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Patently Distinct: The Minnesota Chapter's Intellectual Property Practice Group

The Federal Bar Association's Minnesota Chapter prides itself on the unique and amiable relationship it has between the bench and bar. Part of this special tradition is the chapter's relatively new committee: the IP Practice Group. The IP Practice Group provides a forum outside the courtroom at which practitioners and judges can gather for social events and to discuss and address current issues related to intellectual property, particularly the practice in the District of Minnesota. In light of the heavy patent practice that the District of Minnesota handles—especially in the field of medical devices—the IP Practice Group focuses on patent litigation issues and also deals with copyright and trademark topics. More than just providing a venue for sharing knowledge about the subject, however, the IP Practice Group underscores the interactive and distinctive relationship that lawyers and judges in the District of Minnesota share in their collaborative efforts of making the administration of justice as efficient and effective as possible.

Conception—The Group's Origins

Three prominent IP attorneys conceived of the IP Practice Group. Kristine Boylan of Merchant & Gould, Lora Mitchell Friedemann of Fredrickson & Byron, and Becky Thorson of Robins, Kaplan, Miller & Ciresi—all of whom are IP practitioners as well as good friends—recognized the need for the group. Although other local bar associations were dealing with intellectual property, none focused on intellectual property litigation in federal courts. In light of the substantial patent, trademark, and copyright work done in the District of Minnesota, the trio concluded that “there was a substantial appetite for a subcommittee in the FBA,” as Friedemann explained.

Boylan, Friedemann, and Thorson were right. They took the idea to Judge Michael J. Davis (now chief judge), the Minnesota Chapter president at the time, and he approved the IP Practice Group for an inaugural one-year term in 2005. The group received support from the practicing lawyers and from the district's judges from the beginning. Judge Joan N. Ericksen, for instance, was excited to hear about the group: “We do so much work in the area of patent litigation in this district and we are blessed with such a congenial patent bar, I thought it would be a great idea to form a committee that would help make patent litigation even more of a strength in the Minnesota Federal Bar Association.” Geoff Biegler, *Bar Talk*, “The Intellectual

Property Committee” (March 7, 2008).

Friedemann took charge of the new committee as its first chair. Since the IP Practice Group was created, it has organized social and community service events and CLE programs and has furthered the discussion on key patent issues in the District of Minnesota.

Prosecution—The Work Done

The IP Practice Group has done a lot in just a few years. The group has hosted a number of social events for the IP bar—ranging from happy hours to community service events to formal receptions for new judges. In 2007, for example, the group welcomed newly appointed Judge Patrick J. Schiltz to the bench. In order to fully prepare him to handle all the patent cases coming his way, the IP Practice Group held a reception for him and presented him with the core tools needed to tackle patent matters. Judge Schiltz received a pocket protector, a hat embroidered with POSITA (Person of Ordinary Skill in the Art), a book of “art,” and a CD containing the Federal Circuit's “greatest hits.” This event was so popular that it is now a customary event to welcome a new judge or simply to recognize the judiciary for their work. Tara C. Norgard of Carlson, Caspers, Vandenburg & Lindquist and a past chair of the group, for example, describes the judicial receptions as “a thank you to the judges for being involved in a meaningful way in how the district handles its cases, and an opportunity for everyone to get to know one another other outside the courtroom.”

The IP Practice Group also puts on a set of training sessions designed to teach judicial law clerks about patents. Started in 2007, the group presents a four-part training program that provides the basics of patent litigation. The first session explains the nuts and bolts of a patent and how one is obtained. The second session focuses on the basics of patent litigation, including an introduction to the claims construction process. The third session discusses defenses to claims of patent infringement. And the final session addresses current hot topics in patent law and recent key decisions made by the Federal Circuit and the U.S. Supreme Court. These training sessions, which are held every two years in the fall, are prepared and presented by members of the bar as well as local professors.

The IP Practice Group also organizes an annual

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community service event. In one event, for instance, members of the IP Practice Group volunteered to work on a Habitat for Humanity project.

In addition, the IP Practice Group has presented a number of focused continuing legal education programs. Aware that patent law is not the only aspect of intellectual property, the group has held a trademark seminar and brought in Raymond J. Dowd, FBA vice president for the Second Circuit and author of *Copyright Litigation Handbook*, to discuss copyright law. And last year, amidst Congress' ongoing interest in patent reform, the group hosted a well-balanced and frank debate on the subject.

