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## a Review of 2009 Video Game Litigation and Selected Cases

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# Complex Patent Cases: Observations from the Bench

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## I. INTRODUCTION

In 2002, plaintiffs filed thirty-two patent cases in the Eastern District of Texas.<sup>1</sup> Just four years later, that number grew to 568.<sup>2</sup> With such a great volume of lawsuits comes experience in managing such cases, as well as greater insight into what constitutes as both effective representation and common mistakes. Patent cases are not only administratively challenging and technologically complex, but they can also be significant financial burdens for the parties.<sup>3</sup> Furthermore, when multiple parties, multiple patents, multiple claims, and multiple accused products are involved, the costs and complexities will often increase exponentially.<sup>4</sup> In these large and complex cases, the parties can spend a great deal of time and effort during the discovery and pretrial hearing stages of their cases. This article will examine some of the major obstacles to the efficient adjudication of complex patent cases and provide observations on effectively managing them. This article will also outline procedures and observations regarding the discovery and pretrial

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1. Yan Leychikis, *Of Fire Ants and Claim Construction: An Empirical Study of the Meteoric Rise of the Eastern District of Texas as a Preeminent Forum for Patent Litigation*, 9 YALE J. L. & TECH. 193, 204–205 (2007) (listing the number of patent cases filed in the top ten districts from 2002 to 2006).
2. *Id.*
3. *See id.* at 233 n.21 (a 2003 survey found that companies spend an average of two million dollars solely on legal expenses in a single patent case).
4. *See Linex Tech., Inc. v. Belkin Int'l, Inc.*, 628 F. Supp. 2d 703, 712 (E.D. Tex. 2008) (noting that because numerous parties and accused products are involved, the level of complexity of the case greatly increases).

hearing stages of litigation while conveying pitfalls to avoid and techniques that may be used to ensure effective representation by counsel.<sup>5</sup>

## II. DISCUSSION

As previously noted, this article will address two main topics. First, it will consider the complications associated with litigating cases involving multiple parties, patents, claims, and accused products. These cases can be very difficult to manage. However, employing sound case-management techniques can help the Court and the parties resolve their disputes in a more efficient manner.<sup>6</sup> Second, this article will examine the discovery phase in litigation, as well as the pretrial hearing. Absent proper preparation, these phases can be arduous, complex, and demanding.<sup>7</sup> Again, sound practices can make these stages easier on both the Court and the parties. Hence, the purpose of this article is to provide observations from a judicial perspective that may assist practitioners in effectively presenting their patent case.<sup>8</sup>

### A. Multiple Parties, Patents, Claims, and Accused Products

Cases involving multiple parties, multiple patents, numerous claims, and multiple accused products are complicated and difficult for both the parties and the Court to manage.<sup>9</sup> Absent diligence and preparation in the early phases of litigation, these complex patent cases can become unmanageable. However, there are a number of ways that the parties can prevent these cases from spiraling out of control. The following sections propose methods of effectively managing and presenting complex patent cases. Each section considers a different stage in the litigation process.

#### 1. Infringement and Invalidity Contentions

The local patent rules of the Eastern District of Texas require the parties to set forth their infringement and invalidity contentions in the early stages of

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5. The statements and opinions presented in this article are those of only this author and do not reflect the views of the United States District Court for the Eastern District of Texas, other judges, or any other entity. Moreover, this article does not implicate any pending or future case, each of which will be decided on its individual facts.
  6. Statements made in this article refer only to the local practices, opinions, and experience of litigating in the Eastern District of Texas. As a result, hereinafter, the Eastern District of Texas will be referred to as "the Court."
  7. *See Nike, Inc. v. Adidas Am., Inc.*, 479 F. Supp. 2d 664, 666 (E.D. Tex. 2007) (Clark, J.); *Computer Acceleration Corp. v. Microsoft Corp.*, 503 F. Supp. 2d 819 (E.D. Tex. 2007) (Clark, J.).
  8. This article is limited in breadth to patent cases.
  9. For ease of reference, these cases will hereinafter be referred to as "complex patent cases."

litigation in order to streamline the scope of the case.<sup>10</sup> Patent Rule 3-1 requires a plaintiff to serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.”<sup>11</sup> For each defendant, the plaintiff must outline 1) each claim of each asserted patent that is allegedly infringed by each defendant; 2) each accused device or process of each defendant asserted to infringe each claim, identified by name or model number, if known; 3) a chart identifying specifically where each limitation of each asserted claim is found within each accused device, including the structure associated with any means-plus-function limitations; 4) whether the plaintiff asserts each limitation to be literally present or present under the doctrine of equivalents; 5) the priority date for each asserted claim that claims priority to an earlier application; and 6) any commercial embodiment of the asserted claims if the party wishes to preserve the right to rely on the assertion that its own product practices the claimed invention.<sup>12</sup>

Similarly, Patent Rule 3-3 requires a defendant to serve on all parties “Invalidity Contentions.”<sup>13</sup> Invalidity Contentions must 1) identify each item of prior art that allegedly anticipates or obviates each asserted claim; 2) identify whether each item of prior art anticipates or obviates each asserted claim; 3) contain a chart identifying where each limitation of each asserted claim is found in each item of prior art; and 4) contain any grounds for invalidity based on indefiniteness, enablement, or written description.<sup>14</sup>

Disputes often arise over these contentions. Infringement and invalidity contentions can generate disputes centering on the sufficiency of the disclosures in the contentions, as well as the feasibility of continuing through litigation based on a large number of asserted claims or prior art references. At times, parties will also disagree about whether amendments should be allowed, often because of alleged prejudice resulting from late amendments.

