

# Exh. T

**EXPERT REPORT OF JAY G. TAYLOR**

## **I. INTRODUCTION**

1. I have been retained by and will provide expert testimony on behalf of plaintiff Heartland Recreational Vehicles, LLC ("Heartland") regarding the prosecution of U.S. Patent No. 7,278,650 ("the '650 patent"), and the issue of inequitable conduct allegedly committed by Heartland during that prosecution. Because discovery is ongoing, I reserve the right to render additional opinions and to supplement or amend my opinions based upon the production of further documents, deposition testimony, submissions of expert reports by experts for defendant Forest River, Inc. ("Forest River"), trial testimony or other events that may occur during the course of this action.

2. I am a retired patent attorney registered to practice before the United States Patent Office with over 40 years of experience in all aspects of patent prosecution and litigation. I have handled litigation and prosecution matters in such diverse mechanical, chemical and electrical fields as, for example, computer software, heart pacemakers, urological stents, ceramic products and processes, data recording and transmission equipment, electronic musical instruments, high voltage transmission equipment, food processing equipment and processes, vending equipment, electronic games, railroad equipment, welding equipment and processes, and particle board manufacturing processes.

3. I am being compensated for my work in connection with this matter at my standard billing rate of \$450 per hour. In the last four years, I have given testimony as an expert in the case of Stant Manufacturing Inc. v. Gerdes GmbH, United States District Court for the Southern District of Indiana. My resume setting forth my qualifications, my prior involvement as an expert witness and listing my publications is attached as Exhibit A.

## **II. DOCUMENTS AND MATERIALS RELIED UPON**

4. In preparation of my opinions, I reviewed and considered the '650 patent, the '650 file history, each prior art reference cited in and exhibits attached to that file history. I also reviewed and considered the deposition testimony of Brian Brady, John Rhymer, Timothy Hoffman, Scott Tuttle, Douglas Lantz, Gregory Cooper, Gerard Gallagher and Jeff Babcock taken in this case. I have also considered the following documents and exhibits: Deposition Exhibits 1-34, 40-41, 43, 80, 81, 100-115 and 123-128, Cooper Dep. Exs. 1, 2 (B&T 001-636), and 3, and Gallagher Dep. Ex.1 (Heartland/FR 458-1049) the Amended Counter Claim and Exhibits thereto, Letter dated July11, 2005 from Liegl to Gallagher, and drawing entitled fifth Wheel Section, FE138.

## **III. PATENT PROCESS**

5. The process of patenting inventions is contemplated by the U.S. Constitution. Over the years many regulations and much legal precedent have developed to balance the interests of the patent applicant and the public. The patent system involves the disclosure of inventions to the public to encourage progress of the useful arts. The reward for the inventor's patent disclosure is the grant of a limited right to exclude others from manufacturing, using, selling or offering to sell the invention for a limited period of time. More specifically, the Patent Act, 35 U.S.C. §§ 1 et seq. and particularly 35 U.S.C. § 271, permit an inventor, his or her assignee or exclusive licensee, to exclude others from making, using, selling or offering to sell the patented invention for a period of 20 years from the earliest original filing date of the patent application. In exchange for this "limited right," the inventor must disclose to the public how to make and use the invention, including the best way or "mode" of practicing the invention as contemplated by the inventor at the time of filing the application. In addition, the inventor must describe the

invention in terms specific enough so as to enable those skilled in the art to make and use the invention. The inventor must particularly point out and distinctly claim the invention so that others can determine whether or not they are practicing the invention.

**A. Patent Applications**

6. When an inventor believes that he has come up with a new invention the inventor may file a patent application with the United States Patent and Trademark Office ("the Patent Office"). Since the patent process is procedurally and legally complex, an inventor almost always engages a registered patent attorney or patent agent to prepare and file a patent application with the Patent Office. The process is so technically challenging and procedurally and legally complex that only attorneys who meet certain minimal technical education requirements and who pass an examination administered by the Patent Office are admitted to and registered to practice before the Patent Office.

7. A patent application has four parts: an abstract, one or more drawings, a specification, and one or more claims. The abstract is a brief description of the invention, the drawings illustrate the invention where necessary or appropriate, the specification describes the preferred embodiments of the invention in detail, and the claims define the "metes and bounds" of what the inventor considers as his or her invention.

8. The Patent Act and the Patent Office Rules require each patent application to provide a sufficient description to enable those skilled in the art to make and use the invention as claimed. Further, if the inventor has contemplated a "best" or most preferred mode for the invention as claimed, the application must disclose enough to allow those skilled in the art to practice the preferred mode. Those requirements are known as the "written description"

"enablement" and "best mode" requirements and are set forth by statute in 35 U.S.C. § 112, adopted as Patent Office regulations 37 C.F.R. § 1.51 and § 1.71 among others, and set out in the Manual of Patent Examining Procedure ("MPEP") §§ 2161-2165.04<sup>1</sup>

9. To fulfill the written description requirement, the original specification must provide written support for the claims being examined. In addition, the original specification must have sufficient detail to evidence that the inventor possessed the claimed invention at the time of filing. The enablement requirement requires the patent applicant to disclose adequate technical details to enable one of ordinary skill in the art to which the invention is directed to make and use the claimed invention. The best mode requirement requires that the specification disclose the best way of practicing the claimed invention, known to the application at the time of filing the application. MPEP § 608.01(h).

**B. Duty of Disclosure**

10. Patent applicants and their representatives, and all individuals associated with the filing or prosecution of a patent application, have a duty established by federal regulations and judicial decisions to deal in complete candor and good faith with the Patent Office. 37 CFR § 1.56, also known as Rule 56, governs the conduct of applicants and their representatives in respect to the patent application process. Under 37 CFR § 1.56, patent applicants and their representatives and all individuals associated with the filing or prosecution of a patent application are required to submit to the Patent Office all prior art and other information known

---

<sup>1</sup> The MPEP is a manual created by the Patent Office as a guide for patent examiners. It represents the Patent Office's view on how the patent law should be applied in the examination of patent applications. The MPEP also guides examiners on the various procedures for examining patents. The MPEP is a guide. It does not constitute the law.

with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

\* \* \* \*

(c) Individuals associated with the filing of prosecution of a patent application within the meaning of this section are:

- (1) Each inventor named in the application;
- (2) Each attorney or agent who prepares or prosecutes the application; and
- (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.”

