MAKING THE *MARK(MAN)*: A SUGGESTED METHODOLOGY FOR ENHANCED PATENT CLAIM CONSTRUCTION

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INTRODUCTION

> *He had a word, too. Love, he called it. But I had been used to words for a long time. I knew that that word was like the others: just a shape to fill a lack; that when the right time came, you wouldn't need a word for that any more than for pride or fear.... because people to whom sin is just a matter of words, to them salvation is just words too.*
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> — William Faulkner, (narrative as the character Addie)[1]

Claim construction is an interpretation practice that forms the cornerstone of both patent prosecution and patent litigation in a variety of different forums.[2] Like its name implies, claim construction is when a decision maker (*e.g.*, patent examiner, Article III United States District/Magistrate/Circuit Judge or Article I Administrative Law Judge) "construes" the meaning of a patent claim term. A patent's claims, which appear at the very end of a patent document, define the "metes and bounds" of the described invention as an instance of intellectual property, very much like how a land deed does the same for a parcel of real

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[1] William Faulkner, AS I LAY DYING 172 (New York Vintage International 1985). Author's Note: The author greatly appreciating Faulkner's connection to the University of Mississippi and having a hometown in Oxford, Mississippi in publishing this article in the *Mississippi Law Journal*.

[2] Peter S. Menell et al., *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 BERKELEY TECH. L.J. 713, 716-18 (2010); *see also* Ha Kung Wong, *Patent Claim Construction: Overview*, THOMSON REUTERS: PRACTICAL LAW PRACTICE NOTE, http://us.practicallaw.com/6-524-1100 [https://perma.cc/QV86-T3HX] (last visited Dec. 28, 2023).

property.[3] Claim construction is also more similar to the construction of literary works than to statutory interpretation (*e.g.*, textualism) because the language to be analyzed is grounded in terminology or nomenclature unique to a specific discipline, be it technical, scientific or poetic.[4]

During patent examination—the process of drafting and submitting patent applications with the United States Department of Commerce, Patent and Trademark Office [5]—patents are allowed and issued by Patent Examiners, applying a standard known as the "broadest reasonable interpretation" when searching for and citing prior art references in rejections under Sections 102 & 103.[6] Under the broadest reasonable interpretation standard, "the pending claims must be 'given their broadest reasonable interpretation consistent with the specification.'"[7] After a patent is granted and officially issued with a patent number, and then gets asserted or challenged in a litigation-based tribunal, a different standard is used to construe the claims. [8]

Specifically, once an issued patent is challenged in a United States District Court, the Patent Trial and Appeal Board

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[3] Mark J. Feldstein & Krista E. Bianco, *Claim Construction*, *in* ANDA LITIGATION: STRATEGIES AND TACTICS FOR PHARMACEUTICAL PATENT LITIGATORS (Kenneth L. Dorsney ed., 2nd ed. 2016).

[4] *See* Christian E. Mammen, *Patent Claim Construction as a Form of Legal Interpretation*, 12 J. MARSHALL REV. INTELL. PROP. L. 40 (2012) ("[P]atent claims are a unique type of legal text, and cannot simply be analogized to statutes or contracts, which courts and scholars occasionally attempt to do. Taking lessons from the general legal theory of interpretation, the textualist approach should only be a starting point for the interpretation of patents, rather than an all-encompassing approach."); *see also generally* Camilla Hrdy & Ben V. Picozzi, *Claim Construction or Statutory Construction?: A Response to Chiang & Solum*, 124 YALE L.J. F. 208 (2014) (arguing the difference between judges performing claim construction and statutory interpretation).

[5] Editor's Note: hereinafter USPTO

[6] MPEP § 2111 (9th ed. Rev. Jul. 2022, Feb. 2023); *see also* 35 U.S.C. §§ 102-103.

[7] *Id.* (quoting *In re* Am. Acad. Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004)).

[8] Before November 13, 2018, Administrative Patent Judges ("APJs") at the P.T.A.B. had to apply the broadest reasonable interpretation standard like patent examiners. After November 13, 2018, the *Phillips* standard is used, codified in 37 C.F.R. § 42.100. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 31, 2018) (codified at 37 C.F.R pt. 42); *see also* 37 C.F.R. §42.100 (2018).

("P.T.A.B") of the United States Patent and Trademark Office ("USPTO"), or the United States International Trade Commission ("USITC"), a different standard named after the United States Court of Appeals for the Federal Circuit ("Federal Circuit") case of *Phillips v. AWH Corp.*, is applied.[9] Under *Phillips*, "a claim term must be given 'the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.'"[10] In U.S. District Courts, the most frequently utilized forum in patent litigation, claim construction by a federal judge occurs in a proceeding known as a "*Markman* hearing," or "Claim Construction Hearing."[11] The procedure takes its name from the Supreme Court case of *Markman v. Westview Instruments, Inc.*[12], a unanimous ruling authored by Justice Souter, holding that patent claim construction is "exclusively within the province of the court": that is, patent claim construction is a matter of law for a judge to decide, not a matter of fact left to the jury to determine.[13]

The federal judge who has construed the most patent claim terms out of any other federal judge is the Honorable Roy S. Payne, United States Magistrate Judge of the United States District Court for the Eastern District of Texas, based in

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[9] *See generally* 415 F.3d 1303 (Fed. Cir. 2005); Kevin Greenleaf et al., *How Different Are the Broadest Reasonable Interpretation and Phillips Claim Construction Standards.*?, INTELL. PROP. OWNERS ASS'N, at 1-2, https://ipo.org/wp-content/uploads/2018/10/BRI-v-Phillips-Final-1.pdf [https://perma.cc/7K9Y-MF4B] (last visited Dec. 12, 2023).

[10] *Id.* at 2 (quoting *Phillips*, 415 F.3d at 1313).

[11] *See* Momo Lamken, *What Is A Markman Hearing?*, https://www.mololamken.com/knowledge-what-is-a-markman-hearing [https://perma.cc/TH73-9QG3] (last visited Dec. 12, 2023); *Markman Hearing*, WIKIPEDIA, https://en.wikipedia.org/wiki/Markman_hearing [https://perma.cc/92G2-2PKT] (last visited Dec. 12, 2023). They also occur at the USITC. *See* Michael T. Renaud & Michael C. Newman, *Markman at the ITC and Its Effect on an Investigation*, MINTZ, https://www.mintz.com/insights-center/viewpoints/2016-09-20-markman-itc-and-its-effect-investigation [https://perma.cc/KX9H-67VW] (last visited Dec. 28, 2023).

[12] *See* 517 U.S. 370 (1996).

[13] *Id.; see also* Opinion Announcement of Justice Souter, Markman v. Westview Instruments, 517 U.S. 370 (1996) (95-26), https://www.oyez.org/cases/1995/95-26 [https://perma.cc/J98C-Z9RN]; *Markman v. Westview Instruments, Inc.*, WIKIPEDIA, https://en.wikipedia.org/wiki/Markman_v._Westview_Instruments,_Inc [https://perma.cc/LSS5-LEAM]. Interestingly enough, the inventor, Herbert Markman, had his name misspelled as "Markham" on the asserted patent. U.S. Patent No. Re. 33,054 at [76] (filed Aug. 28, 1987); *see also Markman*, 517 U.S. at 372. Thus, if that mistake was not fixed, then we would be calling the proceeding a "Markham Hearing" today.

Marshall, Texas.[14] Therefore, this paper takes lessons learned from being a judicial law clerk serving in Judge Payne's chambers to propose an enhanced framework for *Markman* claim construction: essentially, an efficient way of conducting *Markman* hearings and producing *Markman* claim construction orders that conserves money (of the parties), takes the least time, most effectively leverages the court's own resources, and achieves equitable and consistent rulings or results. This proposed framework will also hopefully serve as guidance for federal judges and clerks facing an influx of new patent cases, for example, in the United States District Court for the District of Delaware after the United States Supreme Court patent venue case of *TC Heartland LLC v. Kraft Foods Group Brands LLC*, and Judge Alan D. Albright of the United States District Court for the Western District of Texas, who is quickly turning Waco, Texas into the new "Patent Litigation Capital" of the nation.[15]

Part I of this article will focus on a brief history of *Markman* claim construction, including the interesting history behind how the *Markman* hearing got its name (and how it could have been named the *Markham* hearing if the relevant parties did not do

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[14] *See Roy S. Payne*, WIKIPEDIA, https://en.wikipedia.org/wiki/Roy_S._Payne#Markman_hearings [https://perma.cc/MN9 4-LPTS]; *see also generally Magistrate Judge Roy Payne*, UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS https://www.txed.uscourts.gov/?q=judge/magistrate-judge-roy-payne [https://perma.cc/PT62-KENA] (last visited Dec. 15, 2023 1:00 A.M.).

[15] *See* Kenneth Artz, *Surprise—Waco, Texas, Is the Patent Litigation Capital of the United States!*, ALM/LAW.COM (Oct. 8, 2020, 11:41 PM), https://www.law.com/texaslawyer/2020/10/08/surprise-waco-texas-is-the-patent-litigation-capital-of-the-united-states/ [https://perma.cc/X8EC-XUTC]; Mark Curriden, *Waco Overtakes Marshall as Patent Litigation Hotbed in Texas*, HOUSTON CHRONICLE (Dec. 5, 2019, 8:47 AM), https://www.houstonchronicle.com/business/article/Waco-overtakes-Marshall-as-patent-litigation-14883979.php [https://perma.cc/T9RG-2EBB]; Mark Curriden, *User Friendly' Approach Means Texas has New High-Stakes Patent Litigation Hotspot*, DALLAS BUSINESS JOURNAL (Nov. 21, 2019), https://www.bizjournals.com/dallas/news/2019/11/21/patent-litigation-waco.html [https://perma.cc/CTG4-CBJC]; Matthew Bultman, *Law Firms Hang Shingles in Waco Amid Patent Litigation Boom*, BLOOMBERG LAW (Jan. 6, 2020, 5:00 AM), https://news.bloomberglaw.com/ip-law/law-firms-hang-shingles-in-waco-amid-patent-litigation-boom [https://perma.cc/E3MR-7Z78]; Tommy Witherspoon, *Waco Becoming Hotbed for Intellectual Property Cases with New Federal Judge*, WACO TRIBUNE-HERALD (Jan. 18, 2020), https://wacotrib.com/news/local/waco-becoming-hotbed-for-intellectual-property-cases-with-new-federal-judge/article_0bcd75b0-07c5-5e70-b371-b20e059a3717.html [https://perma.cc/KL3Z-T35L].

their due diligence), as well as how the first *Markman* hearings went after the seminal 1996 case of *Markman v. Westview Instruments* became decided by the United States Supreme Court after being appealed from the United States Court of Appeals for the Federal Circuit ("Federal Circuit").

