INSIDE THE MINDS

International IP Issues and Strategies

Leading Lawyers on Managing Intellectual Property Protection and Enforcement Efforts across Multiple Jurisdictions

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Strategic Considerations for Enforcing Patents in International Disputes

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Introduction

When U.S. companies find themselves in patent disputes with foreign competitors, they need to make sure they take advantage of the changes in the playing field on peril of being taken advantage of themselves. Merely relying on experience with the U.S. patent enforcement system is not sufficient for success in patent disputes with international components. For example, knowing how to find, compel, and cross-examine an English-speaking witness in Atlanta or San Jose is not sufficient for getting the case-winning admissions from an executive in Tokyo or an engineer in Stuttgart. And knowing how to prepare a U.S. witness for a deposition is not sufficient for helping a foreign witness, who may have no experience with the adversarial U.S. court system and the critical role of the jury in U.S. litigation.

Patent disputes increasingly require trial practice across international boundaries. Patent trial work in the United States takes on such international issues, when it involves one or more companies, products, or witnesses that are not located in the United States. In my experience, this includes:

- Suits by U.S. companies against European, Israeli, Korean, and Japanese companies
- Suits by non-U.S. companies against U.S. or non-U.S. companies
- Suits involving products that are made outside the United States and shipped into the United States
- Suits involving products that are made in the United States and shipped outside the United States
- Suits involving patents on inventions that were conceived outside the United States, often by citizens of other countries

Less commonly, we may be involved in suits seeking to enforce patents in other countries, particularly within the European Union, or suits to enforce U.S. judgments against non-U.S. companies that require us to seek remedies in the courts of the countries where those companies have assets or operations.

There are a number of strategic and tactical issues facing attorneys practicing in the field of international patent enforcement today that can create opportunities or obstacles, including:

- Cultural, legal, and logistical challenges to gathering evidence abroad
- Limitations on discovery in jurisdictions with blocking statutes
- Uncertainty as to the application of differing rules of privilege and confidentiality in multi-jurisdictional situations
- The cost of patent litigation in the United States compared to other countries
- The large damage awards that are possible in the United States compared to other countries
- The expansive scope of discovery in the United States, as compared to other countries
- Rapidly developing U.S. law in the area of patents
- The proliferation of electronically stored information
- Cross-border reach of U.S. patent rights
- Problems of jurisdiction, venue, and clogged dockets

The rest of this chapter addresses some of the opportunities presented by these issues that allow the savvy practitioner to gain an advantage in international patent cases.

Globalization and International IP Trends That Are Injecting International Issues into Patent Trials

There are obvious and well-recognized economic and political developments driving cross-border intellectual property (IP) issues. The globalization of the consumer electronics and medical device markets is one such factor. The most significant regions in which cross-border IP issues arise are the United States, Europe, Japan, and Korea, where the largest markets for patented goods and processes exist. These markets are the sources of significant new product development and patenting, as well as the markets in which many patented products are made and sold. It is often necessary to proceed in the country where an invention was made, where it is sold, or where the infringer has assets, to develop evidence or enforce a remedy. As important

commercial and technological activity arises in various countries, it becomes necessary to consider patent rights and remedies, as well as the evidence-taking procedures specific to those countries.

For example, in the last decade in particular, there has been more development of medical devices in the European Union, where there may be lower regulatory burdens on medical device testing and approval. A common medical device development path is for a device to be developed by U.S. or global medical device companies working with European doctors and hospitals. This path involves first testing the device and getting it approved under the European CE mark, and then bringing the device to the commercial market in Europe and Japan. After that, the device may be introduced commercially in the United States.

If there is a patent suit in the United States on the product, it becomes necessary to take discovery of the people and companies involved in the development of the product outside the United States, and issues of cross-border practice arise. These cross-border issues usually involve the discovery of documents and the taking of testimony from witnesses outside the United States.