This disclosure requirement exists because, for the most part, patent prosecution is an *ex parte* proceeding involving only the patent applicant and the Patent Office. Patent applications are held in secret, at least until they are published. The public does not have an opportunity to comment or advise the Patent Office as to prior art or other circumstances which might render any given application unpatentable, except in limited circumstances such as a reexamination, or in the protest and public use proceedings provided for in 37 CFR §§ 1.291 and 1.292, and in those proceedings, participation by another party is restricted.

12. In general, the Patent Office has only two sources for prior art and other information. These sources are the art located in the Patent Office files and databases and whatever art or other information the patent applicant may bring to the attention of the Patent Office. Thus, applicants have a strict duty not to withhold or misrepresent material prior art, or

to them which is material to the prosecution of the application and which is not cumulative to information already of record in the application proceedings.

11. Rule 56 states in pertinent part:

(a) "...Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the office all information known to that individual to be material to patentability as defined in this section. .... The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. ....

(b) Under this section, information is material to patentability when it is not cumulative to information already of record in the application, and

(1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or

(2) It refutes, or is inconsistent with, a position the applicant takes in:

(i) Opposing an argument of unpatentability relied on by the Office, or

(ii) Asserting an argument of patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent



other information material to patentability. Rule 1.97 and 1.98 govern the form and content of Information Disclosure Statements filed in satisfaction of rule 1.56. In relevant part, Rule 1.97 specifies that:

- (g) An information disclosure statement filed in accordance with this section shall not be construed to be a representation that a search has been made.
- (h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

In relevant part, Rule 1.98 specifies that an information disclosure statement shall include:

- (1) A list of all patents, publications, applications or other information for consideration by the office.

Rule 1.98 (a)(3)(i) does not require an explanation of relevance of any such listed patent, publication, application or other information except for "each patent, publication, or other information that is not in the English language."

### **C. Patent Examining Procedures**

13. When a patent application is filed with the Patent Office it is assigned to a patent examiner who examines the application to determine whether the application complies with all the requirements for patentability. One of those requirements is "novelty," that is, whether anyone else has already invented the same exact invention as defined by the claims or whether the inventor or another has patented, published, sold or otherwise disclosed the invention to the public more than one year before filing the application. This is also known as "anticipation." (See, e.g., MPEP §§ 2126-2138.06).<sup>2</sup>

---

<sup>2</sup> For convenience I have cited to the current MPEP unless stated otherwise.

14. The patent examiner also determines whether the invention would have been "obvious" to those skilled in the art. In that regard, the examiner considers all relevant prior art references, typically prior patents and publications, and determines whether there is teaching, suggestion, motivation or other basis in the art to combine the teachings of the references, and whether in view of the suggestion and reference teachings, the claimed invention would have been obvious. (See, e.g., MPEP §§ 2141-2146).

15. Typically, an examiner will by written official action reject the application at the outset based on one or more of the prior art references. The patent attorney then responds by arguing that the references do not anticipate or render obvious the claimed invention, by amending the claims to distinguish the invention from the prior art, or both. In many instances, an interview with the examiner may be held either prior to or after an official action by the examiner in an effort to find grounds for allowance. The general procedures and policies for such interviews are set forth in Rule 1.133 and MPEP § 713.01-713.10. After two or more rejections, the application is either allowed or finally rejected. If claims are allowed, the application may be allowed to issue as a patent with those allowed claims. If not allowed, the inventor can appeal to the Patent Office Board of Appeals and request reversal of the examiner's decision. Alternatively, the applicant may file a Request for Continued Examination (RCE) with appropriate fee and present additional arguments and amendments including new claims to the examiner. (See, e.g., MPEP § 706.07 *et seq.* and § 1201 *et seq.*).

16. In addition to examining the application for novelty and non-obviousness, the examiner also reviews the application to ensure the written description and enablement requirements set forth above are satisfied. The examiner also reviews all amendments to the application, including the specification and drawings, to ensure that "new matter," i.e.,

information not contained in the application as originally filed, is not added during the application process. (See, e.g., MPEP §§ 706.03(O), 2163.06-07).

**D. Inequitable Conduct**

17. As set forth above, an inventor, his patent attorney, and those directly and meaningfully involved in the prosecution of a patent application have an "uncompromising duty" to prosecute patent applications in the Patent Office with candor and good faith. *Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co.*, 324 U.S. 806 (1945). This duty extends to not only the inventor but to the applicant's representatives including the assignee owner, attorneys and individuals substantively involved in the prosecution of the application. *FMC Corp. v. Manitowoc Co.*, 835 F.2d 1411 (Fed. Cir. 1987). If the applicant fails to observe its duty of candor in its dealings with the Patent Office and commits inequitable conduct, all claims of the resulting patent may be rendered unenforceable. *LaBounty Mfg., Inc. v. U.S. Int'l Trade Comm'n*, 958 F.2d 1066, 1070 (Fed. Cir. 1992). If anyone meaningfully involved with the prosecution of a patent application breaches that duty of candor with intent to deceive, a patent may be held to be unenforceable. (See MPEP § 2001.01).

18. Inequitable conduct includes an affirmative misrepresentation of a material fact, failure to disclose material information, or submission of false material information, coupled with intent to deceive. *J.P. Stevens & Co. v. Lex Tex Ltd.* 747 F.2d 1553, 1559 (Fed. Cir. 1984), *cert. denied*, 747 U.S. 882 (1985). A party alleging inequitable conduct must offer clear and convincing proof of the materiality of the prior art, knowledge chargeable to the applicant of the prior art and its materiality, and the applicant's failure to disclose the prior art, coupled with an intent to deceive the examiner into issuing the patent. *Braun, Inc. v. Dynamics Corp. of America*, 975 F.2d 815, 822 (Fed. Cir.1992). If the failure to disclose or misleading statements

regarding material information occurred through negligence, oversight, carelessness, or an error in judgment, even if it was grossly negligent, there is no intent to deceive and there is no inequitable conduct. *Kingsdown Med. Consultants v. Hollister, Inc.* 863 F.2d 867, 876 (Fed. Cir. 1988). Intent to deceive is rarely admitted or obvious, and must be inferred in most cases from all the evidence of surrounding circumstances. *Critikon, Inc. v. Becton Dickinson Vascular Access, Inc.*, 120 F.3d 1253, 1256 (Fed. Cir. 1997). However, specific intent to deceive must be proven by clear and convincing evidence, *Kingsdown Med. Consultant*, 863 F.2d at 876, and the inference must “be the single most reasonable inference to be drawn from the evidence to meet the clear and convincing standard.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1366 (Fed.Cir.2008).