Part II of this article proposes an enhanced framework for *Markman* patent claim construction while focusing on how technical advisors, experienced patent litigation attorneys, or former federal judicial law clerks of active patent judges can assist with the observation of *Markman* hearings and the drafting of *Markman* or Claim Construction Orders. This part will also discuss how judicial law clerks with technical backgrounds can serve in the most effective manner possible.

Part III of this article will focus on limits to the *Markman* hearing argument procedures and the briefing schedule (argument time, number of disputed claim terms, page limits, etc.). This section will focus on an approach that is slightly against the adoption of *per se* limits (for instance, a set number of terms) but will encourage the parties to mutually agree on a "reasonable" set of terms or other limits they feel adequately represent their case.

Part IV of this article will focus on novel argument structures to try and apply to unique cases, such as the "mini-*Markman*" hearing approach pioneered by former Chief Judge Davis of the Eastern District of Texas,[16] dispositive claim term hearings that can possibly resolve an entire case (as Judge Sheri Polster Chappell of the Middle District of Florida performed),[17] the "shootout" *Markman* hearing structure created by Judge Alsup of the Northern District of California,[18] hearing structures which

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[16] Michael C. Smith, *Motion for Early Construction of 3 Claim Terms Granted*, E. DIST. & TEX. IP L. BLOG (Dec. 21, 2016, 1:17 PM), https://edtexweblog.com/motion-for-early-construction-of-3-claim-terms-granted/ [https://perma.cc/3Q5Y-DMS7].

[17] Every Penny Counts, Inc v. Bank of America Corporation, No. 2:07-cv-42-FtM-29SPC, slip op. (M.D. Fla. July 3, 2008), https://www.ipmall.info/sites/default/files/hosted_resources/Markman/pdfFiles/2008.07.03_EVERY_PENNY_COUNTS_INC_v._BANK_OF_AMERICA_CORPORATION.pdf [https://perma.cc/7JDV-9JD5] (last accessed Dec. 28, 2023).

[18] Elizabeth Rader, *Preserving Due Process in Approaches to Narrowing Claims in Multi-Patent Lawsuits*, IP WATCHDOG (Sept. 8, 2019), https://ipwatchdog.com/2019/09/08/preserving-due-process-in-approaches-to-narrowing-claims-in-multi-patent-lawsuits/id=113031/ [https://perma.cc/Z74F-XYKU] (last accessed Dec. 28, 2023).

have attorneys, not judges, share a podium in an effort to provide a rapid-fire argument structure to most efficiently flesh out the best arguments from each party,[19] and having multi-judge hearings for efficiency and consistency purposes (which Chief Judge Gilstrap of the Eastern District of Texas and Chief Judge Lynn of the Northern District of Texas or Chief Judge Stark and Judge Burke of the District of Delaware have done before),[20] hearing styles in light of COVID-19 will finally be discussed. Overall, a suggested methodology for enhanced *Markman* claim construction shall be provided in order to serve as a guide for active patent judges or judges having to deal with an increased patent litigation case load.

I. A BRIEF HISTORY OF THE *MARKMAN* CLAIM CONSTRUCTION HEARING

What will now be discussed is a history of the *Markman* claim construction hearing and how it came to be. The historical origins of claim construction can be traced back to 1790, where the short-lived Patent Act passed that year set out no requirements for "claiming".[21] As a result, inventors in the United States started using claims in their inventions even before judicial or statutory frameworks required them to: for instance, the very first use of the word "claim" can be attributed to an inventor named

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[19] Matthew Bultman, *5 Unusual Patent Hearings You Should Know About*, LAW360 (Sept. 26, 2018, 8:08 PM), https://www.law360.com/ip/articles/1086573/5-unusual-patent-hearings-you-should-know-about [https://perma.cc/WLF8-PBWP].

[20] *See generally Id.*; Another such procedure performed by Judges Stark and Burke is "Section 101 Day[,]" brought about by the deluge of transfer motions filed post *TC Heartland*. *See* Matthew Bultman, *'Section 101 Day' Yields Quick Ruling on Patent Eligibility*, LAW360 (Feb. 28, 2019, 6:58 PM), https://www.law360.com/articles/1133434 [https://perma.cc /RP8N-SL77]; *see* Every Penny Counts, *supra* note 17.

[21] J. Jonas Anderson & Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 NW. U.L. REV. 1, 8 (2013).

Isiah Jennings for a patent issued on November 20, 1807.[22] This led to a closer and deeper look at claiming in 1836-1870 (with a focus on a concept known as "central claiming" – or pointing out the key innovative features of an invention) and in 1870-1970 (where there was a shift to the "peripheral claiming" practices exhibited today).[23] The early-to-mid 1990s also saw a resurgence in patent jury trials, where the jury was primarily tasked with claim construction.[24]

This was chaotic and highly unpredictable, because jury decisions on a matter as technical as claim construction was subject to a "black box" where little could understand the rationale or logic that led the jury to a given claim construction decision.[25] In 1996 the U.S. Supreme Court decided the case of *Markman v. Westview Instruments*.[26] Interestingly enough, the patent at issue in that case – United States Reissue Patent No. 33,054 – had a typographical error listing the inventor as "Markham" instead of "Markman."[27] As Justice Souter held in the *Markman* case, claim construction is "exclusively within the province of the court."[28] In other words, the *Markman* case established claim construction as a purely legal determination to be made by judges, not a factual determination made by juries.

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[22] Karl B. Lutz, *Evolution of the Claims of U.S. Patents,* 20 J. PAT. OFF. SOC'Y 134, 135-36 (1938) (the Jennings patent stated: "Such is my invention and I claim the benefit and application of it to every mode of forming thimbles by its instrumentality whether the machine be worked by the foot of the operator upon a treadle, by his hand through a winch, by a wheel turned by hand labor, or by any mechanism set in motion by water, or by any other power"; preceding this was a statement in a patent to Benjamin Dearborn in 1799, which did not intend to limit the patent to any specific disclosure, stating that "[t]he drawings accompanying this description are not laid down by any scale of measurement because the forms, sizes, and proportions of the whole and its parts may be indefinitely varied.").

[23] *Id.* at 8-18.

[24] Anderson & Menell, s*upra* note 21 at 18-21.

[25] *Id.*

[26] Markman v. Westview Instruments, 517 U.S. 370, 370-71 (1996).

[27] U.S. Patent No. 33,054 (filed Aug. 28, 1987) (reissued Sept. 12, 1989); *see id*. at 376.

[28] *Markman*, 517 U.S. at 372.

II. TECHNICAL ADVISORS & JUDICIAL LAW CLERKS WITH TECHNICAL BACKGROUNDS

The advantages and disadvantages of using a technical advisor have been disputed by literature in the field of patent litigation, primarily from articles written by practicing attorneys.[29] For instance, Luke L. Dauchot and Jeffrey C. Metzcar argue that:

> While the technical advisor is a welcome addition to the claim construction process in that "a well-informed claim construction is more likely to be the right one," he or she comes at the cost of predictability in claim construction. Whether and how a trial judge will use a technical advisor, who will be used as a technical advisor, and how much impact that advisor will have on the ultimate claim construction, is anyone's guess.[30]

They ultimately conclude, however, that,

> Although the Federal Circuit has it right in leaving the choice of whether to use a technical advisor to the sound discretion of the trial judge, that discretion should simply rest on the judge's need for education, rather than a showing that the case itself is "exceptionally technically complicated." Moreover, the use of technical advisors … should be made subject to stringent and uniform standards that are designed to prevent undue or improper influence over the decision-making process and allow for proper appellate review.[31]

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[29] Luke L. Dauchot & Jeffrey C. Metzcar, *Technical Advisors: Welcome Scientific Education, But at What Cost to a Patent's Notice Function?*, 9 IP LITIGATOR 17, 17 – 25 (2003), https://www.kirkland.com/-/media/publications/article/2003/03/technical-advisors-welcome-scientific-education-bu/dauchottechadvkirklandellis.pdf [https://perma.cc/R4NB-9FTZ].

[30] Dauchot & Metzcar at 18 (citing William F. Lee & Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J.L. & TECH. 55, 66 (1999)).

[31] *Id.* at 8 (referring to the Federal Circuit's ruling that technical advisors should be left to exceptionally complicated cases) (citing *TechSearch L.L.C. v. Intel Corp*., 286 F.3d 1360 (Fed. Cir. 2002) (citing *Association of Mexican Am. Educators v. California*, 231 F.3d 572, 590-91 (9th Cir. 2000) (*en banc*)).

