



## Markman's in Madison: An Endangered Species?

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Litigating a patent case in the Western District of Wisconsin ("WDWI"), always an interesting prospect, has just gotten more interesting, especially in cases before Judge Barbara Crabb. The WDWI has earned its reputation as a sophisticated venue for patent litigation over the years due to its smart judges, substantial number of filed patent cases, and local rules that make the WDWI a true "rocket docket." And now, former-Chief Judge Crabb, who currently enjoys senior status, has decided to do away with a mainstay of nearly all patent litigations — the *Markman* hearing and related claim construction order. This is an important development, as it presents a potential litigation streamlining procedure for litigants to suggest to other Courts, in addition to its obvious impact on litigants before Judge Crabb.

From a historical perspective, Judge Crabb's new claim construction procedure hearkens back to the period immediately following the Supreme Court's issuance of its *Markman* opinion, when courts and the patent bar wrestled with the proper timing and context for implementing the Supreme Court's directives regarding claim construction in patent cases. During that time, at least one other court forcefully articulated a belief that claim construction should be handled in the context of motion practice, for "[O]therwise the Court risks, crafting elegant, but ultimately useless statements of claim construction that fail to address the controversy before it."<sup>1</sup> In that light, Judge Crabb's approach, which may seem radical now, in effect is a return to previously endorsed approaches to dealing with claim construction, and an attempt to focus claim construction on those terms that are truly of import to the disposition of the case.

This author, having experienced a panoply of claim construction approaches by courts around the country, including some that approximated Judge Crabb's approach and resulted in efficient resolution of those particular cases, welcomes this attempt to streamline a critical component of every patent case — and further hopes that Judge Crabb's announcement will reawaken a dialogue between courts and the patent bar regarding optimal claim construction approaches.<sup>2</sup>

Regardless whether one considers Judge Crabb's "new" approach to be truly new, it no doubt was a surprise to the litigants first apprised of her change in claim construction practice. This surprising development was announced, not by Court press release, but via a Magistrate Judge's order in a pending WDWI patent case. That case, *Dashwire, Inc. v. Synchronoss Technologies, Inc.* (11-cv-257-bbc, W.D. Wisc. 2011), had been filed in April 2011. An initial status conference was held before Magistrate Judge Crocker on July 19, 2011. Judge Crocker then issued an Order on July 28, 2011, and thereby informed the parties that Judge Crabb, "has changed her procedures for construing claims and deciding summary judgment motions in patent lawsuits." According to the Order, Judge Crabb's new procedures would: 1) apply to all pending patent lawsuits where the claim construction briefing process



had not yet begun; 2) still require parties to exchange disputed claim terms by the date called-for in the preliminary pretrial conference order; 3) no longer allow for briefing or argument on claim construction issues in a stand-alone proceeding; 4) eliminate the issuance of a claim construction order by the court; and 5) require the parties to include any claim construction requests in the context of a summary judgment motion. Additionally, only terms that had previously been exchanged would be eligible for construction, and the previous 16 claim term limit is no longer in force before Judge Crabb.

The *Dashwire* Order indicates that the timing of summary judgment briefs is not affected by the new procedures in terms of when responses and replies would be due, but that the deadline for summary judgment would be moved up one month to fall seven months before trial. Oral argument would be held at the Court's discretion, with the parties free to request oral argument on all issues relating to the pending summary judgment motion, including claim construction. This request would need to be made in the opening summary judgment briefs, together with "an explanation as to why this is necessary." Any argument would be limited to the issues and evidence presented in the summary judgment briefing, and would also be limited to no more than 90 minutes per side. The issues to be argued would be chosen by the Court from those suggested by the parties.

These new procedures can definitively be classified as "game changer," particularly in the calculus of deciding whether to bring a patent case in the WDWI. With short odds on drawing Judge Crabb, litigants in the WDWI could very easily find themselves in uncharted patent litigation waters, particularly if they have never dealt with a similar procedure in the past. It will be interesting to see how these new procedures play out in the WDWI, and whether similar procedures will be adopted by other busy District Court Judges faced with expanding dockets and pressure to streamline proceedings. Other potential consequences of interest include but are not limited to: 1) whether the WDWI becomes more inviting to patentees prepared to press alleged infringers even further than is currently contemplated by the "rocket docket" rules; 2) how the Federal Circuit will view these new procedures in the context of appeals taken from patent cases originating in Judge Crabb's court; and 3) how claim construction issues are presented to the jury in those cases where summary judgment motions are not filed or denied by Judge Crabb. An exciting development in the patent litigation world to be sure. And *Dashwire*? It settled on August 2, 2011, less than a week after these new procedures were announced.

#### Endnotes

- 1 See *MediaCom Corp. v. Rates Technology, Inc.*, 4 F. Supp. 2d 17, 22 (D. Mass. 1998). In that case, the Court unequivocally declared that "[F]ree standing Markman hearings are of little use in actual litigation," and went so far as to suggest possible constitutional infirmities with the practice of holding such hearings. Those doubts, the validity of which are for additional study, have obviously done little to temper the long-standing practice in the vast majority of courts to hold stand-alone claim construction hearings. Likewise, the canonization of "patent rules" in various jurisdictions, of which stand-alone claim construction procedures are often a prominent part, evidences that the constitutional question floated in *MediaCom* has failed to generate much practical concern.
- 2 The author would like to thank his partner, Bob McAughan of Locke Lord Bissell & Liddell LLP's Houston office, for alerting him to the historical background relating to Judge Crabb's current approach, and recommends interested readers to Mr. McAughan's illuminating discussion of the interplay between claim construction and motion practice in patent litigation found in Chapter 16, entitled "Motion Practice Strategies," of the *Patent Litigation Strategies Handbook* (BNA Books, First Edition 2000).

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