19. Material information in connection with an examination is defined by the Patent Office Rules, 37 CFR § 1.555(b), to be non-cumulative information that either (1) is a patent or printed publication that by itself or with other patents or printed publications, establishes a prima facie case of unpatentability of a claim, or (2) refutes or is inconsistent with a position taken by the patent owner in (i) opposing an argument of unpatentability relied upon by the Patent Office, or (ii) asserting an argument of patentability. Additionally, prior art or information may be material if a reasonable examiner would have considered it important in deciding whether to allow the application. *Digital Control, Inc. v. The Charles Machine Works*, 437 F.3d 1309, 1315 (Fed. Cir. 2006).

#### **IV. THE ALLEGATIONS OF INEQUITABLE CONDUCT**

20. In paragraph 47 of the Amended Answer and Counterclaim defendant alleges that certain statements made at column 1, line 45-62 and Figure 9A of the drawings of the '650 patent “were false and incomplete and were misleading at the time that they were made,” and

that Heartland was aware of prior art "V" and "bull nose" trailers with tapered front ends which was not disclosed to the Patent Office.

21. In paragraph 48 of the Amended Answer and Counterclaim defendant alleges that Heartland filed an improper information disclosure statement in that it failed to admit that the disclosed information was material to the patentability of any pending claim and it failed to identify any prior art frames actually made and sold within the industry of which the applicants allegedly had knowledge.

22. In paragraph 49 of the Amended Answer and Counterclaim defendant alleges that Heartland failed to disclose information about an "Eliminator" prior art trailer which was allegedly disclosed by a July 11, 2005 letter and which allegedly anticipated some of the claims of the application.

23. In paragraphs 50-52 of the Amended Answer and Counterclaim Forest River alleges that Heartland "secretly" disclosed the Eliminator reference to the USPTO in a continuing application SN 11/834,214, did not inform Forest River of or allow Forest River to attend an interview regarding the examination of that continuation, filed an improper information disclosure statement after the interview and did not adequately comply with Rule 1.133(b) in connection with the prosecution of that continuation.

24. While it is not clear in paragraphs 53 and 54 of the Amended Answer and Counterclaim what the exact legal theory is for the allegations of inequitable conduct with respect to the '650 patent, Forest River alleges that Heartland somehow improperly added claims to its continuing applications SN 11/834,214 and 12/315,894.

25. Forest River alleges in paragraph 55 of the Amended Answer and Counterclaim that certain named inventors are not “co-inventors” within the meaning of the patent act, that the error did not arise without deceptive intent and that its failure to inform the patent office of these alleged facts was material to the patentability of the claims, and thus, in violation of rule 1.56.

26. In addition to the allegations of the Amended Answer and Counterclaim, Forest River identifies in its response to Heartland’s First Interrogatory No. 3 several additional alleged claims of inequitable conduct in addition to those discussed above. Forest River alleges that at least three of the inventors did not read the application sufficiently to understand its content and claims, falsely asserted inventorship and did not disclose information required under 37 C.F.R. 1.56 and this was known or should have been known by Mr. Cooper and Mr. Cooper should have, pursuant to 37 C.F.R. 10 and 1.56, prevented “the patent application from being prosecuted under those circumstances.” Further, Forest River alleges that the prosecuting patent attorneys did not sufficiently gather and pass on information from the inventors with respect to: (a) the nature of the invention, (b) the known scope of the prior art within the industry, (c) the level of ordinary skill of those involved in the design of travel trailers and fifth wheel and (d) the differences and similarities between the claimed invention and the prior art. Finally, Forest River alleges in the response to Interrogatory 3 that the prosecuting attorneys failed to claim the real “invention” of the inventors, and did not comply with 35 U.S.C. §112 by not particularly pointing out and distinctly claiming the subject matter which the named inventors regarded as their invention and by not “enabling” one of ordinary skill in the art to make and use that invention,

27. Additionally, Forest River alleges that Heartland failed to inform the Patent Office of false inventorship in connection with a continuing application that was allegedly admitted in

a deposition of Brian Brady and paid an issue fee to “close down prosecution” before a transcript of that deposition could be created.

## **V. ANALYSIS AND CONCLUSIONS**

28. There is no evidentiary support for Forest River’s allegations in paragraph 47 of the Amended Answer and Counterclaim that certain statements made at column 1, line 45-62 and Figure 9A of the drawings of the ‘650 patent “were false and incomplete and were misleading at the time that they were made,” and that Heartland failed to disclose prior art “V” and “bull nose” trailers with tapered front ends to the Patent Office. The prior art disclosed by Heartland to the Patent Office by its information disclosure statement completely refutes these allegations. For example, U.S. Patent Nos. 6,343,830; 6,860,545; 6,170,903 and 5,746,473 which were disclosed to the examiner in the IDS all disclose that it was conventional to have a fifth wheel trailer with an upper deck with “a rectangular or parallel-shape footprint whose forward corner edges form right angles.” (See, e.g., Figs. 1 & 2 of the ‘830 and ‘545 patents, Figs. 1, 2A & 2B of the ‘903 patent and Figs. 5 & 6 of the ‘473 patent). In context of a patent, “conventionally” merely means known in the art. Thus, that statement was neither false nor misleading. Moreover, the construction shown in Figure 9A of the ‘650 patent is very similar to the front edge construction shown in Figure 2 of U.S. Patent No. 6,860,545 and Figures 5 & 6 of U.S. Patent No. 5,746,473, thus showing that Figure 9A does depict prior art and was neither false nor misleading. Further, I am aware of no reported case that has ever found a statement made in the specification of a patent about the state of the prior art to be the basis for inequitable conduct.

29. There is no legal or evidentiary support for Forest River’s allegations in paragraph 48 of the Amended Answer and Counterclaim that Heartland (1) filed an improper information statement with the United States Patent Office in that it failed to “admit” that the disclosed

information was material to the patentability of any pending claim and (2) it failed to identify any prior art frames actually made and sold within the industry of which the applicants allegedly had knowledge. There is no requirement by either the Patent Act or the Patent Office Rules that an applicant “admit” that disclosed information is either prior art or that it is material. More specifically, Patent Office Rule 1.97 specifically states that:

(g) An information disclosure statement filed in accordance with this section shall not be construed to be a representation that a search has been made.

(h) The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in § 1.56(b).

Moreover, Rule 1.98 provides that all the applicant need to provide is:

(1) A list of all patents, publications, applications or other information for consideration by the office.

