

# Mock Patent Infringement Trial Instruction

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## I. INTRODUCTION

First of all, thank you for setting aside your precious time to participate in this mock trial. The purpose of this exercise is to better understand how a U.S. patent trial works by actually doing one yourself! You will be given a fact scenario including a real patent and real accused product of infringement. After studying the relevant facts and law, you are asked to play a role as part of the plaintiff or defense team. You are further asked to play two critical acts in a patent trial: 1) opening statement; and 2) examine the expert witnesses. It's a great opportunity to practice your lawyering skills in a complex patent lawsuit. Hopefully you will find this experience fun and helpful.

## II. PARTIES

This mock trial is based on a real patent case. Most, if not all of the facts, however, are revised to avoid revelation of any confidential information and also to make it more interesting. Feel free to research the accused product online if you want. But I would caution you not to waste your time in studying the real case because it would not be helpful and might actually mislead your preparation for this exercise.

The plaintiff in this case is a passionate entrepreneur named Mr. iInventor, who owns U.S. Patent No. 6,839,149 ("the '149 patent," attached hereto as Exhibit A. please ignore the assignee listed on the patent). Mr. iInventor owns a small online print company, but he never received adequate funding to get it off the ground. He does, however, own few other unrelated businesses that are profitable.

Defendant is a company called iPrint, Inc. iPrint owns a website called [www.vistaprint.com](http://www.vistaprint.com), which Mr. iInventor claims infringes the '149 patent (see the infringement claim chart attached hereto as Exhibit B). The Vistaprint.com site is a leading online printing business.

## III. FACTS AND RELEVANT LAW

Mr. iInventor always has a passion in the printing business, in fact, many of his ancestors worked in the printing industry since the early days. Mr. iInventor studied economics in Harvard in 2001, but he soon became more interested in computer science. After several programming classes, he came up with the idea of creating a web-based solution for electronic printing, which later became the subject of the '149 patent. Mr. iInventor was very excited about his idea and decided to quit Harvard in the end of 2004. He borrowed \$10,000 dollars from his family and friends and started building a business based on the idea disclosed in the '149 patent. Unfortunately, the money quickly ran out before Mr. iInventor attracted enough customers to make a profit. With income from other profitable business, he was able to keep the site running and have a small group of dedicated customers. Most of them are advertisement mailers who get their design proofed through Mr. iInventor's site. The website has not made any profit in the past seven years.

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iPrint, Inc. was founded by Mr. Vista, a businessman with a passion in the printing industry as well. With funding from a bank owned by a family friend, he launched the vistaprint.com website in 2003 to offer online print orders of business cards. Initially, the site did not accept any uploaded customer designs, the customer has to pick one of the design templates offered by iPrint and customize it by adding information such as company name, title, and contact number etc. The business was not profitable in the first couple of years and was actually on the brink of bankruptcy in the end of 2004. However, Mr. Vista was able to turn the business around in 2005, and rapidly grew it into a No. 1 site for online printing.

Also in 2005, iPrint started accept customer uploads in file formats such as PDF, JPG, PS and others. iPrint has also gradually expanded its offerings to other products such as business flyers, greeting cards, folders, and many others. Mr. Vista contacted Mr. Inventor in 2005 and offered to buy his patent for \$50,000. Mr. Inventor rejected the offer and there was no further contact between the two.

It's known that the number of uploads to vistaprint.com have grown very rapidly in recent years, but only accounts for about 30% of iPrint's overall business, 25% of which include uploads in a PDF or Postscript file format. iPrint's revenue in 2010 is \$1 billion. But it does not break up revenues based on the type of file formats or whether customers upload their own design or not.

Through discovery, it is further known that when Vistaprint.com takes in a customer upload, it first converts the uploaded file into a PNG file. The PNG file is downloaded to a software module called Studio, where a customer can customize the design by cropping, resizing or move the pictures. Any changes the customer makes is written into a XML file, which is transmitted to the backend server. There is a software module called DOC\_MAKER will read the information from both the original design file (regardless file formats) and the XML file. It then creates a final high-resolution PDF and sends it to the printer for print.

