

Strategic Importance

- Frames the issues for MSJ and trial
 - Or not: claim constructions frequently subject to multiple interpretations
 - MSJ may be a “meta-*Markman*”
- Opens settlement window
 - Or not: could cause the parties to dig their heels in
 - “Practice round” for MSJ or Trial
- Chance to speak with the Judge
- Focuses clients/counsel on case

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Strategic Considerations

- Anticipation/Obviousness v. (Non)infringement?
 - Trial or MSJ?
 - Forum
 - Willingness to appeal
- Other (In)validity
 - Written description
 - Enablement
- Experts
 - Locked in?
 - Discovery
- “Merits”
 - How much to say in *Markman* proceedings?

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Best Definitions

- Simple
 - Rubber Duck is “a duck-shaped toy made of rubber”
 - Not a “an amusement device with two lateral fins and tail fin that is made of natural or synthetic material and will not submerge in water”
- Intuitive
 - Remote control is a device for controlling another device remotely
 - Not a “device for controlling another device that communicates using a radio frequency between 100Mhz and 300Mhz”
- Consistent with the specification
 - Don't contradict specification
 - Carefully add or subtract meaning
 - Try not to read out embodiments
- Think about appeal

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Hearing Strategy

- Know thy audience (the Judge, law clerk)
 - Check standing orders, local rules, case management orders
 - Ask around for tips on likes/dislikes
 - Read all prior Markman rulings
- Make it interesting
 - Analogies
 - Animations
 - Graphics
- Leave the briefing in your bag
 - Explain the technology
 - Respond to what's happening at the hearing

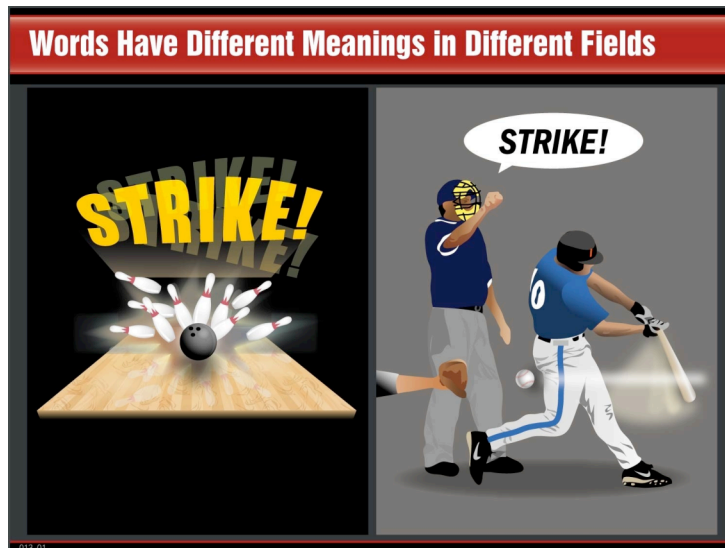
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Analogies



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Graphics



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Animations

How Packet Switching Works

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Evidentiary Hearing

- Most hearings have some evidence
- What evidence?
 - Testimony
 - Fact (Inventor)
 - Expert
 - Deposition or Live?
 - Documents
 - Party documents
 - Prior Art Documents
 - Dictionary definitions

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Live Testimony: Pros

- Good experts can be more persuasive than patent litigators
- Judge gets to assess expert's live credibility
- If expert credible, helpful for MSJ
- Makes hearing more interesting
- Everyone around the case more engaged

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Live Testimony: Cons

- Live direct can be slow and cumbersome
- Easier to make points through argument
- Subjects experts to potentially devastating cross-examination
- Cross-examination interrupts your presentation

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After Hearing

- Post-hearing briefs
- Demonstratives in record?
- Re-evaluate experts

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After Claim Construction Ruling

- Post-ruling steps depend on timing
- Reconsideration?
- Multiple interpretations of rule?
- Some local rules provide for modifying contentions
 - Seek case management order provisions if no rule
 - New or modified expert reports

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After Claim Construction Ruling

- **Infringement**
 - If clear either way, Rule 54(b) certification?
 - Both sides may have incentive avoid further proceedings
- **Summary Judgment**
 - Already filed?
 - If so, modification required?
 - Second chance for “losing” party
- **Willfulness opinions**
 - Re-evaluate in view of *Markman* rulings

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