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10. See The Rules of Practice for Patent Cases before the Eastern District of Texas, available at <http://www.txed.uscourts.gov/Rules/LocalRules/Documents/Appendix%20M.pdf> [hereinafter, “P. R.”] (the original rules, adopted on February 22, 2005, were modeled after those originally adopted by the Northern District of California, and have been utilized in a similar fashion by Judge T. John Ward, of the Marshall Division of the Eastern District of Texas). See *Nike*, 479 F. Supp. 2d at 667; *Computer Acceleration Corp.*, 503 F. Supp. 2d at 822.

11. See P. R. 3-1. (requiring that “any party claiming patent infringement” serve a “Disclosure of Asserted Claims and Infringement Contentions” [hereinafter, “Infringement Contentions”]) (emphasis added). So a defendant asserting a counterclaim for patent infringement would also be required to serve on the plaintiff Infringement Contentions. However, for clarity, the author will hereinafter refer to the party serving Infringement Contentions as the “plaintiff” and the party upon which the Infringement Contentions are served as the “defendant.”

12. *Id.*

13. *Id.* at 3.3.

14. *Id.*

While certain disputes will be inevitable, thorough contentions that are carefully prepared in anticipation of subsequent litigation proceedings not only simplify the management of complex patent cases, but also enhance the merit of a party's position should a dispute later arise.

## 2. Insufficient Contentions

A plaintiff has time to investigate, assess, and prepare before filing its complaint, and as a result, the Court expects the plaintiff to meet a certain level of preparedness before filing suit.<sup>15</sup> In this vein, a plaintiff's infringement contentions are expected to be sufficiently specific. A plaintiff who shirks this duty will often face a challenge to the sufficiency of the infringement contentions.<sup>16</sup> With respect to drafting invalidity contentions, a defendant, on the other hand, faces a limited period to gather relevant facts, obtain pertinent prior art references, and prepare invalidity contentions.<sup>17</sup> Despite such a time limitation, a defendant may still face a challenge to the sufficiency of its invalidity contentions if the contentions fail to convey the requisite level of detail.

### *a. Motions Challenging the Sufficiency of a Party's Contentions*

Understanding the Court's objectives and purpose in requiring early disclosure of infringement and invalidity contentions is a first step towards understanding how to prepare sufficient contentions. When faced with a motion challenging the sufficiency of a party's contentions, the Court will often re-examine these objectives as a basis for ruling. In addition, the Court has provided guidance helpful to understanding the detail necessary for sufficient contentions.

In complex patent cases where numerous products are accused of infringing multiple claims, and the parties lack a mechanism to focus discovery, cases can very easily "[stagger] for months without clear direction."<sup>18</sup> At times, such faltering is unintentional, but it can be strategic as well. The Court has recognized that despite the Federal Rules' goal of full and open

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15. Being able to establish such pre-suit diligence when pertinent can at times help justify a party's actions. See *Connectel, LLC v. Cisco Sys., Inc.*, 391 F. Supp. 2d 526, 528 (E.D. Tex. 2005) (Davis, J.) (discussing the diligence shown by the plaintiff in *Am. Video Graphics L.P. v. Elec. Arts, Inc.*, 359 F. Supp. 2d 558, 560-61 (E.D. Tex. 2005) (Davis, J.)); see also Yan Leychkis, *supra* note 2, at 219.

16. See *Am. Video Graphics*, 359 F. Supp. 2d at 560 (Davis, J.) ("[t]o the extent defendants are given vague infringement contentions, they are hampered in their ability to prepare their defense").

17. Yan Leychkis, *supra* note 2, at 219.

18. *Connectel*, 391 F. Supp. 2d at 527 (Davis, J.).

disclosure—a goal also explicated in the Court’s Local Rules—parties often have a substantial motive to delay disclosure in patent cases.<sup>19</sup>

The Patent Rules are designed to achieve a notice function. They are intended to help streamline discovery by requiring the parties to “formulate, test, and crystallize their infringement [and invalidity] theories” early in litigation, so discovery takes a clear path and is focused on narrowing issues for *Markman*, summary judgment, and a trial or other final resolution of the litigation.<sup>20</sup> Streamlining discovery in this manner is one method of accelerating the litigation process and reducing the cost of litigation.<sup>21</sup> Achieving these objectives requires infringement contentions to be sufficiently specific so as to “provide defendants with notice of infringement beyond that which is provided by the mere language of the patent [claims].”<sup>22</sup> Where feasible, purchasing accused devices and ascertaining the mechanics of infringement prior to bringing suit not only can provide the level of detail necessary to draft sufficient contentions, but also can be used as evidence of pre-suit diligence.<sup>23</sup> To that end, vague or conclusory contentions are never sufficient.<sup>24</sup> When multiple parties, patents, claims, and accused products are involved, the level of detail required to put a defendant on notice of specific theories of infringement may become difficult to gauge.<sup>25</sup> A party should not expect to accuse products or categories of products and then enlarge or narrow this number at its own convenience.<sup>26</sup> Nor should a party expect to be afforded an inordinate amount of time to confirm theories of infringement via discov-

