

Ridout & Maybee LLP

CANADA'S INTELLECTUAL PROPERTY AND TECHNOLOGY LAW FIRM

Bright minds
protecting
bright ideas
since 1893



Podcast: Is my client infringing a patent?

Presented by Matt Norwood
Ridout & Maybee LLP

This podcast is not legal advice. If you want our views on your specific situation, contact Matt Norwood at 416-865-3523 or mnorwood@ridoutmaybee.com.

Source of Info in This Podcast

- 1) Expertise of Ridout & Maybee LLP ([R&M website](#)) and Matt Norwood ([Matt's bio](#)).
- 2) Canadian Intellectual Property Office (CIPO)
 - [CIPO website](#)

Help! I think I might be infringing a patent!

- Client receives a demand letter / cease & desist letter
- Client served with a Statement of Claim or Complaint
- Client discovers the patent independently

Don't Panic

- Patents are confusing documents
- This is a step-by-step guide to assessing your client's patent infringement risks



Patent Basics


- A patent is a 20-year monopoly
- It bars anyone else from making, using, or selling the invention
- Enforced through the Courts
- Proving infringement is a long, complex, and expensive process – you have time

Step 1: Who's the owner?

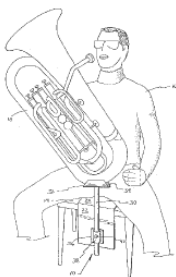
- Lawsuit: easy, but [confirm at CIPO](#)
- Demand letter: definitely [confirm at CIPO](#)
- Discovered independently: you can [check CIPO](#) (but it may be out of date)

If US patent: [check USPTO](#)

Step 1: Who's the owner?

(19)  Canadian Intellectual Property Office An Agency of Industry Canada	Office de la Propriété Intellectuelle du Canada Un organisme d'Industrie Canada	(11) CA 2 206 512 (13) C
(12)		(40) 29.08.2000 (43) 13.08.1998 (45) 29.08.2000
(21) 2 206 512	(51) Int. Cl.:	G10G 005/00
(22) 29.05.1997		
(30) 08/800,299 US 13.02.1997	(72)	JOHNSON, Wallace W. (US).
(73) JOHNSON, Wallace W. 307 Monroe Street IOWA CITY XX (US).	(74)	MCFADDEN, FINCHAM
(54) PORTE-INSTRUMENT DE MUSIQUE MUSICAL INSTRUMENT SUPPORT		

(57) A chair-borne musical instrument support that is both adjustable and portable. The musical instrument support includes a seat portion having an adjustably attached support arm with an instrument rest attached to the top thereof. The musician places the seat portion of the device on the seat of a chair, and then sits on the seat portion. The support arm and instrument rest extend upward near the front edge of the chair and between the legs of the musician. The weight of the musician sitting on the chair holds the device in place. Alternatively, the musical instrument support may be held in place on a chair by adjustable straps. The base of the tuba is then placed upon the instrument rest which is covered with a non-abrasive, non-skid surface. The support arm and instrument rest may be adjusted vertically up or down to a comfortable height. The instrument then rests in the same position as if it were being held on the musician's lap, but now it does not have to be borne by the musician's legs. The musical instrument support is not permanently attached to the chair, therefore, the support may be easily removed and carried with the musician or stored for later use. Several embodiments of the present invention are contemplated which are designed to be used by different size musicians and with different types of instruments.



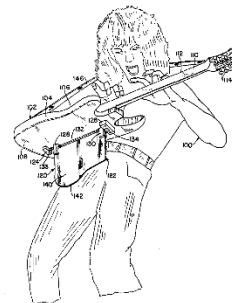
"Inventor"
or
"Applicant"

on patent document can provide a starting point

United States Patent [19]
Van Halen [45] Patent Number: 4,656,917
Date of Patent: Apr. 14, 1987

[54] MUSICAL INSTRUMENT SUPPORT
[76] Inventor: Edward L. Van Halen, 1900 Ave. of Stars #1780, Los Angeles, Calif. 90067
[21] Appl. No.: 760,598
[22] Filed: Jul. 30, 1985
[51] Int. Cl. G10G 5/00
[52] U.S. Cl. 84/327; 224/910
[58] Field of Search 84/327, 453, 267, 280, 84/411, 421; 224/910; 248/444, 371, 443
[56] References Cited
U.S. PATENT DOCUMENTS
1,285,802 11/1918 Russell
1,945,162 1/1934 Raamussen
2,814,229 11/1957 Vaccaro et al.
3,371,570 3/1968 Lester
3,955,461 5/1976 Ivic
3,979,993 9/1976 Proctor
4,213,369 7/1980 Swartwout
Primary Examiner—S. J. Witkowski
Assistant Examiner—David Warren
Attorney, Agent, or Firm—Lerner, David, Littenberg, Krumholz & Mentlik
[57] ABSTRACT
A supporting device for stringed musical instruments, for example, guitars, banjos, mandolins and the like, is disclosed. The supporting device is constructed and arranged for supporting the musical instrument on the player to permit total freedom of the player's hands to play the instrument in a completely new way, thus allowing the player to create new techniques and sounds previously unknown to any player. The device, when in its operational position, has a plate which rests upon the player's leg leaving both hands free to explore the musical instrument as never before. Because the musical instrument is arranged perpendicular to the player's body, the player has maximum visibility of the instrument's entire playing surface.


