



Monday, October 20
11:00 am-12:30 pm

106 IP Competitive Intelligence

Steve Gardner

Partner

Kilpatrick Stockton LLP

Eric Ho

Patent Counsel

Qualcomm Incorporated

Susanna McDonald

Attorney

Mark Medice

National Brand Manager - IP Intelligence

West, a Thomson Reuters Business

Faculty Biographies

Steve Gardner

Steve Gardner is a partner with Kilpatrick Stockton LLP in Winston-Salem, NC. He is the co-chair of the firm's patent litigation group, and he maintains an active practice in patent litigation, due diligence, counseling, and prosecution strategy and management. He has represented companies in patent suits in federal courts in Colorado, Delaware, the District of Columbia, Florida, Georgia, Illinois, Louisiana, Missouri, North Carolina, Ohio, Oklahoma, and Texas, including multiple cases in the Eastern District of Texas.

Before joining Kilpatrick Stockton, Mr. Gardner clerked for the Hon. Frank W. Bullock, Jr., Chief Judge, US District Court for the Middle District of North Carolina, and the Hon. Alvin A. Schall, US Court of Appeals for the Federal Circuit.

Mr. Gardner currently serves as editor-in-chief of the ABA's Intellectual Property Litigation newsletter. He is also on the board of directors for the Children's Museum of Winston-Salem.

Mr. Gardner received a BS and MS from the University of North Carolina at Charlotte. He received a JD, with honors, from the Wake Forest University School of Law, where he was editor-in-chief of the law review.

Eric Ho

Eric Ho is currently a patent counsel at Qualcomm, Inc., a Fortune 500 wireless telecommunications research and development company based in San Diego, California, where his duties include developing and managing a patent portfolio, client counseling on patent, trademark and copyright matters, and support of litigation teams by providing claim interpretation and portfolio analysis.

Mr. Ho began his career at Blakely, Sokoloff, Taylor and Zafman, a leading intellectual property boutique firm, where he prepared patent applications for Intel, Apple, and Sun Microsystems. Mr. Ho has prepared and prosecuted patent applications, strategically planned and managed IP portfolios, performed IP due diligence to support transactions, and prepared patentability, infringement, clearance, and validity opinions. Mr. Ho has also structured, drafted, and negotiated numerous licensing, development, chip design and manufacturing, sales, distribution, service, joint venture, settlement, and employment agreements. During private practice, Mr. Ho represented a variety of companies, mostly in Silicon Valley, before the US Patent and Trademark Office—from Fortune 100 to start-ups—in a wide range of technologies in the areas of electronics, semiconductor devices, memory chips, power circuits, digital and analog circuits, computers, servers, computer hardware, software, processor architecture, digital imaging, integrated circuit manufacture, and digital signal processing.

Mr. Ho earned his bachelor's degree from the University of California, Berkeley and his JD from University of Southern California (USC) School of Law.

Susanna McDonald

Susanna McDonald is the former general counsel and director of information for Claimant Management Systems, LLC, a software development company. In her capacity as director of information, she ensured the integrity of their clients' data and the accuracy of information output.

Entering the law was a second career for Ms. McDonald. She has worked in software development for several years for a variety of industries, including legal, banking and insurance, and in a variety of roles from junior database developer to project manager. She still manages to do some development at her current company.

She has a BA from University of Texas in Arlington and a JD from Widener University School of Law, cum laude.

Mark Medice

Mark Medice is a national brand manager with West's Business of Law. In his role, Mr. Medice leads efforts with Peer and IP Monitor, assisting law firms with IP intelligence and strategy.

Mr. Medice is a licensed intellectual property attorney, having worked at IBM, Procter & Gamble, and as an associate at Morgan Lewis.

Mr. Medice holds an MBA from the University of Pittsburgh and a JD from Northern Kentucky University.