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19. *Finisar Corp. v. DirecTV Group, Inc.*, 424 F. Supp. 2d 896, 898-99 (E.D. Tex. 2006) (Clark, J.) (citing James M. Amend, *PATENT LAW: A PRIMER FOR FEDERAL DISTRICT JUDGES* 19 (1998)).
  20. *Connectel*, 391 F. Supp. 2d at 527; *see also Am. Video Graphics*, 359 F. Supp. 2d at 560; *Network Caching Tech., LLC v. Novell, Inc.*, 2003 WL 21699799, at \*4-5 (N.D. Cal. 2003); *Nike*, 479 F. Supp. 2d at 666-67; *Linex Tech., Inc. v. Belkin Int’l*, 628 F. Supp. 2d 703, 707 (E.D. Tex. 2008) (Love, J.).
  21. *Nike*, 479 F. Supp. 2d at 666-67.
  22. *Connectel*, 391 F. Supp. 2d at 528.
  23. *Am. Video Graphics*, 359 F. Supp. 2d at 560.
  24. Furthermore, severe consequences resulting from conscious disregard of the court’s policy requiring open and full disclosure are not unheard of. *See Computer Acceleration Corp.*, 503 F. Supp. 2d at 824-25 (E.D. Tex. 2007); *see also Connectel*, 391 F. Supp. 2d at 528 (noting the insufficiency of vague and conclusory allegations).
  25. *Linex Tech.*, 628 F. Supp. 2d at 712-14 (ordering plaintiff to supplement its infringement contentions and noting that “more thorough Infringement Contentions will ensure that Defendants will better understand Plaintiff’s claims”); *see also Connectel*, 391 F. Supp. 2d at 528 (“[h]ere . . . Connectel has made shotgun accusations of hundreds of products infringing hundreds of claims”).
  26. *Davis-Lynch, Inc. v. Weatherford, Int’l, Inc.*, No. 6:07-CV-559, 2009 WL 81874, at \*5 (E.D. Tex. Jan. 12, 2009) (Love, J.).

ery.<sup>27</sup> The accumulation of evidence to support an infringement theory for summary judgment and trial should not delay the timely disclosure of that theory in contentions.<sup>28</sup> One alternative may be to designate an exemplar or representative accused product or a standard that may reduce the necessity of a claim-by-claim and element-by-element analysis for all accused products.<sup>29</sup>

Patent cases where software is accused of infringing can “present unique challenges.”<sup>30</sup> This is because prior to discovery, a plaintiff usually has access only to the manifestation of the allegedly infringing source code, while the code itself remains confidential.<sup>31</sup> Preparing highly specified infringement contentions based on allegedly infringing software code that is protected as highly confidential—and is thus not available to the public—is a difficult, if not impossible, task.<sup>32</sup> Thus, there have been times when the Court has condoned delay in providing software contentions where the software must be escrowed or presented in some other manner necessary to secure its use only in the case at hand.<sup>33</sup>

While this guidance is undoubtedly useful to plaintiffs, defendants also need to be aware of these requirements. Invalidity contentions require specific disclosures as well, and when a defendant fails to draft proper contentions or to timely disclose a prior art reference, the contentions or the disputed reference may be stricken from the record.<sup>34</sup> As a result, it is important for all parties to keep in mind not only the objectives of the Patent Rules

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27. *Id.* at \*3; *Realtime Data, LLC v. Packeteer, Inc.*, No. 6:08-CV-144, 2009 WL 2590101, at \*3-\*5 (E.D. Tex. Aug. 18, 2009).

28. *See Linex Tech.*, 628 F. Supp. 2d at 713 (Infringement contentions “are not meant to provide a forum for litigation of the substantive issues; they are merely designed to streamline the discovery process.”); *but see Realtime Data*, 2009 WL 2590101, at \*5 n.5 (“to the extent that the identification of additional evidence in support of a plaintiff’s infringement contentions assists in the communication of notice of such contentions, identification of evidence obtained during discovery would appear to more effectively achieve such notice.”).

29. *Connectel*, 391 F. Supp. 2d at 528-29; *see also Linex Tech.*, 628 F. Supp. 2d at 709-11 (noting that at times exemplary or representative accused products may be sufficient, though there can be potential problems in doing so and ordering the plaintiff to supplement its contentions on a product-by-product basis).

30. *Am. Video Graphics*, 359 F. Supp. 2d at 560.

31. *Id.*

32. In such a situation, “plaintiffs must somehow divine whether the defendants’ code infringes.” *Id.*

33. *See id.* at 561; *see also Connectel*, 391 F. Supp. 2d at 528-29; *Linex Tech., Inc. v. Belkin Int’l, Inc.*, 628 F. Supp. 2d 703, 710 (E.D. Tex. 2008).

34. *See Saffran v. Johnson & Johnson*, 2:07-cv-451, (E.D. Tex. Feb. 24, 2009) (Ware, J.) (striking invalidity contentions from the record); *Finisar Corp. v. DirecTV Group*, 424 F. Supp. 2d 896 (E.D. Tex. Mar. 28, 2006) (Clark, J.) (striking certain prior art references from the record).

in requiring early disclosure of contentions, but also to observe the specific guidance the Court has set forth on these issues. There is not and never will be a rote method for preparing infringement and invalidity contentions, and complex patent cases require more than mere manpower—they require thorough analysis and careful consideration.

