

Markman Survey – Summary of Results

June 2010

Abstract

This is a summary of responses to the *Markman* survey that was conducted by the Minnesota Chapter of the Federal Bar Association earlier this year. The respondents were overwhelmingly pleased with the current process and do not suggest any significant changes.

1. Executive Summary

At the request of the judges of the United States District Court for the District of Minnesota, the Minnesota Chapter of the Federal Bar Association has been conducted a multi-faceted investigation of the district's claim construction, or *Markman*, process.

Over the past three years, the FBA's Markman Study Group interviewed all of the district and magistrate judges about scheduling using Form 4 and their preferences for *Markman* hearings. From this, the Study Group drew conclusions and presented them in an earlier forum.

Starting in December 2009, the Study Group conducted an online survey of more than 200 attorneys involved in patent cases in Minnesota. While the survey remains open and all are invited to participate, this report summarizes the preliminary results.

The survey polled lawyers from all levels of practice and included participants from law firms and legal departments of all sizes. These preliminary results show that lawyers in Minnesota generally like the schedule and process imposed by Form 4. Only a small percentage of lawyers favor a change to existing Form 4 and the process it developed—most attorneys in Minnesota think that Form 4 enables the Court to effectively manage patent cases. Virtually all lawyers practicing in Minnesota believe that a claim-construction hearing is necessary in every case.

If you want to participate in the survey, please follow this link:

<http://www.surveymonkey.com/s/2BCW6YG>

2. Demographics

A. Sample

About 200 people responded to the survey. Of those, about 60% completed the survey. Respondents were approximately normally distributed in years of practice: one third have been in practice for less than 11 years, one third have been in practice for 11 to 20 years, and the balance in practice for more than 20 years. Lawyers with less than six years of experience were much more likely to quit the survey before completing it (63% rather than 40% in the overall population). About half of lawyers in practice for 21 to 30 years quit before finishing the survey. Among the rest of the population, about 1 in 3 members of each group prematurely ended the survey. Consistent with this,

about one third of individuals who used Form 4 quit before they completed the survey (32 of 94).

This is an analysis of the 61 respondents who:

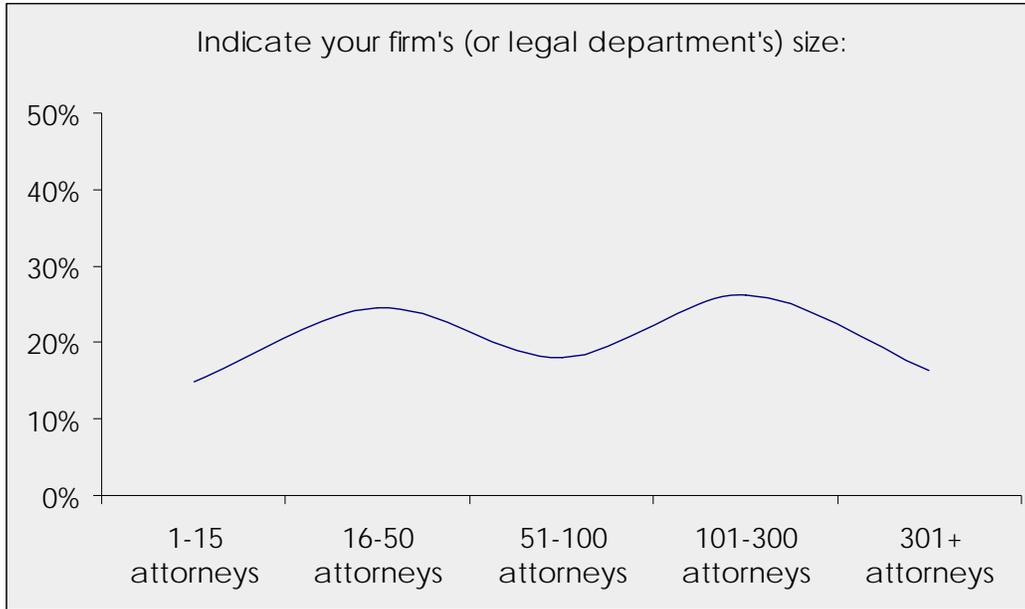
- (1) completed the survey; and
- (2) self-reported as having used Form 4.

