

Intellectual Property
Enforcement

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Benefits Of Litigation

- Preliminary Relief
- Damages
 - Disgorgement of infringer's profits
 - Lost profits
 - Conveyed sales
 - Price erosion
 - Reasonable royalty
 - Statutory damages
 - Treble damages

Types Of IP Available And What They Protect

- Patent: **prevent others** from making, using or selling invention.
- Trademark (or service mark): “symbol” capable of **identifying source** of products (or services)
- Trade secret: **information deriving value from secrecy**, take measures to keep secret
- Copyright: to creator of written, musical or artistic work. **Right to use and prevent others** from copying without permission.

The Infusion Pump



The Accused Device



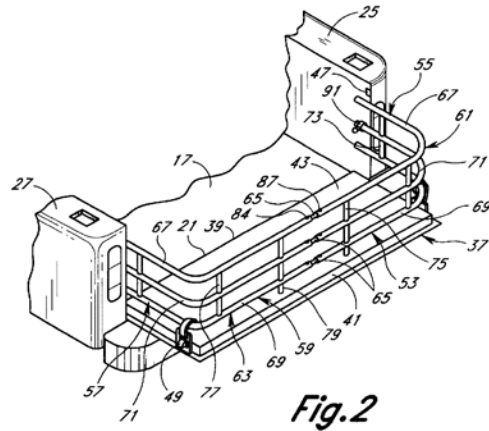
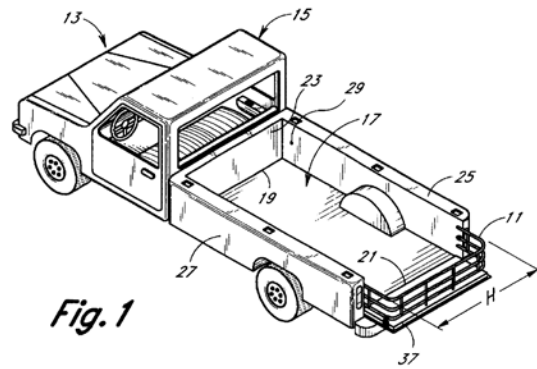
The Patented Product

Utility Patent Claim

- 1. A compact portable apparatus for dispensing a liquid under pressure at a substantially constant flow rate over a period of time comprising:
an elongated generally cylindrical support member;
elongated elastic sleeve means mounted and sealingly secured at fixed spaced longitudinal positions on said support member for defining a substantially zero non-pressurized volume pressure reservoir for holding a liquid in a pressurized state for dispensing therefrom;
housing means comprising collapsible non-stretchable housing means for containing said support member and said pressure reservoir for enabling said pressure reservoir to expand naturally and for confining said reservoir to fill concentrically about said support member;
inlet means for introducing a liquid into said elastic pressure reservoir; and
outlet means for dispensing liquid from said pressure reservoir to a selected site.**

The Bed Extender

U.S. Patent Dec. 23, 1997 Sheet 1 of 4 5,700,047



Competitor's Product



Utility Patent Claim

20. A truck bed extender for use with a vehicle having an open storage bed having a rear end, a first upstanding side panel to one side of said bed, a second upstanding side panel to an opposite side of said bed and a tailgate, a first mounting station fixed with respect to said first upstanding panel defining a first station surface, a second mounting station fixed with respect to said second upstanding panel defining a second station surface, said apparatus comprising:

a first side wall;

a second side wall;

a connecting wall extending between said first side wall and said second side wall, said first side wall, said second side wall and said connecting wall cooperating to form a generally U-shaped frame;

a first mount secured to said first side wall comprising a first interlocking member defining a first pivot surface; and

a second mount secured to said second side wall comprising a second interlocking member defining a second pivot surface, said first station surface and said first pivot surface, and said second station surface and said second pivot surface cooperating to secure said apparatus to said vehicle so that said apparatus is rotatable about an axis between a first position wherein said connecting wall is in an upright position over said tailgate rearward of said rear end of said bed and a second position wherein said connecting wall is in an upright position spaced forward from said rear end of said bed, and wherein one of said first station surface and said first pivot surface defines a first opening through which the other of said first station surface and said first pivot surface can be manually withdrawn to disengage said extender from said first panel and one of said second station surface and said second pivot surface defines a second opening through which the other of said second station surface and said second pivot surface can be manually withdrawn to disengage said extender from said second panel, wherein said tailgate defines a latch to secure said tailgate to one of said first upstanding side and said second upstanding side, said truck bed extender further comprising at least one buckle secured to one of said walls, sized and shaped to be releasably captured by said latch of said tailgate.

