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Claim Limits and Claim Narrowing: Tools That Promote Efficiency and Fairness

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In this article, the authors propose that courts should adopt local rules or standing scheduling orders that impose reasonable limits on patent claims and prior art, and a schedule by which such claims and art are narrowed.

Particularly in cases brought by non-practicing entities (NPEs), discovery burdens and litigation costs in patent cases are not equal, usually falling disproportionately on defendants. Many NPE plaintiffs' strategy of asserting an extraordinary number of patent claims – often many dozens or hundreds of claims – against a defendant, only to drop most of them shortly before trial, exacerbates this imbalance. This practice not only requires defendants to expend enormous resources unnecessarily developing non-infringement, invalidity, and other arguments for many patent claims that will never be tried, but also allows NPE plaintiffs to effectively

“hide the ball” regarding the patent claims that they actually intend to pursue.

The costs associated with litigating an unreasonable number of patent claims are not borne only by defendants. Courts devote considerable resources to managing patent cases, and, where patentees assert an excessive number of patent claims, are often asked to decide issues – regarding claim construction, discovery disputes, and dispositive and *Daubert* motions – that become irrelevant once the plaintiff inevitably narrows its case.¹

Recognizing these issues, and following the Federal Circuit's decision in *In re Katz Interactive Call Processing Pat. Litig.*,² district courts have been increasingly willing to limit the number of claims a plaintiff may pursue and to require further narrowing as a case proceeds. Further, where courts have required a plaintiff to narrow its claims, they often also require that, in response, the defendant narrow its prior art-based invalidity arguments. In many cases, however, such limits on the number of patent claims are set only after extensive negotiations between the parties and, often, briefing to the court, i.e., yet another issue for the court to resolve ad hoc. To address these problems, courts should adopt local rules or standing scheduling orders that impose reasonable limits on claims and prior art,

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and a schedule by which such claims and art are narrowed.

RATIONALE FOR REQUIRING CLAIM NARROWING

The reasons to limit the number of asserted claims are now well established.

First, patent holders can as a practical matter assert only a small number of claims at trial. Based on our analysis of patent trials in the five venues with the highest number of patent cases in 2022³ and 2023 (the U.S. District Courts for the Western District of Texas, District of Delaware, Eastern District of Texas, Central District of California, and Northern District of Illinois), on average, patent holders ultimately assert only five claims at trial. Patent holders thus understand that trying a large number of claims to a jury is not practical or desirable.⁴ And litigating many claims that will never see the light of day at trial wastes substantial party resources – developing non-infringement, invalidity, and other arguments – and court resources – construing claim terms, resolving discovery disputes, and deciding dispositive and *Daubert* motions.⁵

Second, allowing plaintiffs to maintain an unreasonable number of claims (as many NPEs do), only to drop most shortly before trial gives plaintiffs an unfair advantage by enabling them to “hide the ball.” Defendants are forced to “play the whole field” because they do not know which claims will be dropped, while plaintiffs can focus their resources on the claims they know will be tried. This imbalance is exacerbated by discovery limits, which can impair a defendant’s ability to prepare a defense when a plaintiff asserts a large number of claims. For example, with most depositions limited to seven hours, and where the plaintiff asserts dozens and dozens of claims, a defendant is forced to try to address all asserted claims in just seven hours. More realistically, a defendant must focus its limited time on a subset of asserted claims, but those claims may not be the ones that are ultimately tried.⁶

Third, reasonable limits on the number of patent claims do not prejudice plaintiffs. A plaintiff must have a basis for its infringement allegations prior to filing a complaint and cannot use litigation as a fishing expedition. Reasonable limits on the number of claims asserted and staged narrowing allow a plaintiff to conduct discovery on specific claims

for which it had a basis for filing suit, to identify the defendant’s defense theories, and to evaluate which claims to take to trial. The fact that plaintiffs (particularly NPEs) often drop the majority of their claims close in time to trial demonstrates that plaintiffs can narrow their claims, but dispense with them at a time that provides a strategic advantage.⁷

MANY COURTS HAVE IMPOSED LIMITS AND REQUIRED NARROWING

Courts have the authority to address these problems by imposing reasonable limits on the number of claims a plaintiff may pursue.⁸ In recent years, courts have been increasingly willing to exercise that power when defendants move for such narrowing. For instance, we have obtained court-ordered limits on the number of asserted claims in many cases, including, for example:

