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# 10 Things Patent Owners Should Consider Before Filing a Patent Lawsuit

**WRITTEN BY**

Pantelis Takos | Gregory D. Len

Patent litigation is a complex and strategic endeavor, requiring thorough preparation and careful consideration. Before proceeding with a lawsuit, patent owners should evaluate several critical factors to refine their strategy and increase their likelihood of success. Here are 10 essential considerations:

**1. Understand Your Patent Portfolio**

Begin by thoroughly assessing what you own. A comprehensive review of your patent portfolio will help you understand the scope and value of your patents. Consider the breadth of your claims and the remaining lifespan of your patents. Understanding the scope of your patents is crucial, as it determines the extent of protection and possible recovery. For example, are there open continuations that could allow you to adjust your claims if necessary? The ability to redraft claims allows you to expand the patent's scope to include possible variations of target product designs, limiting infringers' ability to escape liability, and allows you to limit the scope to avoid potential invalidity challenges.

Furthermore, an extensive patent portfolio comprising several patents or patent families provides flexibility to assert a wider variety of claims. This flexibility creates a strategic advantage during litigation by safeguarding your lawsuit against failure due to the loss of any single claim from an invalidity finding or a voluntary withdrawal for other strategic reasons.

**2. Evaluate Patent Validity and Enforceability**

Ensure your patents are valid and enforceable. This includes checking maintenance fees and expiration dates. Additionally, patent owners should analyze the history of assignments as well as any licenses to determine who else might have rights in the patent. A patent is not enforceable against a party who already has a right to use the patented subject matter. A patent owner can also conduct a prior art search to assess the strength of its patents and identify any invalidity weaknesses, such as closely related prior art.

Verify that your products are appropriately marked according to the marking statute.[1] Under the marking statute, a patent owner can only begin collecting damages for a patented article after appropriate notice, such as affixing the patented material with the appropriate patent number. This, however, does not apply if there are no products to mark,[2] such as where you do not manufacture a product, your own products do not practice the patent, or you plan to assert only method claims.[3]

### 3. Identify the Proper Defendants

Determine who infringes on your patents and the total universe of parties you could capture in litigation. Analyze the corporate structure of your target, including parent or child companies, and consider upstream or downstream parties like manufacturers, suppliers, and distributors. Understanding the full scope of potential infringers can help you strategize effectively and maximize the impact of your litigation.

### 4. Assess the Threat of Countersuit

Investigate whether the anticipated defendants have patents of their own or are part of a patent pool. Consider whether there are any products of yours the defendants might allege infringement against. Understanding the potential for a countersuit is crucial, as it can significantly impact your litigation strategy and outcomes.

### 5. Choose the Right Venue

Decide whether to file in the U.S. International Trade Commission (ITC or Commission), a district court, or both. The ITC is an administrative law court and a popular venue for efficient patent litigation. The ITC's statutory mandate to issue a finding within 18 months of filing and ability to award an injunction on importing foreign infringing products can provide a critical advantage. However, the ITC cannot award monetary damages. Therefore, patent litigants often file simultaneous lawsuits in district court and the ITC for the opportunity to secure both a prospective exclusion order from the Commission and past monetary damages from the district court.

Consider that the ITC requires complainants (plaintiffs) to prove they have a "domestic industry." To meet the domestic industry requirement, complainants must prove they have made (A) significant investment in plant and equipment; (B) significant employment of labor or capital; or (C) substantial investment in its exploitation, including engineering, research and development, or licensing.[4] Additionally, complainants must show the investments are directed to products or services within the U.S. that practice at least one claim of the asserted patents. Domestic industry must be properly pleaded in the complaint, and the Commission may order a 100-day proceeding on the issue.[5] Thus, you should determine the strength of your domestic industry claims before filing suit.[6]

For the district court, consider factors like the defendant's state of incorporation, principal place of business, and physical locations. Research the related court's familiarity with patent cases and review local patent rules, which may be favorable for your goals. Some district courts are unfamiliar with patent cases, so it is essential to choose a venue that aligns with your litigation strategy. Additional considerations could include patentee win rate and venue transfer rate.

