

# THE UMBRELLA<sup>®</sup>

by CARSTENS & CAHOON, LLP



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## THE UMBRELLA<sup>®</sup>. AN INTELLECTUAL PROPERTY LAW UPDATE.

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### Pre-Litigation Patent Correction Procedures



Shaukat Karjeker

*Partner*

So, to give your business an “edge,” you invested in a team of innovative professional engineers and scientists. It paid off: you developed and perfected advanced technologies, as compared to your competitors. But, now they seem to have adopted your technologies to compete with you. However, you took the precaution to obtain patent rights. Now might be

the time to exercise those rights and protect the return on your R&D investments.

Before proceeding, there are a host of factors to consider, including broader business and market strategies, in addition to the “purely legal issues” posed by filing a patent lawsuit. As to the legal issues, at the outset one is plainly “due diligence.” This includes simply taking those steps that a reasonable, prudent businessman would take. One of these steps is to have a person skilled at reading patent claims, a patent lawyer, take a look at the issued patents,

and compare the patent claims with the technology (products, devices, systems or processes) that your competitors are offering. In making a preliminary assessment, a review of the patent claims and the patent file history (the communications with the US Patent Office during prosecution of the patent) is necessary. From this review, and perhaps additional prior art searches, it might become apparent that it would be necessary, or desirable, to make some changes

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C&C Diversity News



Colin Cahoon

Partner

day.

Carstens & Cahoon continues to lead the Texas IP pack in the promotion of diversity and diversity initiatives. Earlier this year, Carstens & Cahoon was recognized by PepsiCo Inc. as a part of PepsiCo's outside counsel diversity initiatives for the firm's demonstrated commitment to increasing diversity and inclusion in the legal profession at PepsiCo's annual diversity recognition

Law firms recognized on this day participated in PepsiCo's diversity survey adapted from the ABA Model Diversity Survey. The survey collects diversity metrics from U.S. law firms that billed PepsiCo in the prior calendar year. PepsiCo used a weighted formula to generate a diversity index score and examined the firms' initiatives related to diversifying the legal profession. PepsiCo recognized law firms that earned diversity index scores above the median in comparison to their peers and demonstrated an exceptional commitment to diversity and inclusion through qualitative efforts.

The firm's PepsiCo Relationship Partner, Colin Cahoon, noted that this is the third year in a row that Carstens & Cahoon has been privileged to receive such recognition from PepsiCo. "We are honored to again make the list of PepsiCo outside law firms who excel in their commitment to diversity. As an intellectual property law firm we face unique challenges in this regard. Nonetheless, of the fourteen firm professionals authorized to work on the PepsiCo account last year, 86% are of minority status. Three of the firm's eight partners are diverse, and all four of the most recent associate hires are minority attorneys, including two women. The firm fully supports PepsiCo's diversity initiatives and will continue to promote diversity within our firm and in the intellectual property field."

One of the firm's diversity initiatives is "priming the pump" to encourage diverse engineering students to attend law school. In the past this effort has included making presentations to various minority oriented student organizations on campuses in both Texas and New Mexico. Last year the firm took this effort one step further by offering

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Where Did We Go Wrong? The Importance of Conducting Prior Art Searches on a Regular Basis.



Andrew Reed

Associate

*Imagine your company has developed a great new product, and you have gone through the steps to protect your intellectual property in the product. Now, a year down the road you are facing an accusation of infringement of a patent that you were not made aware of during the development of your product, but you would have found through even a short and straightforward prior art search performed by your patent attorney.*



James Ortega

Partner

In the fast-paced development found in industry today, it is not uncommon for products to move from development to production in a matter of days or weeks, and not the months or years of previous generations. However, this does create some issues in the realm of intellectual property, as many of these products never have even a short and straightforward prior art search conducted to find if there are any patents or patent applications that would be an issue for patentability or possible infringement. In this article we discuss some of the basics of why companies and individuals should run not only an initial prior art search, but then also do periodic searches on their products, technology fields, and on their competitors.

What are Prior Art Searches?

Prior art searches are searches done on the subject matter (scope or technology area) of your idea or invention to discover "prior art," that is, published documents involving that subject matter or technology field that predate your patent application. These searches can give you a general knowledge of what others are doing or have done on the same subject matter or in the same technology area. A prior art search can range from a patent attorney searching for a couple of hours to determine if there is anything exactly like your idea or invention, to the hiring of a professional search firm to find every relevant patent, patent applications, or publications discussing the subject matter of the idea or invention. The level of searching is often dictated by a...