Others, such as J. Michael Jakes of renowned intellectual property firm Finnegan Henderson states that,

> One court extolled the virtues of using a court-appointed expert in connection with claim construction, stating that the court "learned more technical data in a 45-minute discussion with [the court-appointed expert] than I would have learned in two days of formal testimony" and that the "efficacy of the process cannot be overstated".[32]

A. Technical Advisors v. Count-Appointed Experts

However, the key difference between Technical Advisors and court-appointed experts is that Technical Advisors are not governed by Federal Rule of Evidence 706, while Rule 706 controls the use of expert witnesses for evidence, usually via cross-examination and direct testimony.[33] Instead, Technical Advisors are viewed more as "specialized law clerks" that assist the judge in understanding technologically or scientifically complicated issues.[34] Specifically, the authority for the use of Technical Advisors in *Markman* patent claim construction stems from the 2002 Federal Circuit case of *TechSearch L.L.C. v. Intel Corp*., 286 F.3d 1360 (Fed. Cir. 2002).

Applying the law of the Ninth Circuit, the Federal Circuit upheld the decision of the district court to appoint a technical advisor for *Markman* patent claim construction in a highly technically complicated patent case "far beyond the boundaries of the normal questions of fact and law with which judges routinely grapple", finding that appointing such an expert was permissible to "acquaint the judge with the jargon and theory disclosed by the testimony and to help think through … the critical technical problems."[35]

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[32] *See* J. Michael Jakes, *Using an Expert at a Markman Hearing: Practical and Tactical Considerations*, IP LITIGATOR, https://www.finnegan.com/en/insights/articles/using-an-expert-at-a-markman-hearing-practical-and-tactical.html [https://perma.cc/52PC-HB6P] (citing *MediaCom Corp. v. Rates Tech., Inc.*, 34 F. Supp. 2d 76, 78 n.1 (D. Mass. 1998)).

[33] Dauchot & Metzcar, *supra* note 29, at 3.

[34] *Id.*

[35] TechSearch, L.L.C. v. Intel Corp., 286 F.3d 1360, 1368, 1381 (Fed. Cir. 2002) (citing *Association of Mexican Am. Educators*, 231 F.3d at 590-91).

However, the court emphasized the need to establish "safeguards to prevent the technical advisor from introducing new evidence and to assure that the technical advisor does not influence the district court's review of the factual disputes" such as guidelines to:

> [u]se a "fair and open procedure for appointing a neutral technical advisor … addressing any allegations of bias, partiality or lack of qualifications" … ; clearly define and limit the technical advisor's duties … in a writing disclosed to all parties; guard against extra-record information; and make explicit, perhaps through a report or record, the nature and content of the technical advisor's tutelage concerning the technology.[36]

The Federal Circuit cautioned, however, that "district courts should use this inherent authority sparingly and then only in exceptionally technically complicated cases."[37]

B. The Overlap of Clerk Duties with Technical Advisor Duties

Although in earlier times the roles of a judge's judicial law clerks and the Technical Advisor did not overlap because district court judges – and their clerks by extension – were considered "generalists by training" (with the only law clerks having scientific and/or technical backgrounds being law clerks for United States Circuit Judges at the Federal Circuit, also historically called "Technical Advisors" as well),[38] that trend has shifted significantly in modern patent litigation intensive times. Active patent judges in courts such as the Eastern District of Texas, the District of Delaware, the District of New Jersey and the Northern and

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[36] *TechSearch, L.L.C.*, 286 F.3d at 1377, 1379 (citing *Association of Mexican Am. Educators*, 231 F.3d at 611).

[37] *See id.* at 1378.

[38] Neil A. Smith, *The Use of Special Masters for Claim Construction*, 2 A.B. A. SEC. PUB. INTELL.PROP. REP. 37, 38 (2009) (citing Judge James F. Holderman & Halley Guren, *The Patent Litigation Predicament in the United States*, 2007 U. ILL. J. L. TECH. & POL'Y. 1, 105-6, 114 (2007)); *see also* Peter Lee*, Patent Law and the Two Cultures,* 120 YALE L.J. 2, 79 (2010) (describing the dichotomy between the generalist approach of judges and the technical approach of patent law).

Central Districts of California[39] have often hired and sought out judicial law clerks specifically possessing technical and scientific backgrounds as well as patent litigation experience or at least an interest in patent law.[40] Indeed, the Central District of California even had a Patent Pilot Law Clerk program, where the law clerks sole duty was to work on patent cases for the U.S. District Judges in that court participating in the Patent Pilot program.[41]

Thus, in those active patent courts, the Technical Advisors and technical judicial law clerks of a particular judge work together on observing the *Markman* hearing and drafting, finalizing and perfecting the finished *Markman* claim construction order. In courts that do not utilize the practice of Technical Advisors (such as the District of Delaware), more of the burden of technical analysis for *Markman* hearings is placed solely on the law clerks.

C. Recommendations for Using Technical Advisors

In practice, the use of Technical Advisors can be an efficient, fair and judicially consistent tool for federal judges dealing with inordinately large numbers of patent cases. For instance, by splitting the cost of the Technical Advisor between the parties (as is routinely done in Eastern District of Texas patent cases), an impartial benefit of trial advancement or progress in the interest of both parties can be achieved. Judicial consistency is also obtained due to how Technical Advisors extensively research and

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[39] For a history of why these courts are considered the most active patent courts, *see* Timothy T. Hsieh, *A Tale of Seven Districts: Reviewing the Past, Present and Future of Patent Litigation Filings to Form a Two-Step Burden-Shifting Framework For 28 U.S.C. § 1404(a),* 31 TEX. INTELL. PROP. L.J. 131 (2023).

[40] *See, e.g.*, Timothy Li, The Scientifically Trained Law Clerk: Legal and Ethical Considerations of Relying on Extra-Record Technical Training or Experience 5-8 (Jun. 4, 2013) (unpublished comment) (on file with the George Washington Univ. L. Sch.).

[41] California Lawyers Ass'n, *Law Clerks Needed for Patent Program*, https://calawyers.org/california-lawyers-association/law-clerks-needed-for-patent-program/ [https://perma.cc/K52A-U9AX] (last visited Dec. 10, 2023); *see also Patent Pilot Program*, U.S. District Court for the Central District of California, https://www.cacd.uscourts.gov/judges-requirements/court-programs/patent-pilot-program [https://perma.cc/9FZP-2T4X] [hereinafter *CD Cal*] (last visited Dec. 10, 2023); *Judges Participating in the Patent Pilot Program*, CD Cal, https://www.cacd.uscourts.gov/judges-requirements/court-programs/judges-participating-patent-program [https://perma.cc/ZDZ3-JYN5] (last visited Dec. 10, 2023).

cite the judge's prior *Markman* claim construction orders in different technology areas so as to ensure a result most aligned with past claim construction precedent, no matter how minute or nuanced.[42]

Moreover, the judicial law clerks can work together with the Technical Advisors in order to lessen the load of the judge, or to streamline the understanding and interpretation of the technologically complex concepts to allow the judge to spend their time focusing on making consistent rulings in accordance with prior holdings. Scheduling meetings with the judge, Technical Advisor and law clerks before *Markman* hearings also ensures the most consistent rulings (in technology areas) possible.

III. MANAGING LIMITS: TIME, TERMS & TOTALS

Second, the *Markman* claim construction process can be streamlined by selecting limits that govern each phase.

A. Variable Limits: Number of Terms, Page Limits & Other Totals

First, during the initial stages of the *Markman* claim construction briefing and claim term exchange process, which is set forth by most Local Patent Rules in Rule 4, or 4.1 "Exchange of Proposed Terms for Construction", the laid out scheduling requirements or timing deadlines for submitting particular joint statements, briefs, and terms should be followed.[43] Certain courts, such as the Northern and Central Districts of California as well as the Northern District of Illinois, set a limit on the number of claim terms most significant to the resolution of a patent case to ten ("10") terms. Other courts, such as the Eastern District of Texas, do not set specific limitations, yet individual judges, such as Judge Love in Tyler and former Chief Judge Clark in Beaumont, have

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[42] Author's Note: As a matter of fact, Westlaw has a "Markman" notation *e.g.*, 123 Markman 456, so as to simplify the process of finding and locating past Markman claim construction orders. As a judicial law clerk for Judge Payne, technical advisors would also be selected based on technology area, thereby ensuring consistent and accurate analysis.

[43] *See* N.D. Cal., Pat. L.R. 4; *see also* C.D. Cal., Patent. Standing Order.; E.D. Tex. Pat. L.R. 1; N.D. Ill., Pat. L.R. 4.

mandated the ten-term limit.[44] The page limits and totals should also be set forth by the local patent rules and, if they are not, by individual judge procedures or standing orders. The same applies for the amount of time each party gets to argue during the actual *Markman* hearing. However, a caveat to keep in mind is that exceptions to these rules can be made if the judge orders, so special cases may require special rules.

B. Real World Applications

In real world practice, it helps to have a set list of procedures for a *Markman* hearing so that all parties and participants know what to expect. For instance, preliminary or tentative claim constructions can be printed out and made available on the lectern in a judge's courtroom or on a website for a set amount of time before the actual hearing. This allows the parties to re-shape or craft their arguments so that the parties don't waste any time in arguing unnecessary issues, or claim terms already resolved by the court. The maximum number of claim terms to construe is also ultimately up to the particular judge as well.

Although some judges and local patent rules mandate a maximum of ten terms, it is arguably fair to allow the parties to reach a "reasonable" number on their own. Often, when much of the terms are already agreed upon or some patents have been withdrawn, the pool of terms left over that are still disputed becomes manageable. However, in perhaps more technically complicated cases involving patents with many claims, there might be an unduly large number of terms to construe.

In these cases, the presiding judge should analogize to cases he or she has dealt with in the past involving similar technology areas or similarly complicated patents. If the number of disputed terms appears "unreasonable" or the parties are refusing to agree to term constructions just to be difficult, which does not happen frequently, then the judge can always issue an order limiting the

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[44] *See* Dennis Crouch, *Limiting the number of claims construed*, PATENTLY O BLOG (June 20, 2008), https://patentlyo.com/patent/2008/06/limiting-the-nu.html [https://perma.cc/J4GS-DELR]; Patent Docket Control Order for Mag. Judge John D. Love, UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS (Feb. 2, 2018), https://www.txed.uscourts.gov/?q=judge/magistrate-judge-john-love [https://perma.cc/DM6M-S7MQ].

maximum terms to 20, 25, 30, etc., or give parties leave to reduce the number of terms on their own, which they usually do. Otherwise, it is of the author's opinion that a reasonable number of disputed claim terms should be established *ad hoc* instead of having a standardized limit.