What is perhaps most important, however, is that the IP Practice Group is a means for the bench and bar to communicate about and work together in securing the best possible practices and procedures for litigating and trying IP cases. In 2005, the District of Minnesota adopted and implemented local patent rules, as districts such as the Northern District of California and the Eastern District of Texas had done. The bench did not want to simply impose local patent rules on the district's lawyers, however. Instead, the judges wanted to know if the rules helped and also to find out if any changes needed to be made. The IP Practice Group, therefore, held a forum to discuss the local patent rules six months after the rules went into effect. The forum was a success, allowing practitioners to share their thoughts with the judges on the virtues of the rules in practice as well as any difficulties they had encountered with the rules in their practice.

The forum was so successful, in fact, that it spawned another similar project developed by the IP Practice Group. In light of the feedback from the local patent rules forum and recognizing that the *Markman* process is generally the most significant portion of local patent rules, Judge Ericksen suggested a *Markman* Study Group and was pivotal in forming it. Led by Tara Norgard, the *Markman* Study Group is working to determine whether the claims construction process can become more efficient for the court and the parties in the District of Minnesota. The group has undertaken two main efforts: The study group (1) gathered feedback from the district's judges through in-person interviews and (2) is conducting a survey of the experience and opinions of all patent practitioners in the district.

During the interviews, the judges were asked about the following topics:

- scheduling and exchanges relating to claim construction and the process as prescribed by the local



Members of the IP Practice Group working on “real” property at a house being built by Habitat for Humanity in St. Paul—(l to r) Tara Norgard, Judge Ericksen, Becky Thorson, Jake Holdreith, Laurie Hartman, Lora Mitchell Friedemann, and Kit Friedemann; (front) Ali and R.J. Zayed.

- patent rules;
- the possibility of additional requirements to improve the process—for example, requiring a more detailed claim construction plan from parties at the Rule 16 conference, limiting the number of claim terms, construing representative claims, adjusting the claim construction process for simple vs. complex cases, or fast-tracking cases in light of claim construction issues;
- hearings, timing of the claim construction issues, length, structure, tentative rulings, evidence, effect on discovery, summary judgment, and expert involvement afterward;
- the role of claim construction in settlements;
- jury instructions on interpreting claims and construed terms;
- revision of claim construction or construing of additional terms after a decision;
- ideas to make process more efficient; and
- questions the judge may have for attorneys representing clients in patent cases about claim construction practice.

With 19 judges in the district, gathering this information obviously was a formidable task. The study group, nonetheless, completed the interviews and presented its conclusions to the Minnesota Chapter at the annual seminar.

The group is now finalizing its electronic survey that will be sent out to practitioners in the district about their experiences and preferences with respect to *Markman* procedures. Once the survey is complete, the IP Practice Group will review the results and open a dialogue as to how the *Markman* process can improve patent litigation in Minnesota.

Continuations—Future Work

The IP Practice Group seeks to continue the work it has done to date. Specifically, in addition to the regular social events, the group has planned two major events to be held in the first part of 2010. First, once the *Markman* survey is completed and its results are circulated, the group will host a forum for an open and candid dialogue between the bench and the bar about the information that has been gathered. Second, the group is planning to conduct a high-profile demonstration of a mock trial involving patent issues. This event, tentatively planned for late spring, is intended to highlight effective trial advocacy for difficult and complex material.

The Minnesota Chapter's IP Practice Group has been a success for two reasons. The first is the dedication, motivation, and initiative of the initial trio who recognized the need for the District of Minnesota to have a group that would focus specifically on IP litigation and then

carried through on that idea to get the group up and running. Second, the success of the IP Practice Group is possible only with the interest and efforts of the district's judiciary. "The judges are truly interested in making this district a workable and user-friendly place for litigants and the court—and that makes all the difference," says Norgard. The bar in Minnesota is grateful for the care, attention, and consideration the judges give to these issues and for the judges' efforts to engage in dialogue with practitioners to achieve the best possible practices and procedures for the District of Minnesota. **TFL**

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Int'l Inc., 474 F. Supp. 2d 592, 612 (D. Del. 2007) ("The Court also rejected a categorical rule that a patentee's willingness to license its patent is enough to establish that the patentee would not suffer irreparable harm in the absence of an injunction.").