There is no requirement under the rules that the listed items be either identified as prior art or material to patentability. Rule 1.98 (a)(3)(i) only requires an explanation of relevance of any such listed patent, publication, application or other information where the “patent, publication, or other information that is not in the English language.” (emphasis added) None of the cited references are in a foreign language so there is no requirement under the PTO Rules for any explanation of relevance. The IDS submitted by Heartland fully complies with Rules 1.97 and 1.98, and therefore, cannot be the basis for a claim of inequitable conduct. Rule 1.56 clearly states that “the duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. (Emphasis added)



30. Moreover, there is no clear and convincing evidence that the Heartland or its patent attorneys did not disclose all material non-cumulative information of which they had knowledge in the Information Disclosure Statement filed with the Patent Office. The supposed material prior art of which the inventors allegedly had knowledge identified by Forest River is the Eliminator fifth wheel trailer, the Cherokee fifth wheel trailer, the Holiday Rambler fifth wheel trailer, the Road Master fifth wheel trailer frame, the Cardinal fifth wheel trailer frame and the Space Craft fifth wheel trailer. However, there is no clear and convincing evidence that any of the inventors either knew of these trailers, recognized any of these trailers as material prior art to their invention and intentionally withheld any of these alleged prior art fifth wheels from either the attorneys or the Patent Office for deceptive purposes. Moreover, for the most part, as will be discussed in more detail below, these alleged prior art fifth wheel trailers are merely cumulative of information provided to the PTO by Heartland by its IDS or found by the examiner in his search. "When a reference was before the examiner, whether through the examiner's search or the applicant's disclosure, it cannot be deemed to have been withheld from the examiner." *Molins PLC v. Textron, Inc.*, 33 USPQ 2d 1823, 1832 (Fed.Cir.1995).

31. With respect to the allegations of paragraph 49 of the Amended Answer and Counterclaim that defendant Heartland failed to disclose information about an "Eliminator" prior art trailer which was allegedly disclosed by a July 11, 2005 letter, contrary to Forest River's allegations, there is nothing in the July 11, 2005 letter from Forest River's Mr. Liegl to Heartland's attorney, Mr. Gallagher, that either identifies the "Eliminator" by name or provides any information whatsoever about its identity or construction. All the July 11, 2005 letter merely states is that "[q]uite a few years ago there was a certain recreational vehicle product that had a similar design to the one in question." (Emphasis added) Mr. Liegl suggests that Mr.

Gallagher "do some historical checking" to see if he can find this alleged "certain recreational vehicle product." This is not a sufficient disclosure of prior art to place any obligation on Mr. Gallagher to make a disclosure to the Patent Office. Further, to the extent to which this vague reference is referring to a trailer with a "V" or "Bull" nose, that concept is disclosed by U.S. Patent No. 4,767,132 – Avery. To the extent to which this vague reference is referring to a fifth wheel trailer with curved front corners, that concept is disclosed by U.S. Patent Application No. 2002/0003341 – Hall and foreign publication DE 3321306 uncovered by the examiner's search and listed as a cited reference in the '650 patent.. Both the Avery and Hull references were cited by the examiner in rejecting certain of the claims. Thus, the examiner was fully aware of prior art showing "V" or "Bull" nosed and curved corner trailers and fifth wheels and the Eliminator and other prior art showing the same concepts are merely cumulative and non-material.

32. There does not appear to be any clear and convincing evidence that anyone substantively involved with the prosecution of the '650 patent, and particularly the prosecuting attorneys, had knowledge of the Cherokee fifth wheel trailer (EX. 104) before the '650 patent issued, believed it to be material and withheld that information with an intent to deceive the examiner. Moreover, the Cherokee has both a "V" nose and curved front corners both of which concepts are disclosed by the above cited Avery, Hall and foreign publication references.

33. There does not appear to be any clear and convincing evidence that anyone substantively involved with the prosecution of the '650 patent, and particularly the prosecuting attorneys, had knowledge of the Holiday Rambler fifth wheel trailer (EX. 104) before the '650 patent issued, believed it to be material and withheld that information with an intent to deceive the examiner. Moreover, the Holiday Rambler has slanted or rounded front corners which are

disclosed in the above cited Hall application and foreign publication DE 3321306. Thus, even if the Holiday Rambler fifth Wheel trailer had been known to someone with a duty to disclose at a time during prosecution of the '650 patent, it is merely cumulative of information already before the examiner and therefore not material.

34. There does not appear to be any clear and convincing evidence that anyone substantively involved with the prosecution of the '650 patent, and particularly the prosecuting attorneys, had knowledge of the Space Craft fifth wheel trailer (Ex. 100) before the '650 patent issued, believed it to be material and withheld that information with an intent to deceive the examiner. Moreover, the Space Craft fifth wheel trailer has a "V" nose front which concept is disclosed in the above cited Avery and Hall references. Thus, even if the Space Craft fifth Wheel trailer had been known to someone with a duty to disclose at a time during prosecution of the '650 patent, it is merely cumulative of information already before the examiner and therefore not material.

35. There does not appear to be any clear and convincing evidence that anyone substantively involved with the prosecution of the '650 patent, and particularly the prosecuting attorneys, had knowledge of either the Road Master fifth wheel frame (§21 Amend. Ans. and CC) or Cardinal fifth wheel trailer frame (Ex. 40-41) before the '650 patent issued, believed it to be material and withheld that information with an intent to deceive the examiner.

36. It is not clear from the pleadings and interrogatories whether Forest River is contending that the Shadow Cruiser fifth wheel (Ex. 120), the Catalina Coachman fifth wheel (Ex. 114) or the Trail Bay Hauler fifth wheel toy hauler (Ex. 111) are prior art that was known to someone with a duty to disclose at a time during prosecution of the '650 patent, but to the

extent that Forest River is so contending, there does not appear to be any clear and convincing evidence that anyone substantively involved with the prosecution of the '650 patent, and particularly the prosecuting attorneys, had knowledge of the Shadow Cruiser, Catalina Coachman or the Trail Bay Hauler fifth wheels before the '650 patent issued, believed it to be material and withheld that information with an intent to deceive the examiner. Further, those trailers are merely cumulative of prior art disclosed to and before the patent office. The Catalina and Trail Bay trailers have a lower portion of the front edge that is sloped or curved upwardly from a lower front edge that has square corners. Such construction is disclosed in U.S Patent Nos. 6,860,545 – Ingram et al.; 6,343,830 – Ingram et al.; 6,231,115 - Crean and 5,746,473 - Crean. The Shadow Cruiser has a V nose and sloped front surfaces which is shown in Avery and Ingram et al. Thus, even if the Shadow Cruiser, Catalina Coachman or Trail Bay Hauler trailers had been known to someone with a duty to disclose at a time during prosecution of the '650 patent, those trailers are merely cumulative of information already before the examiner and therefore not material.

