

Tips Regarding *Markman* Briefing and Hearings

1. Judge Burke will permit parties to brief no more than 10 terms in advance of the *Markman* hearing. At the hearing, he will permit argument on no more than six terms. He will provide constructions for those first six argued terms (and, depending on the circumstances, for some or all of any additional terms that were briefed) in the days/weeks/months after the hearing. Judge Burke encourages parties to try to focus on identifying only the most important terms that need to be addressed early in the case. The fewer terms that parties agree should be addressed in the *Markman* briefing, the more pages of briefing the parties will get on each term—and the quicker Judge Burke will be able to issue his claim constructions on all of the identified terms.
2. If you think a claim term should be given its plain and ordinary meaning, you still need to provide Judge Burke with a proposed construction that sets out what you think that plain and ordinary meaning actually is. In other words, if the other side thinks that the term means X, and you disagree, then you must have some view as to what “not X” means. So provide that understanding to Judge Burke in the form of a proposed construction! This will help to ensure that Judge Burke has a good sense of your claim construction position. And it will help you to avoid seeming as if you are trying to hide the ball.
3. It is important to use every page of your share of the Joint Claim Construction Brief to persuade the Court about the merits of your positions. Often, parties spend a number of pages at the beginning of their brief attempting to set out a “theme”—e.g., how the other side is consistently taking a particular approach to the *Markman* process that is not correct. These “theme” arguments, which don’t directly go to the merits, are probably better off omitted. Also, while it can be helpful and necessary for a party to explain some key factual aspects of the technology at issue in its briefing, note that this can also be accomplished (sometimes more effectively) in the party’s claim construction tutorial. In the end, make sure that as much of your brief as possible goes to the merits of your side’s position about the meaning of the disputed claim terms.
4. For every claim term at issue, there will be at least one and perhaps many different disputes between the parties. In the first paragraph of your brief regarding a term, it helps if you clearly: (a) state how many disputes you

think there are; (b) set out what you understand the disputes to be; and (c) explain what particular portion of your (and/or your opponent's) proposed construction relates to each dispute. After you do that, then use the rest of your briefing on that term to tell the Court why you should prevail on each dispute.

5. Citations to case law in a *Markman* brief can be helpful, to a point. For example, it is sometimes useful to cite to a prior judicial opinion in order to identify a relevant tenet of claim construction, or to show that a particular word is widely understood to be a “nonce” word, or to note that another court has construed the same term in the same patent(s). But keep in mind that *Markman* issues are very often fact-specific and patent-specific. Citations to opinions in other cases dealing with different patents and different technology can often feel inapposite, and thus amount to a waste of briefing space.
6. Means-plus-function (“MPF”) terms are complicated, including for the Court. They require a number of steps of analysis and often necessitate a close review of various portions of the specification. So you need to do what you can to make things easier for the Court if a MPF term is at issue in the briefing. One common problem involves a situation where a party is attempting to show a link between the claimed function and certain structure found in the specification. Often, that party is suggesting that many different portions of the specification should be included as references to the requisite structure—but the party does not always explain in its briefing why *each* different portion of the specification at issue actually can be said to be linked to and perform the relevant function. Be sure that you address *every portion* of the identified references to structure and explain why they are correct.
7. Slides can be helpful in a *Markman* presentation. But trying to present too many slides is distracting. That is because, inevitably, the presenter spends his or her limited time trying to rush through all of the slides that he or she has prepared, instead of focusing on Judge Burke's questions. And a slide deck with an inordinate number of slides can start to look like an attempt to put an additional brief before the Court that it didn't request. A good rule of thumb is that, when it comes to a *Markman* hearing, you shouldn't have more slides for your presentation than there are pages in your share of the Joint Claim Construction Brief. And remember that you will have limited

time for your presentation, and that Judge Burke is going to take up about half of that time with his questions. So if you have one hour of argument time, for example, you should only include enough slides for about a half hour's worth of presentation time.

8. It goes without saying that your slides need to be tied in some way to a point that you made in your briefing. But the best slides amount to a *different way* of getting across that point. For example, say in your brief you want to emphasize that the same term (i.e., term #1) appears in five different parts of the patent—and that when it does, it is always accompanied by a particular phrase. A slide that has five different pop-up bubbles with the text of each portion of the specification included therein (along with related citations) can be really helpful in depicting this for the Court. That is because it gives the Court a unique illustration of exactly how term #1 is used in the patent—in a manner that is visually different than what is conveyed by a string citation in a brief.
9. If you want to make a substantive argument at the *Markman* hearing, and that argument is new—meaning it cannot be fairly said to relate to something you wrote in your briefing (like an argument you thought up for the first time in the days before the hearing)—then this is a problem. Arguments made for the first time during the hearing, with no advance notice to the opposing side or the Court, will likely be deemed waived or forfeited. If you plan to make an argument at the hearing that is not fairly presented in your briefing, then you should at least give the opposing side a heads-up before the hearing that you plan to raise the issue. And you should inform the Court by letter of the same. Even then, it may well be too late if the notice provided is not fair notice, or is not provided far enough in advance.
10. Judge Burke will let you attempt to argue that a claim term is indefinite at *Markman*. But if you are going to do that, it often will make sense for you to include expert declarations or other evidence along with your *Markman* briefing regarding how a POSITA would understand the term at issue in light of the patent's disclosures. It is hard for Judge Burke to conclude that a POSITA would not be informed with reasonable certainty about the scope of an invention if he never hears from an expert on that score. Additionally, keep in mind that indefiniteness arguments are not particularly efficient at *Markman* if it is clear that further discovery is needed as to the issue. So you should be prepared to explain why that is not the case.