Scenarios, Advice and Tools

- Intellectual Property Holdings of Competitors and Others
- Avoiding Infringement of Third-Party Intellectual Property
- Identifying Infringement of My Client's Intellectual Property
- Early Warnings – Litigation Involving Competitors



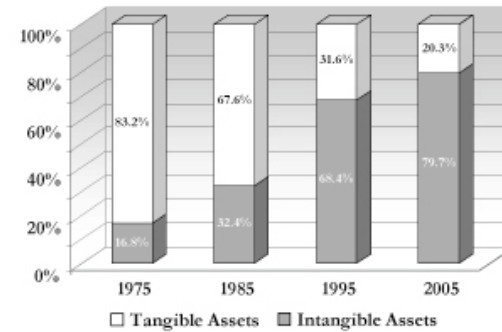
Intellectual Property Holdings of Competitors and Others – Scenarios

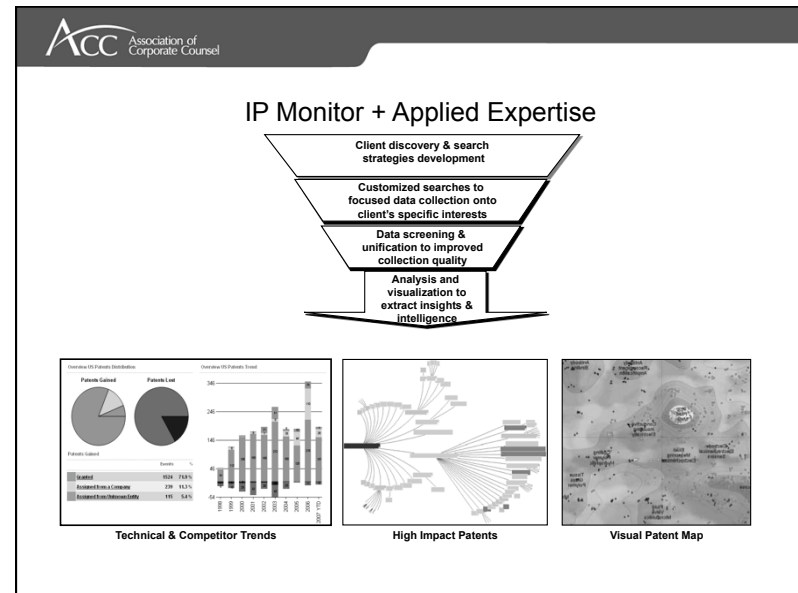
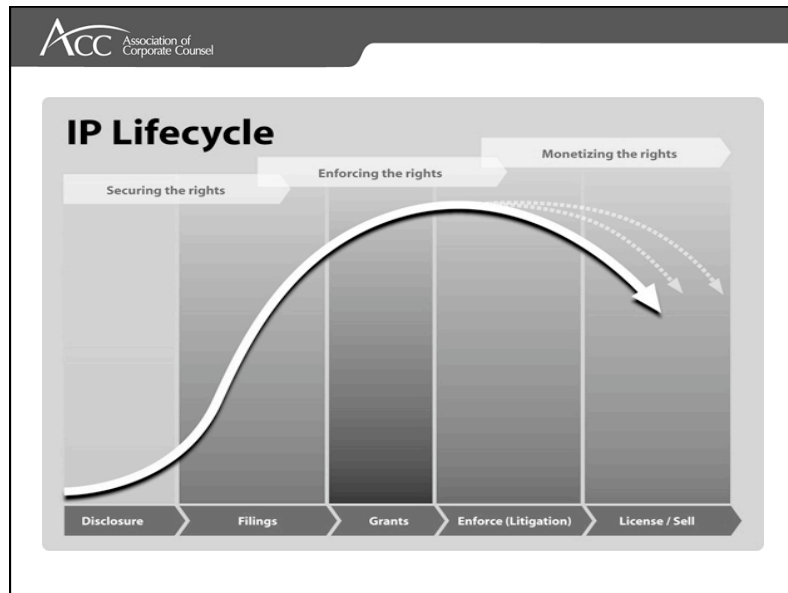
- Determine if infringing third party's patents
- Comparison to motivate company to increase efforts in protecting IP
- Reveal where competitors are spending R&D dollars
- Understand areas in which client may want to patent