37. Forest River alleges in paragraph 52 of the Amended Answer and Counterclaim that Heartland “secretly” disclosed the Eliminator reference to the USPTO in a continuing application SN 11/834,214, did not inform Forest River of or allow Forest River to attend an interview regarding the examination of that continuation, filed an improper information disclosure statement after the interview and did not adequately comply with Rule 1.133(b) in connection with the prosecution of that continuation. These allegations fail to state a claim of inequitable conduct with respect to the '650 patent as the event occurred after the issuance of the '650 patent. Events occurring in connection with the prosecution of a continuation application after the issuance of the parent patent cannot, as a matter of law, render the parent

patent unenforceable due to inequitable conduct. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1370, fn. 10 (Fed. Cir. 2008).

38. Further, by law, patent applications are kept in confidence by the Patent Office, 35 U.S.C. §122, and “information concerning the filing, pendency, or subject matter of an application for patent, including status information, and access to the application will only be given to the public as set forth in §1.11 or in this section.” (PTO Rule §1.14). Rule 1.11 provides for access to a pending application only after publication of the application. Further, proceedings before the United States Patent Office on pending applications, whether published or not, are conducted *ex parte* which means that they are conducted only between the Patent Office and the applicant without the direct knowledge of or participation by any other party. The only participation permitted by third parties in pending published applications is a third party submission of prior art patents or printed publications as provided in Rule 1.99 which allows the submission of no more than ten such items of prior art. No explanation by the third party of the submitted information is permitted. This is the only participation by third parties permitted by the Patent Office in a pending patent application. Thus, Forest River could not have participated in the interview and Heartland’s alleged failure to permit such an intervention cannot form the basis for a claim of inequitable conduct.

39. In paragraphs 53 and 54 of the Amended Answer and Counterclaim, Forest River alleges that Heartland somehow improperly added claims to its continuing applications SN 11/834,214 and 12/315,894. The exact legal theory for these allegations of inequitable conduct with respect to the ‘650 patent is not apparent from the pleadings, and I know of no legal basis for such a claim. Moreover, these allegations fail to state a claim of inequitable conduct with respect to the ‘650 patent as these event occurred after the issuance of the ‘650 patent. Events

occurring in connection with the prosecution of a continuation application after the issuance of the parent patent cannot, as a matter of law, render the parent patent unenforceable due to inequitable conduct. *Star Scientific, Inc.*, 537 F.3d at 1370, fn. 10 (Fed. Cir. 2008).

40. Further, it is completely legally permissible under the Patent Act and Patent Office Rules for the applicant to file as many continuation applications from a pending parent application as the applicant chooses and is willing to pay for. Further, it is completely legally permissible to file as many new claims in those continuing application as the applicant wishes and is willing to pay for so long as those claims are supported by the written specification of the application. However, filing a claim not supported by the specification is only a basis for rejection of that claim by the examiner and not a basis for a claim of inequitable conduct. The examiner is fully capable of determining whether the claims are supported by the specification based upon the information contained in the specification. No additional information need be disclosed to the examiner, and thus, no material information can be claimed to have withheld from the examiner when making the determination of support.

41. In paragraph 55 of the Amended Answer and Counterclaim, Forest River alleges that certain named inventors are not “co-inventors” within the meaning of the patent act, that the error did not arise without deceptive intent and that Heartland’s failure to inform the patent office of these alleged facts was material to the patentability of the claims, and thus, in violation of rule 1.56. These allegations are not supported by either the law or the facts.

42. The Patent Act, 35 U.S.C. § 256 provides that “the error of naming persons who are not inventors shall not invalidate the patent in which the error occurred if it can be corrected as provided in this section.” Section 256 further states that “whenever through error a person is

named in an issued patent as the inventor, ..., and such error arose without deceptive intent on his part... the court before which such matter is called in question may order correction of the patent....” Thus, for Forest River to be able to sustain its allegations of inequitable conduct, it must prove by clear and convincing evidence that someone added their name as an inventor with deceptive intent to deceive the patent office, and that this information was known to someone with a duty to disclose and intentionally withheld from the patent office with the intent to deceive the patent office. There is no evidentiary support for the proposition that any of the named inventors added their name to the application as an inventor with deceptive intent or that such information was purposefully and intentional withheld from the patent office with deceptive intent.

43. At worst, it appears that the decision to add the names of all five owners of the company as inventors was the result of a misunderstanding on the part of those owners as to the meaning of invention, inventorship and the consequences of misnaming inventors. Mr. Rhymer testified that while he thought he was the inventor of the patent, he was the one that proposed all of the names because he didn't think it seemed "right for just my name to be on there. So when the question was asked to me, I answered 'well, I think we should all been on there.' ... It just didn't seem fair that just my name would be on there." Later, in response to the question "Do you know if Scott discussed the inventorship issue with an attorney when the application was pending?" he responded: "Meaning having multiple names on there? ... I don't know that was a problem." (Rhymer Dep. p. 327-8, 330). Mr. Tuttle testified that the reason all five owners were named as inventors was "we felt it was a team effort. ... We were all there for the discussions when we were trying to conceive this ... we felt like we all played a part." (Tuttle Dep. p. 106-70) Tuttle also testified that "there may have been some gray area in my understanding between

what ownership and what inventor, you know, rights and things are.” (Tuttle Dep. p. 85). Mr. Brady’s testimony is ambiguous at best. At page 245 of his deposition he testifies that he believes his “turning radius invention” is incorporated in all Heartland Fifth Wheel products, but at page 72 of his deposition he responded “no” to the question “have you ever invented anything?” However, in the context of the line of questioning at that point in the deposition, it appears that he was responding on the basis that the question was in the context of “apart from” the invention of the patent in suit has he ever invented anything? Apart from the ambiguity of whether Mr. Brady does or does not consider himself an inventor of the patent in suit, there is no testimony by Mr. Brady or other evidence to support a claim that he falsely caused his name to be added to the patent with any deceptive intent. Mr. Lantz testified that “as far as I was concerned, I was an inventor.” (Lantz Dep. p. 119). “My understanding is that I’m a named inventor and I have the right to know as an inventor what’s going on with the patent....” (Lantz Dep. p. 112). Mr. Lantz testified he didn’t know why the five inventors were named on the patent, and he has no “information that any of the inventors were named ... to deceive anyone.” (Lantz Dep. p.126). Mr. Lantz did concede that he doesn’t “know the legal definition of inventorship...” (Lantz Dep. p. 232), but that only indicates a basis for mistake but not a basis for deceptive intent. Finally, Mr. Lantz testified that he does not know if he is one of the three inventors who his attorney alleges “falsely asserted inventorship.” (Lantz Dep. p. 253). Interestingly, Mr. Lantz testified that it was not his recollection that John Rhymer “was the one that came up with the idea for how to improve the turning radius of the vehicle.” Rather, he testified that if he “had to make a decision, I think Tim Hoffman knew of the problem that was out there, the issue that we were trying to get around, and knew that there was a turning radius problem with fifth wheels.” (Lantz Dep. p. 76) Finally, Mr. Hoffman was not asked any