Another commercial trend that breeds cross-border IP issues is the development of high-volume consumer electronic devices outside the United States, which are sold in high volumes to the United States. Mobile phones, digital cameras, personal computers, gaming systems, as well as computerized methods such as video and audio coding, network devices and systems, and Internet commerce systems, are a few examples. Consumer electronics have become a global business, with significant product development and marketing by European companies such as Phillips, Siemens, and Nokia, along with many smaller companies. In Asia, consumer electronics giants with large sales include Sony, Samsung, LG, and many others. In recent years, close to 50 percent of U.S. patents have been awarded to non-U.S. inventors, according to the analysis of the U.S. Patent and Trademark Office[1]. This table from a 2007 USPTO analysis

[1] *See, for example*, United States Patent and Trademark Office analyses for 2007: http://www.uspto.gov/go/taf/pat_tr07.htm
for 2006: http://www.uspto.gov/go/oeip/taf/topo_06.htm#PartB
and for 2005: http://www.uspto.gov/main/homepagenews/bak11jan2005.htm.

shows the extent to which Japanese, Korean, and European inventors are applying for and receiving U.S. patents:

This table displays the ten foreign countries whose residents received the most U.S. patents during calendar year 2007. Figures for the United States and for all countries overall are listed at the end of the table. Counts include utility, design, plant, and reissue patents, and statutory invention registrations.

Rank in 2007	Number of Patents in 2007	Share of All Patents in 2007	Country *	(Rank in 2006)	(Number of patents in 2006)	(2006 to 2007) (Change in Number of patents)
1	35,942	19.6%	Japan	(1)	(39,411)	(-8.8%)
2	10,012	5.5%	Germany	(2)	(10,889)	(-8.1%)
3	7,491	4.1%	Taiwan	(3)	(7,919)	(-5.4%)
4	7,264	4.0%	South Korea	(4)	(6,509)	(11.6%)
5	4,031	2.2%	United Kingdom	(5)	(4,329)	(-6.9%)
6	3,970	2.2%	Canada	(6)	(4,094)	(-3.0%)
7	3,720	2.0%	France	(7)	(3,856)	(-3.5%)
8	1,836	1.0%	Italy	(8)	(1,899)	(-3.3%)
9	1,596	0.9%	Netherlands	(9)	(1,647)	(-3.1%)
10	1,546	0.8%	Australia	(10)	(1,538)	(0.5%)
	93,691	51.2%	United States		(102,267)	(-8.4%)
	182,930	100.0%	All Countries		(196,437)	(-6.9%)

Source: U.S. PATENT AND TRADEMARK OFFICE Electronic Information Products Division Patent Technology Monitoring Team (PTMT) PATENTING TRENDS CALENDAR YEAR 2007 (document dated 21-FEB-2008) http://www.uspto.gov/go/taf/pat_tr07.htm.

Other economies are also generating development and becoming involved in the U.S. patent system.

Israel

Israel has also generated technology development and patenting, especially in the areas of computer network technology, pharmaceuticals, and medical devices. According to one U.S. Patent Office study, Israeli inventors ranked fourteenth in the list of foreign inventors by number of patents received in a multi-year study. (*See* U.S. PATENT AND TRADEMARK OFFICE Electronic Information Products Division Patent Technology Monitoring Team (PTMT) Patents by Country, State, and Year – Utility Patents, December 2007 at www.uspto.gov/web/offices/ac/ido/oeip/taf/st_utl.htm.) Israeli companies and inventors have been active in U.S. patent enforcement efforts in areas ranging from computer security to medical devices to Internet commerce, and many others.

China and India

One emerging issue is whether and how IP issues arising in China and India will harmonize with European and American notions of the protection of patent rights. For the moment, goods made in China that may implicate patent rights typically come up in U.S. patent cases by virtue of being made and sold for companies in the United States, Europe, Japan, Korea, or other countries that have robust patent enforcement rights and processes, or that are reachable by the process of U.S. courts. It is the Japanese, U.S., or global distributor, such as Sony or Samsung, that ultimately distributes the Chinese-made product, and that is the defendant in a patent suit, rather than the Chinese manufacturing company.