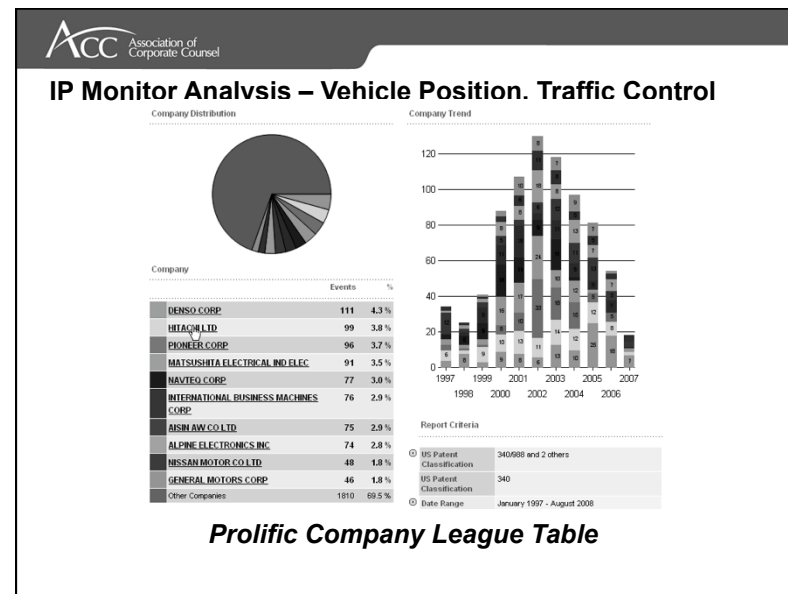
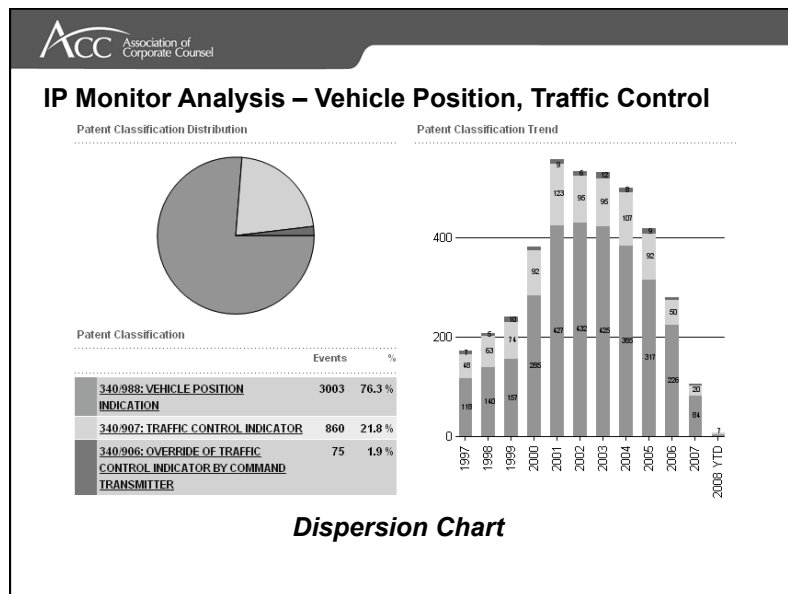
Intellectual Property Holdings of Competitors and Others – Advice

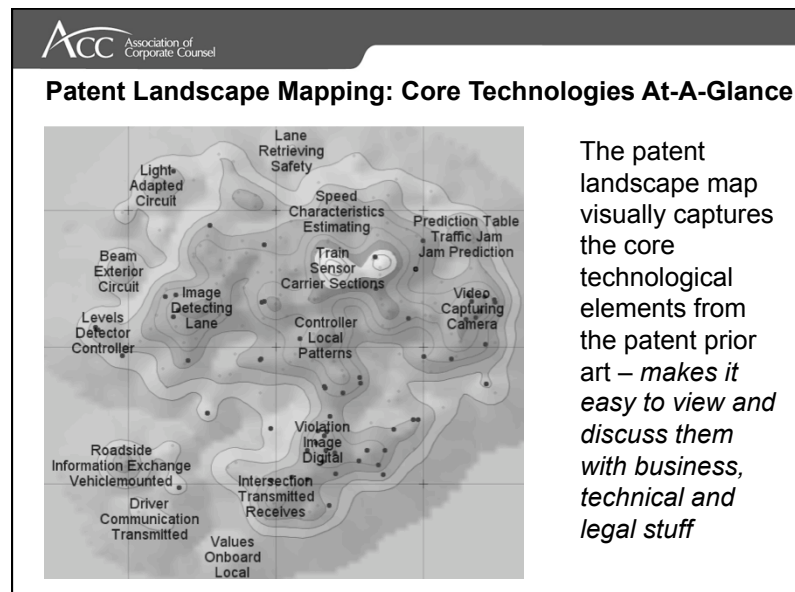
- Benefit v. Risk v. Cost
- Duty of disclosure
- Willful infringement (In re Seagate)
- Formulate searches to reveal information
- Examples

