"The Work Will Teach You How To Do It: Lessons from Patent Litigation Courts On The Use of Limits on Case Activity to Effectively Manage Litigation Costs

I. Introduction

Decisions to limit the activity in a case are not new – they are in fact routine in procedural rules, local rules, judge-specific orders, and agreements between parties. When used properly, they focus the activity in a case. However, when used improperly, limitations can fail to save the parties money, and in the worst situations, unfairly limit the development of a case.

An Estonian proverb states that "the work will teach you how to do it." Thus a good source for tested limitations are those used by judges who have handled large quantities of complex, but similar, litigation. Patent litigation, in particular, provides an example of civil litigation where a relatively small number of judges have handled a large number of similar cases, and developed procedures that include limitations on case activity. Their rules and orders provide examples of effective, experience-based, limitations.

II. Types of Limits

Courts can limit the activity permitted, the time available to conduct it, or by simply adding requirements which deter parties from engaging in it. The following stages of litigation provide a useful framework for analyzing provisions imposing these limitations.

A. Initial motion practice

In addition to limiting the length of motions, courts may also restrict the types of motions that may be filed before or after a specific date. Court may also add requirements or conditions in order to deter a party from reflexively asserting certain claims. For example, U.S. District Judge Rodney Gilstrap of the Eastern District of Texas requires any party alleging that a patent

claim does not qualify as patent-eligible subject matter to serve detailed "Eligibility Contentions".[1] This imposes a significant additional burden on a defendant precisely when it is preparing similar invalidity contentions, thus incentivizing it not to assert every possible invalidity or ineligibility claims.

B. Discovery

The discovery process in civil litigation has become an enormous source of expense and delay, playing a disproportionate role in the resolution of disputes.[2] But there has been significant pushback in recent years, including the Eastern District of Texas' 1991 voluntary adoption of an innovative Civil Justice Expense and Delay Reduction Plan.[3] U.S. District Judge Sam B. Hall, Jr. explained that the Plan sought to reduce the transactional costs of civil litigation "by containing the amount of discovery permitted in a given case, and the time permitted for such pretrial activity" with the goal of "balanc[ing] the needs of the parties for legitimate discovery against the costs of that discovery to litigants and to our society at large." [4]

There are several types of discovery limitations that courts have found helpful.

1. Court-Ordered Disclosures

One of the ways to limit costs in discovery – or anywhere else in civil litigation - is by limiting what the parties can fight about. Initial disclosures, which consist of a court-ordered set of discovery requests, are one tool many courts have found effective in reducing costs.

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[1] Gilstrap, J. Rodney, Standing Order Regarding Subject Matter Eligibility Contentions, https://www.txed.uscourts.gov/sites/default/files/judgeFiles/EDTX%20Standing%20Order%20Re%20Subject%20Matter%20Eligibility%20Contentions%20.pdf (Accessed December 25, 2023).
[2] Kauffman, Brittany, *Initial Disclosures: The Past, Present, and Future of Discovery,* 51 Akron Law Review 783, 784 (2018)
[3] Smith, Michael, *Man With The Plan: Successful Eastern District Practice Requires Understanding History*, Texas Lawyer, April 11, 2011.
[4] *R&D Business Systems v. Xerox Corp.*, 150 F.R.D. 87, 89 (E.D. Tex. 1993) (Hall, J.) (internal citations omitted).

A particularly fertile area for court-ordered disclosures is disclosures tailored to the type of case. For example, many courts hearing patent cases require the parties to provide detailed infringement and invalidity contentions.[5] And in employment cases, the Initial Discovery Protocols for Employment Case, published in November 2011, set forth discovery specific to employment cases alleging adverse action.[6]

2. Staging of Discovery

Some courts stage discovery – with discovery only allowed on certain topics prior to a certain date. For example, Western District of Texas Judge Alan D Albright defers all discovery except with regard to jurisdiction, venue, and claim construction until after the claim construction hearing.[7] Provisions can also rule certain discovery in or out prospectively, eliminating expensive discovery fights.[8]

3. Limits on Depositions & Written Discovery

Many courts limit depositions and conduct in depositions in cases.[9] But limits on written discovery may be the most common discovery restriction, with courts limiting the permissible number of interrogatories, requests for production, and requests for admissions.[10]

4. Discovery Disputes

A common area for local and judge-specific rules is how a discovery dispute can be raised. Judge Albright prohibits discovery motions entirely. Instead, the parties have a

