

Intelligent Scheduling in Patent Cases: How Much Discovery Before the *Markman* Process Kicks In?

All patent cases are litigated in federal court, and virtually all federal courts today employ extensive case management, including detailed scheduling orders under Federal Rule of Civil Procedure 16(b).

A number of courts have decided that the most customary case schedules—for example, initial disclosures, pleading closure, fact discovery, expert discovery, and dispositive motions—are not adequate for effective management of patent cases. It is not so much that patent cases involve unique procedural issues; rather, these cases consistently involve essentially the same, rather elaborate, pattern of issues. The claim construction process under *Markman v. Westview Instruments Inc.*, 517 U.S. 370 (1996), is somewhat analogous to cross-motions for partial summary judgment. Invalidity shares many traits with other affirmative defenses. Opinion testimony from retained experts or percipient witnesses is often tendered, though sometimes separately, on claim construction, infringement, invalidity, damages, and other issues.

The *Markman* process imposes some procedural challenges of a “chicken-or-egg” nature. How the Court is going to construe the patent’s claims has a major bearing on infringement, validity, and other issues; yet the parties may desire to have and understand information on those issues before taking positions on claim construction. This is the type of procedural problem for which there is no perfect solution.

The reality is that at least one party may desire a certain amount of contention, other fact, and even expert discovery before a *Markman* briefing; and at the same time, any party would want substantial time to complete both fact and expert discovery once the Court’s *Markman* ruling is issued. Most patent litigators perceive a rough solution in the *Markman* process occurring somewhere in the midst of discovery; but there are two inherent difficulties with this approach. First, this solution means requiring some expert discovery, possibly including disclosures, before overall fact discovery is closed. Second, some of the fact and expert witnesses on *Markman* issues have

information or opinions on other issues, which ought to be addressed post-*Markman*. Neither deposing a witness twice nor forcing a one-time deposition early in the case is likely to be attractive to all counsel. A perfect solution just doesn’t exist, but the best compromise lies at the initial scheduling stage.

The U.S. District Court for the Northern District of California employs an elaborate and widely respected set of special local rules, including a special schedule, for patent cases (see www.cand.uscourts.gov). These rules impose a logical sequence of contentions regarding infringement, invalidity, and other issues, and they fit the *Markman* process into the sequence about as logically as can be done. However, many litigators in other districts face the challenge of persuading the court to adopt a similar special schedule—often over objections from adversaries with differing agendas. The factors and problems summarized in the preceding paragraph should be carefully laid out for the judge or magistrate at the initial scheduling stage. Deferring confrontation until the inevitable controversies arise may result in one or both parties being forced into trial without adequate discovery on some subjects.

An issue that frequently arises is whether or how much discovery is appropriate before litigants are expected to stake out and brief positions on claim construction. There is authority relevant to both sides of this issue. *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322 (Fed. Cir. 2006), supports the proposition that information relating to the products being accused of patent infringement provides meaningful context for claim construction. *Serio-US Industries Inc. v. Plastic Recovery Technologies Corp.*, 459 F.3d 1311 (Fed. Cir. 2006), observes that “a trial court may consult the accused device for context that informs the claim construction process.” A further argument is that, because knowledge of what is accused of infringement is essential to identify which claim terms are disputed and require construction, discovery on that subject is necessary for claim construction. *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351 (Fed. Cir. 2008).

On the other hand, it has often been said that one may not look to accused products to construe patent claims (as, for example, in *SRI Int’l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107 (Fed. Cir. 1985) (en banc)). Cases holding that claims may not be construed with reference to the accused device, like the *Wilson Sporting Goods* case mentioned above, can be



cited to refute a necessity for infringement-related fact or opinion discovery prior to a *Markman* briefing and decision. A party on this side of the argument will generally seek the earliest possible *Markman* process and employ all lawful means to resist or delay discovery on infringing products and the like until the adversary has committed to positions on proper claim construction.

Virtually all federal courts expect counsel to try to resolve these conflicts in a joint scheduling proposal. Probably the most defensible solution is a practical compromise. The discovery sought by one or both counsel before committing to *Markman* positions should be described and confined as precisely as possible and conducted as promptly as possible. Even in the best of circumstances, some depositions will probably need to be adjourned and resumed later, and interrogatory answers and document productions will almost certainly require supplementation as the case progresses. Federal Rules of Civil Procedure 16 and 26 allow and even encourage follow-up case management conferences between the initial scheduling of the case and trial. Such conferences can be enormously valuable in solving these patent litigation dilemmas, and counsel will find that many courts welcome requests to hold these meetings. **TFL**

Mark Vorder-Bruegge, Jr. litigates patent cases and serves as leader of the intellectual property service team at Wyatt, Tarrant & Combs LLP, a full-service regional firm.

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vacated Stevens' conviction.

At first blush, it looks like the Third Circuit struck a lethal blow against our furry four-legged friends. Upon further consideration, I do not necessarily think that is the case. The legislative history for § 48 indicates that Congress sought to stop "crush videos," which are defined as "a depiction of 'women inflicting ... torture [on animals] with their bare feet or while wearing high heeled shoes.'" H.R. Rep. No. 106-397, at 2 (1999). Stevens was indicted on three counts of knowingly selling depictions of animal cruelty. In all three counts, the depictions were of pit bulls either fighting each other (filmed in the 1960s and 1970s in the United States and more recent footage from Japan) or being used to "catch" wild boars. The facts of this case—in which no crush videos were involved—did not support the intent of the statute. So was this simply a case of bad facts making bad law?

It appears, to me at least, that the Third Circuit may have been punting the ultimate decision of creating a new category of unprotected speech to the Supreme Court. *Stevens*, 553 F.3d at 225–226 ("Without guidance from the Supreme Court, a lower federal court should hesitate before extending the logic of [*New York v. Ferber*] 458 U.S. 747 (1982)] to other types of

speech. The reasoning that supports *Ferber* has never been used to create whole categories of unprotected speech outside of the child pornography context. ... For these reasons, we are unwilling to extend the rationale of *Ferber* beyond the regulation of child pornography without express direction from the Supreme Court.").

Finally, all hope is not lost; the dissent did its best to lay the groundwork for expanding the scope of unprotected speech to include depictions of animal cruelty. Pointing out that laws prohibiting cruelty to animals have existed in this country since 1641, the dissent argued that the government has a "compelling interest in protecting animals from wanton acts of cruelty." *Stevens*, 553 F.3d at 238, 250. The dissent also argued that the prohibited depictions have "such minimal social value as to render this narrow category of speech outside the scope of the First Amendment." *Stevens*, 553 F.3d at 250. **TFL**

Julie China is a member of the FBA editorial board.

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