Mr. Inventor claims that iPrint's vistaprint.com website infringes claim 1 of the '149 patent, specifically when it takes in customer uploads in a PDF or Postscript file format. He demands \$3 million in damages from defendant iPrint. iPrint contests that it does not infringe because it creates a new PDF in the end and does not "revise" the uploaded file as claim 1 of the '149 patent requires. To counter that, Mr. Inventor claims that vistaprint.com revises the original PDF file by reading out the contents, then "revise" the contents to create the new PDF file. Even if the Court found that vistaprint.com does not directly infringe, he claims that iPrint infringes under the doctrine of equivalents ("DOE"). To prove infringement under DOE, one has to prove that the infringing product is performing substantially the same function in substantially the same way, and achieves substantially the same results.

iPrint has retained Dr. Professor as its expert. Dr. Professor graduated from Stanford University with a Ph.D. degree in computer science. He specialized in image processing. Dr. Professor believe that vistaprint.com does not infringe the '149 patent and is ready to defend iPrint in court.

Mr. Inventor also retained an expert Mr. Expert. Mr. Expert also graduated from Stanford university, a few years earlier than Mr. Professor. He had a master's degree in computer science and

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worked on web-based image processing for years. Mr. iExpert is a recognized expert in the field. He is the chairman of several organizations focusing on image processing and related technologies.

#### IV. YOUR TASKS

A patent infringement trial usually lasts about one week or two. You are not asked to do a full-blown patent trial. Instead, I would like you to focus on two of the most critical tasks: 1) an opening statement; and 2) examining the expert witness.

There will be two teams. Ideally, the plaintiff team should include Mr. iExpert and at least two attorneys: one to do the opening statement, and the other to examine Mr. iExpert and cross-exam Dr. iProfessor. Feel free to enlist other people to help. For example, one might play a role as Mr. iInventor, but he will not testify in this mock trial.

Similarly, the defense team should include Dr. iProfessor and at least two attorneys: one to do the opening statement, and the other to examine Dr. iProfessor and cross-exam Mr. iExpert. Again, feel free to introduce other people such as Mr. Vista during the opening statement, but other witness except the expert is not permitted to testify during this mock trial.

For the Plaintiff team, please prepare an opening statement (time limit: 10 minutes or less) to lay out your infringement theory and tell your side of the story. You are also asked to conduct a direct examination of Mr. iExpert on the issue of infringement ONLY (time limit: 10-15 minutes). Remember, limit your examination to prove infringement ONLY.

For the Defense team, please prepare an opening statement to tell your side of the story (time limit: 10 minutes or less). You are also asked do a direct examination of Dr. iProfessor about non-infringement (time limit: 10-15 minutes). You also have the option to cross-exam Mr. iExpert on infringement (5 minutes).

Please focus on the facts and law in this instruction sheet, and don't waste too much time on the patent and accompanying documents. This document alone should be sufficient for you to do a good job in the mock trial.

#### V. MOCK TRIAL TIPS

For your convenience, I have attached the patent (Ex. A) and a sample infringement claim chart (Ex. B) to this document. Use the facts listed in the previous sections as your basis and try to develop a theme for your opening statement. For plaintiff, opening statement is not to lay out your evidence, it is to lay out your infringement theory, to demonstrate that you are a bona fide inventor and deserve a fair value for your invention, and to give a preview on what is going to happen in the coming trial days.

Similarly, Defendant also need layout the counter theme in their opening statement, why its products do not infringe the patent and what the defense will show later in the trial to prove that.

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The expert testimony is also important. For plaintiff, the expert need explain plaintiff's infringement theory and introduce evidence as proof. Therefore, the questioning attorney need go over each limitation of the claim, and ask the expert why he think defendant's product practice them. The attorney can introduce evidence and let the expert do the talking.

Similarly, defendant need explain its non-infringement theory through its expert as well. The expert could also pick holes in the opposing expert's evidence or opinions.

For direct examination, the basic rule is not to ask lead questions, i.e. questions where an answer is already given. For example, plaintiff's attorney cannot ask his expert this: defendant's product infringes claim 1 of the patent, can you explain why? Instead, you should ask, do you think defendant's product practices each limitation in claim 1? If the answer is yes, can you explain why?

During cross-examination, however, the questioning attorney is free to ask lead questions.

I've also attached two short articles on patent trial tips (Ex. C and Ex. D). You might find them helpful in your preparation for the mock trial.

**GOOD LUCK!!!**