Likewise, it has not been the case so far that the laws and courts of China or India have been a vehicle for enforcement of patent rights by U.S. or global companies, in our experience, but rather the courts of the United States.

America

U.S. patent trial counsel can serve clients with international patent disputes by understanding how to combine benefits available to a patent litigant in

different countries. A patent holder may want to file suit in the United States, for example, because of procedural advantages and, for a U.S. company, the home court advantage, but it may be critical to know how to get jurisdiction over a foreign company, how to gather evidence abroad for the U.S. proceeding, and how to enforce the U.S. judgment. Or a U.S. company with foreign patents may need to proceed on those foreign patents in courts, for example in Europe, if there are no significant U.S. sales to pursue or there are commercial and tactical advantages to proceeding in the comparatively fast and inexpensive courts of Europe.

The U.S. courts, along with the International Trade Commission, are the leaders in providing effective remedies to patent holders. Their role in providing compensation in the form of money damages is especially important, as is their capability of providing injunctive relief to halt the sales of infringing products. A particularly significant way the U.S. courts protect the rights of patent holders is by providing discovery to a much greater extent than is available in courts elsewhere. A party in a U.S. patent suit has far greater access to compulsory disclosure of an opponent's documents, and to compelled examination of an opponent's witnesses, than do litigants in patent proceedings outside the United States. In addition, a party in a U.S. proceeding has compulsory access to third-party witnesses, which may be very important to the question of a patent's validity.

Initiating suit and obtaining jurisdiction over a foreign company is relatively straightforward for Japanese, European, Korean, and Israeli companies. Service of process usually occurs by consent, or by service of process under the Hague Convention. Some lead time is necessary for translation of the documents to be served, and generally the easiest and most efficient way to proceed is through one of the commercial agents for foreign service, such as APS. Experienced counsel should be well versed in how to initiate suit over a foreign defendant.

Working across Different Cultures and Laws

Parties in U.S. litigation often find themselves taking discovery outside the United States. This leads to the need to understand and resolve tensions between U.S. law and culture, on the one hand, and the laws and cultures of

other countries, on the other hand. What follows are a few examples of these tensions, along with the skills required to resolve them.

Many countries place limits or prohibitions on the taking of U.S.-style discovery within their borders, often under agreements and rules set forth in the Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (concluded March 18, 1970, entered into force October 7, 1972). A copy of the Hague Convention may be accessed at hcch.e-vision.nl/index_en.php?act=conventions.text&cid=82.

There are not only legal but practical challenges to taking evidence abroad. Just a few examples of issues that arise when attempting to take evidence abroad are the following:

- Compulsory depositions often require assistance of a foreign court, such as through the mechanism of a letter rogatory. The letter rogatory is issued by a U.S. court to a foreign court (or other agency in some cases), asking the foreign court to obtain discovery for use in the U.S. proceeding. It is often necessary to obtain the letter rogatory months in advance, and it can be critical to include the correct instructions to the foreign court. It can be very difficult to deal with a dispute that arises at the time of the foreign deposition if the letter rogatory does not address an important issue. An example of a letter rogatory is included as Appendix C.a
- Depositions may not be taken in Japan, except at the U.S. embassies or consulates in Tokyo and Osaka. It is necessary to plan far in advance to book the limited space at the consulate for a deposition, and to ensure that Japanese witnesses are available on the dates scheduled and will appear at the consulate. A number of documents are required, including an order from the U.S. court naming the action, the witnesses, and the dates. An example of an order for depositions in Japan is included as Appendix D.
- A special deposition visa is required for an attorney taking a deposition in Japan, and it must be applied for weeks in advance of the deposition. Typically, it is necessary to address these issues with an opponent, the U.S. court, and the U.S. consulate at the beginning of a case. Required documents include visa applications, copies of passports, a copy of the court order for the depositions,

flight itineraries, résumés of the applicants, and a statement of concurrence from the Japanese party.