These “Experienced Respondents” are presumably the most valuable attorney source of information about practice in the district.

B. Statistics

Experienced Respondents come from a variety of backgrounds and law-practice environments. They are approximately normally distributed by years in practice; a plurality of Experienced Respondents have been in practice for 11 to 20 years. Experienced Respondents’ responses were generally consistent regardless of years in practice; the few significant differences will be noted. Experienced Respondents work in firms and law departments of all sizes.

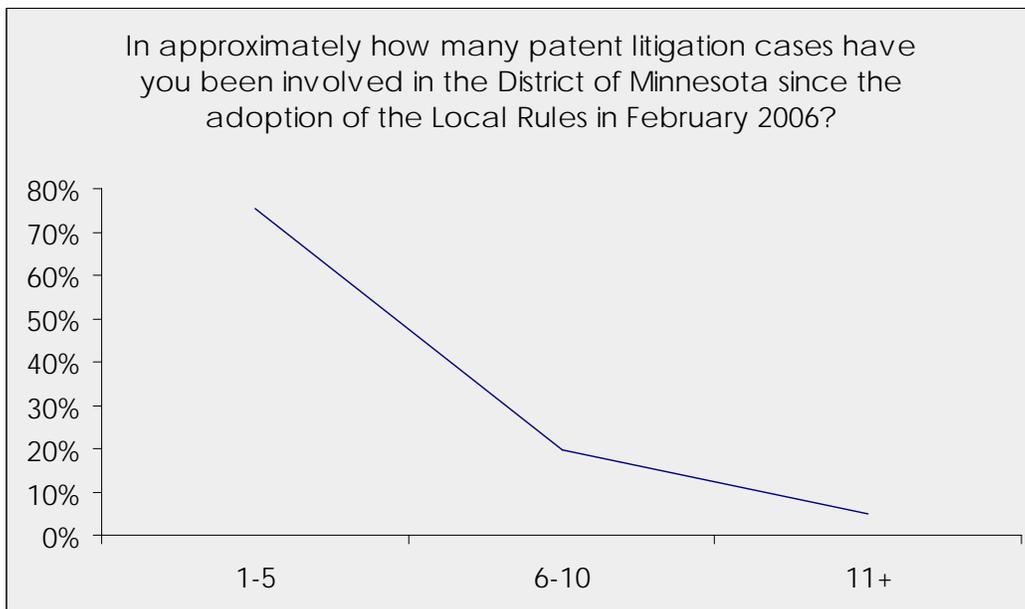




About half of the Experienced Respondents are admitted to the patent bar. Predictably, more than two thirds of Experienced Respondents represented plaintiffs about as often as defendants.

Some three quarters of the Experienced Respondents have participated in more than 10 patent litigations, although most participated in 10 or fewer in Minnesota. Less than a quarter of Experienced Respondents participated in more than five patent cases in Minnesota under the new Local Rules.