***b. Motions Seeking to Focus the Case by Limiting Asserted Claims or Prior-Art References***

When a plaintiff asserts an extremely large number of claims, the complexity of the case can be difficult for the parties and the Court. An important consideration is assessing how the case will actually be tried, particularly how well the jury will be able to comprehend and process the issues it is asked to decide. At times, a defendant will request that the Court order the plaintiff to either limit the number of asserted claims or choose a certain number to focus the remainder of the litigation on.<sup>35</sup> At other times, the Court may *sua sponte* recommend or require a plaintiff to do so.<sup>36</sup> In some situations, limiting the number of claims a plaintiff may proceed on is a means for ensuring the efficacy of resolving the case through dispositive motions or trial. When the parties are unable to limit the claims on their own, the Court may be inclined to do so in order to prepare for *Markman*, dispositive motions, or trial.

In *Realtime Data, LLC v. Packeteer, Inc.*, just months before the *Markman* hearing, the defendants filed a motion to limit the claims asserted by the plaintiff, Realtime Data.<sup>37</sup> At that point, there were thirteen defendants, nine patents, and over one-hundred claims at issue.<sup>38</sup> In denying the motion, the Court noted that such a limitation would not help the parties or the Court prepare for the upcoming *Markman*, while it would necessarily result in prejudice to the plaintiff.<sup>39</sup> However, the Court also noted the impossibility of addressing dispositive motions and proceeding to trial on the

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35. See Def. Citrix Sys., Inc.'s Mot. to Limit Claims, *Realtime Data, LLC v. Packeteer, Inc.*, 6:08-cv-144 (E.D. Tex. Feb. 6, 2009); Dell's Emergency Mot. to Limit Proceedings to a Reasonable Number of Claims and Request for Expedited Briefing Schedule, *Negotiated Data Solutions LLC v. Dell, Inc.*, 2:06-cv-528 (E.D. Tex. July, 23 2008).

36. See *Hearing Components, Inc. v. Shure, Inc.*, 9:07-cv-104, 2008 WL 2485426 (E.D. Tex. June 13, 2008)(Clark, J.).

37. See Def. Citrix Sys., Inc.'s Mot. to Limit Claims, *Realtime Data, LLC v. Packeteer, Inc.*, No. 6:08-cv-144 (E.D. Tex. Feb. 6, 2009) (Doc. No. 284). For ease, remaining references to documents in this case will be cited by their docket entry number. While the motion was filed only by defendant Citrix Systems, Inc., most of the remaining defendants joined in the motion. (Doc. Nos. 190, 193, 194, 225, 226).

38. Doc. No. 184.

39. Doc. No. 248.



number of claims then asserted by the plaintiff.<sup>40</sup> The Court then ordered the parties to submit an agreement or competing proposals after the close of discovery regarding how to narrow the case for trial.<sup>41</sup> When the parties later filed competing proposals, the Court ordered the plaintiff to choose one patent per manufacturing defendant to move forward with, leaving at most four patents in the case.<sup>42</sup> When the plaintiff made this designation, a mere three patents and ten claims remained at issue for trial with the remainder of the claims held in abeyance pending the outcome of the first trial.<sup>43</sup> In that case, the Court invited the parties to agree on a proposal for narrowing the case, but the parties were unable to do so. Thus, the Court was left to choose a course of action. And while the course chosen by the Court was within the Court's discretion, it was not the course either party would have chosen.<sup>44</sup> Similarly, a plaintiff may move for a limitation on the number of prior art references or combinations thereof to be asserted at trial.<sup>45</sup> Again, the Court will look very closely at the breadth of prior art a defendant intends to assert with an eye toward the need for the art and to what extent the art can be absorbed in a trial setting.<sup>46</sup> Both sides should, to some extent, orient their mindset to how this case can most effectively be tried. How the case will be tried is of paramount importance to the Court and plays an important role in the Court's decision making.

*c. Motions to Amend Infringement and Invalidity Contentions*

Disputes also arise regarding whether a party should be allowed to amend its contentions. As discussed above, the parties are required to serve contentions early in litigation and therefore often will want to make changes later. However, late amendments can result in prejudice to the opposing party, and in complex patent cases, the prejudice resulting from late amendments can increase exponentially.

With both the language from the Local Court Rules and guidance from cases in mind, the means for effectively managing and litigating complex

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40. *Id.*

41. *Id.*

42. Doc. No. 432.

43. Doc. No. 435.

44. *See* Doc. No. 432 (rejecting both parties' proposals); *see also* Doc. No. 127 (giving each side 150 and 125 deposition hours respectively, despite the parties' request for 300 and 450 deposition hours as a result of "[concern] about the expense such numbers indicate that the parties intend to incur" and advising the parties "to be prudent with the allotted deposition time").

45. *See* *Realtime Data LLC v. Packeteer, Inc.*, No. 6:08-cv-144, 2009 WL 4782062, at \*1 (E.D. Tex. Dec. 8, 2009) (Love, J.).

