAL

1. ANALYZING A SITUATION OF POTENTIAL IP INFRINGEMENT

- What are your Client's IP rights?
 - Copyright? Trademark? Patent?
 - Are they registered? Is it common law?
 - Confirm ownership and validity
- What infringement act(s) have they identified?
 - When did the infringement start?
 - Did they take any action yet?
- Comparison between Client's IP right(s) and the alleged infringing activity

1. ANALYZING A SITUATION OF POTENTIAL IP INFRINGEMENT

- Consider exceptions or Defenses that the alleged infringer may have or might assert.
- Gather the evidence (documentary & testimonial).
- Evaluate the potential harm and assess damages.
- Decide with the Client which response to the potential infringement is most appropriate.

2. PRE-LITIGATION STEPS

- Avoiding Court should be favored because:
 - The decision of the case remains less predictable in Court
 - The cost of litigation is difficult to assess in advance
 - Costs of litigation might be extremely high (possibly more than the damages), especially if the case goes to Trial
- If successful, it will end the case at a reduced cost.
- Pre-litigation steps are necessary to define the scope of the potential case.
- If not successful, all of the research will be used when drafting the Complaint and can save time and money at that later stage.

Preparing and Sending a Cease and Desist Letter

- Cease and Desist Letter = formal notice demanding that the infringer stop their infringing activities to avoid legal action.
- Goal:
 - Put the recipient on notice of Client's IP right(s)
 - Demand to stop the infringing activity

Preparing and Sending a Cease and Desist Letter

- Content of the Letter:
 - Point out the infringing activities
 - Provide some evidence
 - Highlight the risk(s) for the infringer if they do not stop and/or settle
 - Set a deadline for the infringer to reply
- Potential hurdle: Identify the infringer(s) and determine where and how they can be served
- Outcome:
 - Ideally: Compliance and/or Settlement
 - Can send one or more reminders if needed

Pre-filing Investigations

- Who is/are the Defendant(s)
 - Which entity and/or individual?
 - Where are they located?
- Gather more evidence and re-assess the strength of the case
 - Consider the potential infringer's response to the Letter, weigh again the potential defenses and responses the infringer might assert.
- What are the expected damages?
 - Statutory damages and attorney fees available?
 - Make sure that the type of damages available meet the Client's expectations.

3. STARTING LITIGATION

- No response or unsatisfactory response to the Cease and Desist Letter.
- Client's decision to bring the case to Court.
- Litigation starts with a Complaint that needs to be filed with the Court and served on the Defendant(s).

Decide where to file the Complaint

- State Court vs. Federal Court
- Which Federal Court
- Which State Court?
- Which county/city/Division?

- Why is it important?
 - Avoid unnecessary delay in the procedure if the case is filed in the proper Court right away
 - Attorney needs to be admitted to the Court, possibly *pro hac vice*
 - Impact of procedural Local Rules on the case

Draft, File, and Serve the Complaint

- Drafting the Complaint:
 - Facts
 - Legal basis for the claim
 - Relief sought
 - Exhibits
 - Defendant(s) need to be identified → it can be difficult if Defendant's address is unknown.
 - Jury demand?
- Satisfy jurisdiction and standing requirements
- Ensure all allegations and evidence are well-supported

Draft, File, and Serve the Complaint

- File with the Court = Officially submit the Complaint to the chosen Court.
- What to file?
 - Complaint and Exhibits
 - Court's forms
 - Fees to file

Draft, File, and Serve the Complaint

- Service of process: Legally notifying the Defendant(s) by serving the Complaint.
 - After the Judge/Court signs the Summons
 - Serve the Complaint, exhibits, and all formal documents filed with the Court
 - Service can be difficult if:
 - Defendant resides outside of the U.S.
 - Defendant's address is unknown
- Federal Court, Time limit for Service is now 90 days after the Complaint was filed (can be extended)
- Waiver of service request – give more time to respond and save time and money trying to serve
- Service starts Defendant's response deadline

4. DISCOVERY PHASE

- Usually, once the Complaint has been answered, the discovery phase starts, but sometimes sooner (and sometimes later)
- Discovery is the phase of the litigation when both parties exchange relevant information and evidence
- Discovery includes:
 - Depositions
 - Requests for Production of Documents → Exchange of documents (and things)
 - Interrogatories
 - Requests for Admissions

4. DISCOVERY PHASE

- Goal:
 - Build a stronger case by uncovering all of the relevant facts
- The length of the Discovery phase depends on the Case Management Schedule Entered by the Court
- This is a very costly part of any litigation, and usually where the case gets won or lost

5. MOTION FOR SUMMARY JUDGMENT

- Purpose: Ask the Court to rule on the case without going to trial.
- A Motion for Summary Judgment can be filed by either the Plaintiff or Defendant (often by both).
- When to file?
 - Ideally after all Parties have had time to go through the Discovery exercises
 - Discovery does not need to be closed to file a Motion for Summary Judgment
 - However, a Motion for Summary Judgment filed too early might be denied based on fewer facts

5. MOTION FOR SUMMARY JUDGMENT

- A party asks the Court to decide the case or a specific issue without a trial if:
 - There are **no disputed material facts**
 - They are entitled to judgment as a matter of law based on the evidence presented
- The Motion for Summary Judgment is filed with the Court
- Opposing Party will Oppose the Motion
- Filing Party will file a Reply to the Opposition
- Outcome:
 - MSJ granted → Case dismissed
 - MSJ partially granted → Partial judgment, proceeding to trial for the rest of the issues to be determined
 - MSJ Denied → proceeding to trial on all issues

6. GOING TO TRIAL

Preparing for Trial

- Case where no settlement has been reached
- And no complete summary judgement was granted
- Prepared for trial
 - Motions in Limine (exclude prejudicial evidence)
 - Memorandum of Contentions of Facts and Law
 - Jury instructions
 - Verdict form
 - Exhibit List
 - Witness List
 - Expert Witnesses

6. GOING TO TRIAL

Starting Trial

- Goal: Present a compelling argument before the Court
- Estimated length of most trials is usually 3-6 days
 - Depends on the complexity of the case
 - Court decides how many days the case needs
- Jury or bench trial
 - If it is a jury trial → jury selection
 - The jury decides on the merit of the case following the jury instructions and verdict form
- Verdict
- Appeal

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Any questions?