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## Swallowing the Apple Whole: Improper Patent Use by Local Rule

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## NOTE

### Swallowing the Apple Whole: Improper Patent Use by Local Rule

*Ellisen S. Turner*

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#### BACKGROUND

During patent infringement litigation, the Federal Rules of Civil Procedure (“FRCP”) and the federal district court’s local rules govern the parties’ pretrial discovery and motion practice.<sup>1</sup> The U.S. District Court for the Northern District of California has adopted the most comprehensive local rules to date covering pretrial procedures in the patent litigation context.<sup>2</sup> The Northern District of California Patent Local Rules (“Local Rules”)<sup>3</sup> may come to have a significant impact throughout the federal courts, as it appears that other jurisdictions and commentators are looking to the Local Rules for guidance. For instance, the American Bar Association Section of Intellectual Property

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1. 28 U.S.C. § 2071 (1994) (“[A]ll courts established by Act of Congress may from time to time prescribe rules for the conduct of their business.”); FED. R. CIV. P. 83(a)(1) (“Each district court, acting by a majority of its district judges, may, after giving appropriate public notice and an opportunity for comment, make and amend rules governing its practice.”).

2. Clifton E. McCann, Markman — *Preferred Procedures to Promote Certainty of Patent Claim Interpretation*, 1998-99 A.B.A. SEC. INTELL. PROP. L. ANN. R. 292, available at <http://www.abanet.org/intelprop/98-99report/601.html>.

3. N. D. Cal. Patent Local R. (Jan. 1, 2001) [hereinafter “N.D. Cal. L.R.”], available at <http://www.cand.uscourts.gov>.

Law (“ABA/IPL”) closely examined the Local Rules, found them to have considerable merit, and appeared to use an early version of the rules as a basis for the ABA/IPL 1999 proposed resolutions governing patent claim construction practice and procedure.<sup>4</sup> Federal courts in several other districts have occasionally cited the Local Rules in their opinions and have been willing to use the Local Rules as a guide in developing their own patent infringement litigation procedures.<sup>5</sup> In order to understand how the Local Rules affect the patent litigation process, a short review of patent law is necessary.

The Constitution grants Congress the power to promote the progress of the useful arts by giving inventors the exclusive right to their discoveries for limited times.<sup>6</sup> In other words, Congress may induce inventors to disclose their creations by providing them with a limited monopoly right. The U.S. Patent and Trademark Office (“PTO”) issues patents that vest such a legal monopoly in the patentee by granting the right to preclude others from making, using, selling, offering to sell, or importing the patented invention.<sup>7</sup> The patent’s subject matter is set forth in the specification, which contains the written description of the invention and the patent “claims.”<sup>8</sup> The claims are the legal language that defines the metes and bounds of the patentee’s monopoly right,<sup>9</sup> while the written description explains the invention and provides the context for the terms used in the claim language.<sup>10</sup>

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4. See McCann, *supra* note 2, at 288-90 (showing voting outcomes in favor of Proposed Resolutions 601-1 to 601-7).

5. See, e.g., Thomson Consumer Elecs., Inc. v. Innovatron, S.A., 43 F. Supp. 2d 26, 29 n.1 (D.D.C. 1999) (citing N.D. Cal. L.R. in discussion of *Markman* hearing procedures); Precision Shooting Equip. Inc. v. High Country Archery, 1 F. Supp. 2d 1041, 1042 (D. Ariz. 1998) (“This Court utilized the [N.D. Cal. L.R.] as a guide for this Order. . .”); see also Kenneth R. Adamo, *Get on Your Marks, Get Set, Go; Or “And Just How Are We Going to Effect Markman Construction in This Matter, Counsel?”*, in HOW TO PREPARE & CONDUCT *MARKMAN* Hearings, at 602, 608 (PLI Patents, Copyrights, Trademarks and Literary Prep. Course, Handbook Series No. 665, 2001) (stating that the N.D. Cal. L.R. have the “best known” patent litigation practice procedures and have been “used or adopted” by other districts and individual judges including Judge Ward in the Eastern District of Texas).

6. U.S. CONST. art. I, § 8, cl. 8.

7. 35 U.S.C. § 271 (1994).

8. The specification must also include the manner and process of making and using the invention as well as the inventor’s best mode of carrying out the invention. 35 U.S.C. § 112 (1994).

9. The U.S. patent system is based on the peripheral claiming technique in which the claims mark out the periphery of the area covered by the patent. Only devices or processes that lie within that area infringe the patent. See *Ex parte Fressola*, 27 U.S.P.Q.2d 1608, 1610 (B.N.A.) (Bd. Pat. App. & Int’l 1993) (“Modern claim interpretation is based on the peripheral system where the scope of the claim is not expanded.”); *Renishaw PLC v. Marposs Società Per Azioni*, 158 F.3d 1243 (Fed. Cir. 1998).

10. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996).

The claims of a patent may vary in scope. Broad claims contain fewer limitations, or “elements,”<sup>11</sup> than narrow claims and thus describe, or “read on,”<sup>12</sup> a wider range of subject matter.<sup>13</sup> It is usually beneficial for the patentee to have a patent with broad claims in order to reach as many potential competitors as possible, and to prevent competitors from “designing around” the patent by examining the claim language and then purposefully designing a device that avoids infringement by substituting or removing claim elements.<sup>14</sup> Conversely, if the patentee drafts the claims too broadly they may be invalid in view of the “prior art” — previously existing innovations that either are already the subject of a previously issued patent or are otherwise part of the public knowledge.<sup>15</sup> Claims that are apparent given the public knowledge of the state of the art are invalid because the claimed invention is obvious, while claims that read directly on the prior art are invalid because the claimed invention lacks novelty.<sup>16</sup>

A patentee<sup>17</sup> seeking to enforce its limited monopoly may initiate a suit alleging that an adverse party improperly infringed its patent.<sup>18</sup> Patent litigation normally begins when a patent claimant files a patent infringement complaint in a U.S. Federal District Court.<sup>19</sup> The U.S. Court of Appeals for the Federal Circuit has exclusive jurisdiction for appeals of district court judgments decided under the federal patent laws.<sup>20</sup>

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11. For patented processes, the claim elements define steps or acts to be performed. For patented products, the claim elements define discrete physical structures or materials. U.S. PATENT AND TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 2106 (II)(C) [hereinafter MPEP].

12. A claim reads on a particular device if that device contains all of the claim elements.

13. HERBERT F. SCHWARTZ, PATENT LAW AND PRACTICE 12 (2d ed. 1995).

14. ROBERT C. FABER, LANDIS ON THE MECHANICS OF PATENT CLAIM DRAFTING VII. *Claims of Varying Scope* § 60 (Practicing Law Institute 2000); *id.* X. *Thoughts on Writing a Claim*.

15. *Id.* X.

16. *See generally* 35 U.S.C. §§ 102, 103 (1994). An invention is obvious if the differences between the invention and the prior art are such that the invention would have been obvious to a person of ordinary skill in the relevant industry. An invention is anticipated, and therefore lacks novelty, if a single piece of prior art contains all the essential elements of the invention. *Hybritech, Inc., v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986).

17. This Note uses the terms “patentee” and “patent claimant” interchangeably. The former refers to a party who received a patent from the PTO, whereas the latter refers to a party, usually a patentee or an exclusive licensee with standing to sue, claiming patent infringement.

18. 35 U.S.C. § 271 (1994).

19. *See* 28 U.S.C. § 1338 (1994).

20. 28 U.S.C. §§ 1292(c)(2), 1295(a)(1) (1994).

Courts tend to perform patent infringement analysis in two stages.<sup>21</sup> In the first stage, the court construes, or interprets,<sup>22</sup> the claim language. Claim construction entails clarifying the technical terms, terms of art, special term usages, and ambiguous terms in the claims<sup>23</sup> as well as determining the scope of those terms.<sup>24</sup> When construing claims, the court can neither broaden nor narrow the claim scope to give the patentee something different than what the patent set forth.<sup>25</sup> In essence, claim construction is the process of elaborating terse language in order to understand and explain it, but not to change its scope.<sup>26</sup>

As parties propose a claim construction to the court, they may buttress their position by relying on two types of evidence — intrinsic and extrinsic.<sup>27</sup> In the jargon of patent litigation, “intrinsic evidence” consists of only the claims, specification, and prosecution history<sup>28</sup> of

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21. *Gentry Gallery, Inc. v. Berklene Corp.*, 134 F.3d 1473, 1476 (Fed. Cir. 1998) (quoting *Carroll Touch, Inc. v. Electro Mech. Sys., Inc.*, 15 F.3d 1573, 1576 (Fed. Cir. 1993) (stating that a patent infringement analysis requires two steps: “ ‘First, the claim must be properly construed to determine its scope and meaning. Second, the claim as properly construed must be compared to the accused device or process.’ ”)).

22. This Note uses the terms “claim construction” and “claim interpretation” interchangeably to refer to the combined process of determining both claim meaning and scope. It may be proper, in some instances, to use the word “interpret” when speaking of the meaning of the words and “construe” in connection with determining protection beyond the words, i.e., the scope of a claim. See *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1569 (Fed. Cir. 1995) (Nies, J., dissenting), *rev'd*, 520 U.S. 17 (1997); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1000 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). There may also be a temporal distinction between the terms. Claim interpretation, the process performed by the PTO when reviewing a patent application, gives claims their broadest scope. See, e.g., *In re Prater*, 415 F.2d 1393, 1404-05 (C.C.P.A. 1969). In comparison, claim construction, the process performed by the court and the parties during an infringement action, gives claims the narrowest scope that the patent and its associated prosecution history will allow.

23. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1476 (Fed. Cir. 1998).

24. *Tanabe Seiyaku Co., Ltd. v. United States Int'l Trade Comm'n*, 109 F.3d 726, 731 (Fed. Cir. 1997), *cert. denied*, 522 U.S. 1027 (1997) (“[W]e construe the claim asserted to be infringed to determine its meaning and scope.”).

25. *Texas Instruments, Inc. v. United States ITC*, 988 F.2d 1165, 1171 (Fed. Cir. 1993).