IV. NOVEL HEARING STRUCTURES

The third, final, and perhaps most interesting part of this paper is a brief survey of the novel types of hearing structures that can be adopted to make particular *Markman* hearings more efficient, fruitful, productive, and most importantly, meaningful and impactful.

A. Mini-Markman Procedures

The first type of hearing structure is not really a hearing structure at all, but a way to avoid a comprehensive *Markman* hearing in the first place. It is called a "mini-*Markman*" which is a preliminary pre-trial claim construction ruling that takes place usually via motion or *sua sponte* from the court. Former Chief Judge Leonard Davis was the judge who pioneered this approach in *Parallel Networks v. Abercrombie & Fitch, L.L.C.*.[45]

In the *Parallel Networks* case, the Plaintiff sued 112 Defendants, leading Judge Davis to create a new procedure called a "mini-*Markman*" in order to perform expedited construction of three patent claim terms that ultimately served as a dispositive resolution to all the issues in the case.[46] The mini-*Markman* was also brought about by a motion for summary judgment of non-infringement filed by 99 of the 112 defendants, which was granted after the three terms were construed.

This was a brilliant litigation management decision from Judge Davis that resolved many controversies "in the most judicially economic manner sparing many other courts from

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[45] Parallel Networks v. Abercrombie & Fitch L.L.C., No. 6:10-cv-111, 2014 WL 11531874, n.1, (E.D. Tex. Dec. 27, 2018).

[46] *See* Michael C. Smith, *Summary Judgement Granted As to 13 Defendants Based on Mini-Markman Ruling*, EDTEXWEBLOG.COM (JAN. 10, 2017), https://edtexweblog.com/summary-judgment-granted-as-to-13-defendants-based-on-mini-markman-ruling/ [https://perma.cc/MU7Y-YX7U] ("early mini-*Markman* resulting in dismissal of 99 out of 112 defendant[s] according to the order").

repetitive work, and at the same time saving the parties very significant sums of money in attorneys fees."[47] Since then, Judge Davis' mini-*Markman* process has been codified into a procedure that exists as a Standing Order, which the parties invoked before Judge Payne in the case of *Lexos Media IP, L.L.C. v. Apmex,*[48] In the *Lexos* case, Judge Payne preliminarily construed three key patent terms and ruled that "The Court finds that determining the meaning of the three terms identified by defendants as early as possible may aid in the just and speedy resolution of this in future cases in which Lexos asserts" the asserted patents.[49]

Other judges, such as Judge Feinerman of the Northern District of Illinois, adopted this mini-*Markman* approach in the case of *WorldLogic Corp. v. Chicago Logic, Inc.*, construing two key terms, one from each of the two asserted patents, in a suit involving predictive text technology patents.[50]

B. Dispositive Markman Hearings

Similar to the mini-*Markman* is a single *Markman* hearing conducted for the purposes of disposing of an entire patent case.[51] This occurred in 2008 before then U.S. Magistrate now U.S. District Judge Sheri Polster Chappell of the Middle District of Florida in the case of *Every Penny Counts v. Bank of America*, which U.S. District Judge John Steele of the same court presided

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[47] *Id.* (citing *Parallel Networks v. Abercrombie & Fitch.*, No. 6:10-cv-111, 2011 WL 3609292 (E.D. Tex. Aug. 12, 2011)); *see also Innovative Case Management Techniques in the ED Texas: Judge Davis' Mini-Markman*, WILLIAMS MULLEN BLOG (Jan. 19, 2012, 12:30 AM), https://www.williamsmullen.com/blog/innovative-case-management-techniques-ed-texas-judge-davis-mini-markman [https://perma.cc/ZZL6-QLEK]; John Council, *Move Toward Mini-'Markman' Hearings in Patent Cases*, LEGALTECH NEWS (Sept. 30, 2011), https://www.law.com/legaltechnews/almID/1202517408363/ [https://perma.cc/6HBK-SDRU].

[48] *See* Lexos Media IP v. Apmex, No.2:16-cv-747-JRG-RSP, 2017 WL 1021366 (E.D.Tex. Sept. 5, 2023).

[49] Smith, *supra* note 16 (citing Lexos Media IP, L.L.C. v. Apmex, No. 2:16-cv-747-JRG-RSP, slip op. (E.D. Tex. Dec. 21, 2016)).

[50] R. David Donaghue, *Court Construes Key Terms in Mini-Markman*, CHICAGO IP LITIGATION (July 24, 2017), https://www.chicagoiplitigation.com/2017/07/court-construes-key-terms-in-mini-markman/ [https://perma.cc/V8E3-GNAF] (citing WorldLogic Corp. v. Chicago Logic, Inc., No. 1:16-cv-11713, (No. 35) slip op. at 8-9 (N.D. Ill. Jun. 5, 2017), https://www.govinfo.gov/content/pkg/USCOURTS-ilnd-1_16-cv-11713/pdf/USCOURTS-ilnd-1_16-cv-11713-0.pdf [https://perma.cc/XZ2S-YYUH]).

[51] Bultman, *supra* note 19.

over.[52] As recounted by *Law360*'s Matthew Bultman: [t]he financial stakes were high: Every Penny had estimated that it could recover up to $120 billion in damages and licensing fees if it were successful in the litigation…One morning in May 2008, close to 20 attorneys packed into a Tampa courtroom at 9 a.m., bracing for a claim construction hearing that was scheduled to last up to two days. But by 1 p.m., the judge had entered an order dismissing the case. "I think all of us in the room were shocked by how that played out," said Eliot Williams of Baker Botts LLP, one of the attorneys for MasterCard in the case. "No one was expecting to finish by lunch with a judgment against the plaintiff."

What happened, Williams recalled, was the judge made it through just a single claim term before asking what would happen if [she] ruled for the defendants on that term. The defendants said they would win, and Every Penny conceded it would not be able to prove infringement. And just like that, the hearing — and the cases — were over. The Federal Circuit later affirmed [Judge Steele]'s [judgment affirming Judge Chappell's Report & Recommendation] claim construction…with a precedential opinion.[53]

C. The "Shootout" Markman Hearing

Another innovative *Markman* hearing structure is the "shootout" hearing structure created by Judge Alsup of the Northern District of California. Judge Alsup devised this novel hearing structure in the case of *Comcast Cable Commc'ns. v. OpenTV Inc.*, where Comcast sued for declaratory judgment that its "TV Everywhere" services did not infringe on ten patents.[54] Judge Alsup stated that Comcast did not adequately plead noninfringement, stating during a hearing that "you patent lawyers think you're entitled to special rights" to not use facts to back up pleadings and also warned OpenTV about making the same inadequate factual pleading mistake and saying if they did,

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[52] *See* Every Penny Counts, Inc. v. Bank of Am. Corp., No. 2:07-cv-42-FtM-29SPC, slip op. (M.D. Fla. Jul. 3, 2008), https://bit.ly/3dqGY13 [https://perma.cc/AE2N-H8D2].

[53] Bultman, *supra* note 19; *see also* Every Penny Counts, Inc. v. Bank of Am. Corp., No. 2:07-cv-42-FtM-29SPC (M.D. Fla. Sept. 29, 2008), https://www.leagle.com/decision/infdco20080930559 [https://perma.cc/Y9S3-KGVC].

[54] *See generally* 319 F.R.D 269 (N.D. Cal. Mar. 13, 2017).

he would "throw [their] case into oblivion."[55] Thus, in order to spare the jury of having to deal with ten patents in a 16-hour trial, he "wanted to conduct a hearing that would decide the fate of the case, in which Comcast picks OpenTV's most frivolous infringement claim and OpenTV picks its most damning example of infringement", subsequently telling the parties "[y]ou all are throwing patents around like they're candy. Assuming you get to replead in a way that keeps the case in this court, I'll let you pick one claim out of one patent that shows how ridiculous it is. We'll have a hearing. A shoot out."[56]

Berkeley Law Professor Peter Menell has written a paper entitled *Showdown at the N.D. C[orr]al* which "assesses whether Judge Alsup's patent case management invention works for its intended purposes. Based on a review of the two showdowns to date [the second one being *Finjan, Inc. v. Jupiter Networks, Inc.*], it concludes that the showdown procedure has yielded mixed results. The procedure, however, raises serious fairness concerns that could well lead to a bigger showdown at the Federal Circuit Corral."[57]

D. Multiple Judge or Attorney Markman Hearings

Another novel hearing structure is a proceeding where multiple judges share a bench, or multiple attorneys share one podium.

1. Multiple Judge Hearings

In the first instance, Chief Judge Gilstrap of the Eastern District of Texas and Chief Judge Lynn of the Northern District of Texas held the first "Joint *Markman* or Claim Construction Hearing" regarding patent infringement lawsuits from the

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[55] Cara Bayles, *Frustrated Alsup Orders 'Shoot Out' In Comcast's Patent Row*, LAW360 (Mar. 8, 2017, 9:19 PM), https://www.law360.com/articles/899710/frustrated-alsup-orders-shoot-out-in-comcast-s-patent-row [https://perma.cc/T4ZN-5CXQ].