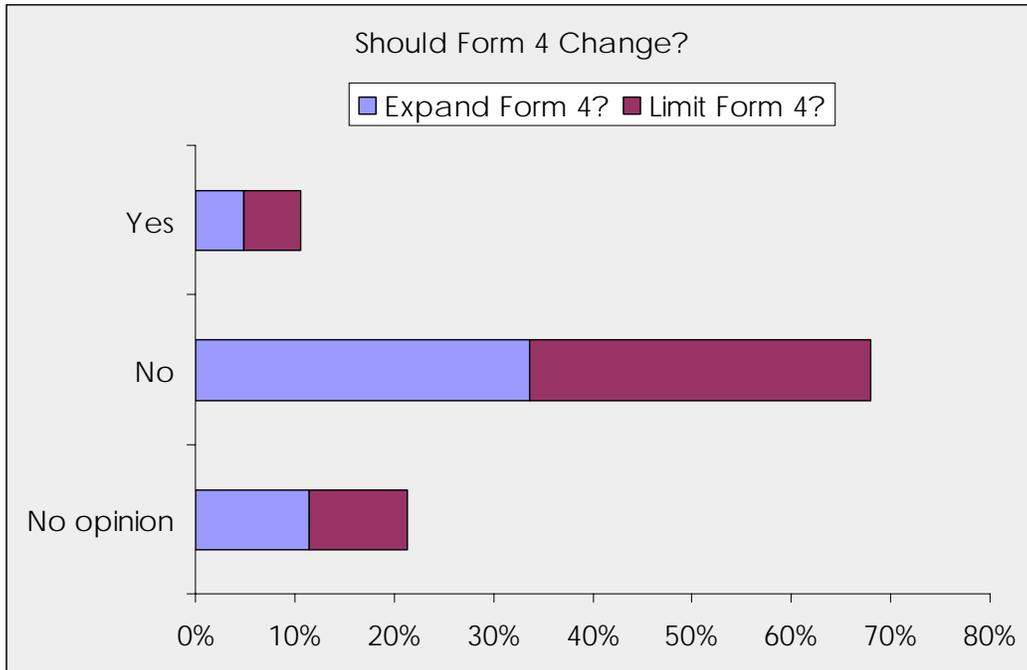
Most Experienced Respondents used Form 4 in fewer than six cases.