- It is generally against German law to take a deposition in Germany. Formally, it is considered impersonating an official of the German government. It is possible to arrange to have cooperation of a German investigating official through letters rogatory. Others avoid the problem by holding a deposition of German witness in a neighboring country such as Holland, or by agreeing to an interview of the witness that is neither under oath nor signed by the witness.
- A compulsory deposition in Israel must be taken in open court before a presiding judge, who will rule on objections during the deposition. Parties may agree to a deposition without formal process, much like a U.S. deposition, but absent such agreement, the deposition must be scheduled through a letter rogatory, and must allow time for compulsory process in Israel. Discovery may be limited by laws and notions of privacy in Israel, as well as attorney/client privilege, and it is necessary to have an Israeli attorney present to argue issues of Israeli law that arise during the deposition.
- Document discovery may be severely limited or unavailable in many countries.

In addition to legal issues, there are cultural and logistical problems that one must deal with in taking foreign discovery:

- Foreign witnesses are not accustomed to the broad scope of U.S. discovery, or to the fact that documents and testimony will be presented to a jury who may pay great attention to the exact phrasing, tone, and implications of anything that is said or written. As an investigating attorney, you may find witnesses are far less careful in what they write and say because of this. As a defending attorney, you may have to do much more work and preparation with witnesses to help them fully understands the U.S. system and their role within it.
- Witnesses often choose to testify in their first language during a foreign deposition. You must know in advance whether the witness

will testify in English. If not, the examining attorney must arrange for a highly skilled interpreter who understands the translation issues, but also the rules of a deposition and the technology at stake. An unprepared interpreter can sap much of the value of a deposition by failing to translate correctly and exactly, or by muddying the record with comments and questions. An unskilled interpreter may not be able to cope with longer or more technical answers, and much of the value of the deposition may be lost if the interpreter asks for excessive interruption and repetition during the witness's answers.

- Likewise, as a defending attorney, it is critical to have a highly skilled check-interpreter to monitor the translation and point out errors so they can be addressed and corrected at the deposition. The interpreters may need to be available to testify in the U.S. court in case of a dispute over the translation.
- The investigating attorney also should be skilled at cross-examination through an interpreter. Many of the techniques that work for controlling a witness during a deposition are not effective when there is translation interposed. It is even more important in a translated deposition to have impeachment material available that is readily understandable by a U.S. jury. Use of a real-time reporting service that displays the transcript on a computer screen as the questions and answers are being spoken can be especially important in tracking the responsiveness of answers during a translated deposition. Real-time reporting is very helpful for interpreters as well, because they can follow the deposing attorney's questions on the screen without having to take notes. This makes their job easier and more accurate.
- As a defending attorney, it is difficult to build a rapport with a foreign witness if you are not able to communicate in the witness's first language, even if the witness is skilled in English. It can be a tremendous advantage if you do. If not, it is important to think about how to build rapport with the witness and gain the confidence of the witness.
- You must be aware of ambiguities that arise during the process of translation. To provide one example, Japanese grammar does not require a subject for proper sentence structure. As an

approximation, the following question and answer are entirely proper Japanese sentence structure:

> **Q:** You and your colleagues developed the high-performance circuit in January of 1996?
>
> **A:** Was developed.

- It is important to understand, when confronted with such an answer, whether you are dealing with an uncooperative witness, or whether you simply have not asked the right question (or both). In either case, it is important to understand that you need to ask first, "What are the names of the people who…" and then "In what month and what year did the people you just identified…"
- It is also important to understand whether your interpreter will translate the answer "was developed" as "yes," which would be perfectly acceptable, and if so, whether the check interpreter will object. I have also watched an investigating attorney waste an hour of precious deposition time because his interpreter insisted on a literal translation to the English "flat," instead of a more idiomatic "straight" or "not curved," and the deposing attorney did not appreciate that there was a language problem rather than a disagreement.
- Most of the time, Japanese does not specify number. Therefore, if you ask the witness what was in the box, and you get an answer "a key" or "keys," the interpreter is probably guessing from context as to whether the answer was singular or plural. If it is an important aspect of the answer, you should confirm whether the answer is a single key or several keys.
- Also, there is the fact that in Japanese, the honorific ending "–san" is sexless. Thus, again, the interpreter is probably guessing whether the Tanaka-san the witness is talking about is a Mr. Tanaka or Ms. Tanaka, and if he guessed wrong, there could be a surprise down the road.
- Important advice for anyone doing interpreted depositions is to understand that interpreting is not a generic function in which one language goes in at one end and another comes out smoothly at the other. It is a difficult, specialized job, and the differences in ability between one interpreter and another can be tremendous. You

should be prepared to pay a premium to get an experienced, well-recommended interpreter who specializes in litigation interpreting.