[56] *Id.*

[57] Peter S. Menell, *Patent Showdown at the N.D. C[orr]al*, 18 CHI.-KENT J. INTELL. PROP. 450 (2019); *see also* Finjan, Inc. v. Jupiter Networks, Inc., No. 3:17-cv-05659-WHA, 2021 WL 3140716 (N.D. Cal. Dec. 12, 2022).

common Plaintiff of Seven Networks, L.L.C. on September 2018.[58] The two Chief Judges held another Joint *Markman* Hearing in September 2019 in cases involving the common plaintiff of Infernal Technology L.L.C.[59] Moreover, Judge McCalla of the Western District of Tennessee, sitting by designation in the Middle District of Tennessee, and Judge Collier of the Eastern District of Tennessee also held a Joint *Markman* Hearing in June 2019 involving the common Plaintiff of Plate, LLC, both writing in a Joint Order that they would hold a concurrent claim construction hearing in the "interest of judicial efficiency and to reduce the risk of inconsistent or conflicting construction."[60]

Finnegan attorneys Erik Puknys and Jordan Fraboni soundly argue that "[j]oint claim construction can benefit the parties by reducing the cost of litigation, increasing the chance of arguing before a judge experienced with patents, and reducing the time to a decision on the merits." Similarly, although not related to any *Markman* hearing, Chief Judge Stark and Magistrate Judge Burke have conducted joint hearings on motions to transfer after the *TC Heartland* case.[61] It is not too difficult to imagine having a United States District Judge and a United States Magistrate Judge perform a joint *Markman* Hearing for a large number of patent infringement cases that can be more efficiently resolved by two judges as opposed to one.[62]

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[58] Erik Puknys & Jordan Fraboni, *INSIGHT: Joint Claim Construction—A New Tool for Navigating Venue in Patent Cases* (Jan. 15, 2020, 3:01 AM), https://news.bloomberglaw.com/ip-law/insight-joint-claim-construction-a-new-tool-for-navigating-venue-in-patent-cases (citing Seven Networks, L.L.C v. ZTE (USA) Inc., No. 3:17-cv-01495-M, 2018 WL 2427147 (N.D. Tex. May 30, 2018) and Seven Networks, LLC v. Google LLC, 315 F.Supp. 3d 933 (E.D. Tex. Aug. 19, 2018).

[59] Puknys & Fraboni, *supra* note 58 (citing Infernal Technology L.L.C v. Activision Blizzard Inc., No. 3:18-cv-01397-M, 2019 WL 4247227 (N.D. Tex. Jan. 24, 2023) and Infernal Technology L.L.C. v. Microsoft Corp., No. 2:18-cv-00144-JRG, 2019 WL 5388442 (E.D. Tex. May 3, 2019).

[60] Puknys & Fraboni, *supra* note 58 (citing Plate, L.L.C. v. Elite Tactical Systems L.L.C., No. 3:18-cv-00265-CLC-HBG, 2020 WL 5209303 (E.D. Tenn. Sept. 1, 2020) and Plate, L.L.C. v. RCTenn L.L.C., No. 3:18-cv-00806, 2019 WL 11254773 (M.D. Tenn. Aug. 3, 2019)).

[61] Bultman, *supra* note 19.

[62] *Id.*

2. Multiple Attorney Hearings

In the second instance of this last novel hearing structure, Judge Bryson of the Federal Circuit conducted a *Markman* hearing for lawsuits brought by Plaintiff Preservation Wellness Technologies and Defendants Allscripts Healthcare Solutions Inc., and NextGen Healthcare Information Systems, LLC.[63] In this hearing, which was held in Washington D.C. in March 2016, Judge Bryson called Plaintiff's and Defendants' attorneys up to the podium at the same time and went through each of the disputed patent claim terms in "rapid succession, asking questions and allowing [the] attorneys to respond to one another's arguments on the spot."[64] One of the attorneys, Stephen Brauerman of the law firm Bayard P.A., drew parallels to a high school debate and thought it was "a really effective argument style" because it "fleshed out the parties' positions and quite frankly, internal inconsistencies between their own positions [which ultimately] helped get to the right answer quicker."[65]

3. *Markman* Hearings in the era of COVID-19

In the wake of the global epidemic of COVID-19, various courts and active patent judges have still found a way to hold *Markman* hearings – but "virtually" via teleconferencing software such as Zoom or WebEx.[66] Judge Alan Albright has also made many of his virtual Markman hearings accessible or viewable online to the general public.[67] There is not that much difference between a virtual *Markman* hearing and a physical one, except for the fact that all the arguments are conducted remotely: this makes the procedure more resemble the proceedings that occur at the P.T.A.B., where participants communicate via video

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[63] Bultman, *supra* note 19.

[64] *See Id.*

[65] *Id.*

[66] Michael C. Smith, *Zoom Markmans*, EDTEXWEBLOG.COM (May 22, 2020), https://edtexweblog.com/zoom-markman/ [https://perma.cc/7LBQ-S7R6].

[67] Erick Robinson, *Markman Hearing Available via Zoom*, THE WACO PATENT BLOG (Oct. 16, 2020), https://www.wacopatentblog.com/waco-patent-blog/markman-hearing-available-via-zoom [https://perma.cc/D5BJ-AHZP] (last accessed Dec. 28, 2023); Erick Robinson, *More Markman Hearings Via Zoom*, THE WACO PATENT BLOG, (Oct. 21, 2020), https://www.wacopatentblog.com/waco-patent-blog/more-markman-hearings-via-zoom [https://perma.cc/TDS7-E9ES] (last accessed Dec. 28, 2023).

conference. In a virtual *Markman*, the opportunity also still exists to present demonstrative graphics, models, and PowerPoint slides as in a real, physical *Markman* hearing. Nonetheless, the shift to presenting arguments online are not without its obstacles: Judge Gilstrap has remarked on several virtual *Markman* instances where attorneys have had to fight for a stable Wi-Fi connection from their children streaming movies or playing online games or be forced to argue from bathrooms of a noisy house.[68] However, as attorneys become wiser and further accustomed to arguing online, the format of the virtual *Markman* will present more and more of its advantages in terms of convenience.

V. CURRENT PRACTICES

This section will cover current practices exhibited by active patent judges. So far, the current ranked list of the top judges who have construed the most claim terms of all time is as follows (from Docket Navigator, as of April 26, 2023)[69]:

Judge	Court	Terms	Rank
Honorable Roy S. Payne	E.D. Tex.	8,601	1
Honorable Richard G. Andrews	D. Del.	7,205	2
Honorable Rodney Gilstrap	E.D. Tex.	4,906	3
Honorable Alan D Albright	W.D. Tex.	4,694	4
Honorable Leonard P. Stark (*now* Fed. Cir.)	D. Del.	4,372	5
Honorable Leonard Davis	E.D. Tex	3,099	6

[68] Chief Justice Rodney Gilstrap, Remarks at the Giles S. Rich American Inn of Court Meeting about remote hearings in the age of COVID-19 (Nov. 17, 2020) (Judge Gilstrap providing oral anecdotes of his experiences adjudicating such remote hearings).

[69] As of December 28, 2023, Judge Roy S. Payne has construed 9,008 terms according to Docket Navigator. *Judge Roy S. Payne*, DOCKET NAVIGATOR: JUDGE PROFILE, https://search.docketnavigator.com/patent/judge/14374/0 [https://perma.cc/W7LW-Y3T8] (subscription required to view) (last accessed Dec. 28, 2023).

Honorable John Love	E.D. Tex.	2,575	7
Honorable Gregory M. Sleet	D. Del.	2,572	8
Honorable T. John Ward	E.D. Tex.	2,341	9
Honorable Charles Everingham	E.D. Tex.	2,094	10
Honorable Marilyn Huff	S.D. Cal.	1,970	11
Honorable Rudi Brewster	S.D. Cal.	1,770	12
Honorable Sue Robinson	D. Del.	1,572	13
Honorable Maryellen Noreika	D. Del.	1,442	14
Honorable David Folsom	E.D. Tex.	1,438	15
Honorable R. Gary Klausner	C.D. Cal.	1,370	16
Honorable Amos Mazzant	E.D. Tex.	1,245	17
Honorable William F. Orrick	N.D. Cal.	1,129	18
Honorable Colm F. Connolly	D. Del.	1,106	19
Honorable Caroline Craven	E.D. Tex.	964	20
Honorable James Selna	C.D. Cal.	947	21
Honorable Lee Yeakel	W.D. Tex.	934	22
Honorable Charles E. Bullock	USITC	903	23
Honorable John A. Kronstadt	C.D. Cal.	903	23
Honorable George H. Wu	C.D. Cal.	882	24
Honorable Brian McNamara	P.T.A.B.	864	25
Honorable Joni Y. Chang	P.T.A.B.	835	26

Honorable Andrew J. Guilford	C.D. Cal.	834	27
Honorable Ron Clark	E.D. Tex.	762	28
Honorable Barbara Parvis	P.T.A.B.	754	29
Honorable Patrick M. Boucher	P.T.A.B.	750	30
Honorable David Shaw	USITC	727	31
Honorable David C. McKone	P.T.A.B.	719	32
Honorable Robert W. Schroeder III	E.D. Tex.	699	33
Honorable Derek T. Gilliland	W.D. Tex.	672	34
Honorable Justin T. Arbes	P.T.A.B.	650	35
Honorable Christopher J. Burke	D. Del.	650	35
Honorable Cathy Ann Bencivengo	S.D. Cal.	630	36
Honorable William J. Martini	D.N.J.	609	37
Honorable Hyun J. Jung	P.T.A.B.	603	38
Honorable Kevin F. Turner	P.T.A.B.	592	39
Honorable Trevor M. Jefferson	P.T.A.B.	579	40
Honorable Sam Sparks	W.D. Tex.	579	40
Honorable Keith P. Ellison	S.D. Tex.	573	41
Honorable Michael R. Zecher	P.T.A.B.	572	42
Honorable Ronald M. Whyte	N.D. Cal.	565	43
Honorable Barbara M.G. Lynn	N.D. Tex.	557	44
Honorable Thomas B.	USITC	552	45