26. *Fairchild Semiconductor Corp. v. Nintendo Co. Ltd.*, 30 USPQ.2d 1657, 1659 (W.D. Wash. 1994), *aff'd*, 39 F.3d 1197 (Fed. Cir. 1994) (unpublished decision).

27. *Renishaw PLC v. Marposh Societá Per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (“The intrinsic evidence, and, in some cases, the extrinsic evidence, can shed light on the meaning of the terms recited in a claim. . .”).

28. The prosecution history contains the complete record of all the proceedings before the Patent and Trademark Office as an inventor applied for a patent. See *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985) (“[T]he prosecution history (sometimes called ‘file wrapper and contents’) of the patent consists of the entire record of proceedings in the Patent and Trademark Office. This includes all express representations made by or on behalf of the applicant to the examiner to induce a patent grant. . . . Such representations include amendments to the claims and arguments made to convince the examiner that the claimed invention meets the statutory requirements of novelty, utility, and nonobviousness. Thus, the prosecution history (or file wrapper) limits the interpretation of claims

the patent in suit.<sup>29</sup> Any other evidence referenced during claim construction is termed “extrinsic evidence” and may include, inter alia, expert testimony, inventor testimony, technical dictionaries, technical treatises and articles, and information related to the allegedly infringing device or process.<sup>30</sup> Once claim construction is complete, the scope attributed to the claims operates to limit the patent claimant’s rights in the remaining litigation.<sup>31</sup>

In the second stage of infringement analysis, claim application, the court determines whether any of the claims as construed read on the accused instrumentality<sup>32</sup> either literally or under the doctrine of equivalents.<sup>33</sup> Generally, literal infringement occurs only if each and every claim element is present in the accused instrumentality.<sup>34</sup> Conversely, if one or more claim elements are missing, there is no literal infringement.<sup>35</sup> The doctrine of equivalents allows a court to find infringement when someone copies the heart of an invention but avoids the literal claim language by making a trivial change in the design of an accused instrumentality.<sup>36</sup> This doctrine allows the patentee a broader right to exclude than what the literal claim language provides. For example, assume a patent specification includes element *A* in one claim describing the invention. Subsequently, a competitor attempts to design around the patent by producing a competing product that fully embodies the patent claim except that the competitor replaces element *A* with an alternative — element *B*. There is no literal infringement of that patent claim because the competing product does not include each and every claim element, but the doctrine of equivalents allows a court to find infringement by ruling that element *B* is equivalent to element *A*. Thus, in creating a realm of protection for its invention, the patentee’s first bite at the apple is in its drafting of the literal claim language. The doctrine of equivalents is simply a second bite at

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[during litigation] so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance.”).

29. 5A DONALD S. CHISUM, CHISUM ON PATENTS § 18.03[2][e][ii] (2001).

30. *Id.* § 18.03[2][e][i]. This Note asserts that, during claim construction, it is not proper to reference the information relating to the allegedly infringing device or process for any reason other than to determine which claim terms are in issue. *See infra* note 75 and accompanying text.

31. *Id.* § 18.03[4].

32. This Note uses the term “accused instrumentality” to refer to the device or process that the patent claimant alleges is infringing the patent in suit.

33. CHISUM, *supra* note 29, § 18.01.

34. SCHWARTZ, *supra* note 13, at 81.

35. *See, e.g.*, Unique Concepts, Inc. v. Brown, 939 F.2d 1558 (Fed. Cir. 1991).

36. SCHWARTZ, *supra* note 13, at 82.

the apple as the patentee attempts to prove infringement in a court of law.<sup>37</sup>

Despite this expansive effect, the doctrine of equivalents technically does not broaden the scope of patent claims; rather it expands the patentee's right to exclude. As the Federal Circuit explained in *Wilson Sporting Goods Co. v. David Geoffrey & Associates*:

This court on occasion has characterized claims as being "expanded" or "broadened" under the doctrine of equivalents. Precisely speaking, these characterizations are inaccurate. To say that the doctrine of equivalents extends or enlarges *the claims* is a contradiction in terms. The claims — i.e., the scope of patent protection *as defined by* the claims — remain the same and application of the doctrine *expands the right to exclude* to "equivalents" of what is claimed. The doctrine of equivalents, by definition, involves going beyond any permissible interpretation of the claim language; i.e., it involves determining whether the accused product is "equivalent" to what is described by the claim language.<sup>38</sup>

Three conclusions should be clear from the *Wilson Sporting Goods* analysis. First, the procedural timing of the doctrine of equivalents — during the claim application stage of infringement analysis rather than the claim construction stage — precludes a court from expanding the literal claim scope. Second, the proper method for a court to expand the patent monopoly right to include an accused instrumentality that does not literally infringe is through an application of the doctrine of equivalents, not through an expansion of the literal claim scope. Finally, the literal claim language limits the doctrine of equivalents because elements in the accused instrumentality must be the equivalent of elements literally claimed.<sup>39</sup>

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37. See *Chiuminatta Concrete Concepts v. Cardinal Indus.*, 145 F.3d 1303, 1311 (Fed. Cir. 1998) ("There is no policy-based reason why a patentee should get two bites at the apple. If he or she could have included in the patent what is now alleged to be equivalent, and did not, leading to a conclusion that an accused device lacks an equivalent to the disclosed structure, why should the issue of equivalence have to be litigated a second time?"); Kenneth R. Adamo, *The Waiting at the (Patent) Bar Is Over — The Supreme Court Decides Hilton Davis*, 79 J. PAT. & TRADEMARK OFF. SOC'Y 431 (1997), ("[A] second bite of the apple under the [doctrine of] equivalents standard is both proper and allowed."); Clarence J. Fleming, *The Doctrine of Equivalents — Should It Be Available in the Absence of Copying?*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 233, 234 (1994) ("Under modern case law, the doctrine of equivalents is thought of by practitioners and the courts as simply a second bite at the apple for the patent owner in attempting to prove infringement."); Werner Stemer, Note, *The Doctrine of Equivalents After Hilton Davis and Markman, and a Proposal for Further Clarification*, 22 NOVA L. REV. 783, 798 (1998) ("[W]here an applicant for patent limits his claims to avoid prior art, the applicant cannot later 'argue for a second bite at the abandoned apple.'") (quoting *Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1208 (Fed. Cir. 1992)).

38. 904 F.2d 677, 684 (Fed. Cir. 1990) (internal citations omitted).

39. An accused instrumentality will only infringe under the doctrine if, for each element in a patent claim, the accused instrumentality has a corresponding equivalent element. See *Unique Concepts*, 939 F.2d at 1562.

This difference between expanding the literal claim scope and expanding the right to exclude is subtle but of considerable consequence because the doctrine of equivalents rests in delicate equipoise with the patent claims' public notice function. The public notice function is the principle, inherent in a claim based patent system, that the invention is exactly what the claims says it is, and that members of the public can avoid infringement by avoiding the claim language.<sup>40</sup> The PTO and the patentee serve the public notice function of a patent when they cement the literal scope of the patent monopoly in the public record<sup>41</sup> at the time the patent issues. A patent monopoly right is the patentee's quid pro quo for providing this disclosure to the public and enabling subsequent innovation. Whenever the patent monopoly right expands beyond the disclosure in the public record, the patent's public notice function disintegrates because parties are entitled to rely on the public record in order to make incremental innovations by building on or designing around the patented invention.<sup>42</sup>

The public's entitlement to rely on the public record only has value if potential competitors are able to determine where the patent monopoly ends and free competition begins. It is for this reason that patent law precludes a patentee from misusing a patent by expanding the patent monopoly's scope with anticompetitive effect.<sup>43</sup> This Note therefore concludes that when a patent claimant is able to reference an accused instrumentality during the claim construction phase of infringement litigation, the patent claimant may improperly expand the patent's literal scope and thus vitiate the claims as a limitation on the doctrine of equivalents. Where the doctrine of equivalents alone provides merely a second bite at the apple, expanding the literal claim

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40. *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991). The Federal Circuit's statements in *Slimfold* illustrate the public notice function:

The district court [was] overly concerned with the fact that the [accused instrumentality] was deliberately designed to avoid infringement of the . . . patent. Intentional 'designing around' the claims of a patent is not by itself a wrong which must be compensated by invocation of the doctrine of equivalents. Designing around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose. Inherent in our claim-based patent system is also the principle that the protected invention is what the claims say it is, and thus that infringement can be avoided by avoiding the language of the claims.

*Id.*

41. The patent and its associated prosecution history make up the public record of the patentee's monopoly rights.

42. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) ("The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention.").

43. SCHWARTZ, *supra* note 13, at 92.



scope during claim construction enables the patent claimant to swallow the apple whole.

A patent claimant may successfully expand the literal claim scope only by convincing the court to accept its claim construction contentions. The eventual finding on claim construction is a matter of law exclusively for the court,<sup>44</sup> but the court draws its decision from the parties' contentions and the evidentiary record. As stated earlier, the FRCP and the Local Rules govern the process by which the parties perform the pretrial procedures that allow them to develop their contentions and gather evidence. The Local Rules also manage the procedure by which the parties prepare for the *Markman* hearing — a mini bench trial in which the court arrives at a claim construction ruling.<sup>45</sup> This Note asserts that, despite the Local Rules' popularity with courts and commentators, in several aspects these rules improperly allow a patent claimant the opportunity to expand the patent's literal scope. This enables and encourages the patent claimant to proffer a strained, litigation-inspired claim construction that amounts to patent misuse. First, and most seriously, the mandatory disclosure procedure set out by the Local Rules grants discovery of the accused instrumentality too early in the claim construction process. Second, the Local Rules exacerbate the problem introduced by this mandatory disclosure procedure by allowing a court too much leeway to rely on extrinsic evidence to determine the scope of patent claims, despite the Federal Circuit's hostility to the use of extrinsic evidence for such purposes.<sup>46</sup> Finally, as the ABA/IPL recognized, the Local Rules limit the court's ability to implement different procedural rules to conduct discovery in a manner that promotes justice in the particular case at hand.<sup>47</sup> This prevents a court from eliminating any opportunity for patent misuse introduced by the mandatory disclosure procedure.

