**FROM DELAWARE TO TEXAS TO CALIFORNIA**

**OCTOBER 28, 2022**

**BENCH BAR PANEL**

**POSSIBLE DISCUSSION TOPICS**

**I. SHORTLISTED TOPICS**

1. **Trial Management Protocols**
   1. *Setting Timeline for Trial*: (Kevin Collins)
      1. *Background*: The judges in the districts represented on the panel generally give each side a specific amount of time for openings, closings, and presentation of evidence at trial, and generally allow between one to two weeks for a patent trial.
      2. *Potential Question*: **Judge Yeakel:** You just had a pretty big patent trial last month that you got through in eight trial days. How do you decide how much time is needed for a given trial?
         1. *Potential Follow-Up Question*: **Judges Seeborg and Connolly:** How do you determine what amount of time is needed for a given trial, and how does that compare to what’s normally done in your district?
      3. *Potential Question*: **[Open Question]:** Do any of the other judges have different views?
      4. *Potential Question*: [**Open Question**]: Do any of the other judges have examples of good or bad use of trial time that they would like to address?
   2. *Voir Dire:* (Josh Thane)
      1. *Background*: Some districts allow the attorneys to conduct a substantial questioning of the jury panel, while in others the judges conduct the voir dire themselves with little input from the attorneys.
      2. *Potential Question*: **Judge Andrews:** You have a sample voir dire form that you provide on your webpage. Do you feel that the attorneys are able to get the information they need to make intelligent decisions with regards to cause challenges and preemptory strikes?
      3. *Potential Follow-Up Question*: **[Judges Outside Texas]:** Do any of the other judges outside of Texas have thoughts on letting attorneys conduct voir dire?
      4. *Potential Question*: **Judge Gilstrap:** You allow the attorneys to conduct a pretty full voir dire. Do you feel the attorneys make good use of the time given to them for questioning the jury panel?
      5. *Potential Question*: **Judge Stark:** Does your experience as a district court judge influence the way you view challenges to trial court rulings on appeal now, and if so, can you elaborate?
         1. *Potential follow-up question:* **Judge Stark:** Now that you’ve been on the Federal Circuit for a bit, is there anything you would have done differently as a district court judge? And is there anything that you would recommend to the trial bar to do differently to make the trial judge’s job easier or your judge easier?
2. **Case Management** 
   1. Time to claim construction (Kevin Collins)
      1. *Background*: Claim construction is a critical milestone in patent cases, following which disputes often resolve or narrow.
      2. *Potential Question*: **Judge Andrews**: Given the crucial role that claims plays in our patent system, are there things that courts and parties can do to get to *Markman* quickly, or at least construe key claim terms, earlier in a case?
         1. *Potential Follow-Up Question*: **[Open Question]:** Do any of the other judges have things they do to try to get to *Markman* quicker or different views on whether claims should be construed early?
         2. *Potential Follow-Up Question*: If there’s a claim term that a party believes is dispositive, would any judges allow teeing up that one claim term without prejudice to having a full claim construction hearing later on?
   2. Early case narrowing requirements (Josh Thane)
      1. *Background*: Although all courts require parties to narrow their case as trial approaches, this is generally done on a case-by-case basis. However, in what appears to be a first, on April 26, 2022, Chief Judge Connolly issued a form Scheduling Order for Hatch-Waxman Cases that requires disclosure of asserted claims within a week or so of the initial scheduling conference. The order requires that, absent an agreement to the contrary between the parties, “Plaintiff(s) may assert *no more than ten claims of any one patent and no more than 32 claims in total against any one Defendant*.”  (Paragraph 5, Scheduling Order for Hatch-Waxman Patent Infringement Cases.)
      2. *Potential Question*: **Judge Connolly**: Are these numbers—10 claims per patent and 32 claims per defendant—the right limits? And what kind of results is the Court seeing from requiring this selection early in the case?
   3. Pre-trial case narrowing (Kevin Collins)