22 Claims, 4 Drawing Figures



Step 2: Is it still in force?

- Generally, patents expire 20 years after being filed
- Federal Court grants remedies on infringement within past 6 years (limitation period)
- If patent filing date is 26+ years ago, you're probably free and clear

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(54) PORTE-INSTRUMENT DE MUSIQUE (54) MUSICAL INSTRUMENT SUPPORT			

Filing Date

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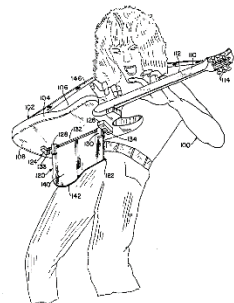
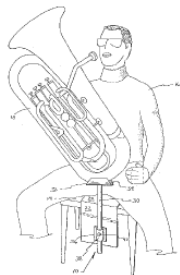
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22 Claims, 4 Drawing Figures

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Step 2: Is it still in force?

Check if maintenance fees have been paid:

- [CIPO](#)
- [USPTO](#)

Step 3: Are you engaged in potentially infringing activity in the patent's jurisdiction?

- Making, using, or selling the invention
- In the country where the patent applies

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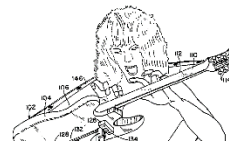
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22 Claims, 4 Drawing Figures



Step 4: Does your product or service infringe the Claims?

- Patent monopoly is not defined by what is described or shown in drawings
- It's defined by the Claims

Step 4: Does your product or service infringe the Claims?

- Claim construction (interpretation) is complex and uncertain
- Courts require expert witnesses to construe claims

THE EMBODIMENTS OF THE INVENTION IN WHICH AN EXCLUSIVE PROPERTY OR PRIVILEGE IS CLAIMED ARE DEFINED AS FOLLOWS:

1. A musical instrument support, comprising:

a seat portion having a downwardly extending portion;
a support arm;

means for adjustably connecting said support arm to said seat portion, said means comprising a hollow sleeve mounted on said downwardly extending portion, said support arm being slidably received within said sleeve, said sleeve having an outer surface with a threaded hole therethrough; and a knob having a threaded rod extending therefrom, said threaded rod being capable of mating with said threaded hole;

a rest attached to said support arm for receiving a musical instrument; and

means for holding said seat portion upon a chair seat.

2. A musical instrument support comprising:

a seat portion having an extended portion for extending beyond a front edge of a seat, said extended portion having a threaded hole therethrough;

a support arm;

a rest attached to said support arm for receiving a musical instrument;

means for holding said seat portion upon a chair seat; and

Step 5 (If “yes” to all of the above): Is the patent valid?

- Examined by patent office → presumption of validity
 - But patents routinely invalidated by courts
- Several grounds of invalidity
 - Most common attack = lack of novelty/inventiveness
 - Collect relevant prior art, talk to IP lawyer

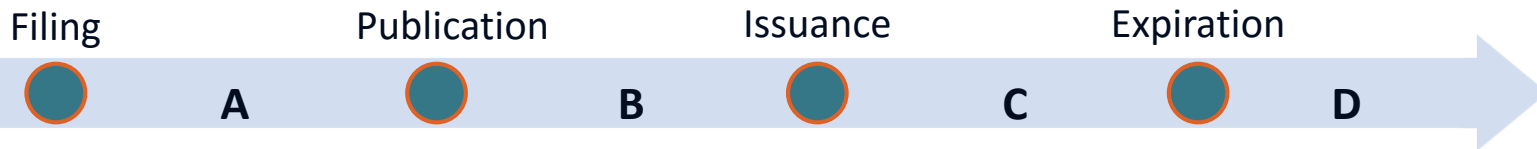
Step 6: Potential Liability

- Damages or profits
 - Usually comparable to each other
 - Accrued over last 6 years (or since patent issued)
- Injunction
- Legal costs (20-50%)

Step 6: Potential Liability

- Timeline of patent issuance and patent action determines remedies:
 - Judgment after patent expires → no injunction
 - Action filed 6 years after patent expires → no damages
 - Damages period = issue date to expiration date

Step 6: Potential Liability



18 months

1-10 (?) years

20 years



6 years

6-12 months

2-4 years

Strategic Tips

- Lots of edge cases and uncertainty
 - Even patent term (20 years) and territoriality can be uncertain
 - A patent lawyer may be able to clarify in an initial consultation
- If you get to claim interpretation, you should consult a patent lawyer

Strategic Tips

- I'm still worried I'm infringing – what should I do?
 - Independently discovered: let sleeping dogs lie (or acquire)
 - Lawsuit: hire litigation counsel
 - Demand letter: hire litigation counsel, consider filing for declaratory relief

Thank you!

Please contact Matt at 416-865-3523 or mnorwood@ridoutmaybe.com if you have any questions about the content of this podcast.