Pender			
Honorable Gregg I. Anderson	P.T.A.B.	545	46
Honorable Thomas L. Giannetti	P.T.A.B.	543	47
Honorable MaryJoan McNamara	USITC	541	48
Honorable K. Nicole Mitchell	E.D. Tex.	537	49
Honorable Jameson Lee	P.T.A.B.	534	50
Honorable Jeffrey S. White	N.D. Cal.	522	51
Honorable Susan Illston	N.D. Cal.	521	52
Honorable Joseph J. Farnan, Jr.	D. Del.	514	53
Honorable James B. Arpin	P.T.A.B.	504	54
Honorable Scott A. Daniels	P.T.A.B.	501	55
Honorable Mary Pat Thynge	D. Del.	501	55
Honorable Cameron Elliot	USITC	496	56
Honorable David C. Godbey	N.D. Tex.	481	57
Honorable Lynne E. Pettigrew	P.T.A.B.	468	58
Honorable Karl D. Easthom	P.T.A.B.	466	59
Honorable Stanley R. Chesler	D.N.J.	465	60
Honorable Barbara B. Crabb	W.D. Wis.	464	61
Honorable Garrett E. Brown, Jr.	D.N.J.	462	62
Honorable Jon S. Tigar	N.D. Cal.	453	63
Honorable Kristina	P.T.A.B.	442	64

M. Kalan			
Honorable Mitchell G. Weatherly	P.T.A.B.	438	65
Honorable Matthew R. Clements	P.T.A.B.	434	66
Honorable Douglas P. Woodlock	D. Mass.	434	66
Honorable James A. Tartal	P.T.A.B.	433	67
Hon. William C. Bryson (*now* Fed. Cir.)	E.D. Tex.	425	68
Honorable Kristen L. Droesch	P.T.A.B.	425	68
Honorable James Ware	N.D. Cal.	424	69
Honorable Robert A. Pollock	P.T.A.B.	423	70
Honorable E. James Gildea	USITC	423	70
Honorable Christopher L. Crumbley	P.T.A.B.	421	71
Honorable Miriam L. Quinn	P.T.A.B.	418	72
Honorable Sally C. Medley	P.T.A.B.	412	73
Honorable Paul S. Grewal	N.D. Cal.	411	74
Honorable Meredith C. Petravick	P.T.A.B.	406	75
Honorable Barry L. Grossman	P.T.A.B.	405	76
Honorable Gale R. Peterson	N.D. Ga.	405	76
Honorable Mariana R. Pfaelzer	C.D. Cal.	398	77
Honorable Dee Lord	USITC	397	78
Honorable Jennifer M. Meyer Chagnon	P.T.A.B.	390	79
Honorable David E.	N.D.N.Y.	388	80

Peebles			
Honorable Kalyan K. Deshpande	P.T.A.B.	379	81
Honorable James J. Mayberry	P.T.A.B.	374	82
Honorable Georgianna W. Braden	P.T.A.B.	370	83
Honorable Bryan F. Moore (*now* Ct. Int'l Trade)	P.T.A.B.	368	84
Honorable Henry C. Morgan, Jr.	E.D. Va.	365	85
Honorable Barbara A. Benoit	P.T.A.B.	360	86
Honorable Joan N. Ericksen	D. Minn.	358	87
Honorable Dana M. Sabraw	S.D. Cal.	357	88
Honorable F. Dennis Saylor, IV	D. Mass.	356	89
Honorable Jennifer L. Hall	D. Del.	354	90
Honorable Bart A. Gerstenblith	P.T.A.B.	354	90
Honorable Keith F. Giblin	E.D. Tex.	354	90
Honorable Jon B. Tornquist	P.T.A.B.	353	91
Honorable Richard Seeborg	N.D. Cal.	350	92
Honorable Daniel J. Galligan	P.T.A.B.	349	93
Honorable Patrick R. Scanlon	P.T.A.B.	349	93
Honorable Edward M. Chen	N.D. Cal.	348	94
Honorable Jed S. Rakoff	S.D.N.Y.	348	94
Honorable Terrence	P.T.A.B.	346	95

McMillin			
Honorable Nathaniel M. Gorton	D. Mass.	339	96
Honorable Dean D. Pregerson	C.D. Cal.	339	96
Honorable Susan L.C. Mitchell	P.T.A.B.	338	97
Honorable Richard E. Rice	P.T.A.B.	336	98
Honorable Marsha J. Pechman	W.D. Wash.	332	99
Honorable Jennifer S. Bisk	P.T.A.B.	327	100
Honorable William V. Saindon	P.T.A.B.	320	101
Honorable Michael W. Kim	P.T.A.B.	317	102
Honorable Beth Labson Freeman	N.D. Cal.	314	103
Honorable Frances L. Ippolito	P.T.A.B.	314	103
Honorable Irma E. Gonzalez	S.D. Cal.	313	104
Honorable Janis L. Sammartino	S.D. Cal.	311	105
Honorable David O. Carter	C.D. Cal.	307	106
Honorable Josiah C. Cocks	P.T.A.B.	307	106
Honorable Kevin W. Cherry	P.T.A.B.	307	106
Honorable George R. Hoskins	P.T.A.B.	302	107
Honorable Carl M. DeFranco	P.T.A.B.	299	108
Honorable Minn Chung	P.T.A.B.	296	109
Honorable James L. Robart	W.D. Wash.	293	110
Honorable Sherry R.	D. Del.	292	111

Fallon			
Honorable Donna M. Praiss	P.T.A.B.	291	112
Honorable Stacey G. White	P.T.A.B.	291	112
Honorable Philip S. Guiterrez	C.D. Cal.	289	113
Honorable Vanessa D. Gilmore	S.D. Tex.	289	113
Honorable Lucy H. Koh (*now* 9th Cir.)	N.D. Cal.	288	114
Honorable Jeffrey W. Abraham	P.T.A.B.	281	115
Honorable Kimberly McGraw	P.T.A.B.	281	115
Honorable Ann D. Montgomery	D. Minn.	280	116
Honorable Claudia Wilken	N.D. Cal.	277	117
Honorable Jeremy Fogel	N.D. Cal.	276	118
Honorable Robert L. Kinder	P.T.A.B.	273	119
Honorable Philip A. Brimmer	D. Colo.	272	120
Honorable Sumner C. Rosenberg	N.D. Ga.	272	120
Honorable Kent A. Jordan (*now* 3d Cir.)	D. Del.	271	121
Honorable Jason W. Melvin	P.T.A.B.	270	122
Honorable John A. Hudalla	P.T.A.B.	268	123
Honorable Sheila McShane	P.T.A.B.	268	123
Honorable Lee H. Rosenthal	S.D. Tex.	267	124
Honorable Andre Birotte, Jr.	C.D. Cal.	266	125
Honorable John W.	D. Kan.	266	125

Lungstrum			
Honorable Edward F. Harrington	D. Mass.	265	126
Honorable Alvin K. Hellerstein	S.D.N.Y.	264	127
Honorable Tina E. Hulse	P.T.A.B.	264	127
Honorable Ed Kinkeade	N.D. Tex.	263	128
Honorable Beverly M. Bunting	P.T.A.B.	261	129
Honorable Haywood S. Gilliam, Jr.	N.D. Cal.	260	130
Honorable Vaughn R. Walker	N.D. Cal.	257	131
Honorable Jo-Anne M. Kokoski	P.T.A.B.	257	131
Honorable Gregory B. Williams	D. Del.	257	131
Honorable Erica A. Franklin	P.T.A.B.	256	132
Honorable Roger T. Benitez	S.D. Cal.	255	133
Honorable Mary L. Cooper	D.N.J.	254	134
Honorable Marilyn H. Patel	N.D. Cal.	253	135
Honorable Jacqueline Wright Bonilla	P.T.A.B.	252	136
Honorable Charles J. Boudreau	P.T.A.B.	251	137
Honorable Sheridan K. Snedden	P.T.A.B.	251	137
Honorable Elizabeth M. Roesel	P.T.A.B.	250	138
Honorable Christopher Kaiser	P.T.A.B.	249	139
Honorable Mark S. Davis	E.D. Va.	248	140
Honorable Joel A.	D.N.J.	247	141

Pisano			
Honorable Robert C. Jones	D. Nev.	245	142
Honorable Neil T. Powell	P.T.A.B.	245	142
Honorable Zhenyu Yang	P.T.A.B.	243	143
Honorable Thu A. Dang	P.T.A.B.	243	143
Honorable Phyllis J. Hamilton	N.D. Cal.	239	144
Honorable Paul L. Maloney	W.D. Mich.	239	144
Honorable James Donato	N.D. Cal.	238	145
Honorable Maxine M. Chesney	N.D. Cal.	238	145
Honorable Richard A. Schell	E.D. Tex.	234	146
Honorable John F. Horvath	P.T.A.B.	232	147
Honorable Phillip J. Kauffman	P.T.A.B.	231	148
Honorable Robert J. Weinschenk	P.T.A.B.	229	149
Honorable Michael H. Schneider	E.D. Tex.	228	150
Honorable John R. Tunheim	D. Minn.	226	151
Honorable Jon Phipps McCalla	W.D. Tenn.	225	152
Honorable William H. Alsup	N.D. Cal.	224	153
Honorable Richard H. Marschall	P.T.A.B.	224	153
Honorable Christopher L. Ogden	P.T.A.B.	222	154
Honorable Clark S. Cheney	USITC	221	155
Honorable Richard G.	D. Mass.	221	155

Stearns			
Honorable Rya W. Zobel	D. Mass.	221	155
Honorable Daniel N. Fishman	P.T.A.B.	220	156
Honorable Scott B. Howard	P.T.A.B.	217	157
Honorable Gale R. Peterson	W.D. Pa.	216	158
Honorable S. James Otero	C.D. Cal.	212	159
Honorable Ken B. Barrett	P.T.A.B.	211	160
Honorable Glenn J. Perry	P.T.A.B.	208	161
Honorable Amanda F. Wieker	P.T.A.B.	207	162
Honorable Otis D. Wright, II	C.D. Cal.	206	163
Honorable Eric C. Jeschke	P.T.A.B.	206	163
Honorable Jeffrey S. Smith	P.T.A.B.	204	164

In order to make recommendations on how to more efficiently carryout claim construction, we must first assess the practices of those who oversee claim construction litigation. As seen in the tables above, the top five judges who have construed the most claim terms are Judge Roy S. Payne (8,601 terms), Judge Richard G. Andrews (7,205 terms), Judge Rodney Gilstrap (4,906 terms), Judge Alan D. Albright (4,694 terms), and Leonard P. Stark (4,372 terms).[70]

[70] Editor's Note: These statistics were obtained using Docket Navigator. Docket Navigator is a SaaS provider that allows users to search documents filed in patent infringement suits and generate related analytics. *See Docket Navigator Research Database*, DOCKET NAVIGATOR (2023), https://www.docketnavigator.com [https://perma.cc/HL5T-Z8SW] (last visited Apr. 28, 2023) (create an account to log-in; choose "Profile Search"; then select "Judge" and enter names).

