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## Guest Column Using Scheduling Orders To Manage Claim Construction

By **George W. Jordan III, Merchant & Gould**

While a scheduling order under Fed. R. Civ. P. 16 is commonly used for setting pretrial deadlines, a scheduling order is particularly useful in patent cases for effectively managing claim construction and common patent discovery disputes. While the use of scheduling orders in patent cases has varied, the vast majority of scheduling orders fall into one of three categories: (i) generic orders; (ii) orders providing a briefing schedule on claim construction; or (iii) orders providing briefing and discovery schedules on claim construction. A generic scheduling order lacks any reference to claim construction or other patent issues. For example, the order may only set deadlines for amended pleadings, expert reports, close of discovery and dispositive motions. In the second category, a scheduling order typically sets deadlines for at least opening and responsive claim construction briefs. A scheduling order in the last category typically sets deadlines for proposed claim constructions and infringement claim charts. Though a handful of district courts have established local patent rules with the goal of a fair, speedy and efficient resolution of patent cases, a scheduling order can help to achieve this goal for any district court.

Absent its own briefing schedule, claim construction is typically briefed along with

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## Recent guest co



**Using Scheduling Orders To Manage Claim Construction**  
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summary judgment issues. Yet, unlike summary judgment, a claim construction ruling is essential during the discovery process to secure a just, speedy and efficient resolution of a patent case. Because claim construction determines the scope of the patented invention, infringement and most invalidity issues depend upon claim construction. While fact discovery on infringement and invalidity is appropriate beforehand, expert discovery on infringement and invalidity often proves wasteful without a ruling on claim construction. For example, where a court has not ruled on claim construction, expert reports on infringement and invalidity must assume a particular scope of the patented invention. Each side will basically assume its proposed scope of the invention. Local Rule 5.1 of the Western District of Pennsylvania avoids such a problem by making initial expert reports by a party on the issues where it bears the burden of proof due thirty (30) days after a claim construction ruling.

Without a claim construction ruling, an accused infringer must assume a particular scope of the invention in identifying prior art. As such, additional prior art that was not intentionally withheld might come into play after the ruling if the court adopted a different scope of the invention. Because of this type of issue, Local Rule 6.7 of the Northern District of Georgia provides for an additional forty-five (45) days of discovery after a claim construction ruling if fewer than thirty (30) days are left for discovery. Another alternative is for discovery to close a certain number of months after a claim construction ruling.

A discovery schedule is essential to making claim construction fair and efficient. Without a schedule defining the discovery obligations and deadlines impacting claim construction, parties are understandably reluctant to put all their cards on the table. Parties need adequate disclosure of infringement and invalidity contentions to determine the particular claim terms genuinely in need of construction. While an accused infringer typically needs adequate disclosure of the patentee's infringement contentions



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#### **Patents And Tying Getting Involved**

*Wednesday, June 22, 2006*  
*Sandip H. Patel, Partner,*  
Marshall, Gerstein & Boru  
Supreme Court's decision  
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including identification of asserted claims, a patentee typically needs adequate disclosure of the accused infringer's non-infringement and invalidity contentions including identification of prior art. As reflected in the table below, the Northern District of Georgia, Western District of Pennsylvania, Northern District of California and Eastern District of Texas have adopted similar infringement and invalidity disclosure requirements in their local patent rules.

Court	Infringement & Invalidity Disclosure Requirements
Northern District of Georgia (Effective July 15, 2004)	<p>Patentee: infringement contentions (including asserted claims) [Patent L.R. 4.1]</p> <p>Accused infringer: response to infringement contentions [Patent L.R. 4.2], invalidity contentions [Patent L.R. 4.3]</p>
Western District of Pennsylvania (Effective July 1, 2005)	<p>Patentee: asserted claims &amp; infringement contentions [LPR 3.2]</p> <p>Accused infringer: non-infringement &amp; invalidity contentions [LPR 3.4]</p>
Northern District of California (Effective January 1, 2001)	<p>Patentee: asserted claims and infringement contentions [Patent L.R. 3-1]</p> <p>Accused infringer: invalidity contentions [Patent L.R. 3-3]</p>
Eastern District of Texas (Effective February 22, 2005)	Patentee: asserted claims and infringement contentions [P.R. 3-

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**Open Source Softv**  
*Wednesday, May 04, 2005*  
 Michael Vella and Ryan F Morrison & Foerster litigal look at the IP risks involve source software.



**A Clo**  
*Friday, Jeremy Gerste latest c patent blade r*

**Jury Still Out On "**  
*Sunday, April 17, 2005*  
 James P. Jeffry looks at tl "inherent anticipation" cas banc" decision in GlaxoSr

**IP Pitfalls Underm R&D**  
*Friday, March 11, 2005*  
 Michael C. Martensen Why is government fundir attorney Michael C. Marte way the government hanc



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Accused infringer:  
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Adequate disclosure of infringement and invalidity contentions helps the parties in crystallizing claim construction issues. Withholding critical information – like the best prior art – till after a claim construction ruling should be discouraged.

Common patent discovery disputes—many of which involve timing, privilege, disqualification and supplementation—can be effectively managed through a scheduling order. For example, a scheduling order can specify patent discovery rules and/or deadlines for recurring patent issues such as the following:

- Deadline for electing to rely on advice of counsel [See N.D. Ga. Patent L.R. 5.2(a); N.D. Cal. Patent L.R. 3-8];
- The scope of waiver based on an election to rely on advice of counsel [See N.D. Ga. Patent L.R. 5.2(b)-(d)];
- Whether or not there is a presumption against bifurcation of damages from liability for purposes of either discovery or trial [See N.D. Ga. Patent L.R. 5.1];
- Deadline for completing invalidity discovery [See Proposed Patent L.R. 5-1, 7 COMP. LAW REV. & TECH J. 149 (Winter 2003)];
- Whether or not an attorney who rendered an opinion tendered in defense of a charge of willful infringement is disqualified or limited from participation in the case [See N.D. Ga. Patent L.R. 5.3(a),(c)-(d)];
- Whether or not an attorney involved in prosecution of the patent-in-suit is disqualified or limited from participation in the case [See N.D. Ga. Patent L.R. 5.3(b)-(d)];
- The scope of discovery of confidential information prior to entry of a protective order (without affecting the burden of proof or persuasion imposed by law on a party seeking to limit

disclosure of confidential information)  
[See N.D. Ga. Patent L.R. 2.1];

- Whether or not discovery will be deferred on damages to any degree; and
- The extent to which patent prosecution documents should be produced.

While many of the above areas are addressed by the local patent rules of the Northern District of Georgia, a scheduling order can be tailored by any district court to address each area depending on the circumstances of the particular case. Accordingly, some courts are now employing a fourth category of scheduling orders similar to those rules: orders providing patent discovery rules including briefing and discovery schedules on claim construction. In this category, a scheduling order addresses common patent discovery issues like those listed above. By knowing a court's default positions on common patent discovery issues, the parties can better manage patent litigation costs.

While not a panacea, a scheduling order can make a real difference and thus should not be taken for granted. Not only can a patent-specific scheduling order extend the advantages offered by local patent rules to any district court, but it can also offer a comprehensive discovery plan for effectively managing claim construction and common patent discovery disputes based on the circumstances of the particular case.

**Jordan is a senior associate in the Atlanta office of Merchant & Gould, a national intellectual property and litigation law firm. He practices intellectual property litigation with an emphasis on patents, software and copyright/entertainment law. His next guest column in this two-part series will be *Patent Discovery—The Difference A Protective Order Can Make*.**

Questions? Comments? E-mail the editor.

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