Components of S&P 500 Market Value









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Avoiding Infringement of Third Party Intellectual Property – Scenarios

- Launch of new product
- Launch of new features
- Significant investment
- In-sourcing a function previously carried out by a vendor

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Avoiding Infringement of Third Party Intellectual Property – Advice

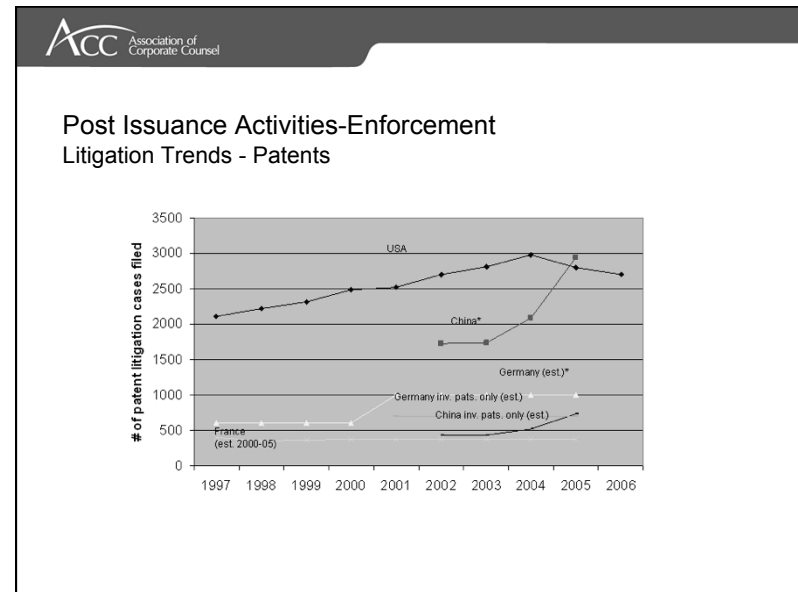
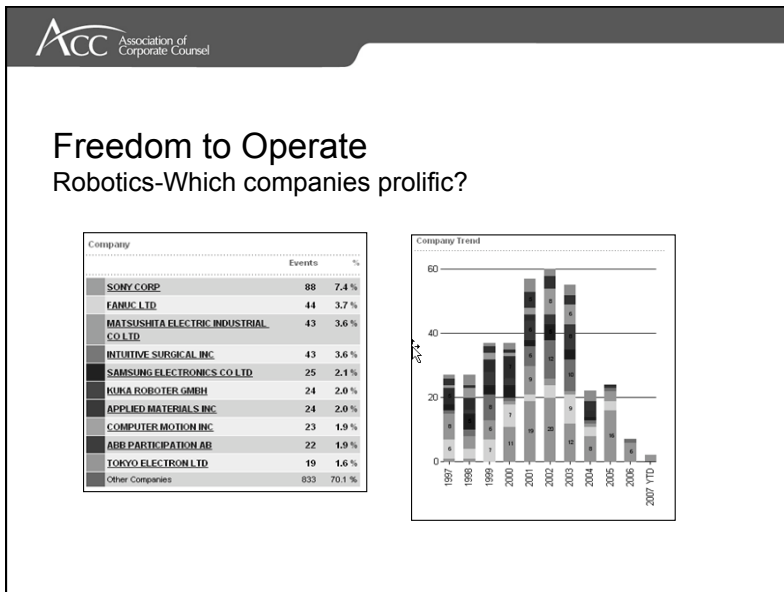
- Benefit v. Risk v. Cost
- Levels of information, uses
- Approaches to clearance searches and analysis

