

INVESTIGATIONS FOR INTELLECTUAL- PROPERTY LITIGATORS

The Mintz Group has extensive fact-gathering experience in litigation involving intellectual property, including patents and trade secrets, copyrights and trademarks, counterfeits and gray-market goods, and false advertising.

Much of our investigative work for intellectual-property litigators involves tracing the origin of products, documents and ideas.

- When a client's goods surface in unauthorized places, we track them back to their sources.
- When a client finds a rival's products too similar to its own, we interview the rival's former employees to explore whether there is a basis for a lawsuit.
- When key employees jump to competitors, we dig deeply (including in the laptop computers they turn back in) for trade secrets they may have stolen.

We also conduct due-diligence inquiries before transactions to determine the bona fides of intellectual property. This was a focus of the chapter that Jim Mintz authored, "Due Diligence Investigative Technology and Know-How," for the reference book *Due Diligence for Global Deal Making* (published in 2002 by Bloomberg Press; available from the Mintz Group on request).

The Mintz Group has conducted investigations particularly in the following kinds of intellectual-property disputes:

Patents and trade secrets

We are often assigned to investigate apparent trade-secret thefts by clients' departed employees or other insiders. In one matter, for example, a computer company hired us after learning that a departing scientist had e-mailed some of its trade secrets to a professor in Japan before quitting to join a competitor. We found that the professor was employed by the competitor and that it was a subsidiary of a Japanese multinational—deep pockets for the theft-of-intellectual-property lawsuit our client brought.

In other cases, our investigations have focused on corporate outsiders who somehow got access to a client's technology. For a client who invented technology that he believed a dot-com misappropriated, we interviewed everyone who had physical access to the client's materials and identified one with ties to the dot-com. We also found that a friend of our client, in whom he had confided his trade secrets, had a substantial stake in the dot-com.

Some details in these case studies have been changed to protect client confidentiality.



Copyrights and trademarks

We have succeeded on a number of assignments to trace the use of a name or image in the marketplace.

The Mintz Group is experienced at determining whether infringing product is for sale, including through pretext approaches that we can then explain in affidavits or testimony.

For example, in recent years we have helped a number of litigators successfully sue commercial websites for violating copyrights. These assignments often begin with identifying the principals behind the sites. We also helped determine damages in one case by finding out from former executives how much the website anticipated earning from the copyright violation.

Royalties

We have helped artists get the facts behind surprising numbers that turned up in royalty audits. In one case, *Fortune* magazine reported:

“Mintz was hired by the Beatles to find out if, as they suspected, Capitol Records had cheated them by secretly selling millions of albums. Using database and old newspaper stories to find people who had worked in the record business 30 years ago, Mintz found the widow of a wholesaler with an attic full of business records. After hours of sifting through boxes, Mintz discovered a check confirming the secret sales. Capitol settled the suit for a reported \$80 million....”

Counterfeits and gray-market

We have traced all sorts of counterfeit and gray-market products to their sources, almost invariably across borders, for rights holders in industries as diverse as apparel, pharmaceuticals, entertainment and machine parts. In one case, we gathered evidence for a rock'n'roll group's lawyers that they used as the basis for cease-and-desist letters to dealers in bootleg CDs. We revisited one of these dealers after he received the lawyer's letter, and the infringer obligingly told us: “We got a letter, so we had to move the bootlegs to the back room.”

The press has reported on the Mintz Group training in-house company investigators in how to combat counterfeiting.

False advertising

We gather evidence, often including photographs, about opponents' advertising. And we have tested claims in advertisements, for example exposing as rigged a purported head-to-head test between our client's product and competitors'.

Contact

Staci Dresher 415-765-9900 sdresher@mintzgroup.com