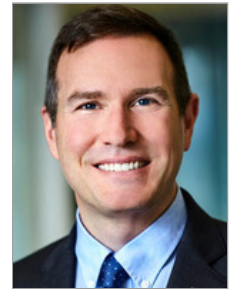


The Latest Pretrial Procedures In The District Of Delaware

By **Jeff Castellano** (March 25, 2019, 2:01 PM EDT)

In the nearly eight months since Judge Colm M. Connolly and Judge Maryellen Noreika took their places as the newest judges for the U.S. District Court for the District of Delaware, they have published, revised and refined their forms and procedures. They have borrowed from their colleagues on the bench in some respects, and forged their own paths in others. Meanwhile, the other judges in the district continue to adapt, devising solutions to new challenges as they arise.

This article will provide an overview of some common threads, differences, and developments in the practices and procedures of the judges in the District of Delaware, with a particular focus on patent procedures. With hundreds of active patent cases each, the judges of the District of Delaware depend on litigants and their attorneys to know and follow their procedures closely.



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Case Scheduling

In the District of Delaware, once an answer to the complaint has been filed, the scheduling process will typically begin. The district's judges follow essentially the same process whether the case is referred to a magistrate judge for scheduling or not — the entry of an order directing the parties to review and submit a draft scheduling order based on the judge's (or magistrate judge's) form within 30 days (or by a date certain in the cases of Judges Connolly and Richard G. Andrews, usually within 30-60 days).

In cases assigned to Chief Judge Leonard P. Stark, or referred to Magistrate Judge Christopher J. Burke for scheduling, the parties must also submit a checklist that asks the parties to consider specific questions, many of which involve ways to narrow or simplify the case, or try it more efficiently.[1] Although some of the checklist items overlap with topics the parties would be expected to discuss under Federal Rule of Civil Procedure 26(f) and District of Delaware Local Rule 16.1, the specific checklist items must be discussed during a verbal meet and confer involving both lead and Delaware counsel.

The judges' form scheduling orders do not include presumptive limits on the number of depositions or written discovery requests (although the parties should be aware of any limits set by the applicable rules). Similarly, the form orders give the parties leeway in setting deadlines, subject to the court's availability for hearings, conferences, or trial. However, the form scheduling orders are not freely modifiable by the parties, and are intended to be used as provided with relatively minor exceptions.

After the parties submit a proposed schedule, an in-person or telephonic scheduling conference is typically held during which the assigned judge will rule on disputes or invite additional argument. Once all disputes are resolved and the judge has provided dates for hearing and trial, the parties submit a revised proposed order to be entered by the court.

Early Motions

Early motions (e.g., motions to dismiss or transfer, or perhaps to stay) are most often briefed according to the local rules as modified by stipulation and court order. However, the number of defense motions challenging subject matter eligibility of asserted patents under 35 U.S.C. § 101 has risen to such a degree that Judge Stark and Judge Burke have instituted periodic "Section 101 Day" hearings, during which multiple Section 101 motions to dismiss may be heard at once, followed by rulings from the bench. In preparation, the parties are ordered to submit two-page letter briefs covering a range of topics relevant to the Section 101 analysis, including whether the briefed claims are representative of others, the necessity for claim construction, factual disputes, and key precedent.

Parties may move forward with a conference under Federal Rule 26(f) and delve into discovery while early motions are pending. Put another way, filing a motion to dismiss, transfer or stay does not necessarily itself stay any aspect of the proceedings, including discovery, even if the court has not yet initiated the scheduling process.

Referrals to Magistrate Judges

Most patent cases are referred early in the litigation (often in connection with the entry of a scheduling order) to one of the magistrate judges for alternative dispute resolution purposes. This referral is followed by an order from the magistrate judge setting a call to discuss the possibility and timing of in-person mediation or other ADR.

