

Connecticut Law Tribune

September 3, 2012

An ALM Publication

Patent Litigator Beats Back Nikon Claim

By THOMAS B. SCHEFFEY

Nikon Metrology et al. v. Faro Technologies: After a two-week trial in U.S. District Court in Boston, patent litigator **William J. Cass**, of Hartford-based **Cantor Colburn**, successfully defended a claim brought by Nikon for \$18.3 million in infringement damages.

The patent in question covered a complex, electronic measuring device produced by Florida-based Faro Technologies.

Twenty years ago, Faro inventors collaborated with Stephen Crampton, a British inventor who was CEO of 3D Scanners, a tech start-up. In 1995, Crampton applied for a British patent for an invention that combined a mechanical arm and a laser scanner, both connected to computer software. With multiple passes, the laser camera and computer combined to map exact 3D measurements of complex parts — a boon in reverse-engineering of any solid object.

In contrast, Faro's early products measured objects with a solid fingertip-like point, calculating dimensions by touching the object. According to Faro's trial brief, its employee, Gregory Fraser, suggested to Crampton the idea of combining the laser scanner and the Faro arm. This contact occurred well before Crampton's patent date, Fraser contended.

The resulting Faro Technologies product was known as the Data Creator.

Crampton's 3D Scanners subsequently sold its patents to a competitor, Metris, which was later purchased by Nikon. In 2008, to its surprise, Faro was sued for patent infringement by Metris and 3D Scanners. For the past four years, Cass and fellow Cantor Colburn partner **Andrew Ryan** have been piecing together Faro's defense.

In today's age of electronic discovery, some of the most potent evidence was old paper documents. For Cass, a big break came when a witness recalled that he had an old 3D Scanners press release in files stored in his basement. It read in part, "The two technologies on which the Data Creator is based were developed by 3D Scanners and Faro Technologies (Lake Mary, FL)."

That statement clashed dramatically with the testimony Cass and Ryan heard from Crampton

when they traveled to England to take his deposition. To qualify for a patent, Crampton had to swear that he was the sole inventor. In his depositions, Crampton took credit for the inventions, or said he couldn't remember key developments.

That deposition testimony got him into trouble in a companion matter, a bench trial over a related Metris patent that was tried in Boston before U.S. District Judge **Patti B. Saris** in 2010. In that case, Saris found that Crampton had perjured himself in his testimony about the invention, and had intentionally deceived the patent office. The Nikon jury was not allowed to hear the results of that case, on grounds that those facts would be more prejudicial than probative.

In last month's trial, also before Judge Saris, Faro defended against the infringement claims on grounds that, to the extent Crampton is an inventor of any of the claimed inventions, he is at most a co-inventor.

Faro also argued several other theories of why the Nikon claim should be rejected. One of them was that all the elements of the measuring device had already been invented, and that the idea to put them together was obvious. In intellectual property law, only "non-obvious" — or original — uses of existing items or systems are patentable.

The patented originality that Nikon was claiming boiled down to a specific combination of design features, described as the multiple-jointed arm with a data communication link to transmit data.

In closing arguments, Cass attacked the inconsistencies in Crampton's testimony. Crampton had said there was no port to hook up a scanner gun to the robot arm in Faro's 1995 device, the Bronze Arm. Evidence indicated that there was clearly such a port.

Cass asked the jury: "Is that perjury? Did they lie to you? Is there any way a Ph.D. with three degrees in engineering, who's a consultant on this case for Nikon, who's come all the way from England to testify...how can they testify it didn't have a port for the connection of a laser? Imagine an inventor who doesn't know how his invention worked."

The case had David versus Goliath undertones, which Cass emphasized in his final arguments.



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Cantor Colburn partner William J. Cass represented a Florida company that marketed an electronic measuring device that combined a mechanical arm and a laser scanner.

"Remember, Faro is a speck of dust compared to Nikon." Faro has annual sales of "a couple hundred million. These [plaintiffs] are multi-billion dollar international companies." A Nikon victory, he said, would "destroy" the Florida company.

Nikon was represented by **Eric M. Acker** and **Mary Prendergrast**, of San Diego's **Morrison & Foerster**.

Last month, Nikon won a re-issued patent from the U.S. Patent and Trademark Office, and Acker told the jury it was powerful evidence that the patent was valid and enforceable. Acker was indignant in his closing arguments: "And Mr. Cass wants to wave it around and say it's a sham? This is the Patent Office of the United States Government. It's not a game."

Acker asked for \$18.3 million in damages to cover the alleged infringement, over a period in which Faro made \$32.3 million in revenue and \$24 million in profits for the device.

Ultimately, after 10 hours of deliberation, the jury returned a defense verdict for Faro on Aug. 9. It agreed with Nikon that Faro had been infringing, but concluded the patent was invalid for obviousness. Cass expects Nikon to appeal, but Acker did not return an e-mailed request for comment, or to say whether his client planned to do so. ■