questions about his role in the development of the invention so there is no basis in his deposition to contend that he is or is not an inventor or that he caused his name to be added with deceptive intent.

44. While it is not clear from the deposition testimony exactly who the actual inventors of '650 patent are, it is clear that to the extent to which there is an error in inventorship, that error occurred as a result of mistake and without any deceptive intent on the part of any of the named inventors to add their names to the application. This conclusion is supported by the fact that all five of the named inventors immediately assigned their rights to Heartland upon execution of the application. There would be no motive whatsoever for any of the five named inventors to falsely and deceptively add their name to the patent application when they knew they were going to assign all their rights to the company. Thus, any error in inventorship that may exist was through mistake and can be corrected pursuant to 35 U.S.C. §256 and cannot be the basis for claiming either invalidity of the patent or inequitable conduct on the part of any of the named inventors.

45. As noted above Forest River also alleges that Heartland failed to inform the Patent Office of false inventorship in connection with a continuing application that was allegedly admitted in a deposition of Brian Brady and paid an issue fee to "close down prosecution" before a transcript of that deposition could be created. This claim is meritless in the present proceedings because it did not occur during the prosecution of the patent in suit, the only patent at issue at this time. Moreover, as pointed out above, the transcript of the Brady deposition does not support Forest River claim that Brady "admitted" not being an inventor of the patent in suit, and if it is ever established by clear and convincing evidence that Mr. Brady is not an inventor,

that error occurred by mistake and without deceptive intent on his part and can be corrected without invalidating the patent.

46. With respect to the claim that the inventors did not read the application sufficiently to understand its content and claims, and that Mr. Cooper or Mr. Gallagher knew or should have known this alleged fact and prevented the application from being prosecuted, there is no clear and convincing evidence to support this claim. Mr. Tuttle testified that he personally provided copies of the application to the inventors and that he saw them reading it. "I recall that as we sat in a room that different partners of mine were absolutely reviewing it and looking at it. . . . They had it in their hands, they saw it, they read it." (Tuttle Dep. p. 213)

47. Further, there is no evidence to support a claim that Mr. Cooper knew of any alleged failure on the part of the inventors to read the application. When Mr. Cooper sent the application to Heartland for execution he stated in his April 5, 2005 transmittal letter that "by signing the Declaration, you are declaring that you have reviewed and understood the contents of the application including the patent claims." (B&T 143) The Declaration was signed by the inventors and returned to him so he had every reason to believe that the inventors had in fact read and understood the application and its claims. Further, Mr. Gallagher who did not acquire the file until after the application had been filed would have no basis or reason to question whether the inventors had read and understood the application in light of the correspondence and signed declarations in the file. Further, at least one reported case has found that an inventor's failure to read an application before executing the Declaration is not a sufficient basis for a finding of either invalidity or inequitable conduct. *Regents of the Univ. of California v. Howmedica, Inc.*, 530 F. Supp. 846, 740-1 (D.N.J. 1981)

48. With respect to the claim in the response to Interrogatory 3 that the inventors falsely asserted inventorship, that claim is covered above and is without merit. As to Mr. Cooper, there is no evidence that he had any knowledge that any of the named inventors were not in fact inventors. In his March 11, 2004 letter transmitting the draft provisional application, he requested the "full name (including middle name) of each inventor." (B&T 043) In response to that request, Mr. Tuttle sent an email on March 29, 2004 listing the names and addresses of the five named inventors. (B&T 067) Those five names were listed in both the provisional and utility application as the inventors by Mr. Cooper based upon the information available to him. Mr. Cooper testified that "as par for the course, that -- those discussion [about inventorship] would take place" and there was "no change" in inventorship when the utility application was filed. (Cooper Dep. p. 33) Thus, there is no evidence to support a claim that Mr. Cooper knew that any one of the named inventors had falsely and deceptively asserted inventorship.

49. With respect to the claim in the response to Interrogatory 3 that the inventors or Mr. Cooper failed to disclose information required under 37 C.F. R. 1.56, this claim is covered below and there is no basis for this claim. There is no clear and convincing evidence that Mr. Cooper knew of any material information that was intentionally withheld from the Patent Office with deceptive intent.

50. With respect to the claim in the response to Interrogatory 3 that the prosecuting attorneys failed to gather and pass on information from the inventors with respect to the nature of the invention, this claim is without evidentiary support or merit. The Barnes & Thornburg file is replete with information, drawings and photographs provided by Heartland to Mr. Cooper regarding the scope of the invention. (See, e.g. B&T 02-040) Further, when Mr. Cooper forwarded a draft of the provisional patent application on March 11, 2004, he requested each

inventor “review this draft for completeness and accuracy, and provide us with comments or suggestions concerning any changes deemed necessary or desirable.” (B&T 043) Again when the utility application was prepared, Mr. Cooper sent a copy to Mr. Tuttle and requested if be reviewed for “errors and omissions.” (B&T 080) Thus, Mr. Cooper took appropriate steps to gather and accurately pass on information from the inventors regarding the nature of the invention.

51. With respect to the claim in the response to Interrogatory 3 that the prosecuting attorneys failed to gather and pass on information from the inventors regarding the known scope of the prior art within the industry, this claim is without evidentiary support or legal basis. Mr. Cooper did inform the inventors of the duty of disclosure and requested that they supply any known prior art information including “patents or literature ... earlier sales or public uses ... or items or processes related to the invention” in his letters of April 5 and 11, 2005. (B&T 141-145) Thus, there is no basis to contend that Mr. Cooper did not attempt to gather and pass on material information. Further, as discussed above, there is no evidence to support a claim that either the inventors or attorneys intentionally withheld any known material prior art. To the extent to which it is Forest River’s contention that the inventors should have disclosed their entire knowledge of the commercially available products in field of the invention, that contention has been found meritless by the Court of Appeals for the Federal Circuit. “To require the inventor to describe his entire personal knowledge in the field of the invention, however the knowledge was obtained, would be an unmanageable assignment. It is prior art that must be disclosed, prior art that is material to patentability.” *Upjohn Co. v. Mova Pharmaceutical Corp.*, 225 F.3d 1306, 1315 (Fed. Cir. 2000).