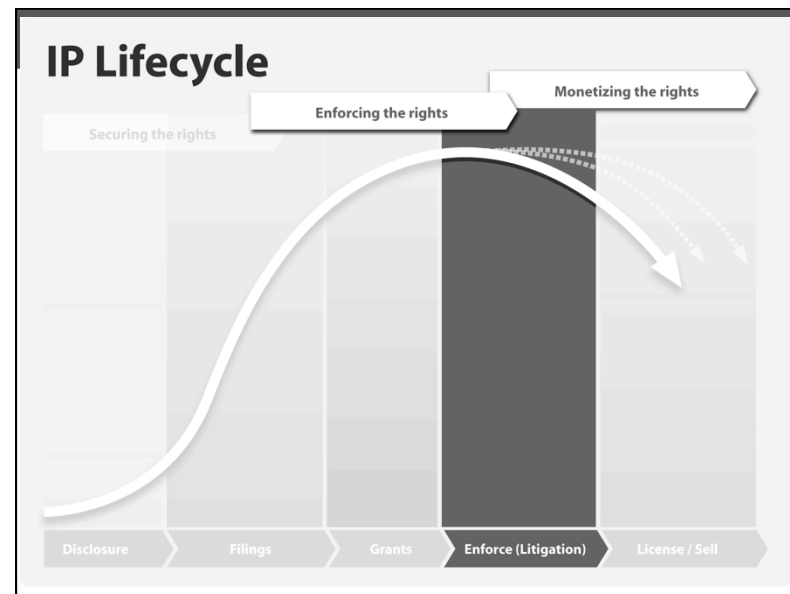
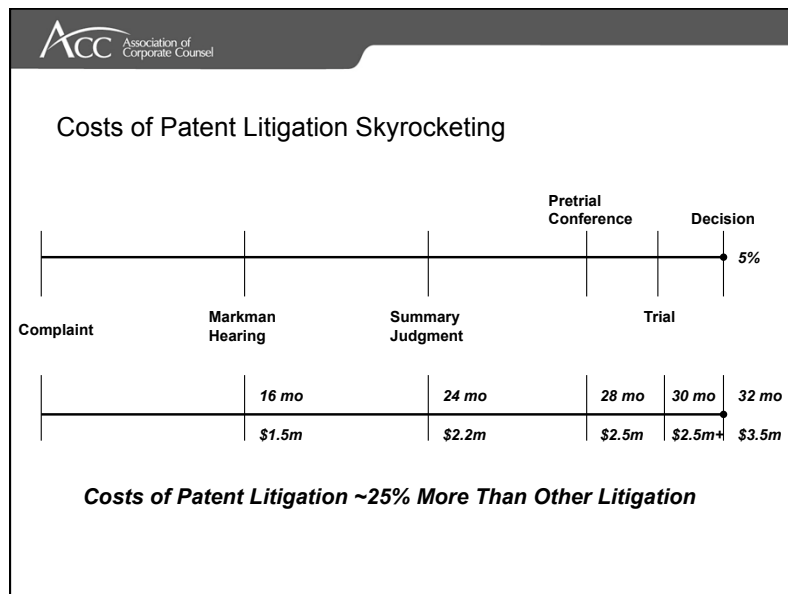
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Example Types of Clearance Analysis

Knock-Out	Limited searching for clear, obvious problems
Very Basic	Professional search and brief analysis regarding whether further due diligence is needed
Basic	Professional search and analysis to determine whether any high-risk patents are identifiable
Standard Clearance	Like Basic, but also includes more detailed analysis to determine whether a small number of high risk patents are infringed and/or invalid and a written opinion regarding same
Thorough Clearance	Like Basic, but includes a more detailed analysis to determine whether multiple high risk patents are infringed and/or invalid and a written opinion relative to same

Can focus on particular patent owners, technical features, patents, etc.