Specifically, Local Rule 3-4(a) requires that an accused infringer disclose all information surrounding the accused instrumentality before the patent claimant or the court engages in claim construction.<sup>48</sup> After receiving that disclosure, the patent claimant may simultaneously expand the scope of its asserted claim construction to ensure

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44. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

45. If a court utilizes a *Markman* hearing to resolve claim construction issues, the issue of infringement, and hence application of the claims to the accused instrumentality, does not occur until the full trial. Indeed, a court may never reach the issue of infringement because a party that did not receive a favorable *Markman* ruling on claim construction may have a greater incentive to settle.

46. *Pitney Bowes, Inc. v. Hewlett Packard Co.*, 182 F.3d 1298, 1308-09 (Fed. Cir. 1999); *see also infra* notes 89-99 and accompanying text.

47. *McAnn*, *supra* note 2, at 293.

48. *See infra* note 59.

that each disputed claim term is sufficiently broad to allow the claims to read on the accused instrumentality, and avoid proposing a construction that might be so broad as to render the patent invalid in light of the prior art.<sup>49</sup> The Local Rules thereafter enable the patent claimant to support this expansive claim construction with evidence extrinsic to the patent's public record.<sup>50</sup> As a result, the public record fails to effectively delineate the scope of the patent claimant's right to exclude. Instead, the patent claimant is able to create a new, litigation-inspired claim scope that is specifically honed to read on the accused instrumentality. Thus, the Local Rules allow the patent claimant to swallow the apple whole.

This Note argues that the Northern District of California should restructure the Local Rules to avoid granting patent claimants the opportunity to expand the patent's literal claim scope and to discourage courts from relying on extrinsic evidence during claim construction. Part I describes how the Local Rules can operate to encourage and enable improper patent use. This Part further argues that, absent extreme circumstances, the Local Rules should bind the patent claimant to the scope it has given to claim terms early in the discovery and mandatory disclosure stages of litigation, before it has received any disclosures related to the accused instrumentality. Part II argues that it is often legal error for the Local Rules to allow a patent claimant to delay asserting a claim construction until after it receives discovery related to the accused instrumentality. This Part shows that the FRCP, as applied to patent infringement litigation, favor early disclosure and discovery of the patent claimant's claim construction, prior to any disclosure regarding the accused instrumentality. Part III argues that there are significant policy reasons why the Local Rules should bind a patent claimant to its early claim construction statements and why a court, prior to its claim construction ruling, should have the discretion to limit a patent claimant's discovery of the accused instrumentality.

This Note concludes that early discovery of a patentee's claim construction, prior to any disclosures related to the accused instrumentality, is often necessary to discourage improper patent use. It may therefore be an abuse of discretion for judges or local rules to allow a patent claimant to delay answering interrogatories that seek the patent claimant's claim construction assertions until after the patentee has discovery of all information concerning the accused instrumentality. This Note further concludes that the Local Rules' treatment of extrinsic evidence encourages improper reference to the accused instrumentality during claim construction. The Local Rules should strictly and

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49. N.D. Cal. L.R. 3-6(a) allows amendments to "Preliminary Infringement Contentions." See *infra* note 68. N.D. Cal. L.R. 3-7 allows additional amendments by order of the court upon a showing of good cause. *Id.*

50. See *infra* Section I.C.

explicitly limit the court's use of extrinsic evidence during the claim construction stage of infringement analysis.

## I. THE PATENT LOCAL RULES EXAMINED

Parties and the courts face certain informational disadvantages as they seek to perform the claim construction step of patent infringement analysis. For example, a patent claimant may require early access to information related to an accused instrumentality in order to properly determine whether and how an opposing party is infringing its patent. Additionally, in certain limited circumstances, a court may find it necessary to examine extrinsic evidence in order to ensure that it arrives at a claim construction ruling that is consistent with the understanding of a person skilled in the art to which the patented invention appertains. Certain procedural aspects of the Local Rules are intended to ameliorate these difficulties, but these same procedures also have the potential for significant deleterious effects.

Section I.A describes the mandatory disclosure procedure of the Local Rules and shows how that procedure can result in substantial prejudice to an accused infringer through its early demand for the disclosure of all information related to the accused instrumentality. Section I.B explains why a patent claimant's legitimate reasons for seeking early disclosure of all information related to the accused instrumentality do not justify the Local Rules' mandatory disclosure procedures. This Section further describes a preferred procedure that would both discourage patent misuse and satisfy the patent claimant's need for the information necessary to shape its infringement contentions. Section I.C shows that the Federal Circuit is generally hostile to the use of extrinsic evidence, including information concerning the accused instrumentality, during claim construction. This Section asserts that the Local Rules' procedures regarding extrinsic evidence do not comport with Federal Circuit precedent.

### A. *Improper Patent Use Under the Local Rules*

An issued patent and its prosecution history make up the public record of the patent monopoly awarded to the patentee.<sup>51</sup> The patent claims, cemented in the public record at the moment of issuance, define the metes and bounds of the patentee's monopoly rights.<sup>52</sup> Subsequent inventors have the right to rely on the patent scope established in the public record to create innovations that expand on or provide

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51. See *supra* note 28 and accompanying text.

52. *Zenith Lab. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir. 1994); *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989).

alternatives to the patented invention.<sup>53</sup> It is improper for a patentee to use its patent to discourage legitimate innovation over the patented invention and thereby discourage competition outside the scope of the patent monopoly.<sup>54</sup>

This Section will demonstrate three mechanisms by which the Local Rules promote such improper patent use during infringement litigation. First, the mandatory disclosure procedures provide premature access to all information concerning the accused instrumentality. This premature access gives patent claimants the ability and incentive to broaden the literal scope of their patent claims during claim construction. Second, the Local Rules fail to impose a rigorous good faith standard in amendments to the parties' proposed claim construction statements. This allows the patent claimant to make bad faith amendments that expand the scope of their patent claims. Third, the Local Rules contain an evidentiary exclusion that significantly inhibits an accused infringer's ability to prove patent misuse.

The Local Rules set forth a system of specific procedures to control the discovery and claim construction procedures in patent litigation. After the initial case management conference held pursuant to FRCP 26(f),<sup>55</sup> the Local Rules give the patent claimant ten days to produce its "Disclosure of Asserted Claims and Preliminary Infringement Contentions."<sup>56</sup> This initial disclosure by the patentee must, *inter alia*, set out each patent claim that is allegedly infringed as well as the specific identity of each instrumentality that allegedly infringes those

53. See *supra* note 28 and accompanying text.

54. *Morton Salt Co. v. G.S. Suppiger Co.*, 314 U.S. 488, 492 (1941) ("The public policy which includes inventions within the granted monopoly excludes from it all that is not embraced in the invention. It equally forbids the use of the patent to secure an exclusive right or limited monopoly not granted by the Patent Office and which it is contrary to public policy to grant."). *But cf.* 35 U.S.C. § 271(d) (1994) ("No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having . . . sought to enforce his patent rights against infringement or contributory infringement.").

55. FED. R. CIV. P. 26(f) ("Conference of Parties; Planning for Discovery . . . the parties must, as soon as practicable . . . confer to consider the nature and basis of their claims and defenses and the possibilities for a prompt settlement or resolution of the case, to make or arrange for the disclosures . . . and to develop a proposed discovery plan. . .").

56. N.D. Cal. L.R., *supra* note 3, at 3-1. Disclosure of Asserted Claims and Preliminary Infringement Contentions:

Not later than 10 days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Preliminary Infringement Contentions . . . contain[ing] the following information:

- (a) Each claim of each patent in suit that is allegedly infringed by each opposing party;
- (b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. . . .
- (c) A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality. . . .
- (d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality. . . .

claims.<sup>57</sup> The most important aspect of this initial disclosure is a claim chart, which sets out in detail where each element of each asserted claim is found within each accused instrumentality, but does not contain a construction of those claims.<sup>58</sup>

Within forty-five days after the patent claimant's initial disclosure, the accused infringer must disclose its preliminary invalidity contentions and produce all documentation sufficient to show the operation of any aspects or elements of each accused instrumentality put in issue by the patent claimant.<sup>59</sup> At this time the Local Rules have not yet required that the patent claimant construe any claim terms. Thus, the Local Rules allow the patent claimant to assert which claims and elements of claims it contends read on the accused instrumentality without constraining the patent claimant's ability to later assert a broader or narrower claim scope as needed to prove infringement or avoid invalidity.

Within the next ten days, by day sixty-five since the initial case management conference, both parties must exchange their "Proposed Terms and Claim Elements for Construction."<sup>60</sup> These are the claim terms, phrases, and clauses that the parties contend the court should construe at a *Markman* hearing. Twenty days later, the parties conduct the "Exchange of Preliminary Claim Constructions and Extrinsic Evidence," in which both parties simultaneously assert their proposed constructions of all disputed claim terms.<sup>61</sup> Hence, after receiving disclosure related to the accused instrumentality, the patent claimant has thirty days before it must assert even a preliminary, nonbinding claim construction.

By allowing the patent claimant to review all information related to the accused instrumentality before it must construe the claims, the

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57. N.D. Cal. L.R., *supra* note 3, at 3-1(a), (b).

58. *Id.* at 3-1(c).

59. *Id.* at 3-4. Document Production Accompanying Preliminary Invalidity Contentions: With the "Preliminary Invalidity Contentions," the party opposing a claim of patent infringement must produce or make available for inspection and copying:

(a) Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its Patent L.R. 3-1(c) chart; and. . .

60. *Id.* at 4-1. Exchange of Proposed Terms and Claim Elements for Construction:

(a) Not later than 10 days after service of the "Preliminary Invalidity Contentions" pursuant to Patent L.R. 3-3, each party shall simultaneously exchange a list of claim terms, phrases, or clauses which that party contends should be construed by the Court, and identify any claim element which that party contends should be governed by 35 U.S.C. § 112(6). . .

61. *Id.* at 4-2 (stating that "the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which the parties collectively have identified for claim construction purposes").