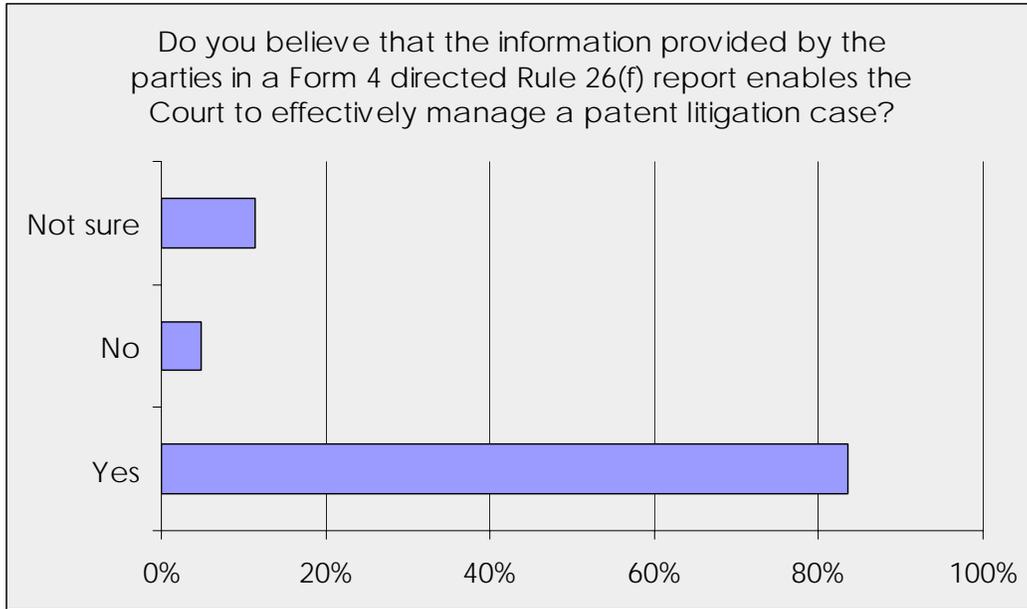
3. Results

A. Most Experienced Respondents had positive experiences with Form 4¹

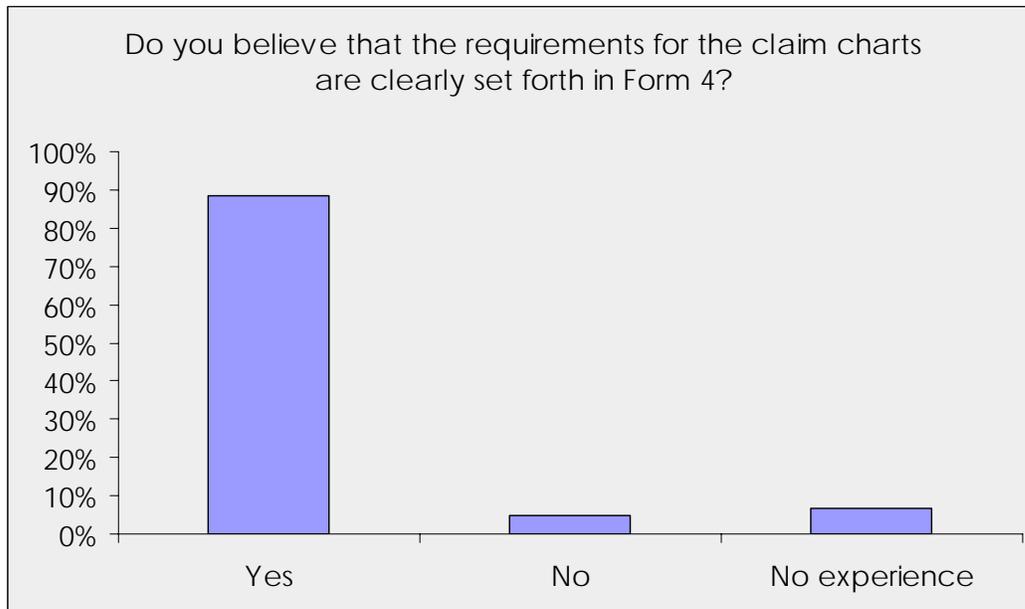
Most Experienced Respondents (83%) think that Form 4 enables the Court to manage cases effectively. Sixty-eight percent do not think that the Court should change Form 4.



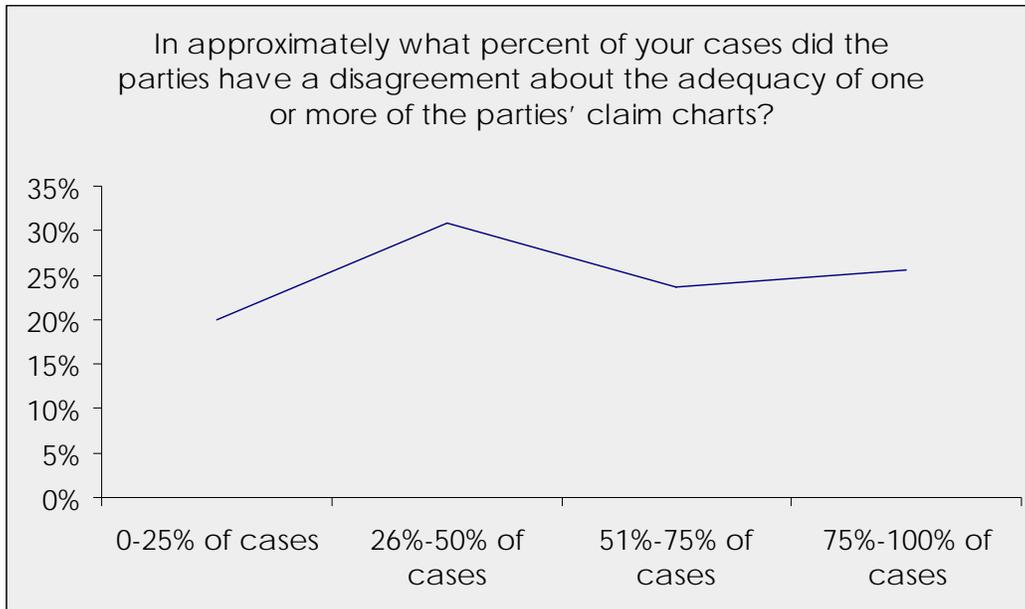
¹ The margin of error for these questions is less than $\pm 18\%$.



The overwhelming majority of Experienced Respondents (88%) think that the claim-chart requirements of Form 4 are clear, although a large majority have experienced claim-chart disputes.



More than 90% of Experienced Respondents think that the claim-term exchange and meet-and-confer requirements are helpful and only 10% of Experienced Respondents think that the process should change. Somewhat puzzlingly, however, only about half of the Experienced Respondents actually *participated in* such an exchange.