46. *See id.* at \*2 ("The purpose of Patent Rule 3-3 is to place the Plaintiff on notice of potentially invalidating art that Defendants will assert in their case and at trial.").

patent cases are available to litigants. First, when a party seeks to amend, this request should be brought to the attention of the opposing parties and the Court as early as possible. Such diligence is taken into account when the Court rules on motions to amend.<sup>47</sup> In complex patent cases, this may mean that a plaintiff should consider the possibility of piecemeal amendments as a potential alternative to a single, subsequent request for extensive amendments.<sup>48</sup> Second, parties should consider the difference between dropping, adding, and modifying the patents, claims or products asserted against a particular party when there are multiple opposing parties. At the beginning of a lawsuit, anticipation and foresight into these differences can decrease the need for amendments later in a case. When a plaintiff seeks to drop patents or claims from a lawsuit, defendants will generally not object to such a proposal. Dropping patents or claims simplifies the case against defendants. Adding patents or claims late in the litigation, even if already in the case against one defendant, requires the defendant(s) against whom the patent or claim is added to evaluate the additions during the middle of a case. When faced with an approaching trial date, beginning the evaluation of new patents and claims and preparing a defense to these additions is generally not a proposition any party wants to face.<sup>49</sup>

## **B. Clarity in Briefing**

There are other important ways that parties can more effectively litigate complex patent cases. First, be clear and articulate in all briefing and oral arguments. While this may seem self-evident, logical organization and astute drafting are fundamental to educating the Court on the issues in dispute. If arguments in briefing switch between asserted patents without clearly noting the change, the arguments quickly become confusing and ambiguous. Second, provide briefing and attachments that will allow the Court to efficiently

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47. See *Network-1 Security Solutions v. Cisco Sys. Inc.*, No. 6:08-cv-30, 2010 WL 596396, at \*2-3 (E.D. Tex. Feb. 16, 2010)(Davis, J.); *Arbitron, Inc. v. Int'l Demographics, Inc.*, No. 2:06-cv-434, 2008 WL 4755761, at \*1-2 (E.D. Tex. Oct. 29, 2008) (Ward, J.); *Coopervision, Inc. v. Ciba Vision Corp.*, 480 F. Supp. 2d 884, 888 (E.D. Tex. 2007) (Clark, J.); *AdvanceMe, Inc. v. Amerimerchant, LLC*, No. 6:06-cv-82, at \*7 (E.D. Tex. July 5, 2007) (Love, J.); *Softvault Sys., Inc. v. Microsoft Corp.*, No. 2:06-cv-16, 2007 WL 1342554, at \*1-2 (E.D. Tex. May 4, 2007) (Davis, J.); *STMicroelectronics, Inc. v. Motorola, Inc.*, 307 F. Supp. 2d 845, 850-51 (E.D. Tex. 2004) (Davis, J.).

48. See, e.g., *Realtime Data, LLC v. Packeteer, Inc.*, No. 6:08-cv-144, 2009 WL 2590101, at \*3-6 (E.D. Tex. Aug. 18, 2009) (denying request for leave to amend in part due to late request for extensive amendments).

49. The parties are generally facing firm trial dates, making late amendments particularly burdensome. See Andrew Spangler, *LITIGATING IN THE EASTERN DISTRICT OF TEXAS*, 922 PLI ORDER NO. 14506 217, 232 (Jan. 2008) (noting the "special circumstances" typically required for Court to move a trial date in the Eastern District of Texas).

rule on disputed issues. Avoid page after page of “background” purportedly showing the egregiousness of the other side’s conduct. Such recitations typically provide little in the way of persuasive argument and tend to obscure the pertinent issues and the most compelling reasoning in favor of a particular outcome. In addition, the elimination of some or all marginally relevant “background” material should reduce costs in preparing motions in already extremely expensive cases. Moreover, prepare filings that plainly set forth all the pertinent information and exhibits in an organized manner. Doing so allows the Court to spend more time on the substantive issues and less time sifting through volumes of documents to find the pertinent information. While these observations are not limited to complex patent cases, they are especially important in these cases because of the complexities that arise when multiple parties, patents, and claims are involved.

### C. *Markman*

While many of the previous suggestions are important in all phases of litigation, such advice should particularly be considered when approaching the *Markman* hearing. First and foremost, it is vital that the parties use best efforts to collaborate in good faith to identify disputed claim terms, parse through the critical issues, identify central disputes, and combine or coordinate arguments. Doing so results in focused and valuable briefing and argument. This is invaluable to the Court when faced with critical disputes, and this will help the Court to have a better opportunity to render a prompt decision.

In cases where numerous claims are at issue, the number of disputed claim terms the parties present for resolution can be significant. Not only can briefing become disorganized and overwhelming when a large number of claim terms are at issue, but a *Markman* hearing can be difficult to effectively conduct. When the parties are unable to present the Court with a manageable number of claim terms, the Court may limit the terms in order to ensure manageability.<sup>50</sup>

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50. See *Hearing Components Inc. v. Shure, Inc.*, 9:07-cv-104, 2008 WL 2485426, at \*1 (E.D. Tex. June 13, 2008). Outside of the *Markman* process, the court may also order the parties to limit the scope of the case by choosing certain patents or claims to continue to assert. See Memorandum Opinion and Order, *Realtime Data LLC v. Packeteer, Inc.*, 6:08-cv-144 (E.D. Tex. Mar. 16, 2009) (ordering the parties to “submit to the Court an agreement or competing proposals regarding how to narrow this case to effectively prepare for trial”); Order Granting Joint Motion to Amend Docket Control Order, *MacLean-Fogg v. Eaton Corp.*, 2:07-cv-472 (E.D. Tex. May 28, 2009) (ordering plaintiff to identify claims for trial); Order from Scheduling Conference and Docket Control Order, *Data Treasury Corp. v. Wells Fargo & Co.*, No. 2:06-cv-72, 3-5 (E.D. Tex. Oct. 25, 2006) (ordering plaintiff to limit number of asserted claims and reserving the right to further limit the claims).