Local Rules open the door for patent misuse because the patentee may expand the scope of its patent with potentially anticompetitive effect.<sup>62</sup> During the thirty days prior to the preliminary claim construction exchange, the patent claimant can shape its claim construction based on the disclosure it received regarding the accused instrumentality, thus ensuring that asserted claim terms are just broad enough to cover the accused instrumentality and yet not so broad as to read on any prior art. As a result, the patent claimant is assured that its asserted claim construction reads on the accused instrumentality, while simultaneously guarding against a construction that would render the patent invalid as obvious or anticipated.<sup>63</sup> Even patent litigation treatises encourage patent claimants to seize just such an opportunity to expand the scope of the patent:

“Even though the patent owner will have identified a particular activity as infringing in character prior to the initiation of the suit,” the patent owner “should not overlook the possibility of other activities . . . which better support the case.” Thus, plaintiffs should use discovery to request “information concerning activities in an area *as broad as any possible scope of the patent in suit.*”<sup>64</sup>

Notice that the patent claimant is encouraged, from the outset of discovery, to assert a patent scope that is as broad as possible, regardless of the patent claimant’s good faith beliefs as to the actual scope of the patent.

The Northern District of California has shown, through amendments to a proposed version of the Local Rules (“Proposed Local Rules”), that it recognizes a patent claimant’s ability to exploit the Local Rules in order to improperly broaden a patent’s literal scope. In the Proposed Local Rules, the patent claimant would file its “Final Infringement Contentions” fifty days after it received the disclosures related to the accused instrumentality.<sup>65</sup> These Final Infringement Contentions allowed the patent claimant to supplement its disclosure of asserted claims, claim charts, and preliminary infringement contentions in light of the accused infringer’s disclosures related to the accused instrumentality.<sup>66</sup> If, as this Note asserts, access to the accused instrumentality raises the specter of patent misuse, then the Proposed Local Rules had no provisions to ensure the propriety of these supplemented disclosures. Under this Note’s theory, a supplementation in

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62. This inhibits the Constitutional purpose of the patent system to encourage innovation through incremental technological advancements. See discussion *infra* Section III.A.

63. See *supra* note 16 and accompanying text.

64. Alan H. MacPherson, *Discovery and Motion Practice in Patent Litigation*, 349 PLI/PAT 273, 280-81 (1992) (emphasis added) (citations omitted) (quoting 3 ROBERT A. WHITE, PATENT LITIGATION: PROCEDURE & TACTICS § 6.02[1], at 6-11 (1992)).

65. Proposed N.D. Cal. L.R. 3-4 (Sept. 18, 2000).

66. *Id.*

the Final Infringement Contentions is proper where the patent claimant seeks to add infringement contentions that it could not have fathomed before reviewing accused instrumentality disclosures. That same supplementation is improper, however, if the patent claimant seeks to use the insights it gained from the accused instrumentality disclosures to add strained, litigation-inspired infringement contentions that expand the scope of the patent beyond the literal language of the claims and the marginal additional scope provided by the doctrine of equivalents.<sup>67</sup>

In the final version of the 2001 Local Rules, perhaps realizing that a patent claimant could use the Proposed Local Rules to improperly expand the patent's literal scope, the Northern District added Local Rule 3-6, which imposes a good faith requirement on the patent claimant. Local Rule 3-6 makes the preliminary infringement contentions final unless the patent claimant believes "*in good faith*" that the court's claim construction ruling or the disclosures related to the accused instrumentality require an amendment to the preliminary contentions.<sup>68</sup> It appears, then, that the Northern District recognized the patent claimant's opportunity to improperly broaden its asserted claim scope, and inserted the good faith requirement as a cure. But this good faith requirement is too vague to discourage a patent claimant from attempting to expand the literal claim scope. Rather than requiring a mere a good faith belief that an amendment is in order, the Local Rules should explicitly require that the patent claimant have a good faith belief that its amendments do not improperly expand the patent's literal scope. The Local Rules should affirmatively indicate that where a court finds bad faith, it shall find the patent claimant guilty of patent misuse<sup>69</sup> and may certify the case as exceptional under 35 U.S.C. § 285,<sup>70</sup> which would entitle the accused infringer to attorney's fees.

The Local Rules exacerbate this incentive for bad faith claim construction amendments through an evidentiary exclusion that deprives a factfinder of highly probative evidence of patent misuse. Local Rule

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67. See *supra* notes 62-63 and accompanying text; *infra* notes 75-76 and accompanying text.

68. N.D. Cal. L.R., *supra* note 3, at 3-6 (emphasis added). Final Contentions: Each party's "Preliminary Infringement Contentions" and "Preliminary Invalidity Contentions" shall be deemed to be that party's final contentions, except as set forth below.

(a) If a party claiming patent infringement believes in good faith that (1) the Court's Claim Construction Ruling or (2) the documents produced pursuant to Patent L.R. 3-4 so requires, not later than 30 days after service by the Court of its Claim Construction Ruling, that party may serve "Final Infringement Contentions" without leave of court that amend its "Preliminary Infringement Contentions" with respect to the information required by Patent L.R. 3-1(c) and (d). . . .

69. A patent claimant may be liable under 28 U.S.C. § 1927 for multiplying the proceedings in the case "unreasonably and vexatiously." See *Automated Bus. Cos., Inc. v. NEC Am., Inc.*, No. 4:98-CV-619-A, 1999 U.S. Dist. LEXIS 20962, at \*11 (N.D. Tx. Feb. 8, 1999).

70. See *Automated Bus. Cos.*, 1999 U.S. Dist. LEXIS 20962, at \*12.

2-4 precludes admissibility of the “proposed terms and claim elements for construction” and “preliminary claim construction statement” unless admitted in connection with motions seeking a modification to the Local Rule’s timetable.<sup>71</sup> This evidentiary exclusion hinders the accused infringer’s ability to show that the patent claimant has attempted to expand the patent’s literal scope and completely deprives the accused infringer of the ability to show bad faith in the patent claimant’s Local Rule 3-6 amendments to its preliminary infringement contentions. Absent the exclusion, an accused infringer could show the patent claimant’s improper patent expansion or bad faith by introducing evidence that the patent claimant has asserted a broader claim construction in its final infringement contentions than it asserted in an earlier claim construction. Such evidence would be especially probative because the broader claim construction follows the disclosures related to the accused instrumentality.

The Northern District has shown, through previous amendments to proposed versions of the Local Rules, that it recognizes the potential for improper claim scope expansion during claim construction. Yet the current version of the Local Rules still prescribes procedures that give patent claimants an incentive to broaden the literal scope of their patent claims during litigation. These procedures give patent claimants the opportunity to tailor their claim construction contentions to fit the accused instrumentality and simultaneously limit the accused infringer’s ability to admit evidence of this type of patent misuse.

### B. *Meeting the Need for Disclosure While Avoiding Misuse*

A patent claimant may have legitimate reasons for seeking early disclosure of the accused instrumentality. Prior to bringing suit, the patent claimant may be unable to obtain a device that it has a good faith belief infringes its patent because the device is prohibitively expensive or because the accused infringer will not sell such a device to its known competitor. In other cases, the patent claimant may hold a process patent and have only a good faith belief that the accused infringer is manufacturing products using the patented method or process. In such cases, the patent claimant may have little actual knowledge of infringement because the accused infringer is maintaining its manufacturing method or process as a trade secret. In these situations, a patent claimant requires access to the allegedly infringing instrumentality before it can determine whether and how its patent is infringed.

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71. N.D. Cal. L.R., *supra* note 3, at 2-4 (“[Proposed Terms and Claim Elements for Construction, Preliminary Claim Constructions, and Preliminary Identifications of Extrinsic Evidence] are not admissible for any purpose other than in connection with motions seeking an extension or modification of the time periods within which actions contemplated by the Patent Local Rules must be taken.”).



Section I.B demonstrates that the Local Rule procedures can meet the patent claimant's need for early discovery of information related to the accused instrumentality while still limiting the potential for patent misuse.

FRCP 11 requires a plaintiff to develop enough facts to support a cause of action before filing a complaint.<sup>72</sup> In the patent infringement context, Rule 11 prohibits a patentee from filing a patent infringement suit in hopes that later discovery will uncover proof of infringement.<sup>73</sup> Thus, before filing a complaint, the patent claimant must first satisfy itself that one or more of its patent claims were infringed. That infringement determination will entail the two-step process of first construing the claims and then applying the claims to the accused instrumentality.<sup>74</sup> Hence, in order to satisfy Rule 11, the patent claimant must have at least some contentions regarding the scope of its patent and at least some intimation of the accused instrumentality's composition.

Although discovery may later be necessary to determine precisely which, if any, of the patent claims read on the accused instrumentality, the Local Rules should require that the patent claimant first disclose at least the initial claim construction for the claims it presumed to be infringed when it filed the complaint. An absence of specific information regarding the accused instrumentality does not relieve the patentee or the court of its responsibility to construe the patent claims without reference to the accused instrumentality;<sup>75</sup> nor does such an

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72. FED. R. CIV. P. 11(b). Representations to Court:

By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, —

- (1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation; the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
- (2) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (3) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.

*Id.*

73. See *Automated Bus. Cos.*, 1999 U.S. Dist. LEXIS 20962, at \*9; see also *infra* Section II.A.

74. See *Automated Bus. Cos.*, 1999 U.S. Dist. LEXIS 20962, at \*9; see also *infra* Section II.A.

75. *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998) (stating that the patentee "argues that 'degradable' must first be construed based on the 266 patent documents, without reference to the accused device" (internal citations omitted)); *Young Dental Mfg. Co. v. Q3 Special Prods., Inc.*, 112 F.3d 1137, 1141 (Fed. Cir. 1997) ("[T]he claim scope is determined without regard for the accused device."); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1580 (Fed. Cir. 1991) ("In 'claim con-

absence render them incapable of doing so. A patent claimant asserting that it is unable to proffer an initial claim construction at the outset of litigation could not possibly have satisfied the requirements of Rule 11. After receiving the patent claimant's initial claim construction, the accused infringer can subsequently disclose information and documentation concerning the accused instrumentality.<sup>76</sup> This disclosure will give the patent claimant the information it needs either to further shape its infringement contentions or to drop the suit after finding that there is no infringement under the claim scope it originally asserted.

