

STRATEGICALLY INSANE:

When to Ignore Conventional Wisdom to Win IP Litigation

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PROFESSIONAL BIO

- ▶ Senior Intellectual Property Counsel at Seagate Technology's headquarters in Cupertino, California
- ▶ Manages patent portfolio for Consumer Products group, advising on strategy, prosecution, litigation, transactions
- ▶ Also manages global trademark portfolio
- ▶ Previously practiced IP litigation at Silicon Valley offices of international law firms Morrison & Foerster LLP and Sidley Austin LLP
- ▶ J.D., University of Chicago Law School
- ▶ Bachelor's Degree in Physics, Cornell University
- ▶ Registered to practice in California, USPTO



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HAVE YOU EVER WORKED AT A COMPANY
THAT HAS BEEN INVOLVED IN LITIGATION?

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CONVENTIONAL WISDOM: Litigation

- ▶ Prep deponents to give short answers
- ▶ Remove from state court to federal court
- ▶ Attack patents from as many angles as possible
- ▶ Have the most senior partner argue motions and speak at trial
- ▶ Pick the most qualified, highly-decorated expert witnesses

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WHAT OTHER LITIGATION RULES HAVE YOU HEARD?

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CASE STUDY 1: Preparing for Depositions

Conventional Wisdom	Situation
Prepare witnesses thoroughly, instructing them to give short, succinct answers.	Key CEO witness in trademark infringement case was a prolific inventor with 80+ patents and had sold a previous company for \$400,000,000. He was also brilliant, verbose, and hard to manage.

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CASE STUDY 1: Preparing for Depositions

New Approach

Allow witness to testify using his own style, propounding on his philosophy in lengthy stream-of-consciousness responses.

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CASE STUDY 1: Preparing for Depositions

Outcome

7 hours of mostly useless testimony with very few harmful admissions, frustrating opposing counsel.

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CASE STUDY 2: Presenting Trial Testimony

Conventional Wisdom

Play videotape of deposition testimony or, alternately, have attorney read testimony into the record.

Situation

Deponent in patent infringement case was awkward on camera/unavailable at trial.

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CASE STUDY 2: Presenting Trial Testimony

New Approach

Hire charismatic, attractive actor to "play" the role of the witness and read into the record testimony.

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CASE STUDY 2: Presenting Trial Testimony

Outcome

Despite judge's instruction that he was an actor, jury fell in love with the "witness" and believed his testimony. Verdict won; surveyed afterwards, jury ranked him their favorite witness.

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CASE STUDY 3: Attacking a Patent

Conventional Wisdom

Challenge both infringement and validity of patent.

Situation

Infringement argument was weak and invalidity case was much stronger. Plaintiff was demanding \$200M+. Defendant did not want to cloud the issues by arguing on infringement and wanted to build credibility with the judge.

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CASE STUDY 3: Attacking a Patent

New Approach

Defendant stipulated to infringement and instead focused on validity.

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CASE STUDY 3: Attacking a Patent

Outcome

Defendant won the jury trial with powerful invalidity arguments.

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CASE STUDY 4: Choosing Expert Witness

Conventional Wisdom

Choose witness with most impressive credentials and awards.

Situation

Potential expert had won a Nobel Prize and was eager to serve, but could not handle the pressure and fell apart emotionally during a prep session.

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CASE STUDY 4: Choosing Expert Witness

New Approach

Passed on the Nobel Prize winner in favor of a more seasoned expert without the awards.

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CASE STUDY 4: Choosing Expert Witness

Outcome

Averted potential disaster.

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CASE STUDY 5: Interactive Illustration

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APPLYING THIS PHILOSOPHY: Discussion

- ▶ How do you get buy-in from key stakeholders to deviate from conventional wisdom?
- ▶ Once you have buy-in, what happens if your unorthodox strategy fails? How do you recover?

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THANK YOU!

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