

## Startling Reversal In Patent Fight

Bloomfield firm uses discovery abuses To turn defeat into victory

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Cantor Colburn intellectual property litigator William J. Cass couldn't believe his eyes when he glimpsed at his opposing counsel's briefcase as the defense was about to present its case in U.S. District Court in New Haven last May.

It was the beginning of what resulted last month in a dramatic reversal of fortune for the litigants in the patent infringement suit.

From a distance, the contents looked like ordinary Polaroids. But Cass suspected they were scanning electron microscope (SEM) originals critical to his task of enforcing valuable dental enamel patents owned by his Wallingford client, Jeneric/Pentron.

The SEMs weren't much bigger than playing cards, and had been demanded four years earlier in discovery requests to the alleged infringers, Liechtenstein-based Chemichl A.G. and its Rhode Island distributor, Dillon Co. Inc.

Instead of the originals, Cass only received fuzzy photocopies of the molecular structures of the enamel. Now, five originals had materialized coincident with the arrival from Liechtenstein of the trial's key defense witness: Dr. Rudolph J. Michl, Chemichl A.G.'s founder and CEO.

A few days earlier, Michl flew to the U.S. to take the stand, and brought along the long lost SEMs. His court role had expanded due to the death of a top Chemichl inventor and scientist, Gerhard Behan, in 2000, in the midst of discovery in the case.

Now, in mid-trial, what the newfound images would show was anyone's guess. Cass addressed Senior U.S. District Judge Ellen Bree Burns: I happened to glance over to Mr. Sommer's desk and I saw some micrographs; and I

asked him; I said, Are those micrographs that are now going to be introduced in your case?

Defense lawyer Peter K. Sommer, of the Buffalo, N.Y., firm of Phillips, Lytle, Hitchcock, Blaine & Huber, said the images from the University of Zurich were just recently discovered. The night before, when Michl first gave them to him, Sommer said he immediately checked the discovery documents. I could see they should have been disclosed; which is what Sommer told Burns he'd planned to do at the first opportunity. I'm standing here with egg on my face, he conceded.

Strategically, Cass had been dealt five wild cards. He and his experts had never studied the images. To be safe, he requested they be excluded, which Burns ordered.

The defense went ahead with its case, in which it contended Chemichl had been producing its own dental enamel mix for years before Jeneric patented its own legally indistinguishable compound. It defended on grounds that, even if the Jeneric patent had been infringed, it was actually invalid because the same product had been used in the public domain for years before Jeneric obtained its patent.

During cross examination of Jeneric's scientific expert, Sommer ridiculed the poor quality of the SEM photocopies as the basis for the expert's opinion that Jeneric's enamel was unique and fully entitled to its patent.

The jury ruled against Jeneric on one critical count. It agreed its enamel compound had been in public use, and that its patent was worthless.

### Unconventional Win

But the jury's conclusion was just the beginning for Cass and his Bloomfield-based firm. In post-trial motions, he moved to explore the excluded SEMs, and pressed further into undiscovered discovery. The firm counseled with appellate lawyer Mark R. Kravitz, of Wiggan & Dana.

Over the past summer and fall, Michl's company was urged to finally produce other critical discovery data, including four lab record books of the now-deceased inventor. From that, a brand new picture arose, as recounted in Burns' Feb. 27 decision, which dramatically reversed the jury's verdict.

Even when scientist Behan was healthy, he hadn't had to strictly comply with the U.S. discovery demands, because, as Burns noted in her opinion, Michl testified he didn't want to bother Behan. At one point, Michl, who is bilingual, said he didn't pressure lab personnel with the details of discovery because their English was only fleeting and they didn't comprehend legalese.

When Cass moved for a new trial based on newly-discovered evidence and discovery abuses, Burns noted potential procedural obstacles. Chemichl could object to the admission of Behan's work and writings as evidence, due to authentication problems now that he is dead, the judge noted.

Instead, Burns took a more dramatic step than simply granting a new trial. She used her sanction powers to completely reverse the outcome of the trial. Chemichl's discovery misconduct has permeated this litigation, Burns ruled, overturning the jury's finding of a prior use.

The judge reasoned that so much evidence had come in to build Jeneric's case that the jury, if it heard the case again, would probably rule in favor of the American company. She awarded Jeneric its fees and costs for its post-trial discovery efforts.

Chemichl has vowed an appeal, but low-key Cass is enjoying his unconventional win. It was a team effort. I feel like I got to the end zone, but it was a wild way to get there. •