


PATENT LITIGATION

Eastern District of Texas

AIPLA Spring Meeting - May 14, 2008

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SAYLES | WERBNER

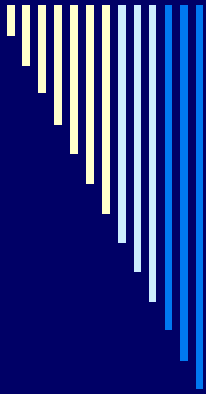
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Eastern District of Texas Practice Tips

What I would tell Tall Building Lawyers about coming to Marshall Texas

1. The Court, court staff, clerk's office and jury will welcome you to Marshall. You will be treated with respect and honor. You will be expected to respond likewise. This community prides itself on small town hospitality and manners.
2. The Judge and the Magistrate know the law and know how to try patent cases. They have done it many times. They have a process that works.
3. Marshall is not just for Plaintiffs. Defendants who have done the things I mention here have been successful.
4. The Courtroom is technologically friendly. You can and should use multimedia in your case.
5. The most important asset you have is credibility. Never ever do anything that will cause Judge Ward (or a jury) to doubt that you are being forthright.
6. The Local Rules and Local Patent Rules are Rules, not guidelines or suggestions. Make a copy and carry them with you to every hearing, deposition, and meeting. The Eastern District website is a valuable resource.
7. The scheduling order is an Order. The Court expects the parties to workout the schedule before he signs it. Once the Order has been entered, do not assume that it can be changed simply by agreement between the parties. There may be good cause, but make sure it is "good" cause and ask to amend as soon as you know there is a problem.
8. Marshall juries are smart, but they don't know the technical jargon of your product. Don't try to impress them with the technical vocabulary and don't talk down to them.
9. Explain your case to your spouse, golf partner, or neighbor (someone who is bright but is not an attorney or an engineer) in ten minutes or less. If you can't explain it to them, you can't explain it to a Marshall jury.
10. Juries have ears, eyes, and hands. Every spoken word needs a picture. Every picture needs spoken words. They need to hear, see, and touch the distinguishing factors of your product (or similarities, depending on your position).
11. Time is the thread that holds events together. Make sure the jury understands the chronology of the events. The jury needs to see a timeline of the "significant" events to understand each witness's explanation.
12. Time is a limiting resource in trial. Cases are tried on the clock. Be efficient in making maximum impact with minimum time and paper.
13. Pick the battles that need fighting. The Court and the jury expect you to be cooperative and professional. If you do have to seek the Court's intervention, make sure that it is clear that you exhausted all possibilities of resolving the dispute on your own. In trial, make the objections that truly deserve an interruption of the case. Remember that an objection is a verbal highlighting of the testimony in question.
14. Attack positions, not people. Whether in Court or in pleadings, demeaning your opponent will distract from the strength of your argument. Trust me. The Court knows when an attorney needs admonition, and he will take care of it.
15. Prepare early. Once you fall behind, it is almost impossible to catch up with the process. It moves fast.



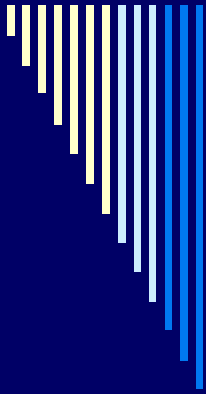
Disclosures in the Eastern District

Local Rule 26 illustrates how the District Judges view the scope of disclosure.

LR 26: Relevant to the Claim or Defense. The following observations are provided for counsel's guidance in evaluating whether a particular piece of information is "relevant to the claim or defense of any party:"

- (1) It includes information that would not support the disclosing parties' contentions;
- (2) It includes those persons who, if their potential testimony were known, might reasonably be expected to be deposed or called as a witness by any of the parties;
- (3) It is information that is likely to have an influence on or affect the outcome of a claim or defense;
- (4) It is information that deserves to be considered in the preparation, evaluation or trial of a claim or defense; and
- (5) It is information that reasonable and competent counsel would consider reasonably necessary to prepare, evaluate or try a claim or defense;

Also, Eastern District does not except impeachment documents from disclosure.



Meet and Confer in the Eastern District

Local Rule 7(h) "Meet and Confer" Requirement. The "meet and confer" motions practice requirement imposed by this rule has two components, a substantive and a procedural component.

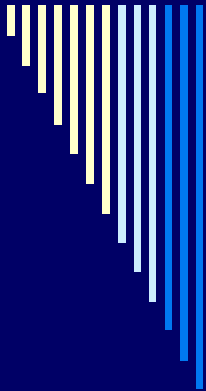
The substantive component requires, at a minimum, a personal conference, by telephone or in person, between an attorney for the movant and an attorney for the non-movant. In any discovery related motion, the substantive component requires, at a minimum, a personal conference, by telephone or in person, between the lead trial counsel and any local counsel for the movant and the lead trial counsel and any local counsel for the non-movant.

In the personal conference, the participants must give each other the opportunity to express his or her views concerning the disputes. The participants must also compare views and have a discussion in an attempt to resolve their differing views before coming to court. Such discussion requires a sincere effort in which the participants present the merits of their respective positions and meaningfully assess the relative strengths of each position.

In discovery-related matters, the discussion shall consider, among other things: (1) whether and to what extent the requested material would be admissible in a trial or is reasonably calculated to lead to the discovery of admissible evidence; (2) the burden and costs imposed on the responding party; (3) the possibility of cost-shifting or sharing; and (4) the expectations of the court in ensuring that parties fully cooperate in discovery of relevant information.

Except as otherwise provided by this rule, a request for court intervention is not appropriate until the participants have met and conferred, in good faith, and concluded, in good faith, that the discussions have conclusively ended in an impasse, leaving an open issue for the court to resolve. Good faith requires honesty in one's purpose to discuss meaningfully the dispute, freedom from intention to defraud or abuse the discovery process, and faithfulness to one's obligation to secure information without court intervention. Correspondence, e-mails, and facsimile transmissions do not constitute compliance with the substantive component and are not evidence of good faith. Such materials, however, may be used to show bad faith of the author.

An unreasonable failure to meet and confer violates Local Rule AT-3 and is grounds for disciplinary action. A party may file an opposed motion without the required conference only when the non-movant has acted in bad faith by failing to meet and confer.



To view the slide presentation
and see other helpful practice
tips please visit our firm's
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