Patents in Litigation		Table of Contents									
MEDTRONIC INC											
The Patent in Litigation section shows an Intellectual Property litigation summary for MEDTRONIC INC, for actions involving patents held by the company. The table can be sorted by clicking on the desired column heading. The full patent or docket may be retrieved by clicking on the associated link.											
CASE FILE #	PATENT NO.	US CLASS	PATENT TITLE	PATENT FIRM	PLAINTIFF	PLAINTIFF FIRM	DEFENDANT	DEFENDANT FIRM	COURT	DOCKET NO.	
3/22/2006	U.S. Pat. 6,927,116	606/01	MULTILOCK ANTERIOR CERVICAL PLATING SYSTEM	Martin & Ferraro, LLP	MEDTRONIC SOFAMOR DANEX USA, INC.	VALMER CUTLERS PICKERING HALE AND DORR, LLP	BLACKSTONE MEDICAL, INC.	KENTON KENTON	D.MAISE	3:06-CV-01963	
3/22/2006	U.S. Pat. 6,927,116	623/116	SPINAL IMPLANT	Martin & Ferraro, LLP	MEDTRONIC SOFAMOR DANEX USA, INC.	PEPPER HAMILTON LLP	GLOBUS MEDICAL, INC.	MCHEA TECCE PC	E.D.PA.	2:06-CV-01424	
7/9/2006	U.S. Pat. 6,959,962	606/018	INTRAVASCULAR RADICALLY EXPANDABLE STENT AND METHOD OF IMPLANT	Vijapuril, Robert J.	MEDTRONIC INC.	DECHERT LLP	V.L. GORE & ASSOCIATES, INC.	MORGAN & FINNEGAN LLP	N.D.CAL.	3:06-CV-01443	
5/15/2006	U.S. Pat. 6,942,533	606/159	SHAVING OR CLIPPING METHOD FOR FEEDING COILS THROUGH STENTING COIL	St. Onge Steward Johnson & Peers, LLC	MEDTRONIC VORMED, INC. A DELAWARE CORPORATION	ROBERG, KAPLAN, MILLER & CREEL, LLP	STORZ ENDOSKOP GMBH		D.D.C.	3:06-CV-00932	
5/23/2006	U.S. Pat. 6,966,161	606/161	POLYAXIAL PEDICLE SCREW NUTS, A TAPERED AND TAPERED COMPRESSION LOCKING MECHANISM	Castellano Mann Ferrario & Book, P.C.	FASTENETT, LLC	DOMENICHINI, NATH & ROSENTHAL LLP	MEDTRONIC SOFAMOR DANEX USA		D.N.J.	2:06-CV-02020	
4/10/2006	U.S. Pat. 6,966,164	606/164	DILATATION CATHETER WITH COLLAPSIBLE OUTER DIAMETER	Voel, Greenfield & Sacks	MEDTRONIC, INC.	AKIN GUMP STRAUSS HANER & FELD LLP	KYPHON INC.	FIRM RICHARDSON	N.D.CAL.	3:06-CV-02553	
3/9/2006	U.S. Pat. 6,969,036	606/036	REINFORCED RAPID EXCHANGE BALLOON CATHETER	Medtronic AVE	MEDTRONIC VASCULAR, INC.	MCKOOL SMITH	BOYTON SCIENTIFIC CORP	NOVREY LLP	E.D.TEX.	2:06-CV-00018	
2/15/2006	U.S. Pat. 6,977,333	607/19	IMPLANTABLE MEDICAL INTERVENTIONAL DEVICE WITH ATRIAL DYSRHYTHMIA THERAPY FOR TACHYCARDIA	O'Connor, Cavanaugh Anderson	MD ECKHARD U ALT	VEL GOTTIHAL & MANGES	MD ECKHARD U ALT	MCKOOL SMITH	E.D.TEX.	3:06-CV-00661	
2/15/2006	U.S. Pat. 6,984,000	606/000	REINFORCED MONORIAL BALLOON CATHETER	Medtronic AVE	MEDTRONIC VASCULAR, INC.	FOLEY & LARDNER	ADVANCED CARDIOVASCULAR SYSTEMS, INC. A CALIFORNIA CORPORATION	FINEGAN HENDERSON FARNSON GARBETT & GUNNER LLP	N.D.CAL.	3:06-CV-01966	

This sections shows information regarding Medtronic's patents that are involved in litigation. The table is sort-able and includes information on whether the company is a plaintiff or defendant In the action, the law firms representing the parties and the patent classifications of the litigated patents. Links are available to retrieve the applicable patents or the dockets.