      1. *Background*: Chief Judge Gilstrap’s Sample Docket Control Order requires that, six weeks before jury selection, parties file a Joint Pretrial Order, detailing their respective contentions. The order states that contentions cannot be “amended, supplemented, *or dropped* without leave of the Court . . . upon a showing of good cause.”
      2. *Potential Question*: **Judge Gilstrap**: Heading into trial, does EDTX regard any particular number of asserted claims and invalidity grounds as reasonable? Are parties directed to comply with those numbers as trial approaches, or does the rule against dropping contentions without permission adequately incentivize parties to properly narrow their cases and to do so at the right timeframe in the life of a case?
         1. *Potential Follow-Up Question*: **[Open Question]:** Do any of the other judges have a different practice on the number of asserted claims and invalidity grounds they allow to be presented at trial?
3. **The State of Patent Law [Open Questions] (Josh Thane and Kevin Collins)**
   1. *Potential Question*: (Kevin Collins) Is the US patent system effectively promoting scientific progress? If you could change one thing about our system, what would it be? And if you could receive guidance form the Supreme Court or Federal Circuit on one patent law issue, what would it be?
   2. *Potential Question*: (Josh Thane) What can lawyers do to better aid judges in handling complex patent cases?
   3. *Potential Question*: (Josh Thane) Are there practices you have seen in other courts or cases that you think should be considered implementing in patent litigation?
   4. *Potential Question*: (Josh Thane) Is there any way to bring more certainty to putting on patent litigation damages cases?
   5. *Potential Question*: (Kevin Collins) What can be done to simplify jury instructions in patent cases?
   6. *Potential Question*: Is there anything else the judges want to say to an audience of trial lawyers that try these cases about what they should be thinking about when they try these complex cases?
4. **Motions for Summary Judgment (Josh Thane)**
   1. Ranking MSJs
      1. *Background*: In April 2021, Chief Judge Connolly issued a Standing Order for Summary Judgment Practice in Patent Cases requiring that parties who file more than one summary judgment motion “number each motion to make clear the order the party wishes the Court to consider the motions in question.” The Standing Order states that the “Court will review the party’s summary judgment motions in the order designated” and if a motion is denied “barring exceptional reasons . . . the Court will not review any further summary judgment motions filed by the party.”
      2. *Potential Question*: **Judge Connolly**, your order explains the rationale for this approach—*i.e*., efficiency and to curb the “proliferation of meritless summary judgment motions in patent cases.” What kind of results are you seeing through this approach and would you recommend that other courts adopt similar rules?
   2. Expectations of success in MSJs
      1. *Background*: Judge Connolly’s Standing Order for Summary Judgment Practice in Patent Cases reads: “[a] wise judge who once sat on this Court was fond of saying that winning summary judgment in a patent case is like hitting a hole in one,” and the standing order notes that “the odds of hitting a hole in one are 12,500 to 1.”
      2. *Potential Question*: **Judge Mazzant**, do you view MSJs as a worthwhile exercise in patent cases and a judicious use of judicial resources?
         1. *Potential Follow-Up Question*: Do any of the other judges have different views?
      3. *Potential Question*: The national data sourced from Docket Navigator, interestingly, doesn’t quite reflect the “hole-in-one” analogy, and instead suggest that while accused infringers are over twice as likely as patentees to move for summary judgment, for both sides, at least some relief is obtained about 40% of the time. **Judge Andrews**: What is your approach to MSJs?
5. **Standing And Litigation Funding Issues (Josh Thane)**
   1. *Background*: Judge Connolly has issued a standing order requiring disclosure of third-party funding arrangements at outset of litigation, while some courts not only do not require such a disclosure, but have denied motions to compel discovery into litigation funding.
   2. *Potential Question*: **Judge Connolly:** Why did you decide to issue your standing order relating to the disclosure of third-party funding of litigation, and how has it been working so far?