These judges practice in courts which any patent litigator will be very familiar: the Eastern District of Texas, the District of Delaware, the Western District of Texas, and the United States Court of Appeals for the Federal Circuit. These courts of course rank highest among the courts that have construed the most claim terms of all time, which is as follows (from Docket Navigator, as of April 26, 2023):

Court	Terms	Rank
E.D. Tex.	30502	1
P.T. A.B.	30447	2
D. Del.	21108	3
N.D. Cal.	7587	4
C.D. Cal.	6953	5
W.D. Tex.	6879	6
S.D. Cal.	5606	7
USITC	3357	8
D.N.J.	2037	9
D. Mass.	1836	10
N.D. Tex.	1301	11
S.D. Tex.	1129	12
USITC	903	13
D. Minn.	864	14
N.D. Ga.	677	15
W.D. Wash.	625	16
E.D. Va.	613	17
S.D.N.Y.	612	18
W.D. Wis.	464	19
N.D.N.Y.	388	20
D. Colo.	272	21
D. Kas.	266	22
D. Nev.	245	23
W.D. Mich.	239	24
W.D. Tenn.	225	25
W.D. Pa.	216	26

The following analysis of current claim construction practices will draw from table above the three district courts that have

construed the most terms all time. Namely: the Eastern District of Texas, the District of Delaware, and the Western District of Texas. Further, and analysis of claim construction practices would be incomplete without the inclusion of the Patent Local Rules, which were first implemented in the Northern District of California. Therefore, we will also analyze the current practices of many courts hearing patent cases, which have adopted local rules specific to patent cases, and most of these are variations of the Patent Local Rules, which are a set of rules and procedures established by certain federal district courts geared to govern the management of patent litigation cases. These rules aim to provide clarity, structure, and consistency in the patent litigation process, streamline case management, and reduce unnecessary delays and costs.

A. Claim Construction Foundations: The Patent Local Rules

The history of the Patent Local Rules can be traced back to the late 1990s and early 2000s when certain federal district courts recognized the need for specialized rules to manage the complexities of patent litigation more effectively.[71] As patent litigation cases increased in volume and complexity, these courts sought to streamline case management, reduce unnecessary delays and costs, and ensure that patent cases received focused and consistent treatment. The Northern District of California is often considered the birthplace of patent local rules.[72] In 2000, it became the first district court to adopt a set of specialized rules for patent cases.[73] The rules were designed to address specific issues that commonly arise in patent litigation, such as claim construction, infringement and invalidity contentions, and discovery.[74]

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[71] Jason W. Wolff et. al., *Patent Local Rules: Knowing Them Well Can Make Litigating Your Case Smoother*, FISH & RICHARDSON, P.C., (Apr. 22, 2020), https://www.fr.com/insights/ip-law-essentials/patent-local-rules-knowing-them-well-can-make-litigating-your-case-smoother/ [https://perma.cc/L5Y7-XQNM].

[72] *Id.*

[73] *Id.*

[74] *Id.*

After the Northern District of California implemented its patent local rules, other district courts followed suit.[75] Some of the early adopters include the Eastern District of Texas, and the Central District of California.[76] Over time, more district courts across the United States have either adopted their own versions of local patent rules or issued standing orders that effectively create local patent rules.[77] These courts have often taken cues from and refined the approaches used in other districts.[78] Aside from the Northern District of California, among the district court judges that have construed the most claimed terms, the Eastern District of Texas has adopted issued local patent rules, whereas the District of Delaware and the Western District of Texas have not.

Notably, the Western District of Texas has not issued local patent rules; instead, Judge Albright periodically updates his standing order titled "Order Governing Proceedings—Patent Cases." Similarly, Chief Judge Connolly of the District of Delaware issued three scheduling orders issued in April 2022 that effectively implement local patent rules. While the local patent rules of the district courts vary, they share common goals: providing structure and consistency in the patent litigation process, ensuring that the parties have a clear understanding of the issues in the case, and promoting the efficient resolution of disputes.[79] The adoption of Patent Local Rules has been widely regarded as a positive development in patent litigation, and they have played a significant role in shaping the way patent cases are managed in U.S. District Courts.[80]

While the Federal Circuit does not use Patent Local Rules, it does have its own set of procedural rules, known as the Federal Circuit Rules of Practice.[81] These rules govern various aspects of appellate practice before the Federal Circuit, including briefing,

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[75] Wolff, *supra* note 71.

[76] *Id.*

[77] *Id.*

[78] *Id.*

[79] *Id.*

[80] *Id.*

[81] *See Rules of Practice*, UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT (Dec. 1, 2023), https://cafc.uscourts.gov/home/rules-procedures-forms/federal-local-rules-of-appellate-procedure/ [https://perma.cc/5JE6-7QQG].

oral arguments, and motions.[82] The Federal Circuit Rules of Practice work in conjunction with the Federal Rules of Appellate Procedure, which apply to all federal appellate courts.[83] The Federal Circuit has nationwide jurisdiction over appeals in patent cases.[84] When parties appeal a patent case from a district court to the Federal Circuit, they typically challenge aspects of the trial court's rulings, such as claim construction, infringement, validity, and damages.[85]

B. Variations in Claim Construction: Claim Term Limits

The local patent rules typically address initial case management, claim construction, infringement and validity contentions, discovery, expert testimony, pretrial and trial procedures, and deadlines and scheduling. However, local patent rules vary among the district courts and even further through individual judge's standing orders. Though many of the procedural elements of the Patent Local Rules are present across the most patent-practiced district courts, judges have carved out some notable differences in claim construction term limitations.

The way these courts handle claim construction is substantially similar. For example, most courts allow similar amounts of time for the parties to conduct their briefing, require that the parties meet to reduce the number of claim terms (or at least to make efforts to do so), and impose hearing procedures as well as time limits. The consistency among these courts affords patent litigators some predictability of the field on which they are at play. It could also be argued that consistency affords both parties a more tenable grasp on just outcomes, improving their trust in the system.

The most notable differences among these courts regard limitations on the number of claim terms. It is common for judges in patent cases to place limits on the number of claim terms that parties may ask the court to construe during claim construction, culminating in what is known as a *Markman* hearing. The specific

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[82] *Rules of Practice*, *supra* note 81.

[83] *Id.*

[84] *Id.*

[85] *Id.*

limits on the number of claim terms may vary depending on the case, the judge, and the complexity of the issues involved. Judges usually impose these limitations through standing orders, case management orders in a specific case, or updates to the court's local patent rules. What follows is an analysis of the three district courts that have construed the most claim terms, as well as the Northern District of California, being that it is the birthplace of Local Patent Rules.

1. The Western District of Texas

In the Western District of Texas, the court imposed its limitations via a standing order issued by Judge Albright.[86] As previously mentioned, the Western District of Texas does not have local Patent Rules; instead, Judge Albright periodically updates this standing order. The Western District of Texas provides some variability to the claim terms each party may request the court to construe. The court requires that when one to two patents are in a suit, each party is limited to eight terms; when three to five patents are in a suit, each party is limited to ten terms; and when five or more patents are in a suit, each party is limited to twelve terms.[87] The court states that it may grant leave for additional terms to be construed depending on the complexity of the subject matter and the number of total terms, in which case the court may split the Markman hearing into multiple hearings.[88]

The Western District of Texas requires the parties to conduct a non-simultaneous Markman briefing, culminating in a joint claim construction statement.[89] Further, Judges Gilliland and Albright give preliminary claim constructions the day before the Markman hearing, with the goal of focusing the parties' arguments on more dispositive points based upon the judges' preliminary interpretation.[90] The court generally believes that

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[86] *Standing Order Governing Proceedings (OGP) 4.3—Patent Cases*, W.D. Tex. (Apr. 4, 2023), https://www.txwd.uscourts.gov/wp-content/uploads/2023/01/Standing-Order-Governing-Patent-Cases.pdf [https://perma.cc/64MT-P4Q4].

[87] *Id.* at 7.