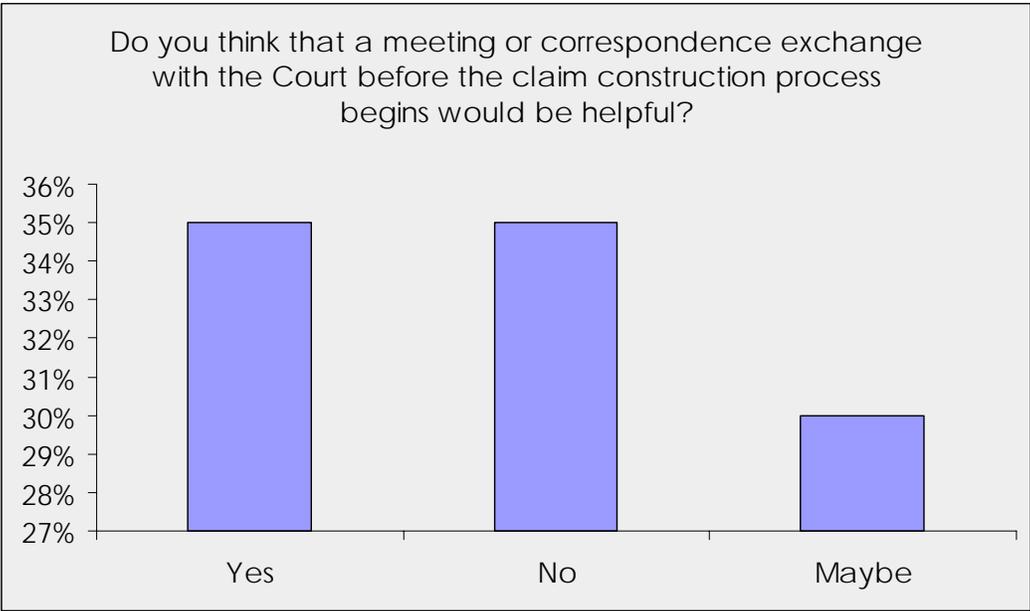


Two thirds of Experienced Respondents think Form 4 obviates the need for interrogatories about infringement contentions. It is important to note, however, that there is a significant difference between responses based on the number of years that an Experienced Responder has been in practice. Half of Experienced Respondents who have been in practice for more than 20 years, as opposed to only a quarter of other Experienced Responders, say that Form 4 does *not* obviate the need for contentions interrogatories.

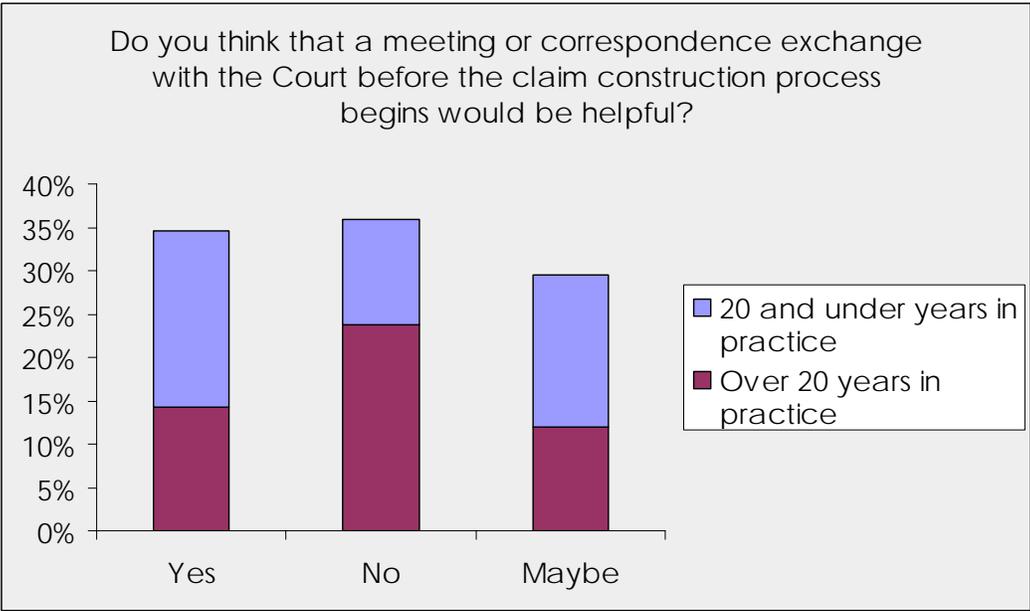
While opinions varied, the plurality of Experienced Respondents thought that modification should be permitted only by leave of Court.