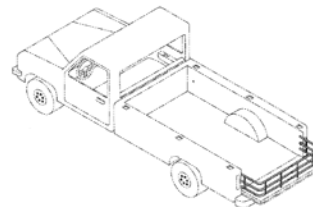
Design Patent



US000417859S

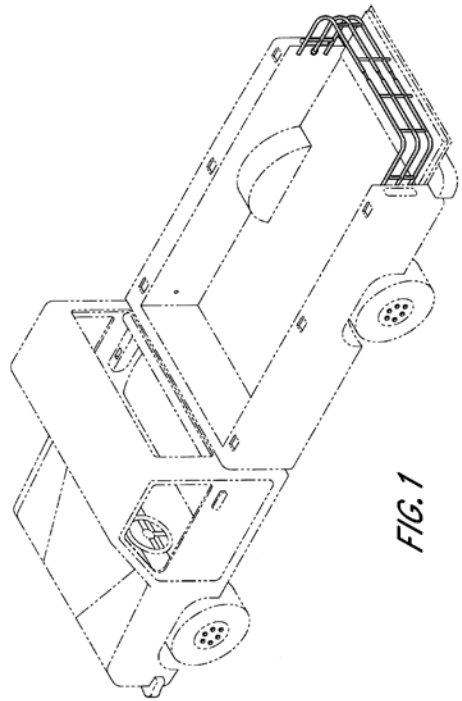
United States Patent [19] [11] **Patent Number: Des. 417,859**
Leitner et al. [45] **Date of Patent: Dec. 21, 1999**

[54] **VEHICLE CARGO BED EXTENDER**
 [75] Inventors: **Horst Leitner**, Laguna Beach;
Jonathan E. Weibel, Norco, both of
 Calif.
 [73] Assignee: **American Moto Products, Inc.**,
 Laguna Hills, Calif.
 [**] Term: **14 Years**
 [21] Appl. No.: **29/083,494**
 [22] Filed: **Feb. 12, 1998**
Related U.S. Application Data
 [63] Continuation of application No. 08/024,230, Sep. 5, 1997,
 which is a continuation of application No. 08/651,921, May
 21, 1996, Pat. No. 5,700,047.
 [51] **LOC (6) Cl.** **12-16**
 [52] **U.S. Cl.** **D12/414**
 [58] **Field of Search** D12/400, 401,
 D12/406, 412, 414, 98, 296/26-27, 37.6,
 50, 56, 57.1; 224/402-404, 492, 496, 314,
 493, 505-506, 572
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U.S. PATENT DOCUMENTS
 D. 160,213 9/1950 Samuelson D12/406
 D. 291,789 9/1987 Nega D12/414 X
 D. 303,334 4/1989 Knüflich D12/414
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FOREIGN PATENT DOCUMENTS
 0629098 9/1978 U.S.S.R.
Primary Examiner—Doris V. Coles
Assistant Examiner—Stacia Simik
Attorney, Agent, or Firm—Knobbe, Martens, Olson & Bear,
 LLP
CLAIM
 [57] **CLAIM**
 The ornamental design for a vehicle cargo bed extender, as
 shown and described.
DESCRIPTION
 FIG. 1 is a perspective view of vehicle cargo bed extender
 illustrating our new design. The vehicle is shown in phantom
 for illustration purposes only and forms no part of the
 claimed design.
 FIG. 2 is an enlarged top plan view of the extender of FIG.
 1.
 FIG. 3 is an enlarged front elevational view of the extender
 of FIG. 1.
 FIG. 4 is an enlarged right elevational view of the extender
 of FIG. 1. The left elevational view is a mirror image of the
 right elevational view.
 FIG. 5 is an enlarged rear elevational view of the extender
 of FIG. 1, and,
 FIG. 6 is an enlarged bottom plan view of the extender of
 FIG. 1.
 The broken line showing of environment in FIGS. 2-6 is for
 illustrative purposes only and forms no part of the claimed
 design.
1 Claim, 3 Drawing Sheets



Design Patent Claim

U.S. Patent Dec. 21, 1999 Sheet 1 of 3 Des. 417,859



Ordinary Observer Test

“If in the eye of an ordinary observer, given such attention as a purchaser usually gives, two designs are substantially the same . . . the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other.”