   3. *Potential Question*: **Judge Seeborg:** Several of the judges in your district have previously denied motions to compel discovery of litigation funding issues, and your district previously considered adding the mandatory disclosure of litigation funders to your local rules, but ultimately decided against it. Do you see litigation-funding issues as outside the normal relevance of the case, and in what circumstances would you allow discovery into these issues?
      1. *Potential Follow-Up Question*: **[Open Question]:** Do any of the Texas judges want to speak on Texas practice related to discovery of litigation funding?
6. **Patent Contention Disclosures, Early Disclosures, and Treatment of Amendments and Omissions (Josh Thane)**
   1. *Background*: While the judges on the panel all have mechanisms for patent contention disclosures, some are handled by local patent rules, some by local discovery rules, and some by individual judges scheduling orders.
   2. *Potential Question*: **Judge Connolly:** Your form scheduling order for patent cases is quite similar in regards to early disclosures to the local patent rules found in EDTX or NDCA. Has Delaware considered adopting a specific set of local patent rules? And why did you decide to use the rules you did when Delaware already has a mechanism for contention discovery in patent cases in its default standard for discovery?
      1. *Potential Follow-Up Question*: **Judge Andrews:** Any follow up thoughts on whether Delaware should adopt local patent rules?
   3. *Potential Question*: **Judge Yeakel:** With the rise in the number of patent cases filed in the Western District of Texas, and with almost all the judges in the district now helping out with patent cases, do you see the district considering adopting a set of local patent rules?
7. **Section 101 Patent Eligibility Disputes (Kevin Collins)**
   1. Pre-*Markman* Section 101 motions
      1. *Background*: While EDTX, DEL and NDCA all require Section 101 patent eligibility contentions in some form, since 2015, Chief Judge Gilstrap has maintained special procedures governing dispositive motions raising Section 101 arguments. Among other things, the “Standing Order Regarding Motions Under 35 U.S.C § 101” requires lead counsel for each side to meet and confer “one-on-one” to decide whether the patent eligibility issues can be resolved without claim construction. The Standing Order states that “efficiency is enhanced by early input as to the propriety or lack thereof regarding claim construction prior to consideration of such motions.”
      2. *Potential Question*: **Judge Gilstrap**, does early resolution of Section 101 issues, *e.g*., through a motion to dismiss, enhance efficiency? Are disagreements as to whether claim terms need to be construed a main challenge in resolving such motions?
   2. Whether Section 101 patent eligibility rules are clear
      1. *Background*: There is a wide variance between EDTX, NDCA, and DEL courts in how often Section 101 motions, particularly early motions to dismiss, are granted.
      2. *Potential Question*: **Judge Mazzant**, what is your approach to Section 101 patent eligibility disputes, and do you believe that trial courts now have adequate guidance from higher courts on these issues?
      3. *Potential Question*: **Judge Stark**, you granted relief in many early Section 101 motions to dismiss brought before you. Before joining the Federal Circuit, what were your views on handling these 101 motions and have your views changed?
8. **PTAB And District Court Interplay (Kevin Collins)**
   1. Role of PTAB
      1. *Background*: Per Docket Navigator, on average nationally, courts grant some relief in motions to stay pending IPR, post-grant review, or reexaminations about half of the time.
      2. *Potential Question*: **Judge Seeborg**: How do you view the PTAB and its role in resolving issues bearing on a patent dispute pending in federal court? Should courts step aside when possible to allow the PTAB to reassess patentability of the claims?
      3. *Potential Question*: **Judge Gilstrap**, what role should the PTAB play in resolving issues relevant to a patent dispute pending in federal court? Does staying a lawsuit pending PTAB proceedings do a disservice to the parties?
9. **Learnings from COVID-19**
   1. *Necessity of in-person activities* 
      1. *Background*: Through the pandemic, most courts allowed some form of remote deposition and trial testimony, including in criminal cases.
      2. *Potential Question*: **[Open Question]** Now that courts are mostly back to business as usual, are there any practices worth retaining to make litigation more efficient and affordable?
      3. *Potential Question*: **[Open Question]** Did any of the panelists find that witnesses testifying remotely prejudiced the administration of justice?