B. Most Experienced Respondents do not want the Markman process to change

There was no consensus as to whether a pre-claim construction process with the Court would be helpful. If it were to be put in place, half of the Experienced Respondents think the timing and process should be decided on a case-by-case basis.



Significantly, Experienced Responders who have been in practice for more than 20 years are more likely to believe such a process will not be helpful than those who have been in practice for less time.



Most Experienced Respondents think that the Court should avoid imposing special requirements for summary judgment motions involving claim construction.

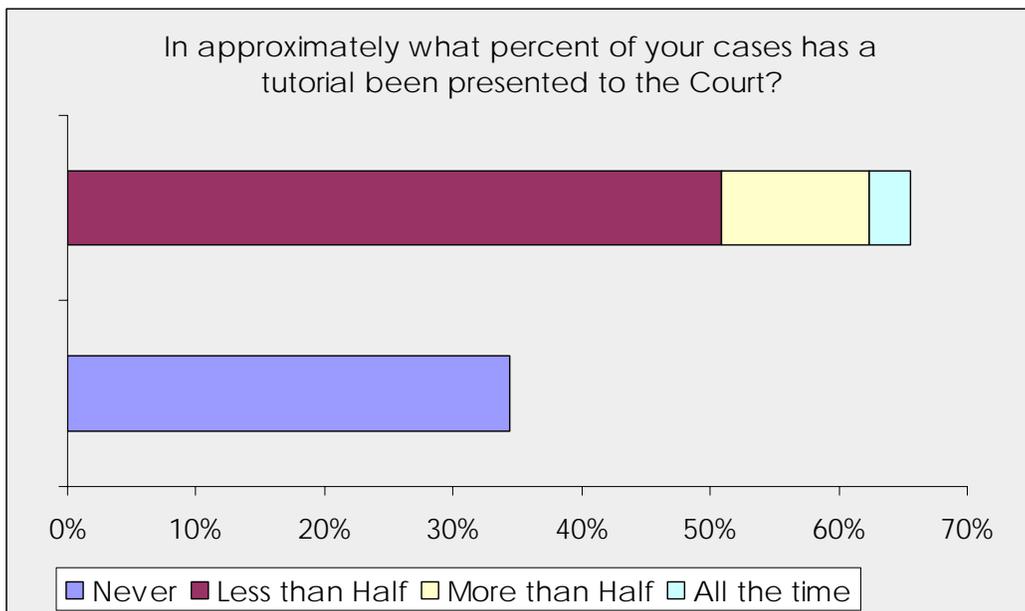
A little less than half of the Experienced Respondents saw live testimony during a claim construction hearing. While Experienced Responders who

have practiced for more than 20 years generally find such testimony helpful (60%), less experienced attorneys find it unhelpful (43%) or neutral (36%). Experienced Respondents disfavor using a special master for claim construction (68%) or adopting a mandatory settlement conference (63%). If forced into a settlement conference, most Experienced Respondents favor a hearing after the Court issues a *Markman* order.