This scheme will require the patent claimant to divulge its initial claim construction at the outset of litigation. The patent claimant can later alter its proffered claim construction as it gains more information concerning the accused instrumentality. But such a scheme will discourage patent misuse only if the patent claimant is bound in some manner by the claim scope it initially asserts. The Local Rules should inhibit the patent claimant from later asserting a claim construction that expands the scope of a claim beyond any construction that the patent claimant has already proffered. In order to prevent a patent claimant from making an initial claim construction contention that is overbroad, the Local Rules should also inhibit the patent claimant from later asserting a narrower claim scope in order to avoid a finding that the patent is invalid in light of the prior art. After a patent claimant has gained access to disclosures related to the accused instrumentality, the only claim construction adjustments the Local Rules should allow are those that will either proffer a construction of claim terms that were not previously addressed or assert that a different or additional set of claims apply to the accused instrumentality. The Local

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struction' the words of the claims are construed independent of the accused product, in light of the specification, the prosecution history, and the prior art. Of course the particular accused product (or process) is kept in mind, for it is efficient to focus on the construction of only the disputed elements or limitations of the claims. However, the construction of claims is simply a way of elaborating the normally terse claim language: in order to understand and explain, but not to change, the scope of the claims.'"). *Contra* ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT § 5.6(g) at 230 n. 354 (4th ed. 1998) (arguing that in certain circumstances claim construction cannot proceed without reference to the accused instrumentality). Note that in *Multiform* the patentee, rather than the accused infringer, was arguing for a claim construction without reference to the accused instrumentality. The district court below had first looked to the specification and prosecution history before reaching a conclusion on the proper definition of a claim term. The Federal Circuit approved of the district court's decision to state its final definition of the disputed term in light of the accused instrumentality as a mere "expedient" to efficient resolution of the issue in litigation. 133 F.3d at 1477-78.

76. When a patent claimant suffers from a dearth of pre-litigation information regarding infringement, a court could require accused instrumentality disclosures prior to the initial claim construction only to the extent necessary to allow the patent claimant to determine which claim elements are arguably present in the accused instrumentality. The patent claimant then need only construe the claim terms describing those allegedly infringed claim elements.

Rules should only allow the patentee to construe claim terms it neglected to construe in its initial disclosure if the patent claimant first convinces the court that it could not reasonably have known the claim or claim term would be in issue prior to examining disclosures related to the accused instrumentality. Finally, the Local Rules should allow an accused infringer to use a change in claim scope as evidence of patent misuse or bad faith by the patentee in making its Local Rule 3-6 claim construction amendments or to show cause why the court should certify the case as exceptional under 35 U.S.C § 285.

This Note does not assert that a court should entirely prohibit early discovery of all information concerning the accused instrumentality. Nor does it assert that a court should require a patent claimant to produce a final and complete claim construction statement before the patent claimant has access to any information concerning the accused instrumentality.<sup>77</sup> Rather, this Note asserts that a court should force the patent claimant to disclose the preliminary claim construction that the patent claimant must have developed in order to satisfy Rule 11, and that a court should give binding effect to the scope of that early preliminary construction. Furthermore, a court should allow accused infringers the opportunity to show patent misuse by allowing offering evidence that a patent claimant has proffered a final claim construction statement that differs in scope from its preliminary claim construction contentions.

### C. *Extrinsic Evidence Under the Local Rules*

After the PTO has published an issued patent or a pending patent application, a member of the public may obtain that published disclosure in order to determine the scope of the patent and design a competing device that avoids infringement. Extrinsic evidence<sup>78</sup> is not available to third parties as they seek to make this determination. The Federal Courts have shown that they are loathe to allow a patent claimant to rely on extrinsic evidence to establish the scope of a patent because a claim construction based on evidence unavailable in the public record would undermine the public notice function of the patent disclosure.<sup>79</sup> A quote from the Federal Circuit is illustrative:

In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is im-

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77. Although in certain circumstances that may be desirable, such as when there are particular concerns that discovery will lead to the disclosure of the accused infringers trade secrets or where it would have been particularly easy for the patent claimant to gain access to the required information without resorting to the discovery process.

78. See *supra* notes 28-30 and accompanying text.

79. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996); see also *Rambus, Inc. v. Infineon Techs. AG*, No. 3:00cv524, 2001 U.S. Dist. LEXIS 10990, at \*12-19 (E.D. Va. 2001).

proper. The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention.<sup>80</sup>

This Section will first outline the Local Rules' procedure by which the parties submit claim construction related extrinsic evidence. This Section will then demonstrate that this procedure is antithetical to the Federal Circuit's hostility to claim construction determinations that rely too heavily on extrinsic evidence.

Under the Local Rules' procedure, the parties must together file a "Joint Claim Construction Statement" within the 115 days following the initial case management conference.<sup>81</sup> This statement contains, *inter alia*, the claim constructions on which both parties agree,<sup>82</sup> each party's construction of any claim terms on which the parties disagree, and an enumeration of all evidence, both intrinsic and extrinsic,<sup>83</sup> that each party intends to rely on in support of its asserted claim construction.<sup>84</sup> By day 145, the parties must have completed all discovery related to claim construction,<sup>85</sup> and by day 155, the patent claimant must serve and file an opening brief along with "any evidence" supporting its claim construction.<sup>86</sup> If the parties or the Court believe a claim construction hearing is necessary, the court will subsequently hold a *Markman* hearing sometime between 176 and 190 days from the initial case management conference.<sup>87</sup> The Joint Claim Construction State-

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80. *Vitronics*, 90 F.3d at 1583.

81. N.D. Cal. L.R., *supra* note 3, at 4-3.

82. *Id.* at 4-3(a) (stating that the joint statement shall contain "[t]he construction of those claim terms, phrases, or clauses on which the parties agree").

83. *See supra* notes 28-30 and accompanying text.

84. N.D. Cal. L.R., *supra* note 3, at 4-3(b) (requiring that the joint statement shall contain "[e]ach party's proposed construction of each disputed claim term, phrase, or clause, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction of the claim or to oppose any other party's proposed construction of the claim, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses.").

85. *Id.* at 4-4 ("Not later than 30 days after service and filing of the Joint Claim Construction and Prehearing Statement, the parties shall complete all discovery relating to claim construction. . .").

86. *Id.* at 4-5(a) ("Not later than 45 days after serving and filing the Joint Claim Construction and Prehearing Statement, the party claiming patent infringement shall serve and file an opening brief and any evidence supporting its claim construction.").

87. *Id.* at 4-6 ("Subject to the convenience of the Court's calendar, two weeks following submission of the reply brief specified in Patent L.R. 4-5(c), the Court shall conduct a Claim Construction Hearing, to the extent the parties or the Court believe a hearing is necessary for construction of the claims at issue.").

ment and evidence supporting the opening brief amount to an open call for extrinsic evidence supporting the patent claimant's claim construction. To the court's chagrin, the patent claimant may attempt to use this extrinsic evidence at the ensuing *Markman* hearing to broaden the scope of the patent beyond the clear limits imposed by the intrinsic evidence.<sup>88</sup>

These procedures enable the patent claimant and the court to use extrinsic evidence, including the accused instrumentality, during claim construction in a manner that is contrary to Federal Circuit precedent. In *Vitronics Corp. v. Conceptronics, Inc.*, the Federal Circuit ruled that it was improper for a court to rely on extrinsic evidence during claim construction when the intrinsic evidence alone could resolve any ambiguity present in a disputed claim term.<sup>89</sup> The court noted that the specification is the single best guide to the meaning of a disputed term, followed closely by the prosecution history.<sup>90</sup>

The Federal Circuit subsequently limited the *Vitronics* decision in *Pitney Bowes, Inc. v. Hewlett Packard Co.*,<sup>91</sup> where the court stated, "*Vitronics* merely warned courts not to rely on extrinsic evidence in claim construction to contradict the meaning of claims discernible from thoughtful examination of . . . the intrinsic evidence."<sup>92</sup> As a result, the *Pitney Bowes* court found that "it is entirely appropriate . . . for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the [intrinsic evidence] is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field."<sup>93</sup>

Two factors serve to narrow the *Pitney Bowes* court's discussion of the proper use of extrinsic evidence during claim construction. First, this language in the *Pitney Bowes* decision was merely a reaction to the Supreme Court's opinion in *Kumho Tire Co. v. Carmichael*,<sup>94</sup> where the Court stated that "[t]he trial judge must have considerable leeway in deciding in a particular case how to go about determining

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88. *Rambus, Inc. v. Infineon Techs. AG*, No. 3:00cv524, 2001 U.S. Dist. LEXIS 10990, at \*12-19 (E.D. Va. 2001) (finding "disturbing" the patent claimant's tendency to "distance its current constructions from what the inventors said in making the claims and explaining the inventions in the specification, and, in so doing, to use the claim construction process to broaden claims rather clearly not made in the intrinsic evidence.").

89. 90 F.3d 1576, 1583 (Fed. Cir. 1996) ("In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper.").

90. *Id.* at 1582.

91. 182 F.3d 1298 (Fed. Cir. 1999).

92. *Id.* at 1308.

93. *Id.* at 1309 (alteration in original).

94. 526 U.S. 137 (1999).

whether particular *expert testimony* is reliable.”<sup>95</sup> Hence, despite its expansive language, the *Pitney Bowes* analysis regarding extrinsic evidence was particularly directed at expert testimony and has little relevance in determining the propriety of claim construction with reference to an accused instrumentality or any other extrinsic evidence.

Second, the district court judge in *Pitney Bowes* had not *relied* on extrinsic evidence to construe the claims.<sup>96</sup> Instead, it had “*referred only briefly* to the extrinsic evidence, which it quite properly examined, in discussing a collateral argument made by Pitney Bowes.”<sup>97</sup> On appeal of the trial court’s decision, the Federal Circuit’s analysis focused primarily on allowing the district court judge the discretion to examine expert testimony as a means to shore up its knowledge in the relevant technical field and to determine the meaning of a term according to one “skilled in the art” as the patent statutes require.<sup>98</sup> Thus, the Federal Circuit never expressly sanctioned a factfinder’s reliance on extrinsic evidence for claim construction. It only approved reference to extrinsic evidence in order to inform the factfinder of the content and level of skill in the relevant technical art.