- *ParkerVision v. Intel*: Judge Albright of the Western District of Texas ordered the patentee to narrow its 328 claims across eight patents to “no more than 4 claims per patent” after *Markman*.⁹
- *Deere v. AGCO*: Chief Judge Connolly of the District of Delaware ordered the patentee to narrow from 200 claims across 13 patents to 39 claims in the Infringement Contentions, 20 claims prior to *Markman*, and ten claims post-*Markman*.¹⁰
- *VLSI v. Intel*: Chief Judge Connolly required plaintiff to narrow from 82 claims across 5 patents to 25 claims prior to *Markman*, and to 18 claims post-*Markman*.¹¹
- *Memory Integrity v. Intel*: Judge Simon of the District of Oregon ordered the patentee to narrow from 118 claims across 5 patents to 15 claims total prior to *Markman*.¹²
- *Eagle Harbor v. Ford*: Judge Settle of the Western District of Washington required plaintiff to narrow from 114 claims asserted across 10 patents to a total of 35 asserted claims.¹³

Courts that require such claim narrowing often also require corresponding limits on defendant’s prior art-based invalidity arguments. The same rationales that support claim narrowing also apply

to narrowing the number of prior art references the defendant may use as anticipatory and/or as part of an obviousness combination – increasing efficiency, focusing discovery efforts and disputes, and seeking to limit case preparation to those issues that will be tried. Because obviousness arguments typically require multiple prior art references per claim, courts typically set limits corresponding to 2-3 references for every asserted claim.¹⁴

Yet parties often narrow their claims and prior art only after an extended back-and-forth and/or court intervention; negotiations and motion practice that burden parties and the courts. Further, the limits, and the stages at which further narrowing is required, often vary case-by-case. Table 2 summarizes the numerical limits on asserted claims and required stages for narrowing in two dozen recent cases. As demonstrated, plaintiffs are typically ultimately limited to 3-5 claims per patent. And courts have imposed claim narrowing at various stages – at the initial status conference, when the parties exchange initial infringement and invalidity contentions,¹⁵ in the middle of fact discovery, prior to *Markman* briefing,¹⁶ post-*Markman*, post-fact discovery, post-resolution of dispositive motions, and prior to trial, leading to uncertainty and disputes.

LOCAL RULES OR STANDING ORDERS SHOULD BE ADOPTED SO THAT CLAIM LIMITS, CLAIM NARROWING, AND PRIOR ART NARROWING ARE IN PLACE FOR EVERY CASE

Some courts are thus already limiting the number of asserted claims early in cases, and setting deadlines for further narrowing, on at least an ad hoc basis. And some district courts have adopted claim (and corresponding prior art) narrowing frameworks that apply more broadly. For example, Chief Judge Connolly of the District of Delaware has issued a scheduling order for Hatch-Waxman cases requiring plaintiffs to serve a “Preliminary Disclosure of Asserted Claims” that is limited to “no more than ten claims of any one patent and no more than 32 claims in total against any one Defendant.”¹⁷ When the “Final Election of Asserted Claims” is served, a plaintiff is limited to “no more than five asserted claims from among the 10 claims identified in the Preliminary Disclosure of Asserted

Claims” for any one patent and “no more than a total of 16 claims.”¹⁸ The Standing Order likewise sets limits on the number of prior art references the alleged infringer may use as anticipatory or part as an obviousness combination, and a schedule for further narrowing of such prior art.¹⁹ Any request to increase the number of asserted claims must “demonstrate with specificity why the inclusion of additional asserted claims” is warranted.²⁰

But because most courts have not established specific limits on claims or timeframes when narrowing is required, the benefits of these tools have yet to be fully realized.²¹ In many jurisdictions, defendants continue to face an unreasonable number of patent claims; the burden of seeking to persuade the plaintiff – and, in many cases, the court – to narrow the case; and the unpredictability of whether, when, and how the court will impose limits.

Adoption of local rules or standing scheduling orders that establish numerical limits on asserted claims (and prior art references) and the juncture at which further narrowing is required – with flexibility where there is a showing of good cause – would benefit litigants and courts.

First, it would eliminate the need for motion practice and expenditure of court resources to put in place narrowing for a case. While disputes may arise around whether adjustments are warranted, such disputes are likely to be less common than the frequency with which courts are asked to take up claim narrowing currently.

