

# Developing A Discovery Plan For A Patentee Plaintiff

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## (A) Review Jury Instructions and Prepare a Proof Rubric

Determine what you need to prove and what the defendant needs to prove. Prepare a list of documents and testimony needed to support your case and refute the defendant's case. From this list, you now know what type of evidence to gather.

## (B) Propound a First Set of Written Discovery Requests

Ask questions to identify witnesses and to find out what documents exist. Propound requests for admission to exclude factual issues for trial. Propound a global request for documents early, as you undoubtedly will encounter resistance needing efforts to pry documents from the defendants.

## (C) Depose the Defendant Under 30(B)(6) (If a Corporation)

Generally this is done first to identify key documents, corporate structure, and witnesses.

## (D) Propound More Written Discovery Requests

Now that you have some documents, identified witnesses, and information from the first set of written discovery and deposing the defendant, follow up with more requests and discovery from third parties.

## (E) Depose Third-Parties

After propounding discovery upon third parties, get them in a deposition. Authenticate documents, secure admissions needed; gauge how the witnesses will perform at trial. Depose key witnesses after less important witnesses, so that the key witnesses will be locked-in to the version of the truth provided by the secondary witnesses.

## (F) Depose Defendant

Identify who is the real party-in-interest. Depose that person on specific issues, such as validity, infringement, willful infringement, and other infringement defenses.

(G) Prepare Follow-Up Requests For Admission

Get necessary admissions nailed down. Get the defendant to admit that at least some of the claim elements are found in the accused device or service. Get admissions on the notice date of infringement, contentions regarding prior inventorship, first sale of accused device, and other issues.

(H) Depose Expert Witnesses

Investigate the expert's other testimony. Read everything that you can find authored by the expert or about the expert. Craft questions for which the only reasonable answer will be answers that help the plaintiff. In essence, prepare to use the defendant's expert to make admissions that help your case.

(I) Propound Final Written Discovery Requests

Review your proof rubric (which you should have been doing all along). What are you missing? Ask for it.

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