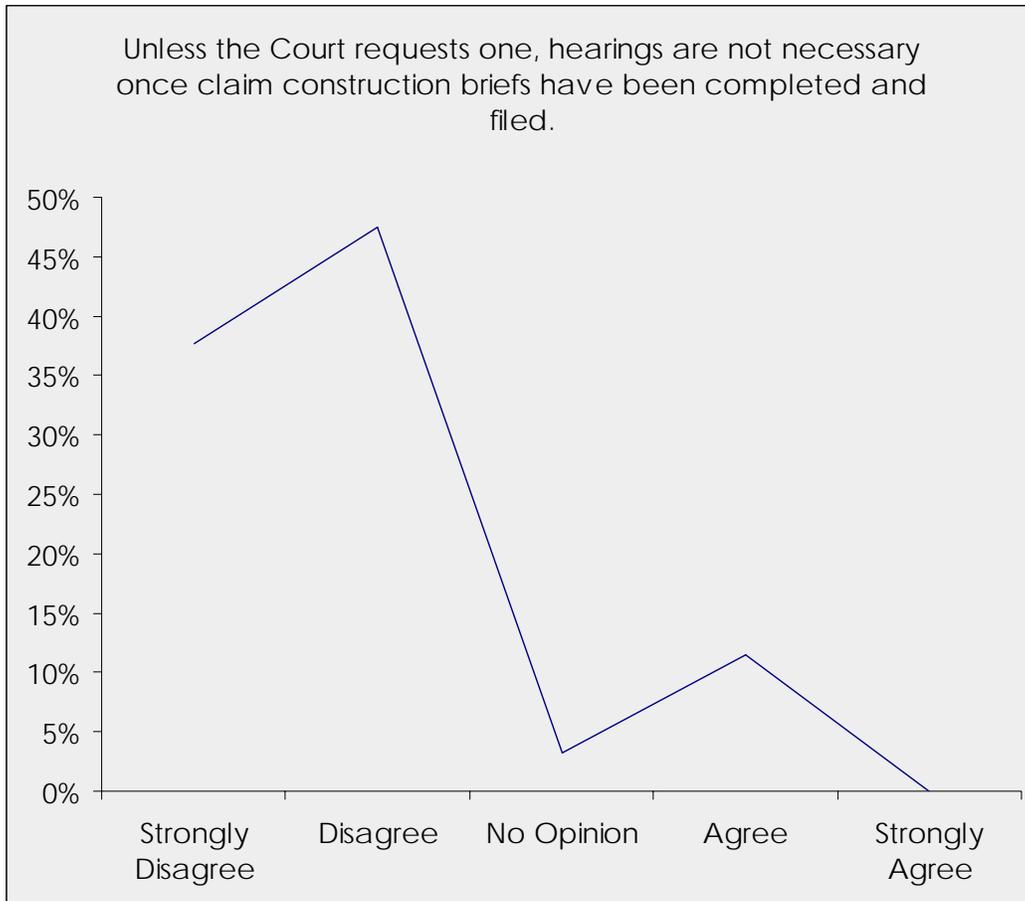
Most Experienced Respondents find that cases settled after the Court issues a pre-trial *Markman* order.

C. Overview comments

While two thirds of Experienced Respondents participated in a tutorial, they did so infrequently. In those cases, the Court usually did not make the tutorial part of the record. Most Experienced Respondents think that tutorials are generally helpful to the Court.



While almost all Experienced Respondents participated in a claim construction hearing, only about half participated in more than five. A significant majority of Experienced Respondents think that claim construction hearings are necessary in all cases, and that the Court should consolidate *Markman* hearings for cases involving multiple parties or multiple claims.



4. Next Steps

The FBA now will conduct “focus group” discussions to gain enhanced feedback on *Markman* proceedings in the District of Minnesota. You are cordially invited to join in these focus group discussions. Please RSVP by following the link below. One hour of CLE credit has been requested for each session. The FBA will present the findings from the written survey and focus group discussions in an upcoming public forum.

***Thursday, June 10, 2010 – 3:00 – 4:00 p.m.**

United States Courthouse, Minneapolis, Jury Assembly Room (2nd Floor)
Welcome by Honorable Joan N. Ericksen

***Thursday, June 17, 2010 – 3:00 – 4:00 p.m.**

Warren E. Burger United States Federal Building & Courthouse, St. Paul, Jury Assembly Room (1st Floor)
Welcome by Honorable Patrick J. Schiltz

***Thursday, June 24, 2010 – 3:00 – 4:00 p.m.**
United States Courthouse, Minneapolis, Jury Assembly Room (2nd Floor)
Welcome by Honorable James M. Rosenbaum

*Please RSVP at <http://www.surveymonkey.com/s/MarkmanFocusGroup>.
Contact Tara Norgard with questions (tnorgard@ccvl.com or 612-436-9620).

Summary prepared by James Hietala.