

# POPULAR PATENT VENUES AND LOCAL PATENT RULES

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## ENTERING AN UNFAMILIAR JURISDICTION

There are known **knowns**; there are things we know we know. We also know there are known **unknowns**; that is to say we know there are some things we do not know. But there are also **unknown unknowns** — the ones we don't know we don't know.

--Donald Rumsfeld

## JURISDICTIONS WE WILL DISCUSS

- District of Delaware
- Eastern District of Texas
- Northern District of California
- Central District of California
- Northern District of Illinois
- District of New Jersey
- Southern District of New York
- Southern District of Florida
- Northern District of Texas
- Southern District of California
- District of Massachusetts
- Western District of Texas

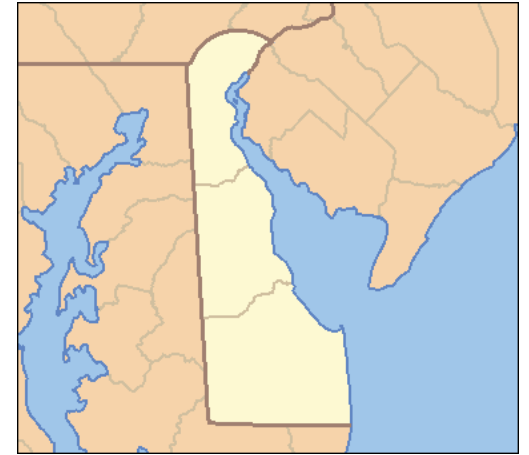
# WESTERN DISTRICT OF TEXAS

- No District-wide Patent Rules
- Patent cases are typically assigned to the Austin Division
- If Judge Yeakel – no discovery prior to Markman
- Seven divisions – San Antonio, Austin, Del Rio, El Paso, Midland, Pecos, and Waco
- Eleven District Judges, four Senior Judges, and two vacancies (one nominee)



# DISTRICT OF DELAWARE

- No District-wide Patent Rules
- Busiest patent District in the country
  - So busy that your case may get assigned to an out-of-District judge
- Must have local counsel
  - Getting licensed in DE is very difficult
- Rarely transfer cases
- Four District Judges, two Senior Status Judges



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# EASTERN DISTRICT OF TEXAS

- Has District-wide Patent Rules
- Reputation as plaintiff's friendly
- Much less congested since TC Heartland, but still busy
- Infringement contentions due before case scheduling conference
- Can amend contentions with good cause – fairly liberal
- Has provision providing for limitations only found within source code
- No discovery requests needed for documents (this is not a rule but is part of the Court's Discovery Order)
- Very easy to get admitted, so do not necessarily need local counsel
- Six divisions – Beaumont, Lufkin, Marshall, Sherman, Texarkana, Tyler
- Four District Judges, three Senior Judges, and four vacancies



# NORTHERN DISTRICT OF CALIFORNIA

- Has District-wide Patent Rules
- Reputation as defendant friendly
- High bar to amend Initial Infringement Contentions
- Requires Damages Contentions and Responsive Damages Contentions
- Limited to ten terms for construction
- Has specific rules for the format of motions/briefs
  - Requires line numbers, for example
- Four Divisions—San Francisco, Oakland, San Jose, Eureka
- Fourteen District Judges, nine Senior Judges



# CENTRAL DISTRICT OF CALIFORNIA

- Has District-wide Patent Rules
- Has document formatting rules similar to the Northern District
- Can amend infringement contentions freely prior to the joint claim construction statement
- Limited to ten terms for construction and must identify any term that is claim or case dispositive (like ND Cal. Rule)
- Three divisions – Eastern (Riverside), Southern (Santa Ana), and Western (Los Angeles—watch out, there are two courthouses in LA)
- Twenty two District Judges, seven Senior Judges, seven vacancies (no nominees)





# NORTHERN DISTRICT OF ILLINOIS

- Has District-wide Patent Rules
- Requires Non-Infringement Contentions along with Invalidity Contentions
- Also requires “Response to Invalidity Contentions”
- Contentions do not become final for 21 weeks
- Final Invalidity Contentions are limited to 25 references
- Limited to ten terms for construction
- There is a presumption against supplementation of Expert Reports
- Two divisions – Eastern (Chicago, Wheaton) and Western (Freeport and Rockford)
- Eighteen District Judges, seventeen Senior Judges, five vacancies (three nominees)