To further assist the Court when multiple claim terms are at issue, *Markman* briefing should explicitly note the patents and claims which contain the disputed terms. When parties fail to do so, the Court is required to sift through all of the patents to identify the pertinent claims before it can begin considering the substance of the parties' arguments. This is not an efficient use of the Court's time given that parties can easily set forth this information.

The plaintiff can also assist the Court by attaching all asserted patents to the opening brief on claim construction. Although the patents may have been attached to previous documents, attaching all patents to the opening brief ensures that the patents are readily available to the Court when the brief is filed. Additionally, attaching the patents in searchable "PDF" format enables the Court to review the patents more efficiently. Also, highlighting the relevant parts of other attachments is helpful. With regard to such attachments, parties should be cognizant of the credibility and reliability of such exhibits.<sup>51</sup> Employing the above practices will aid the parties and the Court in reaching a prompt and well-considered claim construction determination.

## II. DISCOVERY

The discovery process is complex, time-consuming, and expensive. On December 1, 2006, amendments to the Federal Rules of Civil Procedure regarding the discovery of electronically stored information went into effect, and Congress enacted these amendments to help reduce the costs and burdens imposed by electronic discovery.<sup>52</sup> While these amendments helped to clarify the requirements associated with producing electronically stored information, there are direct costs and benefits associated with preserving and producing this information.<sup>53</sup> Because discovery is a uniquely party-driven aspect of litigation, the parties must be cognizant of the requirements of the Federal Rules, the Court's Local Rules, and any Discovery Orders entered in the case. Moreover, as a part of minimizing costs, the parties must be constrained in drafting motions to compel production of documents and not attempt to bring in a plethora of unrelated factual disputes. It is also helpful

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51. See, e.g., *Performance Pricing, Inc. v. Google, Inc.*, No. 2:07-cv-432, 2009 WL 2497102, at \*12, n.15 (E.D. Tex. Aug. 13, 2009) (Love, J.) (noting the innate unreliability of Wikipedia articles used to show the meaning of a disputed claim term in *Markman* briefing); see also *Iovate Health Scis., Inc. v. Bio-Engineered Supplements & Nutrition, Inc.*, No. 9:07-cv-46, 2008 WL 859162, at \*8 n.4 (E.D. Tex. Mar. 28, 2008) (Clark, J.); *Techradium Inc. v. Blackboard Connect Inc.*, No. 2:08-cv-00214-TJW, 2009 WL 1152985, at \*4 n.5 (E.D. Tex. April 29, 2009) (Ward, J.).

52. Jessica DeBono, *Preventing and Reducing Costs and Burdens Associated with E-Discovery: The 2006 Amendments to the Federal Rules of Civil Procedure*, 59 MERCER L. REV. 963, 963 (2008).

53. DeBono, *supra* note 52, at 963-64.

for parties to know the proper use of hotline calls, as well as emergency motions.<sup>54</sup>

### A. Local Court Rules

Federal Rule 26(b)(1) provides that “[p]arties may obtain discovery regarding any non-privileged matter that is relevant to any party’s claim or defense—including the existence, description, nature, custody, condition, and location of any documents or other tangible things and the identity and location of persons who know of any discoverable matter.”<sup>55</sup> The Patent Rules provide for the initial disclosure of certain information, along with the production of infringement and invalidity contentions.<sup>56</sup> Patent Rule 3-2 requires a plaintiff to produce, along with infringement contentions, certain documents, including 1) “documents . . . sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit;” 2) “[all] documents evidencing the conception, reduction to practice, design, and development of each claimed invention;” and 3) a “copy of the file history for each patent in suit.”<sup>57</sup> Similarly, Patent Rule 3-4 requires a defendant to produce, along with its invalidity contentions, 1) “[s]ource code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality;” and 2) a “copy of each item of prior art . . . which does not appear in the file history of the patent(s) at issue.”<sup>58</sup> Generally, the Court will also issue a discovery order that adds further, additional disclosure requirements. Even in the course of producing these required initial disclosures, disputes often arise.<sup>59</sup>

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54. See LOCAL COURT RULES CV-7(m), CV-26(e).

55. Fed. R. Civ. P. 26(b)(1); Local Court Rule CV-26(d) expands on the proper scope of “relevant” material by setting forth five such examples. Under this rule, material relevant to the claim or defense of any party includes 1) information that would not support the disclosing parties’ contentions; persons who, if their potential testimony were known, might reasonably be expected to be deposed or called as a witness by any of the parties; 2) information that is likely to have an influence on or affect the outcome of a claim or defense; 3) information that deserves to be considered in the preparation, evaluation or trial of a claim or defense; and 4) information that reasonable and competent counsel would consider reasonably necessary to prepare, evaluate or try a claim or defense.