[88] *Id.*

[89] *Id.*

[90] E-mail from Mark Scott to Christopher McDonald, Re: Markman Inquiry (Apr. 21, 2023) (on file with author).

making arguments for fine-tuning the preliminary construction may be more helpful than just trying to argue their original construction.[91] Further, arguments that provide a clarification or a compromise are more persuasive.[92]

2. The Northern District of California

The Western District of Texas's variable claim term limitation depending on the number of patents is not shared by Judge Andrews in the Northern District of California. There, each party is required to serve on each other a list of claim terms that the party contends should either be construed by the court or by 35 U.S.C. §112(6).[93] Thereafter, the parties are instructed to meet and confer for the purposes of limiting the number of terms in dispute by "narrowing or resolving differences and facilitating the ultimate preparation of a Joint Claim Construction and Prehearing Statement."[94] The court also requires the parties to jointly identify no more than ten terms likely to be most significant to resolving the parties' dispute.[95] Thus, the parties are not strictly limited to ten claim terms but are forced to jointly identify the claim terms most significant to the case. Further, if any of the terms' construction would be case or claim dispositive, those must be identified as well.[96]

3. The Eastern District of Texas

On October 29, 2013, the Eastern District of Texas adopted a model order in order to focus patent claims.[97] Rather than incorporating the Model Order into a revised version of its Local Rules, the Eastern District included the Model Order as an appendix to the Local Rules, which gives litigants and the court

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[91] Scott Email, *supra* note 90.

[92] *Id.*

[93] *Patent Local Rules*, N.D. CAL. (Nov. 4, 2020), https://www.cand.uscourts.gov/localrules/patent [https://perma.cc/WP4R-RF74].

[94] *Id.* at 4-1(b).

[95] *Patent Local Rules*, *supra* note 93.

[96] *Id.*

[97] *General Order Adopting Model Order Focusing Patent Claims & Prior Art to Reduce Costs*, E.D. TEX. ORDER 13-20 (2013), http://www.txed.uscourts.gov/sites/default/files/goFiles/13-20.pdf [https://perma.cc/5PWT-UAKK] [hereinafter General Order].

flexibility to tailor limits on a case-by-case basis.[98] In fact, the Local Rules make no mention of any limitations on the number of claim terms.[99] Instead, the court merely outlines the claim construction proceedings and the respective deadlines.[100] The only mention of reducing the number of claim terms merely asks that the parties meet and confer for the purposes of finalizing the list, narrowing or resolving differences, and facilitating the ultimate preparation of a Joint Claim Construction.[101]

In addition, in the Eastern District of Texas, initially, each party simultaneously exchanges a list of claim terms that the party contends should be construed or founded indefinite by the court.[102] The Eastern District of Texas Model Order includes two phases for limiting asserted claims and prior art references. During the first phase, each patent claimant (i.e., the party alleging infringement) serves a Preliminary Election of Asserted Claims, which asserts "no more than ten claims from each patent and not more than a total of 32 claims."."[103] During the second phase, the patent claimant serves a Final Election of Asserted Claims no later than 28 days before it serves its Expert Report(s) on Infringement.[104] The Final Election of Asserted Claims identifies "no more than five asserted claims per patent from among the ten previously identified claims and no more than a total of 16 claims."[105]

The court's goal in adopting this Model Order is to reduce the court's burden and reduce patent litigation costs by focusing cases to the issues at the core of the dispute.[106] Litigants should discuss these limitations early on in a case as post-entry motions to modify numerical limits on asserted claims require a demonstration of good cause warranting the modification.[107]

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[98] *General Order*, *supra* note 97, at 7-9.

[99] *Patent Rules*, E.D. TEX., http://www.txed.uscourts.gov/?q=patent-rules [https://perma.cc/V5SL-YR24] (last visited Apr. 25, 2023).

[100] *Id.*

[101] *Id.* at 4-1(b).

[102] *Id.* at 4-1(a).

[103] General Order, *supra* note 97, at 3.

[104] *Id.* at 4, ¶ 3.

[105] *Id.*

[106] *Id.* at 13, ¶ 5.

[107] *Id.*

4. The District of Delaware

The District of Delaware does not have a set of local rules specific to patent cases. Instead, the court that has local rules that simply apply to all proceedings. However, the court effectively implements local patent rules through three scheduling orders issued by Chief Judge Connolly in April 2022.[108] One of the scheduling orders applies to Hatch-Waxman patent infringement cases, while the other two do not. Of these latter two standing orders, one applies where infringement is alleged, and the other applies when only invalidity is alleged.[109]

All three standing orders are subject to word limitations on briefs, a three-hour time limit on claim construction hearings, and a joint effort to meet and confer to reduce the number of claim terms.[110] However, it is only the Hatch-Waxman Patent Infringement standing order that limits the number of claim terms to specific numbers.[111]

Similar to the Northern District of California, at the outset of the claim construction process where Hatch-Waxman Patent Infringement is asserted, the parties are to simultaneously exchange claim terms they believe need construction, and their

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[108] *See generally Chief Judge Colm F. Connolly*, UNITED STATES DISTRICT COURT FOR THE DISTRICT OF DELAWARE (Oct. 3, 2023, 1:00 PM), https://www.ded.uscourts.gov/judge/ chief-judge-colm-f-connolly [https://perma.cc/G749-7ZU3] (Chief Judge Connolly's page indicates that three scheduling orders regarding patents were entered in April 2022.).

[109] *Id.*

[110] *Form Scheduling Order for Non-Hatch-Waxman Patent Cases in Which Only Invalidity and Not Infringement Is Alleged*, D. DEL., (Apr. 18, 2022), https://www.ded.uscourts.gov/sites/ded/files/chambers/Form%20Scheduling%20Order%20for%20Non-Hatch-Waxman%20Patent%20Cases%20Invalidity%20Only.pdf. [https://perma.cc/34A6-ZVZZ]; *Form Scheduling Order for Non-Hatch-Waxman Patent Cases in Which Infringement is Alleged*, D. DEL., (Apr. 18, 2022), https://www.ded.uscourts.gov/sites/ded/files/chambers/Form%20Scheduling%20Order%20for%20Non-Hax%20Waxman%20Patent%20Cases%20in%20Which%20Infringement%20is%20Alleged.pdf [https://perma.cc/66DW-LGGD].; *Scheduling Order for Hatch-Waxman Patent Infringement Cases*, D. Del., (Apr. 26, 2022), https://www.ded.uscourts.gov/sites/ded/files/chambers/Scheduling%20Order%20for%20Hatch-Waxman%20Patent%20Infringement%20Cases.pdf [https://perma.cc/8JLW-DYFC] [hereinafter *Scheduling Order*].

[111] *Scheduling Order*, *supra* note 110, at 2 ("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.").

proposed claim constructions of those terms.[112] Specifically, the Hatch-Waxman Patent Infringement Scheduling Order requires that in the Preliminary Disclosure of Asserted Claims, the plaintiff is to assert "no more than ten claims for any one patent and no more than 32 claims in total against any one Defendant."[113] This document is served to the defendant and is sometimes not filed with the court.[114]

The parties are then required to meet and confer to prepare a Joint Claim Construction Chart, which is to be filed with the court.[115] The plaintiff may then file its opening brief, which is not to exceed 5,500 words and the defendant may provide an answer that is not to exceed 8,250 words.[116] Each party is further allowed a single brief and response, subject to word count limitations.[117] Interestingly, each of these briefs are served to the other party but not filed with the court.[118] This briefing process culminates with a Joint Claim Construction Brief, which is filed with the court. Within the Joint Claim Construction Brief, the court requires the parties themselves to self-organize their claim construction arguments with each disputed claim term.[119] To this writer, this seems to be an exceptional practice that reduces the gamesmanship the parties can play in disorganizing their briefs, reduces the burden on the court to organize all the arguments and terms itself, and significantly increases the overall clarity of presentation of the parties' arguments.

The court then provides for a hearing on claim construction limited to three-hours, at which the parties may not present testimony.[120] Following the hearing, the plaintiff shall serve on the defendant a Final Election of Asserted Claims that shall identify no more than five asserted claims for any one patent and

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[112] *Scheduling Order*, *supra* note 110, at 14.

[113] *Id.* at 2.

[114] *Id.* at 14.

[115] *Id.*

[116] *Id.* at 15.

[117] *Scheduling Order for Hatch-Waxman Patent Infringement Cases*, D. Del., (Apr. 26, 2022), https://www.ded.uscourts.gov/sites/ded/files/chambers/Scheduling%20Order%20for%20Hatch-Waxman%20Patent%20Infringement%20Cases.pdf [https://perma.cc/8JLW-DYFC] [hereinafter *Scheduling Order*].

[118] *Id.*

[119] *Id.* at 16.

[120] *Id.* at 18.

no more than a total of 16 claims.[121] "Any request to increase the limits on asserted claims… must demonstrate with specificity why the inclusion of additional asserted claims… is warranted."[122] Therefore, an implementation of the aforementioned best practices will lead to the most streamlined and efficient results for claim construction, as evidenced by the preceding statistics from the most active patent courts.[123] For example, whenever there are opportunities to conduct a mini-*Markman* hearing, or case dispositive one, or even one structured in a "shootout"-style, those approaches should be adopted in order to make the best use of judicial resources. Moreover, utilizing Technical Advisors and following the above time, term number and page quantity limits will provide a consistent and sustainable framework to follow that parallels the methodology of the most active patent federal district courts mentioned above.

CONCLUSION

Combining one of the above-discussed approaches with the use of a Technical Advisor and/or the implementation of certain rules regarding time, term, and total (e.g., page) limits will ensure *Markman* hearings are conducted in the most efficient, effective means possible and executed in a manner that saves money and resources of not only the litigating parties (such as doing away with unnecessary and unwieldy discovery costs) but the judicial system as a whole. As a result, these suggestions can be implemented by future leading patent judges and judicial law clerks in highly active patent district trial courts such as the Western District of Texas and the District of Delaware, as well as existing active patent trial courts such as the Eastern District of Texas, the District of New Jersey, the Northern District of Illinois, and the Northern and Central Districts of California and/or Article II tribunals such as the United States Court of International Trade or the Patent Trial and Appeal Board. Following the above suggestions to enhance the *Markman* claim construction process will allow these courts to effectively "make

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[121] *Scheduling Order*, *supra* note 110, at 18-19.

[122] *Id.* at 22.

[123] *See* Hsieh, *supra* note 39.

the mark" so that patent claim terms can be construed and *Markman* hearings can be conducted in the most effective fashion attainable.