- Taking discovery through the intermediary of a foreign judge can present a number of challenges. When a deposition is conducted before a foreign judge in response to a letter rogatory, understanding how the judge will allow you to proceed and building a rapport with the judge are critical.
- It can also be very important to associate with skilled and knowledgeable local counsel. For example, some judges will want to conduct the questioning, and others will allow you to pose the questions. Some judges will allow you to submit written questions that the judge will pose and will allow you to follow up, or to suggest follow-up questions. Some judges will become very interested in the whole proceeding and will begin to intercede in the answers and the translations, in an effort to be helpful in clarifying the record—a dynamic that can be challenging.
- It is important to consider that a foreign-language deposition takes far more time per unit of useful information than one conducted in English between native speakers. In my experience, with a skilled interpreter and a skilled court reporter, you can expect a record that is 35 to 50 percent an English language record, although sometimes you get more. It may be important to modify time limits for depositions under the Federal Rules of Civil Procedure or the applicable case management order to double the time limit for translated depositions.
- There are, of course, many practical issues that arise in conduction law practice in what may be an unfamiliar place. Being prepared on simple logistical issues like power source and plug compatibility, paper-size compatibility (e.g., knowing what A4 is), and knowing how and where to get high-speed, high-quality volume copies is crucial.

Jury Trials

The most obvious (and unique) aspect of U.S. patent litigation is the right to be heard by a jury. The jury trial influences virtually every aspect of patent litigation in ways that make it unique among patents systems. In particular:

- The equities, narrative, and emotional content of the dispute take on significance that can determine the outcome of the case. It matters to a great degree how an invention was made, how well the inventor can convey the invention story, and who will benefit from the outcome of a jury's decision.
- Well-qualified experts are necessary who can explain sometimes complex and unfamiliar technology in a clear and precise way. The role of experts can determine the outcome of a case.

By contrast, patent cases in Europe are conducted primarily by submission of written briefs, without discovery, followed by brief oral presentations of counsel, perhaps only in response to questioning by the court. Compared to U.S. patent litigation, the European procedure may have the relative advantages of speed and economy of cost. In addition, for products that are not made, sold, or used in the United States, there may be no jurisdiction in the U.S. courts, and the only place to proceed may be in the courts of countries where the products are made, used, or sold.

Of course, it is possible that substantially the same product is sold in both the United States and Europe. If such a product is made outside the United States, it may be necessary to proceed in the United States as to the units sold in the United States and, for example, in countries in Europe for the units sold in those countries. There is, at present, no world forum where worldwide patent infringement can be addressed in a single place.[2]

European Patent Litigation

Patent litigation in Europe is different both procedurally and substantively from U.S. patent litigation, and different in ways that may make European patent litigation less attractive to U.S. companies in most circumstances. The reason is that European patent litigation generally proceeds with very limited discovery, or none at all. It may be necessary to gather all relevant proofs without having any access to your adversaries' private documents or witnesses. In many cases, this may put proofs out of reach, although some discovery may be available, particularly by court order. In some cases, it

[2] Parties can agree to arbitration to address all worldwide issues in one forum.

may be possible to attempt to develop discovery in a parallel U.S. proceeding, although many U.S. protective orders prevent the use of U.S. discovery for any purpose but prosecution of the U.S. case.

European courts often separate the issue of validity from infringement proceedings. Accordingly, it is sometimes necessary to proceed in two separate actions in two separate courts on the issues of infringement and validity respectively.