56. See P. R. 3-2, 3-4.

57. *Id.* at 3-2.

58. *Id.* at 3-4.

59. This author’s proposed form discovery order is available at <http://www.txed.uscourts.gov/Judges/Love/Orders&Forms.htm>.

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Local Court Rule CV-7 also sets forth a requirement that parties “meet and confer” in good faith prior to filing a motion, with only certain limited exceptions.<sup>60</sup> In discovery-related motions, both lead and local trial counsel for all parties must confer either in-person or by telephone, and all parties must discuss the dispute with “sincere effort” and “meaningfully assess the relative strengths of each position.”<sup>61</sup> Furthermore, this rule specifically lists four factors the parties shall consider during this discussion:

(1) whether and to what extent the requested material would be admissible in a trial or reasonably calculated to lead to the discovery of admissible evidence; (2) the burden and costs imposed on the responding party; (3) the possibility of cost-shifting or sharing; and 4) the expectations of the court in ensuring that parties fully cooperate in discovery of relevant information.<sup>62</sup>

It is also important to note that this rule requires “good faith,” which is defined as “requir[ing] honesty in one’s purpose to discuss meaningfully the dispute, freedom from intention to defraud or abuse the discovery process, and faithfulness to one’s obligation to secure information without court intervention.”<sup>63</sup> This rule is important for counsel to be familiar with because an unreasonable failure to comply may be grounds for disciplinary action.<sup>64</sup>

## **B. Disputes**

Discovery disputes should not provide an opportunity for parties to present the Court with a litany of grievances.<sup>65</sup> In ruling on discovery disputes, the Court’s purpose is to resolve the dispute in order to allow the case to move forward, unless sanctions are at issue.

### **1. Discovery Order**

As noted above, near the beginning of a case, the Court generally issues a discovery order that provides provisions limiting the scope of discovery.

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60. See LOCAL COURT RULE CV-7(i). Parties need not meet and confer on motions to dismiss; motions for judgment on the pleadings; motions *in limine*; motions for judgment as a matter of law; motions for a new trial; agreed, joint, or unopposed motions; nor certain criminal motions.

61. LOCAL COURT RULE CV-7(h).

62. *Id.*

63. *Id.*

64. *Id.* The requirements of this rule must be established in a Certificate of Conference attached at the end of all pertinent motions. See LOCAL COURT RULE CV-7(i).

65. As a result of the broad nature of discovery in most patent cases, an extensive litany of grievances can be quickly compiled. See Jason Rantanen, *Slaying the Troll: Litigation as an Effective Strategy Against Patent Threats*, 23 SANTA CLARA COMPUTER & HIGH TECH. L.J. 159, 187–89 (2006) (discussing high discovery costs associated with extensive discovery as a result of electronic discovery and inequitable conduct claims).

While parties often submit an agreed upon proposed discovery order, at times there are certain provisions of the order that the parties are unable to reach consensus on, such as the allowed number of deposition hours. While such provisions are undoubtedly important, the parties should use their best efforts to agree to all provisions. Most disputes regarding the discovery order should easily be resolved, and should an agreed provision later give rise to a dispute, it can be presented to the Court at that time. Such disputes arise before discovery has even begun and generally will not have a substantial effect on the outcome of litigation. Thus, parties should use their best efforts to reach an agreement on discovery order issues and avoid needless intervention from the Court.

## 2. Motions to Compel

Once discovery has commenced, disputes can be seen as inevitable. Yet, using their best efforts, the parties can resolve many of these disputes without court intervention. When court intervention becomes necessary, the parties need to present an isolated dispute. More specifically, a party should specify clearly what is sought and succinctly explain why it is entitled to that particular item. It is not helpful to the Court when parties present an extended history of inconsequential disputes that have occurred over the course of the litigation. Such information does not assist the Court in resolving the dispute forming the basis of the motion.<sup>66</sup> When the parties are unable to isolate the dispute without presenting a litany of grievances, the Court is inundated with an extensive factual history that is often neither helpful nor relevant.<sup>67</sup> As noted earlier, the elimination or reduction in the background of the parties' dispute can also result in cost savings. Thus, when the parties have reached an irresolvable impasse in a discovery matter, it is important that the parties focus on properly framing the dispute that resulted in the motion to compel.

## 3. Meet and Confer

The "meet and confer" requirement of Local Court Rule CV-7 is not just a procedural hurdle that the parties must overcome before filing a motion. This rule is intended to create an opportunity for the parties to resolve the dispute without court intervention. Absent such a resolution, this required conference should help focus the parties on the key dispute in order to present the Court with an isolated set of facts. Failure to comply with the requirements of this rule is not taken in due course. In *Konami Digital En-*

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66. This author has considered limiting discovery motions to no more than five pages to help eliminate such practice.

67. In addition to filing motions with extensive and extraneous factual records, at times parties will also file consecutive and unnecessary motions to compel which result in a similar waste of judicial resources. See Spangler, *supra* note 49 (warning parties to avoid filing multiple motions to compel "*in seriatim*").