52. With respect to the claim in the response to Interrogatory 3 that the prosecuting attorneys failed to gather and pass on to the patent office information from the inventors regarding the level of ordinary skill of those involved in the design of travel trailers and fifth wheels, this claim is without legal basis. First, Rule 1.56 only requires disclosure of material prior art information. Rule 1.56 does not require any disclosure of the level of ordinary skill in the art to which the invention pertains. Further, nothing in the Patent Act requires disclosure to the Patent Office of the level of ordinary skill in the art. Section 112 of the Patent Act merely provides that the specification shall contain adequate description of the invention so as "to enable any person skilled in the art to which it pertains ... to make and use" the invention. This is merely a technical requirement for the content of the specification and not a disclosure requirement. Similarly, Section 103 of the Patent Act sets forth the test of whether prior art renders an invention unpatentable as obvious depending on whether "the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Once again this is a test to determine obviousness of an invention and not a disclosure requirement. Thus, there is no legal basis for a claim that the failure on the part of the attorneys to gather and pass on to the patent office information from the inventors regarding the level of ordinary skill of those involved in the design of travel trailers and fifth wheels constitutes inequitable conduct. There is no reported case to my knowledge that has ever found the failure to disclose the level of ordinary skill in the art to be a basis for inequitable conduct.

53. With respect to the claim in the response to Interrogatory 3 that the prosecuting attorneys failed to gather and pass on to the patent office information from the inventors regarding the differences and similarities between the claimed invention and the prior art, this

claim is without evidentiary support or legal merit. As discussed above, there is no requirement in the Rules that the inventors or attorneys provide information regarding the “differences and similarities between the claimed invention and the prior art.” The only requirement is that any known material information be disclosed to the Patent Office in the manner specified in Rules 1.97 and 1.98, and there is no requirement for that information to be “admitted” to be prior art or that it be discussed, described or differentiated in any way except as provide in Rule 1.98 (a)(3)(i) for prior art that is not in the English language. Further, as discussed above, there is no evidence that the inventors did not pass on to the attorneys information they knew was material to the application or that attorney’s did not pass on all of the material prior information of which they had knowledge.

54. With respect to the claim in the response to Interrogatory 3 that the prosecuting attorneys failed to claim the real invention of the inventors, did not comply with 35 U.S.C. §112 by not particularly pointing out and distinctly claiming the subject matter which the named inventors regarded as their invention and for not enabling one of ordinary skill in the art to make and use that invention, this claim is without evidentiary and legal support. Forest River’s contention appears to be that the inventors didn’t considered the configuration of the frame of the trailer as claimed in the ‘650 patent to be their “invention.” However, the documentary evidence refutes that contention. In the disclosure materials provided to Mr. Cooper by Heartland are drawings of the various configuration of the frame that are incorporated into the patent. Also, in Heartland’s written disclosure, it is stated that “Heartland has engineered a unique new 5<sup>th</sup> wheel concept.... This revolutionary concept involves both rethinking how the steel frame of the 5<sup>th</sup> wheel is designed.... The first step was cutting off the corners of the upper front section of the frame instead of extending them all the way out at a 90° angle, as is the case

in a traditional 5<sup>th</sup> wheel frame design.” (B&T 009) Thus, it is quite clear that the inventors considered the frame design to be a significant aspect of the invention. The claims of the ‘650 patent presumptively do distinctly claim that invention because they were allowed by the examiner after his review of those claims. One of the patent examiner’s duties in examination of a patent application is to make a determination of whether the claims and specification meet the requirements of §112. Also, the specification is presumed to meet the enablement requirement of §112 as all of the formal §112 objections to the specification made by the examiner were corrected by the applicant during prosecution and the examiner allowed the patent to issue. Moreover, the written description and drawings adequately enable one of ordinary skill in the art to make and use the claimed invention. Further, I know of no reported case that has ever found a failure to comply with the enablement or claiming requirements of §112 to be inequitable conduct.

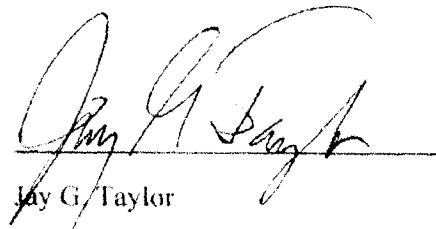
55. Finally, there is absolutely no clear and convincing evidence on the record that anyone substantively involved with the prosecution of the ‘650 patent withheld any material non-cumulative information from the Patent Office with the intent to deceive the Patent Office. Mr. Lantz testified that he did not “intentionally” withhold or misrepresent any prior art to the Patent Office, and if it did occur, it was done “inadvertently.” (Lantz Dep. p. 124). Mr. Tuttle, the person most involved in the prosecution of the patent application, testified that he did not “intentionally lie to the patent office,” did not “intentionally deceive the patent office in any way,” did not “intentionally withhold any references of any type from the patent office,” nor did any of the inventors “to his knowledge.” (Tuttle Dep. p. 92-93). Additionally, Mr. Tuttle did, in the invention disclosure, discuss the existence of a patent on a Glendale fifth wheel that attempted to solve the turning radius problem with a “very different” solution and design which

involved “going over the cab of the truck with their unit,” (B&T 009) This illustrates that Mr. Tuttle thought he should bring this information to Mr. Cooper’s attention although it was “very different” solution and design and not material to the Heartland invention. Mr. Brady had no involvement with the prosecution of the patent after signing the Declaration and there is no clear and convincing evidence that he was either aware of any of the allegedly withheld material prior art or that he withheld such prior art with deceptive intent. Mr. Hoffman was not specifically asked about his knowledge of prior art or whether or not he withheld any such knowledge from the Patent Office during his deposition. Thus, there is no evidence upon which to base a claim of inequitable conduct against Mr. Hoffman. Finally, Mr. Rhymer testified that it was Mr. Tuttle’s responsibility to “gather up all the prior art” and they “discussed it” and he told Mr. Tuttle “everything that I knew about prior art.” (Rhymer Dep. p. 213-214). Mr. Tuttle also asked him several times “do you see this as prior art?” (Rhymer Dep. p. 215). He also testified that he “did not consider any horse trailers or cargo trailers – travel trailers as Prior Art according to our fifth-wheel RV” and in his view “there is a big difference between the ‘turning radius issues for travel trailer’ and the ‘turning radius issues for fifth-wheels.” (Rhymer Dep. pp. 328, 331) Thus, it appears from the record that Mr. Rhymer attempted in good faith to provide his knowledge of what he thought was relevant prior art and cannot be said to have withheld any information with intent to deceive. Thus, there is no clear and convincing evidence that any of the inventors either withheld from or misrepresented any material non-cumulative information to the Patent Office with intent to deceive the Patent Office. To the extent to which there was any failure to disclose known information by the inventors, that failure was inadvertent and without any deceptive intent.



