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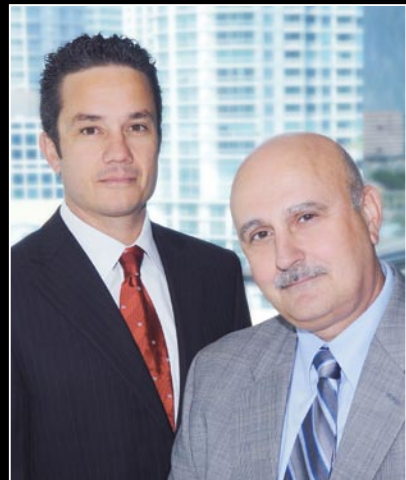
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WINNING

Profiles of successful attorneys
and their strategies.



A toy-like exhibit was the key to victory

Defense team turned the tables to defeat a potentially crippling infringement claim.

BY KAREN SLOAN

They looked like something one would find on the shelves of a toy store. The large plastic blocks featured horizontal layers that formed a rainbow: red, orange, yellow, green, blue and purple.

The colorful blocks weren't playthings. They were a key to attorney David J.F. Gross' successful defense of hard disc drive manufacturer Seagate Technology LLC against a patent infringement suit lodged by European engineering giant Siemens A.G.

The layered blocks represented the complex sensor technology at the heart of the patent dispute. They were intended to help the jury grasp the defense case without having to delve into the dense science.

"We had to figure out a way to teach the jury about that technology, which was going to be tricky because it was almost impenetrable," Gross said. "The blocks made it a lot easier for the jury to understand."

The technology behind the sensors—and the question of who patented it first—was the crux of the six-week jury trial that began in a federal courtroom in Santa Ana, Calif., on Nov. 14, 2008.

Two years earlier, Siemens filed a lawsuit in the Central District of California against Seagate, claiming that the giant magnetoresistive (GMR) sensors in the disc drives Seagate had sold since 2000 infringed upon a patent held by Siemens. Siemens—which was represented by a team of attorneys from Fulbright & Jaworski—initially sought damages of more than \$1 billion. *Siemens A.G. v. Seagate Technology LLC*, No. 06cv00788 (C.D. Calif.).

Gross, the head of the intellectual prop-

DAVID J.F. GROSS | FAEGRE & BENSON LLP



DAVID J.F. GROSS: "This was the only trial I've ever had where the most important witness appeared by video."

erty litigation practice at Minneapolis-based Faegre & Benson, knew he had several challenges on his hands: He needed to educate the jury about GMR sensor technology and explain the basics of patent law.

'IBM WAS FIRST'

U.S. District Judge James V. Selna opened the trial by instructing the jury that Seagate's hard disc drives indeed infringed the Siemens patent. Gross' case hinged on proving that Siemens' patent itself infringed on GMR technology first invented and patented by

International Business Machines Corp. Seagate obtained a license from IBM for the sensors during the 1990s.

"Our only defense was that the patent was invalid. We had to educate the jury on how a patent case works," Gross said. "I wrote on a board 'IBM was first.' We proved it at trial and the jury agreed."

Gross began with a PowerPoint presentation explaining that a patent is invalid if someone else invented the item first. Once he established that, Gross needed to convince the jury not only that IBM had invented the GMR sensors first but that

the IBM sensor technology was actually superior to the Siemens version. That's where the rainbow blocks came in.

Each colored layer of the blocks represented a layer in the tiny sensors. The block layers could be pulled apart and combined in different ways, which helped Gross argue that IBM invented the technology and did a better job. For example, the IBM block model included a purple layer, while the more simplistic model representing the Siemens patent lacked that purple layer. About 90% of the technical aspects of the case were addressed using the blocks, Gross said.

Gross began to feel increasingly confident with his case when the plaintiffs' experts agreed on cross-examination that the blocks were a fair and accurate representation of the sensor technology.

Gross' most important witness was Stuart Parkin, the IBM experimental physicist whom the defense argued invented the GMR sensor. However, Parkin's testimony was delivered by video deposition—something Gross knew juries tend to hate because they are boring.

"This is the only trial I've ever had where the most important witness appeared by video," Gross said. "We tried to make it as interesting as possible."

To that end, the attorneys had Parkin explain his sensor invention in an informal manner. Parkin got up and moved around during the deposition, and even cracked a few jokes. The informal and lively delivery helped to hold the jurors' attention, Gross said.

The plaintiffs had their own star expert witness in Nobel Prize-winning physicist

TRIAL TIPS

Come up with a theme anyone can understand, such as "IBM was first."

Develop a simple way to explain technology.

Treat a video deposition as if it were direct testimony.

Sheldon Glashow. Gross said that, under cross-examination, he was able to show that the GMR sensor technology was outside Glashow's area of expertise.

Just before closing arguments, Selna limited the potential damages to \$160 million, on the ground that Siemens could recoup damages only against Seagate hard disc drives sold after 2004. Siemens had failed to mark its product with the patent number before that date and therefore was limited to damages on disc drives sold after the notice of patent infringement was made, Selna ruled.

The jury deliberated for three days before returning a verdict that the Siemens patent was invalid and awarded no damages to the plaintiff. Siemens has filed an appeal in the U.S. Court of Appeals for the

Federal Circuit. Gross expects a ruling in about a year.

John O'Malley, the lead counsel representing Siemens, did not respond to calls for comment on the district court trial.

Gross, who began his legal career as a litigator with the U.S. Department of Justice, has tried many complex intellectual property cases. He represented drug maker Wyeth in a successful trade secret theft lawsuit against Natural Biologics Inc. in 2003 that involved the blockbuster hormone replacement drug Premarin. Gross was the lead counsel for 3M Co. in a series of successful patent infringement cases against competitors. He won a \$2 million judgment for FLOE International Inc. in a patent infringement suit involving snowmobile trailer technology in 2006.

Gross said that the key to his success in the Seagate case was keeping the technical explanations to a minimum and returning often to the theme that IBM had invented the GMR sensor first.

"We told the jury, 'We went to the true owner [of the sensor patent] and we got a license. We did the right thing,'" Gross said. "It was very important for the jury to understand that Seagate Technology did the right thing."

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