### 6. Gather Evidence

Start collecting evidence early. This could include researching the related technologies. Does the target company advertise the alleged products or features on their website? Have they published articles on the subject matter? Sometimes preparing for patent infringement allegations requires purchasing and inspecting products in the market.

Contact the named inventors on the patents. Named inventors may have intimate knowledge of the relevant

technology, related products, and distinctions over the prior art. They will also likely become involved during the course of the litigation, including depositions. Your current or past relationships with the named inventors could become a critical point during litigation.

Build out claim charts to assess the strength of your infringement claims. Gathering robust evidence is critical to substantiating your claims and strengthening your case. An experienced law firm can help you in this process.

**7. Consider Costs**

Litigation can be expensive. Factor in costs for technical and damages experts, filing fees, and legal fees. Decide whether to opt for hourly or alternative fee structures, including contingency fees and fees per milestone. Understanding the financial implications of litigation is essential for budgeting and ensuring you have the resources to see the case through to completion.

Weigh the potential litigation costs against impacts to the business. While litigation can be expensive, allowing infringers to continue unchecked could be much more costly when considering lost sales, market share, and future opportunities.

**8. Define Your Goals**

Clarify what you want to achieve from the lawsuit. Are you seeking a lump-sum payment, a running royalty, a license agreement, or an injunction? Consider the remaining years on your patent and whether you want to license the technology, especially if it is related to your core assets. Defining clear goals will guide your litigation strategy and help you measure success.

**9. Plan Your Timeline**

Understand the timeline for litigation. District court cases will likely take more than two years, while ITC investigations are quicker, lasting fewer than 18 months. Consider how willing you are to settle prior to a resolution at trial or appeal. Weigh the time versus money impact on your business. Planning your timeline is crucial for managing expectations and aligning litigation with business objectives.

**10. Prepare for Potential Disruptions to the Business**

Litigation will likely require input from designers, inventors, and management. Depending on the technology, engineers and developers may have to take time to explain the complexities of the technology to your attorneys as well as the history of development – especially in the early stages. Your employees are the best source of this information and can be invaluable for the patent litigation process. Consider that the opposing party may want your employees to give deposition testimony during discovery.

Be prepared for document production. Establish a litigation-related document retention protocol and be ready to produce internal documents to opposing counsel during the discovery process. Discovery will be subject to a court-issued protective order governing the handling of confidential business information. Preparing for the business impacts of litigation readies your organization to support the legal process without disrupting operations.

In conclusion, by carefully considering these factors, patent owners can strategically plan their litigation approach, minimizing risks and maximizing potential rewards. A well-prepared lawsuit can protect your intellectual property and strengthen your competitive position in the market.

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[1] Under 35 U.S.C. § 287 ("the marking statute"), patentees must provide prior public notice to recover damages in any infringement action for patented articles. Typically, a patentee satisfies the marking statute by fixing the word "patent" and the number of the related patent or patents onto the patented article.

[2] *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1220 (Fed. Cir. 2002).

[3] *Crown Packaging Tech., Inc. v. Rexam Beverage Can Co.*, 559 F.3d 1308, 1316-17 (Fed. Cir. 2009); *Am. Med. Sys., Inc. v. Med. Eng'g Corp.*, 6 F.3d 1523, 1538 (Fed. Cir. 1993).

[4] *Lashify, Inc. v. International Trade Commission*, 130 F.4th 948, 955 (Fed. Cir. 2025).

[5] https://www.usitc.gov/press_room/featured_news/pilot_program_will_test_early_disposition_certain.htm

[6] For additional information on pursuing litigation at the ITC, please see the article "The Top Five Challenges of Pursuing Litigation at the ITC."

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