56. Additionally, there is no evidence that either of the patent attorneys involved with the prosecution of the '650 patent application failed to disclose any material prior art of which they had knowledge during the prosecution of the '650 patent. Mr. Cooper transferred the application file to Mr. Gallagher after filing the application, but before the information disclosure statement was due. His duty to disclose terminated with that file transfer. In the transferred file was a list of (Cooper Dep. Ex 3) and copies of patents Mr. Cooper had apparently located although he does not recall exactly how those patents were found. He testified that those patents either came from the client or were found in a formal or informal search. (Cooper Dep. p. 40) Mr. Gallagher testified that he reviewed the file and disclosed all of the patents he found in the transferred file in the Information Disclosure Statement filed with the Patent Office. (Gallagher Dep. p. 30-31) There is no credible evidence that either of the attorneys had knowledge of and intentionally withheld any other material prior art.

57. In conclusion, I find no evidentiary and/or legal basis for the claims of inequitable conduct made by Forest River in this case.



Jay G. Taylor

**EXHIBIT A**

JAY G. TAYLOR  
11625 Tidewater Drive S.  
Indianapolis, IN 46236  
(O) 317-826-0152  
(F) 317-826-0152  
(C) 317-431-9034  
(H) 317-823-8343  
Email: jay@jaytaylor.biz

EXPERT  
WITNESS:

Mr. Taylor has been an expert witness in connection with a number of litigated matters. In particular, he served as an expert and was deposed in connection with the evaluation of the intellectual property of Baldwin United Corporation in connection with Baldwin United Corporation's Bankruptcy. He was retained and deposed as a patent damages expert for Arachnid, Inc. in connection with patent litigation against London Distributing, Corp. and Merrit Industries, Inc. He was retained and deposed as a patent office practice expert for Uniden Corporation of America, Inc. against AOR Limited and Crum Development Corporation. He was deposed and testified at trial as a patent expert on design patent infringement and validity for ILCO Corporation in the case of Best Locks Corp. v. ILCO Corp. He was retained by Innotek Pet Products, Inc. as a patent expert in a case against Radio Systems, Inc. He was retained by Chubb Custom Insurance Co. as expert on reasonable compensation for patent defense. He was deposed and testified at trial as an expert witness on the issues of inequitable conduct and willful infringement for Gerdes GmbH in the case of Stant, Inc. v. Gerdes GmbH. He was retained by and deposed as an expert witness on the issue of inventorship for International Game Technology, Inc. in the case of Goff v. Harrah's Operating Co. Inc. et al.

EDUCATION:

B.S.M.E., University of Cincinnati, 1964  
J.D. (magna cum laude), Indiana University, 1967

HONORS:

Pi Tau Sigma, Mechanical Engineering Honorary

Order of Coif, Law Honorary

Indiana University Law Journal, Editorial Board. Author of Use of An Arbitration Clause As A Defense To 8(a) Charge Resulting From The Employer's Refusal To Bargain When Acting Unilaterally With Respect To A Mandatory Subject of Collective Bargaining, Indiana Law Journal, Vol. 41, p. 455.

Author, Intellectual Property: A General Practitioner's Guide, Illinois Bar Journal, February 1990, Vol. 75, No. 3, p. 104, reprinted Res Gestae, April 1991, Vol. 34, No. 10, p. 452. Contributing Author, Reflections On The Practice of Patent Law, The Art and Science Of Patent Law, Aspatore Books, 2004

## EMPLOYMENT

### HISTORY:

1967 - June to October - Associate, Kirkland and Ellis

November 1967 - December 1969 - U.S. Army, First Lieutenant and Captain, Contract Administration Officer, Ammunition Procurement and Supply Agency

December 1969 - December 1977 - Kirkland and Ellis, Partner (1973-77)

January 1978 - December 1989 - Haight & Hofeldt, Partner

January 1990 - December 2008 - Ice Miller, Partner

## BAR

### ADMISSIONS:

Supreme Court of Indiana, Supreme Court of Illinois

U.S. District Courts for the Southern District of Indiana, Northern District of Indiana, Northern District of Illinois (including the Trial Bar) and Western District of Michigan.

United States Court of Appeals for the Federal, Second, Seventh Circuits

United States Patent and Trademark Office (Reg. No. 25,799)

## LEGAL

### EXPERIENCE:

Has been extensively involved in patent, copyright, trademark, unfair competition, antitrust, trade secret, and product liability consultation and litigation.

Has handled litigation and prosecution matters in such diverse mechanical and electrical fields as, for example, thermostatic mixing valves, children's car seats, dental methods and devices, hearing protection devices, soil aerating equipment, computer software, heart defibrillators and pacemakers, urological stents, ceramic products and processes, data recording and transmission equipment, electronic musical instruments, high voltage transmission equipment, food processing equipment and processes, vending equipment, electronic games, railroad equipment, welding equipment and processes, UV curable inks and coatings, plastic lamina, and RF curable particle board manufacturing processes

Also has had extensive experience in trademark, copyright and software litigation, prosecution, licensing and counseling.

## PROFESSIONAL

### ORGANIZATIONS:

Member of the American Bar Association, Indiana Bar Association, Intellectual Property Law Association of Chicago, American Intellectual

Property Law Association, Federal Circuit Bar Association and the Patent Office Society.

Past Chairman of the Intellectual Property Law Section of the Indiana Bar Association.

**OTHER RECOGNITIONS:**

Listed in Best Lawyers in America

Listed in Who's Who

Listed in Who's Who in American Law

Selected as an Indiana Super Lawyer, 2004, 2006, 2007, 2008

Martindale-Hubbell AV rated