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[5] *See* Eastern District of Texas Local Patent Rules, https://www.txed.uscourts.gov/?q=patent-rules (accessed December 23, 2023); OGP at note 3, p. 2.
[6] Pilot Project Regarding Initial Discovery Protocols for Employment Cases Alleging Adverse Action, FED. JUD. CTR., at 1 (Nov. 2011), (accessed December 23, 2023). https://iaals.du.edu/sites/default/files/documents/publications/federal_employment_protocols_pilot_project.pdf
[7] Albright, Alan D, Standing Order Governing Proceedings – Patent Cases (OGP) v. 4-3, p. 3 https://www.txwd.uscourts.gov/wp-content/uploads/2023/01/Standing-Order-Governing-Patent-Cases.pdf (accessed December 25, 2023).
[8] *See* OGP at note 7 at p. 3 (no search and production of email absent a showing of good cause).
[9] *See* OGP at note 7, p. 9.
[10] *See* OGP at note 7, p. 3.

conference – usually telephonic – with the court after sending required information.[11] Judge Gilstrap limits discovery-related motions and responses to seven pages and adds a second meet and confer which is expressly limited to lead and local counsel.[12]

C. Pretrial motion practice

Numerical limits of some kind on motions for summary judgment are routine in many courts. Judge Albright's OGP, for example, notes that he does not limit the number of motions, but does have a page limit.[13] The Eastern District of Texas local rules similarly do not limit the number of motions, but do provide both a per motion and an overall cap on pages.[14]

One interesting limitation is that used by U.S. District Judge Colm Connolly in Delaware which requires a party filing multiple summary judgment motions to "rank" their motions. If the court decides to deny a motion filed by the party, barring exceptional reasons the court will not review any lower ranked summary judgment motions filed by the party.[15] Judge Connolly applies a corresponding rule to motions to strike expert testimony. The first denial of a motion to strike an expert will result in no consideration of other motions, and if a party does not cross-examine the expert at trial on the grounds of a denied motion, the court will reduce "by an appropriate amount" the time allotted to that party at trial.[16]

Courts also sometimes limit motions *in limine*. Judge Gilstrap recently began imposing a set of 26 standard *limine* rulings to be applied to all parties and allowing the parties to propose

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[11] *See* OGP at note 7 at p. 4.
[12] Gilstrap, J. Rodney & Schroeder, Robert W., III, Standing Order Re: Discovery Meet & Confer Obligations https://www.txed.uscourts.gov/sites/default/files/judgeFiles/Standing%20Order%20Regarding%20Meet%20and%20Confer%20Obligations%20for%20Discovery%20Dispute.pdf , (Accessed December 29, 2023).
[13] *See* OGP at note 7 at p. 9.
[14] E.D. Tex. L.R. CV-7(a)(1-3).
[15] *See* Connolly, Colm, Scheduling Order for Patent Cases, p. 31, https://www.ded.uscourts.gov/sites/ded/files/chambers/Form%20Scheduling%20Order%20for%20Non-Hax%20Waxman%20Patent%20Cases%20in%20Which%20Infringement%20is%20Alleged.pdf (accessed December 27, 2023).
[16] *See* Connolly, Scheduling Order, p. 22.

and argue – if opposed – up to five additional motions.[17] Like mandatory disclosures, this eliminates the need for the parties to meet and confer over precise language.

Some courts also restrict the number of exhibits. Judge Gilstrap recently began limiting the number of exhibits in civil cases, setting a limit of 60 joint exhibits and 25 exhibits per side (75/30 in patent cases).[18] Such limits save parties the enormous costs of cross designating and objecting and meeting and conferring on exhibits and deposition cuts which are highly unlikely to ever be used at trial by simply eliminating them from the outset.

D. Trial

Finally, most courts impose some sort of limitations at trial. The most common limitation is a limit on trial time, sometimes by the use of a chess clock, so that parties are aware how much time they have used and have remaining. Some courts justify stringent time limitations during trial by providing extensive attention to the case before trial, ruling on the admissibility of documents before a jury has been empaneled, and dispensing with time-consuming foundation requirements.

III. Conclusion

It may be asking too much for the participants in a case to accept voluntarily significant limitations on their ability to prepare and present their cases. But limitations from courts can play a critical role in allowing cases to be developed at a more reasonable cost.

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[17] Gilstrap, J. Rodney, Standing Order On Motions in Limine (August 11, 2023), https://www.txed.uscourts.gov/sites/default/files/judgeFiles/8.11.23%20Patent%20Standing%20Limine%20Order.pdf (Accessed December 29, 2023). A corresponding order in civil cases has 18 topics.

[18] Gilstrap, J. Rodney, Standing Order On Exhibits (August 8, 2023), https://www.txed.uscourts.gov/sites/default/files/judgeFiles/Amended%20Standing%20Order%20on%20Number%20and%20Use%20of%20Exhibits.pdf (Accessed December 29, 2023).