Sills Cummis & Gross P.C.

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{Q&A with Sills Cummis' Scott Stimpson}

Scott D. Stimpson

Scott D. Stimpson is chairman of Sills Cummis & Gross PC's intellectual property practice group and is resident in the firm's New York office. He has practiced intellectual property litigation and counseling for about 25 years. He has significant trial (jury and nonjury), arbitration and mediation experience. He has successfully litigated many patent infringement cases, serving as lead litigation counsel in numerous cases. Apart from his experience representing American clients, Stimpson has also served as lead counsel for clients in Japan, China and Korea. He is a registered patent attorney.

Q: What is the most challenging case you have worked on and what made it challenging?

A: I have had the pleasure of working on many interesting and challenging cases in the course of my career. One of the most memorable was a patent infringement case on vaccines for pigs. The case had many challenges. For me, with most of my experience and education in the mechanical and electrical arts, the biotechnology of viruses was a totally new field, but learning it made me somewhat sorry that I did not focus my undergraduate work in a different direction.

Depositions of factual witnesses and experts were loaded with what I found to be a fascinating technology, and (despite being a case largely about pigs) the case had a very emotional overtone as it related to a terrible swine disease for which our inventor found the solution.

Our first trial witness, a veterinarian who experienced the devastation of the disease firsthand, had the jury in tears as he described in vivid detail the devastation of the disease — a prelude to the testimony of our second witness, the inventor, who walked to the stand with his hero status a foregone conclusion.

The case had innumerable other challenges for the entire team, some large, and some seemingly small (for example, I recall watching as our videographer, valiantly trying to capture swine farm footage for our jury, received a not-so-friendly nibble on his aft quarters). Despite the challenges, the trial was a rousing success, and it drove home for me the critical importance of making a patent case "real" for the jury — these cases come down to much more than trials about boring patent claims.

Q: What aspects of your practice area are in need of reform and why?

A: In my view, generally speaking, federal courts are too reluctant to consider early summary judgment in patent cases, and many will not consider such a motion until after claim construction is completed. This routine practice, in many cases, needlessly burdens the court with many months of discovery and an unnecessary formal claim construction proceeding on all terms in dispute. Quick, easy, "rifle shot" summary judgment motions should be considered early in patent cases where such motions are filed, and they should perhaps be filed more frequently. The Federal Circuit's comment 20 years ago that "[w]here no issue of material fact is present ... courts should not hesitate to avoid an unnecessary trial by proceeding under Fed. R. Civ. P. 56 without regard to the particular type of suit involved," has not been fulfilled, as hesitation is the routine and expected practice in many jurisdictions. *Chore-Time Equip. Inc. v. Cumberland Corp.,* 713 F.2d 774, 778-79 (Fed. Cir. 1983).

Patent cases are a unique breed of federal litigation that makes them frequent candidates for summary judgment. In many cases, it simply comes down to a question of what the claims mean — a question of law that should not preclude summary judgment. And many analyses under the doctrine of equivalents are equally amenable to summary judgment, as the U.S. Supreme Court and the Federal Circuit have together provided numerous tools for eliminating an equivalents argument as a matter of law. Does the claim specifically exclude the alleged equivalent (such as claiming "up" when the alleged equivalent is "down," or claiming "inside" when the alleged equivalent is "outside," or requiring a specific location for an element not met by the alleged equivalent)?

These claim requirements may well be appropriate for summary judgment as a claim cannot equivalently encompass its opposite, or structure that is specifically excluded by the language of the claims. And there are other options. Does the specification disclose the alleged equivalent, for example? If so, then it is disclosed but not claimed — another legal basis preventing a finding of equivalents. *Johnson & Johnston Assocs. v. R.E. Serv. Co.,* 285 F.3d 1046, 1054 (Fed. Cir. 2002). There is also prosecution history estoppel — the Festo presumption is another way for district courts to end patent cases. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,* 535 U.S. 722, 739-740 (U.S. 2002).

Q: What is an important issue or case relevant to your practice area and why?

A: Rule 11 and Section 285 are too infrequently used by the district courts to deter patent holders and their counsel from bringing frivolous patent cases. For the unscrupulous would-be plaintiff, or would-be plaintiff's lawyer, there is simply not enough deterrent in the current system.

While there is perhaps some understandable reluctance to make Rule 11 allegations against an adversary, litigants facing frivolous claims should not be so reluctant. Rule 11 exists for a reason. It serves an important purpose of deterring frivolous claims, and absent rigorous enforcement of Rule 11 it becomes a paper tiger.

In a recent patent case where I represented a defendant, the Federal Circuit unanimously reversed the denial of a Rule 11 motion, and I am hopeful that the court will continue in the future to rigorously enforce this rule where appropriate. Section 285 is another arrow in the quiver of litigants facing weak or baseless cases, but this rule allowing the award of fees in "exceptional cases" is also not employed enough my view. While Section 285 is generally compensatory in nature, it also serves a deterrence function and courts should not be reluctant to employ it.

Q: Outside your own firm, name an attorney in your field who has impressed you and explain why.

A: I have been fortunate to have worked with many truly outstanding patent lawyers over the course of my career, first at Pennie & Edmonds, then with Morgan Lewis & Bockius. It is difficult to single out one, but I will identify Frank Morris — a former partner at both Pennie and Morgan Lewis. I worked with Frank for many years, over various cases and matters. Whether discussing intricacies of patent practice or the most complex electronics, you need to try very hard to find a topic that Frank does not thoroughly understand. At Morgan Lewis, I was fortunate to have Frank's office next to mine, and the benefits of being able to simply walk next door and have almost any question answered immediately, or to discuss intricacies of complicated strategic decisions, was immeasurable.

Q: What is a mistake you made early in your career and what did you learn from it?

A: Missing a deadline sticks with you. Long ago (more than 20 years now), I recall that we had a filing due in the U.S. International Trade Commission. Back then, the option of faxing or emailing to local counsel for filing was not available, and so someone had to hand-deliver the document to the ITC before a certain hour on a certain day — a flight to Washington, D.C., was required. I tried to make it to the airport, document in hand, in time to catch the last shuttle flight to D.C. that would allow me to get to the ITC in time for the filing. Having arrived in New York City not many months earlier from my small hometown in Maine, however, my understanding of New York City traffic patterns was not as clear as it would later become, and I missed the flight. The deadline was missed.

I still remember the dejected ride back to the office, on my way to report the missed deadline to the senior partner. It was as much fun as one might imagine.

Lesson learned: Never leave anything to the last minute. To this day, the lesson stays with me. Associates working on my cases learn quickly that they will not keep me happy with documents ready for filing only on the due date.