So in essence, *Pitney Bowes* merely encourages courts to exercise discretion in receiving extrinsic evidence, and particularly expert testimony, for three purposes: (1) to supply the proper technological context in which to interpret the claims; (2) to ensure that the claim construction it arrives at conforms to the understanding of one skilled in the art; and (3) to help the trial court understand the patent process itself.<sup>99</sup> Therefore, the Local Rules should affirmatively limit the parties’ ability to submit extrinsic evidence to the court by requiring that the parties have a good faith belief that each submission is solely for the purpose of satisfying one of the three *Pitney Bowes* purposes. Moreover, for each piece of extrinsic evidence submitted, the Local Rules should require that the submitting party specifically indicate which of the *Pitney Bowes* purposes that evidence is meant to serve.

Although the Local Rules should allow the parties to submit extrinsic evidence in the form of expert testimony, inventor testimony, dictionaries, technical treatises, and articles to satisfy the *Pitney Bowes* purposes,<sup>100</sup> the accused instrumentality, which is also extrinsic evidence, should never be admitted as evidence during claim construc-

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95. *Kumho Tire*, 526 U.S. at 152 (emphasis added) *discussed in Pitney Bowes*, 182 F.3d at 1308 n.2.

96. *Pitney Bowes*, 182 F.3d at 1309 (“[W]e do not doubt the district court’s express statements that it did not rely on extrinsic evidence in its claim construction.”).

97. *Id.* (emphasis added).

98. See 35 U.S.C. § 112 (1994).

99. *Pitney Bowes*, 182 F.3d at 1314 (Rader, J., additional views).

100. *Id.* at 1308.

tion. Putting the substantial prejudice to the accused infringer and the Federal Circuit's clear directives to exclude the accused instrumentality from claim construction aside,<sup>101</sup> the Local Rules should also exclude the accused instrumentality from evidence during claim construction because it simply fails to serve the *Pitney Bowes* purposes. First, the "proper technological context in which to understand the claims" cannot be the context of the accused instrumentality. Such a definition would cause the court to expand the patent scope to cover the accused instrumentality as a matter of course. Rather, it means the technological context of the invention and the background and scientific field of the patent in suit.<sup>102</sup> Second, technical dictionaries and prior art documents are sufficient to evidence "the understanding of one skilled in the art" to which the patent appertains. In the rare case that they are not,<sup>103</sup> testimony by the inventor and other experts knowledgeable in the field would be the logical and linguistically proper means to evidence the understanding of one skilled in the art. The accused instrumentality is a poor guide to the semantics of the patent claims because until and unless it is found to infringe, it may be a separate invention — an expansion on, or alternative to, the level of understanding common in the pertinent technical field. A person skilled in the art is "presumed to be one who thinks along the lines of conventional wisdom in the art and is not one who undertakes to innovate."<sup>104</sup> If the accused instrumentality were allowed to guide the court in its determination of the knowledge of one skilled in the art, infringement would be a foregone conclusion because the court would first have to presume that the creator of the accused instrumentality was not "one who undertakes to innovate," but instead someone who undertakes to copy or merely use the "conventional wisdom."<sup>105</sup> Finally, there is simply no reasonable basis for any assertion that the

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101. See *supra* notes 62-63, 75 and accompanying text.

102. *Anderson v. Int'l Eng'g & Mfg., Inc.*, 160 F.3d 1345, 1348-49 (Fed. Cir. 1998) ("Dictionary definitions of ordinary words are rarely dispositive of their meaning in a technological context. A word describing patented technology takes its definition from the context in which it was used by the inventor.").

103. *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996) (stating that instances where ambiguity cannot be resolved through the use of intrinsic evidence alone will rarely, if ever, occur).

104. *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 454 (Fed. Cir. 1985); see also *HARMON*, *supra* note 7, § 4.3(a) 129. *But see* *Gould v. Hellwarth*, 472 F.2d 1383 (C.C.P.A. 1973) (explaining that one skilled in the art is generally a highly trained person knowledgeable in the field and aware of the relevant prior art).

105. In addition, infringement under the doctrine of equivalents is partially focused on known interchangeability — whether one skilled in the art would know to substitute a claim element for an alternative element used in the accused instrumentality. See *Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1465 (Fed. Cir. 1998) ("[K]nown interchangeability is often synonymous with equivalence."). If the accused instrumentality dictated the knowledge of one skilled in the art, then elements of the accused instrumentality would by definition be interchangeable.

accused instrumentality could inform the court of intricacies of the patent application process. After all, the accused instrumentality may never have been the subject of a patent application.

Due to the accused instrumentality's lack of utility as extrinsic evidence, the Local Rules should allow judges the discretion to limit discovery of the accused instrumentality prior to claim construction. Although the Local Rules' mandatory disclosure procedures do not appear to allow an accused infringer to seek a limiting order that excludes the accused instrumentality from discovery prior to a *Markman* hearing,<sup>106</sup> the Federal Circuit has expressly held that such limiting orders may be proper. In *Vivid Technologies v. American Science & Engineering Inc.*, the district court judge required the early resolution of claim construction issues without allowing discovery concerning the accused instrumentalities.<sup>107</sup> In reviewing the decision, the Federal Circuit held that it is within the discretion of a district court to deny a patent claimant discovery of the accused instrumentality prior to claim construction.<sup>108</sup> Consequently, a court may properly exclude an accused instrumentality from evidence prior to a *Markman* hearing and an accused infringer may properly seek a limiting order that excludes the accused instrumentality from discovery.

A synthesis of the *Vitronics*, *Pitney Bowes*, and *Vivid Technologies* cases reveals that a court should postpone the admission and discovery of any extrinsic evidence until the court finds as a preliminary matter that it is unable to resolve the ambiguity of a claim term by examining the intrinsic evidence alone. Hence, the Local Rules should explicitly require the parties first to limit the body of evidence to intrinsic material and then to submit only that extrinsic evidence that will serve the *Pitney Bowes* purposes. In the extremely rare occasion that a court finds itself unable to determine the scope and meaning of a claim term using intrinsic evidence alone,<sup>109</sup> it may expand its examination of extrinsic evidence to prior art documents, dictionaries, and possibly expert testimony, but never to the accused instrumentality.<sup>110</sup>

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106. See N.D. Cal. L.R., *supra* note 3, at 2-5. The rule does not include the accused instrumentality among the enumerated categories of potentially objectionable discovery requests.

107. 997 F. Supp 93, 95 (D. Mass. 1997), *aff'd in relevant part, vacated in part and remanded*, 200 F.3d 795 (Fed. Cir. 1999).

108. 200 F.3d at 804.

109. *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1585 (Fed. Cir. 1996) (stating that instances where ambiguity cannot be resolved through the use of intrinsic evidence alone will rarely, if ever, occur).

110. *Id.* ("Even in those rare instances [where extrinsic evidence is needed], prior art documents and dictionaries, although to a lesser extent, are more objective and reliable guides. Unlike expert testimony, these sources are accessible to the public in advance of litigation.").



## II. SUPPORT FROM THE FEDERAL RULES OF CIVIL PROCEDURE

To this point, this Note has asserted that the Local Rules' mandatory disclosure procedures promote improper patent use, primarily by requiring the accused infringer to produce accused instrumentality disclosures before requiring the patent claimant to construe the patent claims. This Note has also asserted that the Local Rules promote improper patent use by failing to impose strict limitations on the submission and examination of extrinsic evidence prior to and during claim construction hearings. Part II will demonstrate that the Local Rules' mandatory disclosure procedures are not aligned with the FRCP, which tend to favor early disclosure of the patent claimant's claim construction. Section II.A shows that because FRCP 11's pre-filing investigation requirement forces the patent claimant to form a claim construction prior to filing suit, the Local Rules should ordinarily require the patent claimant to disclose a preliminary claim construction with its initial disclosures. Section II.B asserts that trial judges should often compel early answers to FRCP 33(c) interrogatories seeking a patent claimant's claim construction contentions.

### A. Rule 11 Pre-filing Investigation

In *View Engineering v. Robotic Vision Systems*, the Federal Circuit held that Rule 11 requires that a law firm "at a bare minimum, apply the claims of each and every patent that is being brought into the lawsuit to an accused device and conclude that there is a reasonable basis for a finding of infringement of at least one claim of each patent so asserted."<sup>111</sup> Essentially, *View Engineering* requires the patent claimant to perform an "infringement analysis"<sup>112</sup> before filing suit where it at least: (1) determines the meaning and scope of each term of one or more patent claims, i.e. construe the claims, and (2) concludes that one or more of the claims so construed reads on the accused instrumentality.<sup>113</sup> Thus, a patent claimant could not have a reasonable belief that an accused instrumentality infringes without first having construed and applied the claims.

The Local Rules' mandatory disclosure procedures do not comport with this requirement. Local Rule 2-5 allows a patent claimant to object to discovery requests seeking to elicit either its claim construction position or a comparison of the asserted claims to the accused instru-

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111. 208 F.3d 981, 986 (Fed. Cir. 2000).

112. *Id.*

113. See *supra* notes 21-32 and accompanying text; see also *Judin v. United States*, 110 F.3d 780, 784-85 (Fed. Cir. 1997) (noting that "[d]etermining infringement . . . requires that the patent claims be interpreted and that the claims be found to read on the accused devices" and imposing Rule 11 sanctions on a patent claimant's attorney for failing to perform these steps prior to filing suit).

mentality on the grounds that the requests are premature in light of the timetable set up by the Local Rules.<sup>114</sup> This timetable currently allows the patent claimant to delay such claim construction assertions until after it has received accused instrumentality related disclosures.<sup>115</sup> But in order to satisfy the stringent requirement of *View Engineering*, the patent claimant must have already formed at least a preliminary claim construction before filing its complaint. Therefore, it does not need further discovery of all information related to the accused instrumentality before it discloses at least an initial claim construction statement.

To comport with Rule 11, the Local Rule 3-1 Day 10<sup>116</sup> disclosure could also require that the patent claimant disclose a preliminary set of proposed claim terms for construction and a preliminary construction of those terms along with its preliminary infringement contentions and claim chart. But given the complex nature of patent infringement litigation it is difficult to maintain a per se rule requiring early disclosure of the patent claimant's claim construction along with its infringement contentions. In fact, the ABA/IPL criticized the Local Rules for this sort of stringent control of the discovery process.<sup>117</sup> Instead, the Northern District of California should adjust the Local Rules so that patent claimants no longer may refuse to provide early answers to claim construction related discovery requests as a matter of course.