In addition, cases are often referred in part or in whole to magistrate judges to handle early motions, discovery, and other issues up to and including dispositive motions. Each magistrate judge is paired with certain district judges.[2] These pairings (modified from a prior permutation after the retirement last year of Judge Gregory M. Sleet and the seating of Judges Noreika and Connolly) permit the judges to efficiently divide responsibilities and address administration of the cases in a timely manner.[3]

Judge Connolly does not appear to have begun to systematically make referrals of pretrial issues in his cases, and has continued to handle scheduling and early motions. However, Judge Noreika has recently begun referring issues up to dispositive motions to Judge Burke, which notably could push referred Section 101 motions into the above-described Section 101 Day process, or something akin to it (specifically with regard to the pre-hearing letter brief process).

Early Patent Contentions

Although the provenance is unclear, the saying goes that “the District of Delaware does not have patent local rules.” While true, the district’s “Default Standard for Discovery, Including Discovery of Electronically Stored Information” does provide for a set of staged, alternating disclosures of contentions in patent cases, first of accused products (by the patentee), then of core technical documents (by the party accused of infringement), then infringement contentions, then invalidity contentions.[4]

The four early contention dates — along with dates for “final” contentions — have in some cases made their way into the judges’ form scheduling orders. For example, Chief Judge Stark’s form both incorporates the default standard by reference and includes staged contention disclosures like the default standard.[5] Judge Noreika[6] and Judge Burke[7] include similar provisions in their form orders. Chief Magistrate Judge Mary Pat Thyng[8] and Magistrate Judge Sherry R. Fallon[9] incorporate the default standard by reference in their form orders, but do not separately include contention dates. The form scheduling orders for Judge Andrews[10] and Judge Connolly[11] do neither. Nonetheless, parties may add staged contentions to the schedule even where not contemplated by the form.

Discovery and Protective Order Disputes

All of the judges require that parties bring discovery disputes (e.g., motions to compel or for a protective order) according to procedures that are more streamlined than typical discovery motion practice.

Judge Stark requires that the parties submit a joint letter certifying that lead counsel and Delaware counsel have met and conferred, and laying out the issues for resolution in a brief, nonargumentative list. After the letter is submitted, the judge typically issues an order within a week or two setting a teleconference, along with a schedule for opening and responsive three-page letter briefs due several days prior to the teleconference. After the letters are submitted, Judge Stark may rule on the papers and cancel the teleconference (and does so not infrequently).

Judges Andrews, Connolly and Noreika follow similar briefing procedures but the process is instituted by a call to chambers, rather than a letter. In addition, Judge Connolly separately requires submission of a proposed order (a good general practice and likely to be appreciated by any of the judges) and an express averment that Delaware counsel met and conferred much like Judges Stark and Burke and similar to the certification required for nondispositive motions by Local Rule 7.1.1. Letters are due no later than 72 and 48 hours prior to the conference under Judge Connolly’s procedures.

Judge Thyng requires that parties first call chambers then file a motion for a teleconference. No party may raise more than three issues at a time. Four-page letter briefs are due 72 and 48 hours prior to the teleconference, and the party seeking relief must include a proposed order. Parties are instructed not to include the entire “history” of the dispute and should instead focus on the current scope of the request and the current dispute. Judge Fallon follows a similar procedure, but adds that opening letters should not include “extensive argument or authorities” but instead should consist of “a statement of the issue to be addressed and a summary of the basis for the party’s position on the issue.”

Judge Burke requires that the parties submit a joint agenda letter like Judge Stark, and a motion for a teleconference like Judge Thyng. Four-page letter briefs are due no less than 96 hours and 48 hours before the teleconference, and any party seeking relief must submit a proposed order. Judge Burke, like Judge Thyng, advises that affidavits may be submitted where necessary to resolve a factual dispute.

Motions to Strike and Amend

Some of the District of Delaware judges have created abbreviated procedures for frequently filed motions such as motions to strike and motions to amend.

Judges Stark and Burke shunt motions to strike and amend into special procedures that fall somewhere between traditional motion practice and their discovery dispute procedures. Motions are to be accompanied by a three-page opening letter, to be followed by a five-page responsive letter seven days later, and a two-page reply three days after that.

