

Preface

Conflicts over intellectual property, and specifically over patents, have assumed a pivotal role in the world economy. Fred Warshofsky, in his 1994 book *The Patent Wars*, wrote:

In the war for global economic dominance, the fiercest battles today are over intellectual property. Where nations once fought for control of trade routes and raw materials, they now fight for exclusive rights to ideas, innovations, and inventions. The battlefields in this bloodless war are the world's courts, where billions of dollars are won and lost each year through patent litigation. Beyond licensing fees and individual companies' rights to manufacture specific products, what is at stake is the ultimate control of key high-tech industries such as biotechnology, electronics, and communications.

Legislation proposing significant patent law reform was considered by the Congress in the last few years for the first time since 1952, the last time significant changes were enacted to the patent statute.

Judgments and settlements in favor of patent holders routinely amount to millions of dollars and recently have even reached the one billion dollar mark. Injunctions are often sought, and sometimes these injunctions command wide public attention, as evidenced by the 2003 Research in Motion (RIM) litigation where the patent holder prevailed and Blackberry users faced the real possibility that an injunction would be entered that would have disrupted the continued use of those devices.

Against this background, the Complex Litigation Committee of the American College of Trial Lawyers (ACTL) was charged in 2005 with drafting a manual detailing a patent case for the purpose of informing judges and lawyers not familiar with patent litigation of commonly used practices in this area of the law. Our intention was to prepare a concise, narrative summary of the steps required to bring a patent case to trial and of the key elements of such litigation.

This idea originated with a suggestion by ACTL Judicial Fellow the Honorable Garr M. (Mike) King and was endorsed by former ACTL President David W. Scott and the Regents of the College. The Committee formed a Working Group consisting of members of the Complex Litigation Committee, other members of the College, and other experi-

enced patent practitioners. Working Group members reviewed the many published treatises on patent litigation and determined that none addressed the issues in the form of a concise guide to patent litigation for trial judges and lawyers. The object of this manual is to offer suggestions as to how judges and lawyers may deal with some of the procedural problems presented in patent litigation. We hope that this manual will add to the resources currently available.

The Committee would like to acknowledge the efforts of the following members of the Working Group who contributed to this project: George E. Bowles, Christine W.S. Byrd, Joseph A. Calvaruso, Steven Cherny, Morgan Chu, John L. Cooper, Ford F. Farabow, Jr., Lawrence B. Goodwin, Michael Graif, Robert J. Gunther, Jr., Roy W. Hardin, George F. Pappas, Michael O. Warnecke, and Ken S. Weitzman. The Editorial Committee, chaired by George F. Pappas and ably assisted by John L. Cooper and Morgan Chu, blended the several chapters into a condensed text.

The Committee owes special thanks to the following judges who reviewed our draft outline and provided meaningful suggestions: District Judges William H. Alsup, P. Kevin Castel, David J. Folsom, Garr M. (Mike) King, Kathleen M. O'Malley, James L. Robart, Fern M. Smith, Sam Sparks, Thomas John Ward, and Ronald M. Whyte, Third Circuit Judge Kent A. Jordan, Federal Circuit Chief Judge Paul R. Michel, and Federal Circuit Senior Judge S. Jay Plager.

The project would have been impossible without the assistance and support of several past Presidents of the College, including David W. Scott, James W. Morris III, Michael A. Cooper, David J. Beck, and Mikel L. Stout, and current President John J. (Jack) Dalton.

The American College of Trial Lawyers' Statement of Purpose is included below.

John Nyhan
Chair

George F. Pappas
Vice Chair

Complex Litigation Committee
American College of Trial Lawyers

American College of Trial Lawyers' Statement of Purpose

The American College of Trial Lawyers, founded in 1950, is composed of the best of the trial bar from the United States and Canada. Fellowship in the College is extended by invitation only, after careful investigation, to those experienced trial lawyers who have mastered the art of advocacy and those whose professional careers have been marked by the highest standards of ethical conduct, professionalism, civility, and collegiality. Lawyers must have a minimum of 15 years' experience before they can be considered for Fellowship. Membership in the College cannot exceed 1% of the total lawyer population of any state or province. Fellows are carefully selected from among those who represent plaintiffs and those who represent defendants in civil cases; those who prosecute and those who defend persons accused of crime. The College is thus able to speak with a balanced voice on important issues affecting the administration of justice. The College strives to improve and elevate the standards of trial practice, the administration of justice and the ethics of the trial profession.