### B. *Rule 33(c) Construction Interrogatories*

A proper adjustment would allow judges to give more serious consideration to compelling early answers to an accused infringer's contention interrogatories that seek the patent claimant's claim construction assertions ("construction interrogatories") where such interrogatories are appropriate. Although Rule 33(c)<sup>118</sup> on its face grants a judge the discretion to delay a response to contention inter-

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114. N.D. Cal. L.R. 2-5 ("A party may object, however, to responding to the following categories of discovery requests . . . on the ground[] that they are premature in light of the timetable provided in the Patent Local Rules . . . (a) Requests seeking to elicit a party's claim construction position; (b) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, or other instrumentality. . . .").

115. See *supra* notes 57-61 and accompanying text (explaining that the Local Rules require accused instrumentality related disclosures on day 55, while delaying claim construction assertions until day 85 since the initial case management conference).

116. See *supra* note 56.

117. McCann, *supra* note 2, at 293 ("[I]t is unlikely that a clear majority of IPL Section members or a significant number of district courts would agree to such detailed discovery procedures.").

118. FED. R. CIV. P. 33(c).

rogatories until the end of discovery or later,<sup>119</sup> the Northern District provided guidance as to the scope of this discretion in *In re Convergent Technologies*.<sup>120</sup> In *Convergent*, the court favored delaying answers to contention interrogatories until the close of discovery<sup>121</sup> but set guidelines for determining when earlier answers might be necessary. Applied to patent infringement litigation, these guidelines indicate that construction interrogatories deserve and require an early response.

The *Convergent* court expressly recognized the need for early answers to at least some contention interrogatories in certain factual settings.<sup>122</sup> The court concluded that Rule 33(c) and the Advisory Committee Notes accompanying the 1970 amendments to the FRCP did not create a formal presumption in favor of delaying answers to contention interrogatories until the end of discovery.<sup>123</sup> The court stated that it would not preclude entirely the early use of contention interrogatories, but would place a burden of justification on the serving party:<sup>124</sup> (1) the party must handcraft a limited set of questions; and (2) the party must show that there is good reason to believe the answers will contribute meaningfully to clarifying the issues in the case, narrowing the scope of the dispute, or setting up early settlement discussions, or that such answers will likely expose a substantial bases for a motion under either FRCP 11 or 56.<sup>125</sup>

Assuming the accused infringer handcrafts its construction interrogatories, they will by nature meet the *Convergent* requirements.

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119. "An interrogatory otherwise proper is not necessarily objectionable merely because an answer to the interrogatory involves an opinion or contention that relates to fact or the application of law to fact, but the court may order that such an interrogatory need not be answered until after designated discovery has been completed or until a pre-trial conference or other later time." FED. R. CIV. P. 33(c) ¶2 (emphasis added).

120. 108 F.R.D. 328 (N.D. Cal. 1985) (providing a full treatment of contention interrogatories and timing thereof).

121. *Id.* at 334 ("While [Rule 33(c) and the Advisory Committee Notes] probably do not go so far as to create a formal presumption in favor of not compelling responses to contention interrogatories until the end of the discovery period, they certainly invite courts to give active consideration to the wisdom of ordering such a postponement of answers to these kinds of interrogatories.").

122. *Id.* at 336 ("[T]here may be situations in which . . . important interests would be advanced if answers were provided early to at least some contention interrogatories.").

123. See *supra* note 121.

124. *Id.* at 338 ("[T]his court believes that the wisest course is not to preclude entirely the early use of contention interrogatories, but to place a burden of justification on a party who seeks answers to these kinds of questions before substantial documentary or testimonial discovery has been completed.").

125. *Id.* at 338-39; see also *Brown v. United States*, 179 F.R.D. 101 (W.D.N.Y. 1998) (contention interrogatories are often deferred until the end of discovery unless the requesting party can show "how an earlier response assists the goals of discovery such as exposing a substantial basis for a motion under Fed. R. Civ. P. 11 and 56."); *Braun Med., Inc. v. Abbott Labs.*, 155 F.R.D. 525, 527 (E.D. Pa. 1994)

First, if the patent claimant has satisfied the Rule 11 pre-filing investigation requirement set forth in *View Engineering*, then the patent claimant must have already engaged in claim construction and application of the claims to the accused instrumentality.<sup>126</sup> Hence, the patent claimant does not need additional discovery in order to provide answers to contention interrogatories on this subject. An accused infringer may then argue that the patent claimant must either provide answers to construction interrogatories or show cause why the court should not dismiss the case and grant a motion for Rule 11 sanctions.<sup>127</sup> Second, if the court will not allow the patentee to expand the scope of an earlier asserted claim construction,<sup>128</sup> then answers to claim construction interrogatories will establish the outermost metes and bounds of the patent, which will narrow the issues for trial and enable the accused infringer to shape its noninfringement arguments.<sup>129</sup> Finally, a well-reasoned response to such an interrogatory

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126. See *supra* Section II.A.

127. Rule 11(c) allows a court to impose sanctions on a party and its attorneys for not performing a reasonable pre-filing inquiry to ensure that, inter alia, the complaint is not being maintained for any improper purpose, that the claims are warranted, and that the allegations have evidentiary support. Fed. R. Civ. P. 11(c).

128. The procedural scheme propounded in Part I *supra*.

129. Courts, commentators, and practitioners have often asserted that resolving claim construction issues prior to trial will narrow the issues in the subsequent litigation. See, e.g., *Embrex, Inc. v. Service Eng'g Corp.*, 1998 U.S. Dist. LEXIS 15143, at \*6 (E.D.N.C. June 22, 1998) ("Defendants assert that a pretrial construction of the claims by the court will significantly narrow the issues for trial. . . ."); *Mediacom Corp. v. Rates Tech., Inc.*, 4 F. Supp. 2d 17, 22 (D. Mass. 1998) ("Questions regarding the construction of patent claims can now safely be addressed in many circumstances prior to the completion of fact discovery, and certainly before trial. In this case, the Court determined that an early *Markman* hearing was a salutary mechanism for narrowing the disputed issues and securing prompt disposition of those matters as to which there were no factual disputes."); Mark L. Austrian & Shaun Mohler, *Timing Is Everything in Patent Litigation — Fulfilling the Promise of Markman*, 9 FED. CIR. B.J. 227, 230 (1999) (asserting that early resolution of claim construction contentions "narrow[s] the issues for both pre-trial and trial proceedings."); Kimberly M. Ruch-Alegant, Note, *Markman: In Light of De Novo Review, Parties to Patent Infringement Litigation Should Consider the ADR Option*, 16 TEMP. ENVTL. L. & TECH. J. 307, 308 (1998) (resolving claim construction pretrial through alternative dispute resolution would narrow the issues for trial and save the parties' time and money); cf. *Elf Atochem N. Am., Inc. v. Libbey-Owens-Ford Co.*, 894 F. Supp. 844, 857 (D. Del. 1995) (noting the efficiency of "early resolution of the claim construction issue."). Early answers to claim construction related interrogatories both narrow and clarify the issues for trial because claim construction is often the central issue in an infringement suit and often takes on case-dispositive significance. See, e.g., *EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998) ("resolution of most of a complex infringement case with no more trial than a two-day [claim construction] hearing."); Adamo, *supra* note 5, at 602 (explaining that claim construction is the "focal point" of infringement litigation); Robert C. Weiss et al., *MARKMAN PRACTICE, PROCEDURE AND TACTICS*, PLI Order No. G0-00BN Patent Litigation 2000, 619 PLI/Pat 117 (Oct. 2000) ("In view of the decisions in *Markman v. Westview Instruments, Inc.*, and the more recent decisions of the Federal Circuit, the issue of claim construction has taken on paramount significance, often of case dispositive nature. Indeed, the Federal Circuit characterized claim construction as 'the central issue of nearly every patent appeal.'") (quoting *Minco, Inc. v. Combustion Eng'g, Inc.*, 95 F.3d 1109, 1114 (Fed. Cir. 1996)).

may convince the infringer of the strength of the patent claimant's case and hence encourage settlement of the dispute.

The Northern District should harmonize the Local Rules with the FRCP by recognizing the patent claimant's duties under Rule 11 and allowing the use of contention interrogatories in a manner consistent with Rule 33(c). Contention interrogatories seeking a patent claimant's claim constructions need not be delayed until the patent claimant has had adequate opportunity to examine the accused instrumentality because it is well settled law that the accused instrumentality is neither necessary to formulate a claim construction nor properly relied on for that purpose.<sup>130</sup> Additionally, a court need not delay answers to a handcrafted set of contention interrogatories seeking a patentee's claim construction because such interrogatories meet the requirements of *Convergent*: narrowing and clarifying the issues for trial, potentially encouraging settlement discussions, and potentially exposing a basis for a motion seeking summary judgment under Rule 56 or sanctions under Rule 11.

### III. POLICY PERSPECTIVES

This Note has previously explained how the Local Rules' procedures allow a patent claimant to expand the scope of its patent during litigation. This Section points out how such an extended monopoly right threatens both the constitutional foundation of patent law and the public policies that shape the patent system. Section III.A demonstrates that patent law policy does not favor the patentee and nor should patent litigation procedures. Section III.B discusses the role of the patent disclosures as a public record of the invention and explains how the improper use of extrinsic evidence subverts this role.

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130. See, e.g., *View Eng'g, Inc. v. Robotic Sys.*, 208 F.3d 981, 986 (Fed. Cir. 2000) (interpreting Rule 11 to require at least a preliminary claim construction before the suit is even filed); *Young Dental Mfg. Co. v. Q3 Specialty Prods., Inc.*, 112 F.3d 1137, 1141 (Fed. Cir. 1997) (stating that "the claim scope is determined without regard for the accused device"); *Jurgens v. McKay*, 927 F.2d 1552, 1560 (Fed. Cir. 1991) (same); *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1580 (Fed. Cir. 1991) ("in 'claim construction' the words of the claims are construed independent of the accused product, in light of the specification, the prosecution history, and the prior art"). *But cf.* *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1580 (Fed. Cir. 1991) ("Of course the particular accused product (or process) is kept in mind, for it is efficient to focus on the construction of only the disputed elements or limitations of the claims. However, the construction of claims is simply a way of elaborating the normally terse claim language: in order to understand and explain, but not to change, the scope of the claims."). The *Scripps Clinic* analysis comports with this Note's view that the Local Rules may properly allow early discovery of the accused instrumentality only to the extent necessary to determine which claim terms are in issue. See *supra* note 76 and accompanying text.