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## Cease and Desist Letters After TC Heartland - Best Practices



Vince Allen

Partner

The Supreme Court recently reversed almost 30 years of Federal Circuit precedent that allowed patent infringement suits to be filed anywhere that the court could exercise personal jurisdiction over the defendant. So long as, for example, the infringing product was sold in the district, venue was proper there. As a result of the liberal interpretation of the venue rules, the Eastern District of Texas became

a popular forum for patent infringement cases, with more cases being filed there than any other district in the country.

Subsequently, new decisions regarding the inconvenience of a forum required the trial court to transfer the case if it was found to be clearly more convenient for the parties to have the case heard elsewhere. But now, after the Supreme Court's TC Heartland decision, a patent infringement suit can only be filed against a corporate defendant either 1) where the defendant is incorporated or 2) where the defendant has a regular and established place of business and has committed acts of infringement.

The Supreme Court's decision has resulted in a decline in filings in the Eastern District of Texas and a rise in filings in the District of Delaware where many companies are incorporated. Motions filed in numerous cases have resulted in disputes over what is a "regular and established place of business" under the patent venue statute, and it will be some time before the specific parameters of the venue statute are defined. But in the meantime, we know that the venue in many patent cases will be limited depending on where the defendant is doing business.

Historically, patent owners have been reluctant to send detailed cease and desist letters to alleged infringers in many cases because of fear that the infringer might file a declaratory judgment action in the venue of its choice seeking a finding of non-infringement and/or invalidity of the asserted patent. However, this may be changing after the TC Heartland decision given that the possibilities for venue are more limited for those infringers who do not....

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## Firm Updates

### AWARDS

> We are honored to announce David Carstens, Colin Cahoon, and Vince Allen have received the prestigious award "Best Lawyers in Dallas 2017" by D Magazine.

> Attorneys David Carstens, Colin Cahoon, Vince Allen, and Greg Marcum were named as 2017 Super Lawyers. The selection for Texas Lawyers, published by Thomson Reuters, is based on peer nominations and professional achievements. A panel of lawyers selected by the Super Lawyers editors makes the final selections. Of those nominated, no more than five percent of eligible Texas attorneys are selected for inclusion.

> The firm completed the PepsiCo Outside Counsel Diversity Survey and has once again been recognized by PepsiCo as having some of the best diversity and engagement metrics and practices among the firms that were surveyed. The Photo below shows Associate, Stephen Liu, accepting an award for our commitment to diversity.



### PRESENTATIONS, & Other News

> Partner, Colin Cahoon has made multiple guest appearances on the Mark Davis Show to discuss various hot IP topics.

> Partners, Ted Baroody and James Ortega, sponsored and participated in Dallas Bar Association's Pro Bono Golf Tournament in April 2017.

> Partner Ted Baroody, will be a panel speaker at the upcoming "U.S. Patent and Trademark Office Comes to Albuquerque" event in October.

Keep up with the latest Carstens & Cahoon, LLP news by following us on our social media pages.



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### Professional Profile



Celina Orr

*Associate*

Ms. Orr was born in Corpus Christi, Texas, just a few years after her family moved to the U.S. from Peru. When she was about four years old, determined to be able to communicate with her grandmother, she quickly became bilingual by studying Spanish newspapers. As a young student, she approached every new challenge with the same determination, foregoing food and sleep in favor of finding the solutions to every problem she could find until she had a firm grasp on every subject. Following high school, Ms. Orr double-majored in Chemistry and Spanish Civilizations at the University of Texas at Austin. After enjoying her last semester in Spain where she was able to satisfy her love of art and culture, she decided to make her way back to Austin to focus on a new challenge, attending law school at University of Texas. During law school, Ms. Orr was active in the Student

Recruitment Organization Committee, Intellectual property Law Journal, Student Bar Association, and the Hispanic Law Students' Association. Ms. Orr also served as attorney ad litem for children involved with CPS cases. She was selected as one of four permanent class agents for her graduating class. During a visit to Asia, she caught the technology bug and decided to combine her fondness of science and the arts with her knowledge of law in the practice of IP. She joined Carstens & Cahoon in 2007, where she still enjoys utilizing her problem solving skills. Ms. Orr is a member of the State Bar Women in IP law subcommittee, Dallas Hispanic Bar Association, and the Dallas Chapter of Texas Exes.



Celina with Partner, Colin Cahoon, at PepsiCo's headquarters in New York.