Utility Patent Infringement



20. A truck bed extender for use with a vehicle having an open storage bed having a rear end, a first upstanding side panel to one side of said bed, a second upstanding side panel to an opposite side of said bed and a tailgate, a first mounting station fixed with respect to said first upstanding panel defining a first station surface, a second mounting station fixed with respect to said second upstanding panel defining a second station surface, said apparatus comprising:

a first side wall;

a second side wall;

a connecting wall extending between said first side wall and said second side wall, said first side wall, said second side wall and said connecting wall cooperating to form a generally U-shaped frame;

a first mount secured to said first side wall comprising a first interlocking member defining a first pivot surface; and

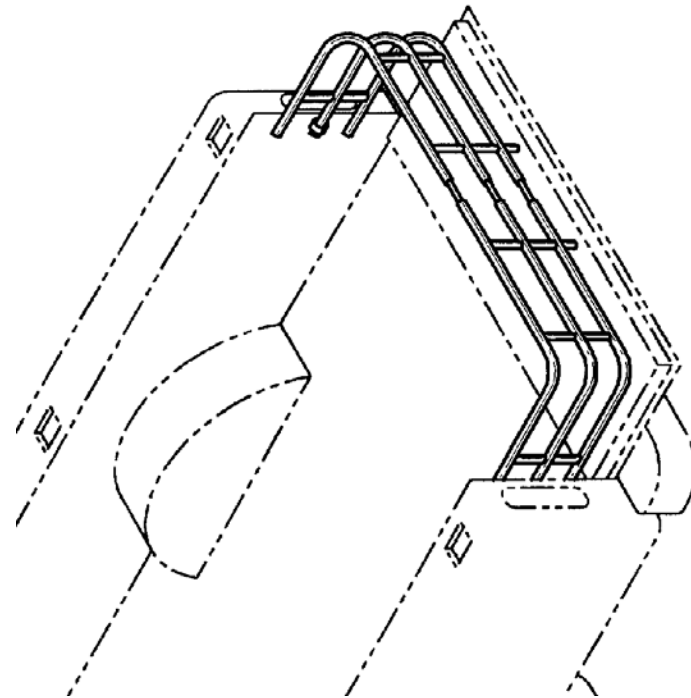
a second mount secured to said second side wall comprising a second interlocking member defining a second pivot surface, said first station surface and said first pivot surface, and said second station surface and said second pivot surface cooperating to secure said apparatus to said vehicle so that said apparatus is rotatable about an axis between a first position wherein said connecting wall is in an upright position over said tailgate rearward of said rear end of said bed and a second position wherein said connecting wall is in an upright position spaced forward from said rear end of said bed, and wherein one of said first station surface and said first pivot surface defines a first opening through which the other of said first station surface and said first pivot surface can be manually withdrawn to disengage said extender from said first panel and one of said second station surface and said second pivot surface defines a second opening through which the other of said second station surface and said second pivot surface can be manually withdrawn to disengage said extender from said second panel, wherein said tailgate defines a latch to secure said tailgate to one of said first upstanding side and said second upstanding side, said truck bed extender further comprising at least one buckle secured to one of said walls, sized and shaped to be releasably captured by said latch of said tailgate.

Design Patent Infringement

19

Sheet 1 of 3

Des. 417,859



Comparison

Utility Patent

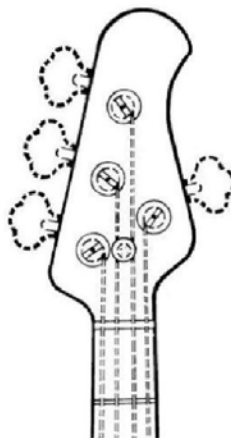
- Expensive to get
- Claim Construction
- Complicated Local Patent Rules
- Summary Judgment
- Difficult to Prove Damages

Design Patent

- Cheap to get
- Often No Claim Construction
- Usually No Local Patent Rules
- Summary Judgment More Difficult
- Disgorgement of Profits—even if you're an NPE
- Easier to design around

Registered Trademarks Are Forever

United States of America United States Patent and Trademark Office



Reg. No. 3,816,108

Registered July 13, 2010

Int. Cl.: 15

ERNIE BALL, INC. (CALIFORNIA CORPORATION)
151 SUBURBAN ROAD
SAN LUIS OBISPO, CA 93401

FOR: MUSICAL INSTRUMENTS, NAMELY, GUITARS, IN CLASS 15 (U.S. CLS. 2, 21 AND 36).