### A. *Symmetry in the Law, Asymmetry in the Courts*

A patent owner is not favored under the law and consequently should not be favored during patent infringement litigation. The social value of patent law does not lie merely in its ability to protect the rights of a patentee to his or her invention. Rather, the quid pro quo of the patent statutes provides the patentee with a limited monopoly right in exchange for public disclosure of the invention.<sup>131</sup> The patentee is recompensed for its expenditures in developing the invention while the public receives valuable knowledge from the patent specification, which reveals how to make and use the patented invention. Hence, the social value of patent law lies in its ability to use the patent monopoly and its associated public disclosure as a tool to encourage incremental innovation and investment in research and development.<sup>132</sup> But patents also impose social costs in the form of reduced levels of competition in the market for the patented invention.<sup>133</sup> Because an optimal patent system encourages innovation while limiting the encumbrance of this social cost on society, the rights of the accused infringer are at least equal to, and may slightly outweigh, the right of a patentee to its limited monopoly.<sup>134</sup> As a result, the law should seek to avoid any asymmetry in rules governing patent litigation.

Unfortunately, patent litigation contains an intrinsic information asymmetry favoring the patent claimant:

The moment a patent suit is filed, the plaintiff has already accumulated and developed most of what is needed for the plaintiff's case. The patent plaintiff has already obtained and examined the allegedly infringing device, along with data books and other information about the defendant's product. The patent plaintiff has thus already developed its contentions about infringement . . . thus entering litigation with the foundation of its entire case intact . . . . In contrast, patent defendants often begin litigation with an enormous information deficit. . . . Beyond a good-faith belief in non-infringement, the defendant has not had the opportunity to develop its contentions . . . the defendant sometimes may have no way of knowing what information will be needed to prove invalidity, non-infringement or other defenses.<sup>135</sup>

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131. See *supra* notes 79-80 and accompanying text.

132. HARMON, *supra* note 75, § 1.2 at 11 ("The exclusive right, Constitutionally derived, was for the national purpose of advancing . . . technological innovation.").

133. *Id.* at 12 (describing the costs of the right to exclude, including "inflated costs (invariably absorbed by the consumer) . . . and overinvestment").

134. *Id.* at 11 ("The patent system seeks to maintain an efficient balance between incentives to create and commercialize and the public costs engendered by those incentives.").

135. MacPherson, *supra* note 64, at 318-19.

In effect, this information asymmetry has become mandatory due to the Federal Circuit's interpretation of Rule 11,<sup>136</sup> requiring a patentee to develop its contentions about infringement, including its claim construction and application to the accused instrumentality, before filing suit.

The Local Rules enhance this asymmetry by requiring immediate production of all documents tending to support the patentee's position, including information concerning the accused instrumentality.<sup>137</sup> The patentee thus has early access to an even greater amount of information and is then able to adjust its claim construction to cover the accused instrumentality without having ever disclosed its earlier and potentially more limiting claim construction.<sup>138</sup> Because the social policies behind patent law do not favor the patentee over the public, the Local Rules should not heighten the information asymmetry inherent in patent infringement litigation.

### B. *The Public Notice Doctrine*

The Local Rules' permissive procedures for the introduction of extrinsic evidence contravene the Federal Circuit's constitutionally grounded hostility to the use of extrinsic evidence for claim construction purposes. The quid pro quo for awarding the patentee a limited monopoly in the subject matter of its invention is the creation of a public record of the invention.<sup>139</sup> This public disclosure is the device by which Congress encourages innovation as required by the Constitution.<sup>140</sup> The court stated in *Vitronics* that "competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention."<sup>141</sup>

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136. See *supra* Section II.A.

137. See *supra* notes 57-59 and accompanying text.

138. See *supra* Section I.A.

139. *Kewanee Oil Co. v. Bicon Corp.*, 416 U.S. 470, 484 (1974) (characterizing "disclosure" as the "the quid pro quo of the right to exclude").

140. U.S. CONST. art. 1, § 8, cl. 8 ("To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.").

141. *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996); see also *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995), *rev'd on other grounds*, 520 U.S. 17 (1997); *Slimfold Mfg. Co. v. Kinkead Industries, Inc.*, 932 F.2d 1453 (Fed. Cir. 1991); *Yarway Corp. v. Eur-Control USA, Inc.*, 775 F.2d 268, 277 (Fed. Cir. 1985) ("The incentive to 'design around' patents is a positive result of the patent system."); Maureen A. O'Rourke, *Toward a Doctrine of Fair Use in Patent Law*, 100 COLUM. L. REV. 1177, 1239; Peter K. Schalestock, *Equity for Whom? Defining the Reach of Non-Literal Patent Infringement*, 19 SEATTLE U. L. REV. 323, 335 ("By identifying slight improvements in patents that only just escape the language of the claims, inventors make small, incremental advances in technology that are critical to long-term progress."). Note also that if rights require justification, then by implication those rights must be subordinate to other concerns.

If a district court or party could alter the public record through the use of extrinsic evidence, such as an accused instrumentality, introduced at a claim construction proceeding or during trial, the right of the public to design around would be meaningless.<sup>142</sup> This right is at the basis of the constitutional authority granting Congress the right to legislate patent law.<sup>143</sup> If patent monopolies are continually expanded during infringement litigation, incremental innovation will be chilled because a fear of liability will discourage potential inventors from examining and designing around a patent that may prove to be broader in scope than what the potential inventor can possibly ascertain from the public record. The fear that the benefits of their labor will eventually accrue to a patentee when their new technology is found to infringe an existing patent will discourage the public from investing in further technological advances in the area pertinent to the patented invention.<sup>144</sup>

As an analytical framework when ruling on the proper interpretation of patent claims, the Federal Circuit has analogized a patent to a statute.<sup>145</sup> In keeping with this analogy, expansion of the patent during litigation, beyond the scope disclosed by the public record, would make an accused infringer subject to an ex post facto law. This is hardly a novel comparison. Thomas Jefferson, who wrote more on the subject of the patent law than did any other founding father,<sup>146</sup> recognized that a grant of patent rights in ideas in the public domain “was akin to an ex post facto law ‘obstructing[ing] others in the use of what they possessed before.’”<sup>147</sup> When the Local Rules allow the patent claimant to expand the patent monopoly during litigation, they deprive the public, and the accused infringer, of property — the use of

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142. *Vitronics*, 90 F.3d at 1583 (citing *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995)).

143. See *supra* note 140 and accompanying text.

144. Schalestock, *supra* note 141, at 335-36 (“Encouraging inventors to design around patents is one of patent law’s most important goals, a goal that is fully supported by the Federal Circuit. By identifying slight improvements in patents that only just escape the language of the claims, inventors make small, incremental advances in technology that are critical to long-term progress. . . . If inventors cannot be certain that staying outside the language of claims protects them from infringement actions, they will not risk modest advances. Technological progress is thwarted as a result. This result would directly contravene the constitutional purpose of the patent system, which is to ‘promote the progress of . . . the useful arts.’”).

145. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 987 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996) (finding that the statutory interpretation, which as a matter of law is for a court to decide, is the more appropriate analogy for interpreting patent claims than a contractual interpretation analogy).

146. Edward C. Walterscheid, *The Use and Abuse of History: The Supreme Court’s Interpretation of Thomas Jefferson’s Influence on the Patent Law*, 39 IDEA 195, 198 (1999).

147. *Id.* at 214; see also *id.* at 215 (noting that Jefferson acknowledged that the constitutional prohibition on ex post facto laws applied only to criminal law but argued that “they are equally unjust in civil as in criminal cases”).



technology in the public domain — without ever having provided the quid pro quo of establishing a public record. Returning again to the statute analogy, the resulting prejudice to the accused infringer is akin to a procedural due process violation — depriving the accused infringer and the public of property in the public domain without relying on a properly enacted statute.

As this Section has shown, where the Local Rules enable patent scope expansion during litigation, they undermine the basic goal of patent law — to promote the progress of the useful arts. Potential innovators, unable to determine reliably the bounds of patents by reviewing the public disclosures and fearful of litigation where the Local Rules will disfavor them, are discouraged from attempting technical advances that may expose them to liability.

### CONCLUSION

By requiring early disclosure of all information related to the accused instrumentality, by allowing bad faith adjustments to the patent claimant's preliminary infringement contentions, and by excluding preliminary claim construction contentions from the evidentiary record, the Local Rules encourage and enable the patent claimant to improperly expand its monopoly to the detriment of the public and the accused infringer. The Local Rules thus allow the patent claimant to deprive the public of their constitutional right to design around the patent and discourage potential innovators from pursuing incremental advances over the patented technology for fear that the patent claimant may broaden the patent scope during trial. The Local Rules prejudice an accused infringer because they allow a patent claimant to enforce an amorphous patent that broadens in order to read more closely to the accused instrumentality as discovery progresses.

To resolve these issues, the Local Rules should bind a patent claimant to a preliminary claim construction that it asserts at the outset of infringement litigation in response to the accused infringer's construction interrogatories. The Local Rules should prohibit the patent claimant from broadening the scope of this preliminary claim construction in order to ensure that the claims read on an accused instrumentality. Furthermore, to keep the patent claimant from asserting a strained, overly broad initial claim construction, the Local Rules also should prohibit the patent claimant from narrowing the preliminary claim construction in order to avoid the prior art.

A court's use of extrinsic evidence during patent litigation may result in a claim construction that varies from the public record of the patent monopoly. Hence, the Local Rules' receptive attitude to extrinsic evidence is detrimental to the rights of potential innovators who seek to rely on the public record. The Local Rules should expressly limit the types of extrinsic evidence that the parties may offer to evi-

dence that will serve either to supply a proper technological context to understand the claims, to ensure that the claim construction the court arrives at conforms with the understanding of one skilled in the art, or to help the trial court understand the patent process itself. The Local Rules also should adopt procedures to ensure that the parties and the courts do not rely on extrinsic evidence in the first instance, but rather seek first to arrive at a claim construction from intrinsic evidence alone.