Judge Noreika directs parties to submit requests to strike or amend via the discovery dispute procedure described above.

The district's other judges do not publish separate procedures for these types of motions.

Claim Construction

Under Judge Stark's procedures, the parties first exchange a list of claim terms and proposed construction(s). Thereafter, the parties submit a joint claim construction chart containing the disputed terms, the parties' constructions, and identifying/attaching the cited intrinsic evidence, followed by simultaneous opening and responsive briefs on all terms. In advance of the hearing, the parties must submit a letter stating whether they intend to offer live testimony and requesting an amount of time for argument. Judge Stark holds hearings for claim construction, and endeavors to issue rulings within 60 days of the hearing, although he may issue rulings from the bench.

Judge Andrews follows a similar procedure through submission of the joint claim chart, but briefing proceeds differently. Rather than simultaneous opening briefs and simultaneous answering briefs, Judge Andrews requires that the parties follow an opening-answering-reply-surreply format. The briefs (20, 30, 20 and 10 pages respectively) are served but not filed, and after briefing is complete, they are combined into a joint brief organized on a term-by-term basis, which is then filed along with a joint appendix.

Judge Andrews' form scheduling order notes that no testimony is permitted at the claim construction hearing, and argument shall not exceed three hours (it is typically substantially shorter). This is also the system used by Judge Thyng, and also — with slight modifications — by Judges Connolly, Noreika, Burke and Fallon. Judge Connolly sets briefing limits by word count (5,500, 8,250, 5,500 and 2,750) and requires that submissions be in 14-point font. [12] Judges Noreika, Burke and Fallon require a pre-hearing letter like Judge Stark's regarding live testimony and argument time.

Judges Stark and Burke require submission of technology tutorials along with opening briefs of no more than 30 minutes in total. Judge Noreika invites but does not require tutorials.

Summary Judgment

Summary judgment is not permitted in bench trials in the ordinary course. For example, the Judges who have separate scheduling orders for Hatch-Waxman cases (tried to the Judge) include provisions explaining that summary judgment is not permitted unless otherwise agreed and/or ordered by the court.[13]

Where summary judgment is permitted, all the judges prohibit parties from filing early motions without leave. Parties may generally make a request for early summary judgment during the case scheduling process, or later in a motion for leave. Judge Burke includes a specific procedure for requesting leave by letter brief. In all cases, early summary judgment is the exception, not the rule, and in exchange for hearing an early motion, the judge may ask the moving party to agree not to file a dispositive motion on the same issue later in the case.

Judges Noreika and Connolly have introduced procedures that focus on development of the factual record for dispositive motion practice. Both judges require submission of separate statements of facts along with summary judgment motions. The nonmoving party is permitted to respond by introducing additional material facts, and admitting or disputing the facts introduced by the moving party (Judge Noreika also permits a reply by the moving party). Each fact (or dispute) in these submissions is expressly required to be supported by specific citations to the record, which can be attached in relevant part.

Judges Stark, Noreika and Burke permit the parties to submit summary judgment briefs totaling 40, 40 and 20 pages regardless of the number of motions filed (the page limit goes up slightly if a Daubert motion is included). Judge Connolly uses word limits, but the length requirements are roughly the same.

If the parties extend their dispositive motion deadline where a trial date has been set, they should be aware that they may lose their trial date. Judges Connolly and Thyng expressly state that extending the summary judgment schedule may (or will, in the case of Judge Connolly) result in loss of the trial date, with no new trial date to be set until dispositive motions have been decided.

Pretrial Order

The timing and basic content of the proposed pretrial order are governed by Federal Rule 26(a)(3) and Local Rule 16.3. The specifics of the pretrial order preferences and practices of each judge is beyond the scope of this article.

