



FOLEY & LARDNER LLP

# World Research Group (WRG) IP Management Series Conference

## “The Summit on Intellectual Property for Wireless Technology”

June 20-21, 2007



# When Third Parties Want a Piece of the Wireless Technology Business: Assessing and Responding to Patent Claims

## ■ Speakers:

- Steven C. Becker, Partner, Foley & Lardner LLP
- William E. Growney, Jr., Vice President Business Affairs and General Counsel, imeem, Inc.

# Introduction and Format

- Presentation
- Open Floor Questions

# Presentation Overview

- Being prepared
- Process
- Managing expectations
- The Written Opinion
- Responding

# Being Prepared

- Budget for the defense (non-litigation)
- Counterclaim database
- Mine your portfolio with competitors in mind
- Indemnification from suppliers
- Brainstorm for new invention disclosures in the space of key competitors
- Retain old product development files

# Process

- Initial assessment and report to management
- Assemble the right team
- Set weekly or biweekly meetings
- Assess the claim

# Process

- Assess other common business interests
- Identify resolution strategies
- Get senior management approval of resolution strategy
- Implement

# Managing Expectations

- Even if you have a strong case, you may get sued
- Patents are presumed valid
- What a court may award in damages is difficult to predict with any certainty
- Patent litigation is costly and disruptive



# Managing Expectations

- You may need to change your product to improve your position
- You may need to pay significant dollars for a license
- An opinion of counsel means your counsel believes you are more likely than not to succeed

# The Written Opinion

- If you receive an offer to license, you should seek the advice of counsel
- Goal is to build a discoverable record of having acted reasonable under the circumstances
- Generally, the closer the case, the more stringent the requirements should be of the opinion
- Opinion may be updated

# The Written Opinion

- Minimum requirements for any opinion
  - Address each and every claim of the patent
  - Study the entire prosecution history
  - Fully understand the product – have technical contact review your product description
  - Apply the appropriate legal standards
- Inside counsel v. outside counsel

# Responding – Bill Growney