Typically, European courts proceed based on the "loser pays" rule, so that the unsuccessful party is ordered to pay a portion of the winner's fees and costs. A litigant may ask the court to order that a security be posted early in the case to guarantee payment of these costs in case the litigant is successful. By U.S. standards, however, the amounts are relatively small, typically not more than six figures, although in some countries they can exceed seven figures and may have an impact on the desirability of going forward with such a sum tied up in security and at risk.

European courts typically offer the remedies of damages and an injunction in patent cases. Judges decide these cases rather than juries, typically on a comparatively brief written record, with limited oral presentations by counsel.

The Effect of U.S. Decisions

The U.S. courts make decisions that have effects far beyond the borders of the United States. For example, U.S. courts can and do issue injunctions against manufacturing and sales from the United States to anywhere in the world. Such an injunction can be worked around by re-sourcing and manufacturing entirely outside the United States, if commercially feasible.

In this field, an interesting situation has arisen with respect to software. In America, software can infringe patents if it contains patented code. A debate has arisen that continues to draw divided views in the Supreme Court as to whether software written in the United States is considered a U.S. component that is reachable by the U.S. courts when it is recorded to a physical medium (such as a CD-ROM) outside the United States. For example, Microsoft's Internet Explorer browser was adjudged to infringe

patent claims owed by EOLAS and the University of California because the browser contained code for running applets. In that case, it was adjudged that the relevant software component was "made" in the United States because it was developed and reduced to a master in the United States. The Court of Appeals for the Federal Circuit ruled that the U.S. courts could reach and award damages on copies made and sold outside the United States. *Eolas v. Microsoft*, 399 F.3d 1325 Fed. Cir. (2005). The U.S. Supreme Court allowed this decision to stand. Microsoft argued, albeit unsuccessfully, that some of the software was "made" when it was copied onto compact discs at reproduction facilities outside the United States. Under this decision, it would be possible to obtain worldwide relief for software written in the United States. A later decision of the Supreme Court, however, in *Microsoft v. ATT*, reached a different result. *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437 (2007). In that case, a majority of the Supreme Court ruled that the relevant component was the copy of the software made outside the United States from a master supplied from the United States, and therefore held that foreign sales of foreign copies of the Microsoft software could not be reached by U.S. courts. Justice Stevens filed a dissent, expressing the view that the master is a "component" that finds its way into the end product, and because the master originated in the United States, it should be reachable by the U.S. courts.

This ongoing debate about the reach of U.S. courts simply points out the practical issues for parties to patent disputes: commerce is global, patent issues cross borders, but courts generally can act only on activity within their national borders. The party to a cross-border patent dispute, therefore, needs counsel who can operate in the various countries whose courts need to be involved to resolve the dispute.

Conclusion

A plethora of laws and organizations form the legal framework governing international IP issues and strategies. For enforcement of IP rights in litigation and quasi-litigation, these are extremely important:

- National laws and courts of each country
- The European Patent Office
- The U.S. Patent Office

- The U.S. International Trade Commission
- The Hague Convention on Taking of Evidence

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Mr. Holdreith was trial counsel in Medicis Pharmaceutical Corporation v. Upsher-Smith Laboratories, et al., *No. CV05-3458*, St. Clair Intellectual Property Consultants, Inc. v. Canon, Inc. et al., *No. 03-241,* St. Clair Intellectual Property Consultants, Inc. v. Fuji, Ltd. et al., *No. 03-24*1*,* St. Clair Intellectual Property Consultants, Inc. v. Sony Corp. et al., *No. 01-557, and other cases.*

Other cases of Mr. Holdreith include trial experience in complex, multi-million dollar patent litigation in multiple forums and before the Federal Circuit Court of Appeals. Technologies include, among others, medical devices, surgical methods, computer hardware and software, and pharmaceuticals.

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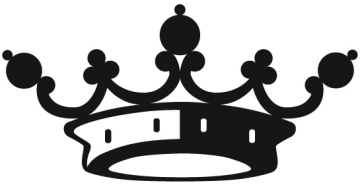

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