

Chicago attorneys the latest to seek a more predictable patent system

Lynne Marek / Staff reporter
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CHICAGO — A group of Chicago intellectual property lawyers is drafting a set of local patent rules — aimed at increasing predictability — that could be in use as soon as next year in U.S. District Court for Northern Illinois.

A committee of lawyers from the Intellectual Property Law Association of Chicago (IPLAC) is drafting rules in the hopes of "getting a little more predictability in how a case is going to proceed if it's filed here," said Michael Padden, a partner in Howrey's Chicago office who is part of a committee.

"We've got very sketchy outline stuff at this point, but right now we're trying to go to the next level and get more meat on the bones," Padden said.

The rules would outline procedures and timelines for the unique aspects of patent litigation, especially with respect to the sequence of discovery, construction of claims and other matters, and could take effect only if judges in the district approve them. Such rules are in place only in a small percentage of U.S. district courts, but those few courts handle a disproportionate share of patent cases.

The U.S. District Court for Northern California was the first to implement such rules in 1998 and others, including Western Pennsylvania, Eastern Missouri and the popular Eastern Texas, have followed suit. The rules have helped the courts structure proceedings to include Markman hearings, a unique aspect of patent litigation prompted by the U.S. Supreme Court's 1996 ruling in *Markman v. Westview Instruments Inc.*

The committee has met several times with Northern Illinois district judges, including Chief Judge James Holderman and judges Matthew F. Kennelly and Amy St. Eve, to discuss potential rules and receive input from the bench, Padden said.

With the district handling a higher number of patent cases than most, it's worth considering such rules, Kennelly said. The advantages are that they allow predictability, especially in a large district with a lot of judges handling such cases, he said.

"From the judge's perspective, having a default structure in place, it's kind of like having pattern jury instructions — you don't have to fight the same issues over and over again," Kennelly said.

The IPLAC group aims to deliver a draft of the rules by late October, Kennelly said. Once approved by the district's judges, the rules would still need to be posted for a comment period before implementation. Earlier this year, the judges asked the group to survey attorneys about support for local patent rules. While the response was limited, the feedback was mainly positive, Padden said.

"It gives more predictability to the process and I think it brings an economy to the cases," said McDermott Will & Emery attorney Fay Morisseau, who heads the firm's new east Texas patent litigation group.

Still, some Chicago attorneys said that such rules might slow the process and add costs. **Patent litigator Richard Beem** said special rules aren't necessary because judges in the district already do very well using federal rules of civil procedure and existing local rules.

"To take that kind of case management, control, out of the discretion of judges and mandate a certain schedule and certain set of procedure by rule I think would be unnecessary, costly and unproductive," said **Beem**, whose Chicago-based firm has three lawyers.

Also, rules reduce the parties' ability to manage timing and cost, said Brinks Hofer Gilson & Lione attorney Bill Frankel, who chairs the copyright practice group for the Chicago-based firm.

"On the one hand, it makes perfect sense to identify early on what the claims, terms are in a dispute," Frankel said. "On the other hand, all of these procedures add their own layer of cost and complexity for the client."

The rules are more likely to benefit the defendant by forcing the plaintiff to take positions early on in a case, Frankel said.

The judges in a meeting in September suggested the IPLAC committee, which includes six attorneys, expand to include more lawyers, including more from the plaintiff's bar, to get a broader perspective on the issue.