

Patent Case Management Judicial Guide

**FEDERAL JUDICIAL CENTER
2010**

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FEDERAL JUDICIAL CENTER

2010

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The contents of this volume (in Boolean searchable format), links to Internet-accessible materials cited herein (such as Patent Local Rules, standing orders, and model jury instructions), updates, and recent cases and other developments relating to patent case management can be found at the project's website:

<http://www.patentcasemanagement.org>

The 2010 edition of the *Patent Case Management Judicial Guide* tracks the 2009 edition with minor corrections and inclusion (in Appendix E) of “Model Patent Jury Instructions” prepared by the National Jury Instruction Project (released June 17, 2009).

Foreword

This judicial guide on patent case management is a collaborative effort between the Federal Judicial Center and the Berkeley Center for Law & Technology of the University of California–Berkeley School of Law. This collaboration began in 1998 when the Berkeley Center and the Judicial Center conducted their first intellectual property seminar for judges. That seminar was structured to provide district judges with a background and understanding of the many areas of intellectual property law. From that initial program has evolved an annual intellectual property seminar for judges at the Berkeley Center as well as a range of innovative intellectual property programs at the Federal Judicial Center’s national and local workshops.

Then and now, the driving force behind these judicial education efforts in intellectual property has been Professor Peter Menell, director of the Berkeley Center. Building on the enormous success of these programs, Professor Menell approached the Judicial Center several years ago with the idea of collecting materials on patent case management that had been compiled for the intellectual property seminars. With coauthors Lynn Pasahow, James Pooley, and Matthew Powers along with the assistance of a distinguished group of collaborators and advisors, Professor Menell prepared this comprehensive guide. I believe this guide will be a valuable aid to judges handling the complex arena of patent cases

BARBARA J. ROTHSTEIN

U.S. District Judge

Director, Federal Judicial Center

Preface

As the number, size, and complexity of patent cases have grown throughout the United States over the past several decades—paralleling expansion in the role of high technology enterprises in the U.S. economy—the need for a comprehensive, user-friendly, and practical judicial guide for managing patent cases has become increasingly apparent. Although similar in many respects to other forms of complex civil litigation, patent cases pose distinctive case-management challenges. Patent cases feature complex and dynamic technological facts to a degree rarely encountered in most other areas of litigation. Furthermore, they employ unique procedures (such as claim construction hearings) that affect and interact with other aspects of the case (such as summary judgment motions and expert reports) in ways that create unusual scheduling and substantive complexity. In addition, patent cases often entail distinctive and difficult discovery issues, extensive use of experts, and particularly complex dispositive and pretrial motion practice.

Because of the decentralized, general jurisdiction structure of federal courts in the United States, much of the experience relating to managing patent cases is siloed in particular judicial chambers. As one jurist aptly noted, best practices for patent case management have been transmitted largely through word of mouth. Given the crowded, diverse dockets of federal courts, the accessibility and reliability of such knowledge is far from ideal. Judges in some districts have partially codified recommended practices in the form of Patent Local Rules, standing orders, and patent jury instructions, but these documents do not address the full range of distinctive challenges posed by patent litigation. Furthermore, such judicial wisdom continues to evolve.

Recognizing these patterns, the authors undertook in 2006 to survey the range of approaches and perspectives on patent case management, foster discussion and analysis of patent case management techniques, and develop an authoritative guide for judges, law clerks, practitioners, and patent and civil procedure professors and scholars. This project grew out of an annual series of intellectual property education programs that Professor Peter Menell has organized since 1998 for the Federal Judicial Center. It began by collecting available materials relating to patent case management and constructing a comprehensive outline. Over the next year, the team drafted, revised, and edited the principal chapters of the guide. They first vetted a draft at the FJC intellectual property conference in June 2007. They then undertook a substantial revision of the manuscript. Between December 2007 and August 2008, the authors met with district judges and magistrate judges in the most active patent jurisdictions around the nation—the Northern District of California, the Central District of California, the District of Delaware, the Northern District of Illinois, the District of New Jersey, the Southern District of New York, the Eastern District of Texas, and the Eastern District of Virginia—as well as the Federal Circuit to discuss the overall project and refine the specific case-management recommendations.

Such sessions explored the range of practices and honed the best practices set forth in this Guide. The authors also assembled an advisory board of leading patent litigators and academics to provide input on the project.

Given the dynamism of the patent system and patent litigation, the authors plan to revise the guide on a biennial basis.

Acknowledgments

This project could not have reached fruition without the support and encouragement of the Federal Judicial Center and the Berkeley Center for Law & Technology. We are especially grateful to the many federal judges, practitioners, and professors who have provided insights and guidance on patent case management. We thank James Morando and Ted Sichelman for detailed comments on the manuscript; Ashley Doty, Blake Greene, Tamar Gubins, David Haskel, Justin Lee, Will McGinty, Hersh Reddy, and Jeff Thomas for excellent research assistance; David Grady and Jennifer Zahgkuni for their assistance in editing and formatting the guide; and Laura Rochelois and the studio of By Design Legal Graphics for their assistance with figure illustrations. We owe a special debt of gratitude to David Marshall at the FJC for his tireless efforts to produce the final manuscript.

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