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Identifying Infringement of My Company's Intellectual Property – Scenarios

- Trademark infringement examples
- Valuable trademarks
- Susceptible to infringement via internet

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Identifying Infringement of My Company's Intellectual Property – Advice

- Infringement not addressed can lead to loss of rights
- Confirm your company has senior rights
- Set up systematic approach
- Internet / search / monitor registrations

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Intellectual Property Business Models

Licensing-focused entities (e.g. Thinkfire, IPvalue)	- Help companies commercialize intellectual property
Auctions (e.g. Ocean Tomo)	- Organize multiple auctions per year - Sellers include individuals, large companies
Portfolio assertion companies (e.g. Acacia, Mosaid)	- Assert individual portfolios
Investment companies (e.g. Rembrandt IP, Altitude Capital)	- Private investment companies - Finance later-stage development or litigation

Source: Intellectual Ventures, LLC



Early Warnings: Litigation Involving Competitors – Scenarios

- Be proactive
- Anticipate patent trolls, other suits
- Keep up with disputes
- Understand progression of the IP laws



Early Warnings: Litigation Involving Competitors – Advice

- Duty of disclosure / willfulness issues
- Opportunities for design around
- Opportunities for DJ suit
- Know hot buttons

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U.S. Party/Case Index

Form Instructions

Enter your search criteria in the form to your right and click on search.

Select a particular state or region of the country to limit your search. The default is to search all courts.

Limit your search to a particular date range. To search one day, enter the same beginning and end date. To search forward, just enter a beginning date. To search backward, just enter an end date. The default is to search for cases without a date range.

Limit your search by selecting both a state or region and a date range.

Civil Search

Region:

Case Filed date: through

Party Name: Format: lastname, firstname

Case Number: Format: 99-99999 or 9:1999cv99999 or 1999cr99999 or 1:98-999

Nature of Suit (NOS): Format: 999
specify ranges with a dash (EX: 999-999) or
multiple NOS with commas (EX: 999, 999, 999, ...)

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U.S. Party/Case Index

Civil Name Search Results

286 Total Party matches for selection MEDTRONIC NOS 830 for ALL COURTS

Search Complete
Fri Aug 22 15:10:55 2008
Selections 1 through 54 (Page 1)

 [Download \(6 pages, 5.0 KB\)](#)
 [Next 54](#)

Name	Court	Case No.	Filed	NOS Closed
1 MEDTRONIC ANEURX, INC.	dedece	1:2001cv02015	09/25/2001	830 03/31/2006
2 MEDTRONIC AVE INC	txedce	2:2002cv00073	04/08/2002	830 04/10/2003
3 MEDTRONIC AVE INC	dedece	1:2001cv02015	09/25/2001	830 03/31/2006
4 MEDTRONIC AVE INC	dedece	1:2001cv02015	09/25/2001	830 03/31/2006
5 MEDTRONIC AVE INC	dedece	1:2001cv02015	09/25/2001	830 03/31/2006
6 MEDTRONIC AVE INC	dedece	1:1998cv00080	03/20/2003	830
7 MEDTRONIC AVE INC.	dedece	1:1998cv00080	03/20/2003	830
8 MEDTRONIC AVE INC.	dedece	1:2003cv00402	04/18/2003	830 09/07/2006
9 MEDTRONIC AVE INC.	dedece	1:1999cv00833	12/06/1999	830 01/10/2001
10 MEDTRONIC AVE INC.	dedece	1:1999cv00833	12/06/1999	830 01/10/2001
11 MEDTRONIC AVE INC.	dedece	1:2000cv00886	10/06/2000	830 08/04/2006