

# The Intellectual Property Litigation Checklist

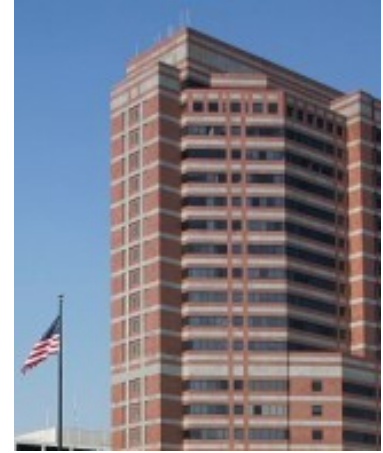
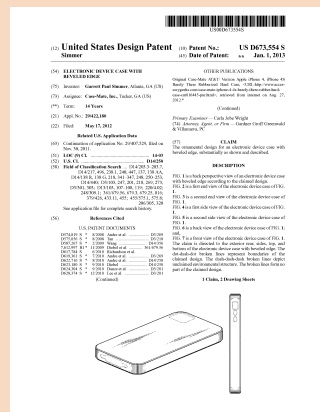
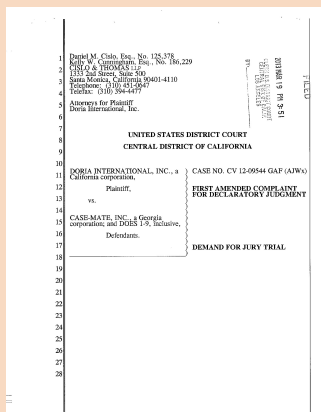
*Intellectual Property disputes are serious matters and require swift action*

whether your client encounters an allegation of infringement or wants to stop someone from infringing.

*Keep this checklist handy* for quick answers to important issues related to IP litigation.

## You have been sued or threatened with suit for infringing someone's IP?

- ☐ Address any charge of infringement promptly and obtain a written opinion of counsel of non-infringement and/or invalidity of the asserted intellectual property.
- ☐ Tender the complaint to each insurance carrier that might be obligated to cover defense costs or damages.
- ☐ Consider filing a declaratory judgment action here or in some other beneficial forum.
- ☐ Check the Federal Rules, the District Court's Local Rules, and the assigned Judge's procedural requirements for the deadlines to file motions to challenge jurisdiction, venue, service, legal sufficiency of the claims, etc.
- ☐ Either image your electronically stored data to maintain evidence or suspend your normal document destruction policies and instruct employees not to delete any electronically stored information, including emails, metadata, and file browsing histories.
- ☐ Do not put anything in writing that you would not want a judge or jury to read. Instruct employees and contractors not to discuss the claims with anyone other than the attorneys since essentially all confidential, internal communications, emails, information, and social media are discoverable.
- ☐ Consider which people within or outside the company who have any helpful documents or information about the case and gather and organize any such documents and information.



Los Angeles Federal Court

## Federal Litigation Timeline

- ☐ IP litigation ordinarily occurs in Federal Courts because most IP rights arise from the U.S. Constitution and Federal statutes.
- ☐ In Federal Court, the plaintiff has **90 days** from the filing date of the complaint to serve the complaint on the defendant, although proper service is determined state-by-state.
- ☐ The defendant must answer or otherwise respond to the complaint within **21 days** of service, although the plaintiff and defendant may stipulate to an additional **30 days** for this answer or other response. Any further extension will require Court approval.
- ☐ Shortly thereafter, the Court will set a date for a scheduling conference in the coming weeks. The parties' counsel must meet to prepare a joint discovery proposal within **21 days** of this order to and serve initial disclosures **14 days** after that.
- ☐ For further deadlines, including any required patent-specific disclosures, refer to the **Federal Rules of Civil Procedure**, the **District Court's Local Rules**, and often, the **Judge's Procedures and Requirements**, at [www.cacd.uscourts.gov](http://www.cacd.uscourts.gov).

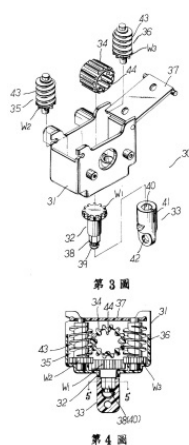
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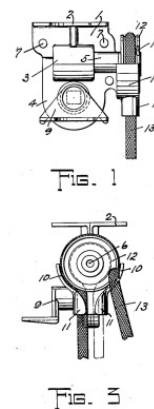
## You need to stop or sue someone for infringing your IP?

- Obtain physical samples of each potentially offending product, materials, etc.
- Consult with qualified IP counsel about any possible statutes of limitations and other preclusion, jurisdiction, or standing issues.
- Have qualified IP counsel conduct a thorough pre-suit investigation to confirm that the offending of infringement/validity.
- Upon confirming IP infringement, consider whether you should:
  - file a complaint in your preferred forum before sending the defendant a cease and desist letter
  - drafting a complaint that avoids triggering the defendant's insurance coverage of its attorney's fees (which can create an imbalance).
  - drafting a complaint that might trigger the defendant's insurance duty to pay any your damages but that seeks only the defendant's profits to help shield your own financials from discovery.
  - file for a temporary restraining order or a preliminary injunction.
- Suspend any document destruction policies, including on each server and each computer that may contain work information.
- Consider whether to issue a press release about the lawsuit once the lawsuit is filed.

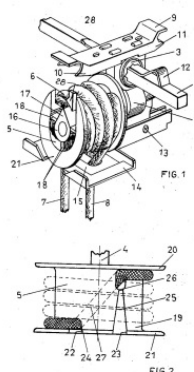
('007 Patent)



('809 Patent)



('270 Patent)



(continued)

- Consider the best forum to file lawsuit:
  - Any jurisdictional limits due to the infringer or the acts alleged. Otherwise, your home forum is typically most convenient.
  - Other particular advantages may include:
    - Which are speedy courts (e.g., E.D. of Virginia, C.D. of California)
    - Which are patent-owner friendly courts (e.g., E.D. of Texas, E.D. of Virginia)
    - Which courts are experienced in patent cases (e.g., C.D. or N.D. of California, E.D. of Texas, D. of Delaware, N.D. of Illinois)
    - Which courts are experienced in copyright cases (e.g., C.D. of California, S.D. of New York)
- Once you file a complaint in Federal Court, you must formally serve the complaint on the defendant within 90 days, although the Court may insist upon earlier service or order activity before you effect service.



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