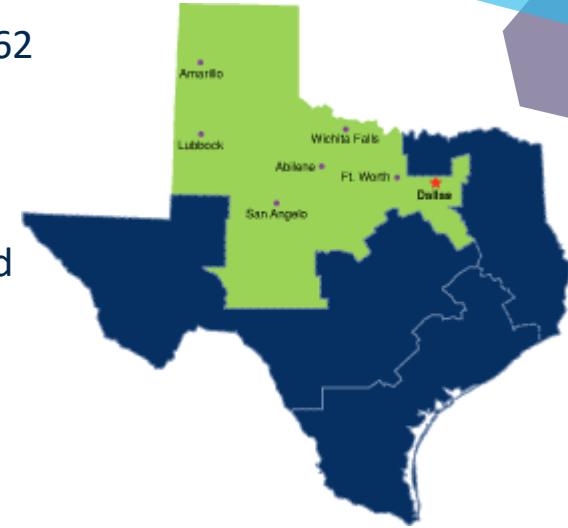
# DISTRICT OF NEW JERSEY

- Has District-wide Patent Rules
- Go-to District for patents on Pharmaceuticals
- Has specific rules for Hatch-Waxman cases
- Requires Non-Infringement and Validity Contentions
- No limits on number of terms for construction but must identify case or claim dispositive along with terms that will promote settlement
- Three divisions – Camden, Newark, Trenton
- Thirteen District Judges, nine Senior Judges, five vacancies (no nominees)



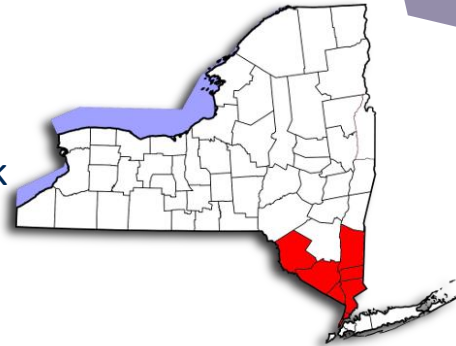
# NORTHERN DISTRICT OF TEXAS

- Has District-wide Patent Rules
  - They are hidden. Look for Amended Miscellaneous Order No. 62
- Preliminary Contentions are deemed Final Contentions unless changed by claim construction or other good cause
- No limit on number of terms for construction but briefs are limited to 30 pages
- Seven Divisions – Abilene, Amarillo, Dallas, Fort Worth, Lubbock, San Angelo, Wichita Falls
- Nine District Judges, four Senior Judges, five vacancies (one nominee)



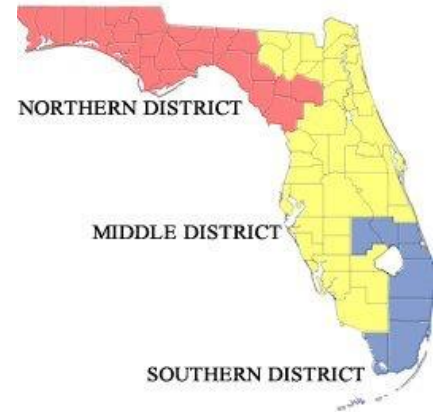
# SOUTHERN DISTRICT OF NEW YORK

- Has District-wide Patent Rules
- Time to disposition can vary greatly depending on the assigned Judge
- The Patent Rules are short and not as detailed as others – mostly just provide for contentions
- Has a specific rule allowing for objections to discovery requests that seek information, such as contentions and constructions, that must be produced under the Patent Rules
- Sits in two Manhattan courthouses and in White Plains
- Twenty-four District Judges, eighteen Senior Judges, six vacancies (two nominations)



# SOUTHERN DISTRICT OF FLORIDA

- No District-wide Patent Rules
- Fast time to trial – average over past ten years is 15 months
- Must have local counsel
- Five Divisions – Fort Lauderdale, Fort Pierce, Key West, Miami, and West Palm Beach
- Thirteen District Judges, eleven Senior Judges, five vacancies (three nominations)



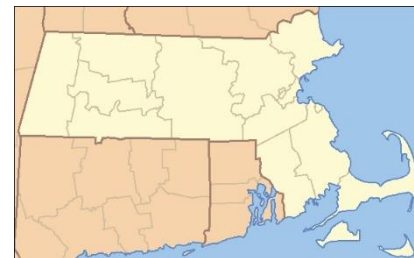
# SOUTHERN DISTRICT OF CALIFORNIA

- Has District-wide Patent Rules
- Requires an “Early Neutral Evaluation” Conference in front of a Magistrate prior to the case management conference
- Rules require a Markman hearing within 9 months and a trial within 18 months of the Defendant’s appearance
- Can amend contentions freely up to the filing of the Joint Claim Construction Statement
- Only two counties and two courthouses
- Ten District Judges, seven Senior Judges, and four vacancies (no nominees)



# DISTRICT OF MASSACHUSETTS

- Has District-wide Patent Rules
- Requires trial within 24 months and Markman within 9 months from scheduling conference
- Requires a post-Infringement Contention meet and confer to determine scope of technical production
- Requires Non-Infringement Contentions
- Parties allowed 10 total terms for construction
- Three divisions – Boston, Worcester, and Springfield
- Eleven District Judges, seven Senior Judges, and two vacancies (no nominations)



# QUESTIONS?

