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PATENT LITIGATION IN THE DISTRICT OF DELAWARE: JUDGE ROBINSON'S NEW PROCEDURES

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On March 24, 2014, Judge Sue L. Robinson of the U.S. District Court for the District of Delaware - who has one of the busiest patent dockets in the country - overhauled her form scheduling order for patent cases. Judge Robinson announced the changes in a letter addressed simply to "Counsel," "apologiz[ing] for the inevitable confusion and inefficiencies that come from these modifications" while emphasizing that the changes are necessary because "the very nature of patent litigation has changed."

What Are the Major Changes?

In a nutshell, Judge Robinson's changes represent a more hands-on approach by Judge Robinson and the magistrate judges of the District of Delaware and require more rigorous upfront disclosures from the parties.

• Initial Disclosures and Written Discovery

- o The plaintiff is now required to produce the following early in the case: identify the accused products and the asserted patent(s) the accused product(s) allegedly infringe(s); provide a damages model; produce the prosecution history of the patent(s) in suit.
- o Thereafter, the defendant must produce: "core technical documents" related to the accused product(s) sufficient to show how they work; and sales figures for the accused products.

- o After these initial disclosures, the parties are required to have a status conference with an assigned magistrate judge. The purpose of the conference is to ensure that the initial exchanges have been meaningful.
- o Following the status conference, the plaintiff is required to produce an initial claim chart (i.e., infringement contentions) by a certain date.
- o Thereafter, the defendant must produce initial invalidity contentions.
- o Note: Delaware practitioners should already recognize the majority of these initial disclosure requirements. Apart from the addition of the plaintiff's damages model, the defendants' sales figures and the status conference with the magistrate judge, these new disclosure requirements mirror the initial disclosure requirements set forth in the court's existing default standard for discovery, the standard that currently applies in cases where parties are unable to agree on a different manner of conducting initial disclosures/discovery.
- o Following the initial disclosures, the plaintiff is required to provide final infringement contentions, followed by the defendant's production of final invalidity contentions.

• Claim Construction

- o Judge Robinson had previously conducted *Markman* hearings in conjunction with summary judgment hearings and would issue a *Markman* ruling along with her summary judgment rulings. All of this would always take place after expert discovery.
- o Under Judge Robinson's new procedures, the *Markman* hearing will take place and the *Markman* ruling will be issued prior to expert discovery.
- o Following the *Markman* ruling, Judge Robinson will conduct a status conference with the parties to discuss the scope of the case and determine whether any limits need to be imposed to focus the case prior to expert discovery.

• Other

- o Judge Robinson will conduct an in-person status conference "if the parties have any issues regarding expert discovery." *Daubert* motions are not permitted unless first discussed with and deemed appropriate by Judge Robinson during this status conference.
- o Motions *in limine* are not permitted. Evidentiary issues shall be discussed at the pretrial conference and during trial.
- o The assigned magistrate judge will resolve all discovery motions, motions to dismiss, amend the pleadings and transfer venue.

What Prompted These Changes?

Simply put, the District of Delaware, with its four Article III judges and three magistrate judges, is one of the busiest patent districts in the country – second only to the Eastern District of Texas (which has seven Article III judges and eight magistrate judges) in the number of active cases. Judge Robinson is currently overseeing more than 300 patent cases.

Looking for a way to more efficiently manage the court's ever-growing dockets of complex patent cases, Judge Robinson and Judge Leonard P. Stark organized a "Patent Study Group" (PSG) comprised of Delaware patent litigators to discuss potential solutions. Vincent Poppiti and Austen Endersby of Fox Rothschild's Wilmington, Delaware office attended one of the PSG sessions with Judge Stark in January 2014 and participated in a lively discussion of possible ways to streamline patent cases - including holding *Markman* hearings early in the case (prior to expert discovery) and requiring infringement and invalidity contentions to be served early in the case.

What Is the Impact?

- The changes apply to all non-ANDA patent cases that have had a scheduling order entered in the past six months.
- The new initial disclosure and "final infringement/invalidity contention" requirements should help to ferret out weak infringement claims.
- Increased dialogue with the parties through in-person status conferences will keep the litigants on track.
- Early *Markman* procedures will result in cost savings to the parties and may present an opportunity for early settlement.

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