³⁹See, e.g., *Voda v. Cordis Corp.*, 536 F.3d 1311, 1329 (Fed. Cir. 2008) (alleged harm to exclusive licensee but noting that despite result, "patent owners that license their patents rather than practice them 'may be able to satisfy the traditional four-factor test' for permanent injunction ...").

⁴⁰*eBay*, 500 F. Supp. 2d at 573.

⁴¹*eBay*, 500 F. Supp. 2d at 583–84; *Muniauction Inc. v. Thomson Corp.*, 502 F. Supp. 2d 477, 483 (W.D. Pa. 2007) ("The jury's finding that defendants have willfully infringed plaintiff's patent for six years supports our conclusion that plaintiff has suffered irreparable injury to its patent rights, for which there is no adequate remedy at law."), *rev'd in part, vacated in part on other grounds*, 532 F.3d 1318 (Fed. Cir. 2008), *cert. denied*, 129 S. Ct. 1585 (2009).

⁴²See, e.g., *z4 Techs. Inc. v. Microsoft Corp.*, 434 F. Supp. 2d 437, 443–44 (E.D. Tex. 2006); *Paice LLC v. Toyota Motor Corp.*, No. 2:04-CV-211, 2006 U.S. Dist. LEXIS 61600 (E.D. Tex. Aug. 16, 2006), *aff'd in part, vacated in part on other grounds, and remanded*, 504 F.3d 1293 (Fed. Cir. 2007). But note that the Federal Circuit approved the amelioration of such adverse effects by the district court through a sunset provision. *Voda*, 536 F.3d at 1329.

⁴³*Broadcom Corp.*, 543 F.3d at 704 (affirming permanent injunction in face of arguments of harm claimed by infringer noting "[o]ne who elects to build a business on a product found to infringe cannot be heard to complain if an injunction against continuing infringement destroys the business so elected").

⁴⁴*Acumed LLC v. Stryker Corp.*, 04-CV-513-BR, 2007 U.S. Dist. LEXIS 86866, *20 (D. Or. Nov. 20, 2007) ("the court concludes there is not sufficient objective evidence of any public-health issue in the form of screw back-out problems with the

Polarus product to find the public interest would be disserved by a permanent injunction against Defendant"); *Martek Biosciences Corp. v. Nutrinova Inc.*, 520 F. Supp. 2d 537, 559 (D. Del. 2007) ("Lonza has presented no evidence nor made any argument that a permanent injunction would harm the public") *aff'd in part, rev'd in part*, Nos. 2008-1459, 2008-1476, 2009 WL 2780367 (Fed. Cir. 2009); *800 Adept Inc.*, 505 F. Supp. 2d at 1338 (granting permanent injunction where there is no evidence of record that suggests that the infringing services are related to any issue of public health or some critical public interest); *MPT Inc.*, 505 F. Supp. 2d at 421 (granting permanent injunction where there "is no critical public need for use of placards to practice the patented method").

⁴⁵*Broadcom Corp.*, 543 F.3d at 704 (noting "[w]e agree that the sunset provisions mitigate the harm to the public and that the district court did not abuse its discretion in fashioning a remedy that protects [the patentee's] rights while allowing [the infringer] time to develop non-infringing substitutes."); see also *Verizon Servs. Corp.*, 503 F.3d at 1311, n.12 (approving the use of sunset provisions to blunt harm to public and/or infringer).

⁴⁶See note 43.

⁴⁷*Amado v. Microsoft Corp.*, 517 F.3d 1353, 1361 (Fed. Cir. 2008), citing *Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293, 1317 (Fed. Cir. 2007); see also *Fresenius USA Inc. v. Baxter Int'l Inc.*, 2008-1306, 2008-1331, 2009 U.S. App. LEXIS 20155 (Fed. Cir. Sept. 10, 2009). Obviously, this would be unnecessary if the parties' agreed to license terms.

⁴⁸*Paice*, 504 F.3d at 1314.

⁴⁹This, of course, does raise some Seventh Amendment issues, chiefly whether the imposition of the post-verdict royalties by the court deprives the patentee of its right to a jury on this damages issue. *Paice* is supportive of the conclusion that the Federal Circuit does not think this is a problem. See also *Fresenius USA Inc.*, 2009 U.S. App. LEXIS 20155 (remanding determination of post-verdict royalties for determination by court in light of other rulings).

⁵⁰*Paice*, 504 F.3d at 1317.