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*ertainmentt Co. v. Harmonix Music Sys., Inc.*, the Court denied the defendants' motion to compel certain documents, declining to reach the substantive merits because the parties had failed to comply with the "meet and confer" requirements of this rule.<sup>68</sup>

#### **4. Hotline Calls**

Local Court Rule 26(e) provides that a judge will be on call during business hours to rule on discovery disputes and to enforce the Local Court Rules.<sup>69</sup> This rule makes clear that the proper subject matter for hotline calls includes questions about whether a particular discovery request falls within the applicable scope of discovery, as well as requests to enforce or modify provisions of the rules as they relate to a particular case. Hotline calls are also commonly utilized to resolve disputes that arise during a deposition, such as privilege or other significant objections.

#### **5. Emergency Motions**

Local Court Rule CV-7(m) provides the required procedures for filing emergency motions. In addition to titling the motion "emergency" and filing under the proper event code in the CM/ECF system, chambers of the presiding judge must be notified of the filing.<sup>70</sup> Emergency motions are particularly applicable to disputes that require resolution in less time than required by the normal briefing schedule, but are not well-suited for a hotline call. For example, discovery disputes may be better presented as emergency motions when they require explanation of complex factual background or legal positions or when no further benefit would accrue from immediate resolution, rather than resolution just days later.

Discovery is a major part of litigation. Unlike many other parts of litigation, discovery is party-driven, and as a result, the parties enjoy greater responsibility in managing the process. It is vital that the parties observe the requirements of the Federal Rules, the Court's Local Rules, any discovery orders, and applicable codes of professional responsibility.

### **III. PRETRIAL CONFERENCE**

When facing an upcoming pretrial conference, parties should be diligent and use their best efforts to adequately prepare prior to appearing for the pretrial hearing. One aspect of preparing for a pretrial conference includes attempting to agree on issues that will be addressed at the conference. While the Court will entertain a request to reset a portion of the pretrial conference to allow the parties further opportunity to agree, this is not preferable. There

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68. *Konami Digital Entm't Co. v. Harmonix Music Sys., Inc.*, 6:08-cv-286, 2009 WL 3448148, at \*2 (E.D. Tex. Oct. 22, 2009) (Love, J.).

69. LOCAL COURT RULE CV-26(e).

70. LOCAL COURT RULE CV-7(m).



are a number of matters that will generally be addressed, and absent agreement, the matters can be extensive enough to make a pretrial conference arduous and time consuming. The issues that may be addressed at a pretrial conference include pending summary judgment motions, pending expert motions, motions *in limine*, objections to deposition designations, objections to trial exhibits, objections to trial witnesses, and trial procedures.

### A. Motions

If there are summary judgment or expert motions pending at the time of the pretrial conference, the Court will generally hear argument on these motions, and therefore the parties should be prepared to argue the motions. The parties should also be prepared to argue pending motions *in limine*. However, the parties are expected to meet and confer in good faith about all pending motions *in limine* before the pretrial conference. Because motions *in limine* are generally filed as the parties are at the height of trial preparations, it is not uncommon for the parties to arrive at the pretrial conference without having truly conferred about the motions *in limine* in good faith with an honest effort to understand the other side's position.<sup>71</sup>

### B. Pretrial Objections

The parties should also be prepared to address objections to deposition designations, objections to rebuttal deposition designations, objections to exhibits and objections to trial witnesses. Each of these objections plays an important role in preparing for what everyone hopes will be a smooth trial. The more objections that the Court and the parties can resolve before opening statements begin, the less time that must be spent on resolving them in front of—or outside the presence of—the jury. Also, fewer remaining objections on the eve of trial will allow the parties to apply more energy toward preparing and presenting their case. Furthermore, the parties are expected to discuss pretrial objections prior to arriving at the pretrial hearing. This not only allows the parties to resolve certain objections on their own, but also provides the parties a forum to fully understand the other side's position. This generally helps ensure better framing of the issues when the objections are presented to the Court.

### C. Trial Preparation

In addition to resolving pending motions, motions *in limine*, and pretrial objections, the parties should be prepared to discuss and address remaining questions about the administration of *voir dire* and trial. Questions regarding jury questionnaires, questions for the Court to ask the prospective jurors, and

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71. Although motions *in limine* are exempt from the requirements of Local Court Rule CV-7(h) and 7(i), this does not mean that any conference ordered by the Court regarding motions *in limine* may be conducted absent good faith, honesty in one's purpose, meaningful discussion, and sincere effort.

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time limitations for *voir dire* and trial are all properly addressed at the pre-trial conference. The pretrial conference is the final time for the Court and the parties to discuss any remaining issues before choosing a jury and presenting opening statements. To the extent that the parties can attempt to work together to resolve the minor issues, the Court will have additional time to focus on resolving the more significant disputes.

#### IV. CONCLUSION

As previously noted, litigating almost any patent case can be challenging—administratively, technologically, and often financially.<sup>72</sup> The increased complexity of cases involving multiple parties, patents, claims, and accused products necessitates heightened organization and efficiency to effectively prepare the case for trial. Furthermore, the Court is aware, as all parties should be, of the costs associated with trying such cases, as well as the importance of avoiding fiscal irresponsibility in doing so. The observations, approaches, methods, and tips previously noted may help practitioners better understand the process from the Court's perspective. This author hopes that in doing so, practitioners are able to apply this knowledge in order to improve their patent practice.

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72. A 2003 survey found that companies spend an average of two million dollars solely on legal expenses in a single patent case. Leychikis, *supra* note 1 at 198.