Damages for Trademark or Trade Dress Infringement/Counterfeiting

15 U.S.C. § 1117(a)

- (1) defendant's profits,
- (2) any damages sustained by the plaintiff, and
- (3) the costs of the action In assessing damages the court may enter judgment ... for any sum above the amount found as actual damages, not exceeding ***three times such amount*** The court in exceptional cases may award ***reasonable attorney fees*** to the prevailing party.

Treble Damages for Counterfeiting

15 U.S.C. § 1117(b)

... in a case involving use of a counterfeit mark or designation ... the court shall ... enter judgment for ***three times such profits or damages***, whichever amount is greater, together with ***a reasonable attorney's fee***

Statutory Damages for Counterfeiting

15 U.S.C. § 1117(c)

In a case involving the use of a counterfeit mark ... the plaintiff may elect ... instead of actual damages and profits, an award of statutory damages ... in the amount of—

- (1) not less than \$1,000 or more than \$200,000 per counterfeit mark; or
- (2) if the court finds that the use of the counterfeit mark was willful, not more than \$2,000,000 per counterfeit mark

Damages for Patent Infringement

- **Lost profits**
- **Disgorgement of profits (only design patents)**
- **Reasonable royalty**
- **Treble Damages**

Damages for Patent Infringement

35 U.S.C. § 284

damages adequate to compensate for the infringement, but in no event less than a ***reasonable royalty*** for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

... the court ***may increase the damages up to three times*** the amount found or assessed

Additional Remedy Available for Design Patent Infringement

35 U.S.C. § 289

... shall be liable to the owner to the extent of his ***total profit***, but not less than \$250

Disgorgement of total profits under Section 289 cannot be trebled

Attorneys' Fees For Patent Infringement

35 U.S.C. § 285

The court in exceptional cases may award reasonable attorney fees to the prevailing party.

Copyright Infringement

17 U.S.C. § 504(a)

...an infringer of copyright is liable for either—
(1) the copyright owner's actual damages and any additional profits of the infringer... ; or
(2) statutory damages

Statutory Damages For Copyright Infringement

17 U.S.C. § 504(c)

(1) the copyright owner may elect ... an award of statutory damages for all infringements involved in the action, with respect to any one work... in a sum of ***not less than \$750 or more than \$30,000*** as the court considers just.

(2) In a case where ... the court finds, that infringement was committed ***willfully***, the court in its discretion may increase the award of statutory damages to a sum of ***not more than \$150,000***. In a case where ... the court finds, that such infringer was not aware and had no reason to believe that his or her acts constituted an infringement of copyright, the court in its discretion may reduce the award of statutory damages to a sum of not less than \$200.

Attorneys' Fees For Copyright Infringement

17 U.S.C. § 505

The court in its discretion may allow the recovery of full costs by or against any party other than the United States or an officer thereof ... the court may also award a reasonable attorney's fee to the prevailing party as part of the costs.

Damages For Trade Secret Misappropriation

California Civil Code § 3426.3:

(a) A complainant may recover damages for the **actual loss** caused by misappropriation. A complainant also may recover for the **unjust enrichment** caused by misappropriation that is not taken into account in computing damages for actual loss.

(b) If neither damages nor unjust enrichment caused by misappropriation are provable, the court may order payment of **a reasonable royalty** for no longer than the period of time the use could have been prohibited.

(c) If willful and malicious misappropriation exists, the court may award exemplary damages in an amount not exceeding **twice any award** made under subdivision (a) or (b).

Oloclip



Oloclip Product



Defendant's Product

Causes of Action

- Trademark Infringement
- Counterfeiting
- Utility and Design Patent Infringement
- Copyright Infringement
- Trade Dress Infringement
- Trade Name Infringement
- Unfair Competition

Consent Judgment and Permanent Injunction

- Trademarks, patents, copyrights, trade dress, and trade name are all valid and enforceable
- Defendant infringes each of the trademarks, patents, copyrights, trade dress, and trade name
- Damages

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949-760-0404



Orange County



Los Angeles



New York



San Diego



San Francisco



Seattle



Washington DC