

New Procedures May Lure More Patent Lawsuits to Massachusetts

By Joel Leeman

The judges of the federal district court in Massachusetts have adopted new procedures that will control the litigation of patent infringement cases in the Commonwealth.

Sunstein attorneys played an essential role in establishing the procedures, serving on the task force which presented the rule to the Court and urged its adoption. The new rule provides a logical framework for patent cases which makes Massachusetts an attractive venue for patent litigants who have a choice of jurisdictions in which to try their disputes.

Introduction: [New Rule 16.6](#), introduced November 4, 2008, is notable for its rigorous regulation of the pre-trial discovery process that accounts for the vast majority of time and expense that patent suits consume. Among other things, parties must try to agree on:

- a. When to exchange their initial positions on infringement and patent invalidity;
- b. When and how the court will conduct the Markman hearing, the often-critical pre-trial hearing in which the judge construes disputed claim terms of the patent in suit; and
- c. Appropriate limits on electronic discovery, which has quickly become one of the more expensive components of all civil litigations.

The rule will provide more certainty and uniformity than previously existed in patent lawsuits before the District of Massachusetts.

Quite a few other federal courts that are well-known magnets for patent lawsuits—such as the Eastern District of Virginia, the Northern District of California, and the Eastern District of Texas—have long had similar rules for such cases.

Even within the District of Massachusetts, some judges already followed procedures much like those embodied in the new rule. A formal rule extends the procedures to all patent suits filed in Massachusetts and gives litigants the certainty they often crave.

Purpose: Patent cases have idiosyncratic procedures that arise from the requirement that the Court perform claim construction to establish the meaning and scope of the asserted patent claims, which in turn has a substantial impact on the basic issues of infringement and validity. Such claim construction occurs in the context of a so-called Markman hearing.

The IP Cases Task Force, comprised of leading patent litigators involved in cases in Massachusetts and throughout the United States, believed that a local rule would promote

uniformity and predictability in the procedures followed in patent cases in Massachusetts. Local Rule 16.6 now provides readily accessible guidelines for the scheduling steps, timelines and procedures that litigants are likely to encounter in this jurisdiction. The new rule also signals to the bar that the United States District Court in Boston is receptive to patent cases.

Basic Rule 16.6 Operation: Rule 16.6 requires that, in addition to the matters listed in Local Rule 16.1 common to all cases, such as deadline for amendments, joinder, discovery, motion practice, etc., the parties must also address the issues peculiar to patent infringement litigation.

These include timing for disclosure by the parties of their initial infringement and invalidity positions, the process for identifying disputed claim terms, claim construction briefing, timing and procedure for a claim construction hearing, the need for technology tutorials, and related issues. The Appendix to the Rule sets forth a sample special scheduling order for patent infringement cases, with suggested timing. At the Rule 16 Scheduling Conference, the Court will set a scheduling order that covers basic timelines, such as the deadline for discovery, as well as time lines specific to patent proceedings.

Patent-Specific Disclosure Requirements. The suggested timelines provide for exchange of infringement and invalidity contentions as follows:

- Patentee's preliminary infringement disclosures – 30 days after Rule 16 conference
- Accused infringer's preliminary invalidity and non-infringement disclosures – 60 days thereafter
- Amended and supplemented disclosures may be provided up to 30 days before the Markman hearing
- Further amendment only within 30 days after the Court's ruling on claim construction

Claim Construction Proceedings. After disclosures are made, claim construction proceedings take place as follows:

- Exchange of claim terms to be construed by the Court – 120 days following completion of preliminary disclosures
- Filing and exchange of claim construction briefs – 20 days thereafter
- Filing and exchange of reply claim construction briefs – 10 days thereafter
- Filing of joint claim construction statement – 15 days after filing of reply briefs
- Claim construction hearing to be scheduled by the Court promptly after the filing of the joint claim construction statement
- Amendment of disclosures permitted within 30 days after Court's ruling on claim construction

Flexibility: Rule 16.6 provides flexibility consistent with ordinary practice in the United States District Court for Massachusetts. The specific schedule for proceedings will be tailored to the individual case. The parties will be called upon to work together to craft a proposed schedule for the Court to impose in their case. Although the rule speaks of “suggested timing,” once the Court has entered a LR 16.1 scheduling order in the case, the parties will be obliged to meet stringent disclosure and briefing obligations in connection with patent-specific contentions and claim construction proceedings.