However, some of the judges do provide written guidance beyond what is contained in the rules. For example, Judges Stark and Burke publish form patent pretrial orders.[14] Judge Noreika provides a helpful "Preferences & Procedures" document that contains provisions that would typically be included in a pretrial order.[15] Judges Thyng and Fallon publish pretrial orders or guidance regarding pretrial orders that are not patent-specific but which should be consulted in patent cases assigned to them for trial.[16]

All judges limit each party or side to three motions in limine, with three pages for opening and response, and one page in reply. The complete briefing on the motions in limine is filed as part of the pretrial order, but not before. The pretrial order, along with the agreed or disputed voir dire, jury instructions, and verdict forms, is generally required to be filed somewhere between a few days and a week ahead of the pretrial conference.

Generally, the pretrial order is relied upon heavily to set the scope and order of trial, and to avoid disputes during trial. Given the Judges' caseloads, litigants are well advised to identify and resolve as many disputes as possible before the pretrial conference, and thereafter, to avoid disrupting the trial schedule.

Conclusion

For every published procedure, there are many more unpublished or unwritten preferences and procedures for each judge and magistrate judge. At a minimum, litigants and counsel with cases in the District of Delaware should familiarize themselves with their judge's published procedures, and consult with Delaware counsel to ensure that their arguments and submissions are well-received.

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[1] <http://www.ded.uscourts.gov/sites/default/files/Chambers/LPS/PatentProcs/LPS-Checklist.pdf>

[2]

<http://www.ded.uscourts.gov/sites/default/files/news/2018/October/01/Oct%201%202018%20Announcement.pdf>

[3] The District Court recently selected Jennifer L. Hall to fill the newly created fourth Magistrate Judge seat in the District. Ms. Hall is currently the Chief of the Civil Division of the United States Attorney's Office for the District of Delaware. She is expected to assume the role of Magistrate Judge later in 2019.

[4] <http://www.ded.uscourts.gov/sites/default/files/pages/Electronic%20Discovery%20Default%20Standard.pdf>

[5] <http://www.ded.uscourts.gov/sites/default/files/Chambers/LPS/PatentProcs/LPS-PatentSchedOrder-Non-ANDA.pdf>

[6] http://www.ded.uscourts.gov/sites/default/files/Chambers/MN/Forms/PATENT_SCHEDULING_ORDER_NON.pdf

[7] http://www.ded.uscourts.gov/sites/default/files/Chambers/CJB/Forms/SCHEDULING_ORDER__PATENT_CA.pdf

[8]

<http://www.ded.uscourts.gov/sites/default/files/Chambers/MPT/Forms/MPT%20Rule%2016%20Sched%20Order.pdf>

[9] http://www.ded.uscourts.gov/sites/default/files/Chambers/SRF/Forms/SRF_RULE_16_SCHED_ORDER__P.pdf

[10] http://www.ded.uscourts.gov/sites/default/files/Chambers/RGA/Forms/Rule16_Scheduling_Order-Patent.pdf

[11] http://www.ded.uscourts.gov/sites/default/files/Chambers/CFC/Forms/PATENT_CASE.pdf

[12] Judge Noreika also permits parties to use a word count limit rather than a page limit. The word count limit is calculated by multiplying the page limit by 250.

[13]

http://www.ded.uscourts.gov/sites/default/files/Chambers/MN/Forms/PATENT_SCHEDULING_ORDER_AND.pdf;
<http://www.ded.uscourts.gov/sites/default/files/Chambers/LPS/PatentProcs/LPS-PatentSchedOrder-ANDA.pdf>; See also J. Thyng's Patent Scheduling Order, cited above.

[14] <http://www.ded.uscourts.gov/sites/default/files/Chambers/LPS/PatentProcs/LPS-PatentPTO.pdf>;
<http://www.ded.uscourts.gov/sites/default/files/Chambers/CJB/Forms/CJB-PatentPTO.pdf>

[15] http://www.ded.uscourts.gov/sites/default/files/Chambers/MN/Forms/PREFERENCES_AND_PROCEDURES.pdf

[16] http://www.ded.uscourts.gov/sites/default/files/Chambers/MPT/Forms/Final_Pretrial_Management_Order.pdf;
http://www.ded.uscourts.gov/sites/default/files/Chambers/SRF/Forms/Final-Pretrial-Order_10-13.pdf