Second, it would ensure that the scope of a case remains more manageable from its very outset.

Third, it would give all parties greater predictability.

Finally, it would be far more efficient, reducing discovery fights and their associated costs and allowing parties to focus on what is truly in dispute. For all these reasons, widespread adoption of claim and prior art narrowing frameworks makes good sense.

Based on the average number of claims tried, and the limits adopted by many courts over a range of cases, we suggest the following default limits at the following stages:

- No more than 25 claims at the initial infringement contention stage, early in the case yet after production of “core” documents regarding the product(s)-at-issue’s operation (and

Table 1. Number of Claims Tried in the Top Five Patent Venues - 2022

Total cases tried – 34	
Total number of claims tried – 175	
Average number of claims tried per case – 5.147	
1. Western District of Texas – 9 patent trials, 43 claims, 4.78 claims per case	
Case	Number of Claims Tried at Trial
NCS Multistage Inc. v. Nine Energy Service, Inc. No. 6-20-cv-00277-ADA, Dkt. 251 (W.D. Tex. Jan. 21, 2022)	10
EcoFactor, Inc. v. Google LLC f/k/a Google Inc. No. 6-20-cv-00075, Dkt. 215 (W.D. Tex. Feb. 10, 2022)	3
Densys Ltd. v. 3Shape Trios A/S et al. No. 6-19-cv-00680, Dkt. 186 (W.D. Tex. Apr. 8, 2022)	2
Caddo Systems, Inc. et al. v. Microchip Technology Inc., No. 6-20-cv-00245, Dkt. 235 (W.D. Tex. June 10, 2022)	17
NCS Multistage Inc. v. TCO Products Inc. et al. No. 6-20-cv-00622, Dkt. 288 (W.D. Tex. Aug. 26, 2022)	2
Voxer, Inc. et al. v. Meta Platforms, Inc., et al. No. 1-20-cv-00655, Dkt. 332 (W.D. Tex. Sept. 21, 2022)	6
Ravgen, Inc. v. Laboratory Corp/ of America Holdings No. 6-20-cv-00969, Dkt. 222 (W.D. Tex. Sept. 23, 2022)	1
VLSI Technology LLC v. Intel Corp. No. 1-19-cv-00977, Dkt. 690 (W.D. Tex. Nov. 15, 2022)	2
2. District of Delaware – 13 patent trials, 59 claims, 4.54 claims per case	
Case	Number of Claims Tried at Trial
PureWick Corp. v. Sage Products LLC No. 1-19-cv-01508 (D. Del. Apr. 01, 2022)	7
Microchip Tech. Inc/ v. Delphi Automotive Systems, LLC et al. No. 1-17-cv-01194 (D. Del. Apr. 13, 2022)	3
First Quality Tissue, LLC v. Irving Consumer Products Limited et al. No. 1-19-cv-00428 (D. Del. Apr. 29, 2022)	7
Complete Genomics, Inc. v. Illumina, Inc. No. 1-19-cv-00970 (D. Del. May. 06, 2022)	8
Deere & Company v. AGCO Corporation, et al. No. 1-18-cv-00827 (D. Del. Jul. 08, 2022)	2
Ingenico Inc. v. IOENGINE, LLC No. 1-18-cv-00826 (D. Del. July 15, 2022)	8
Magnolia Medical Technologies, Inc. v. Kurin, Inc. No. 1-19-cv-00097 (D. Del. July 26, 2022)	2
Aqua Connect, Inc. et al. v. TeamViewer US, LLC No. 1-18-cv-01572 (D. Del. Aug. 12, 2022)	4
Osseo Imaging, LLC v. Planmeca USA Inc. No. 1-17-cv-01386 (D. Del. Aug. 29, 2022)	5
Shopify Inc. et al. v. Express Mobile, Inc. No. 1-19-cv-00439 (D. Del. Aug. 31, 2022)	8
Rex Medical, LP v. Intuitive Surgical, Inc. et al. No. 1-19-cv-00005 (D. Del. Oct. 19, 2022)	1
CR Bard Inc. et al. v. AngioDynamics Inc. No. 1-15-cv-00218 (D. Del. Nov. 22, 2022)	2
RSB Spine, LLC v. DePuy Synthes Sales, Inc. et al. No. 1-19-cv-01515 (D. Del. Dec. 09, 2022)	2

3. Eastern District of Texas – 11 cases, 10 reported, 62 claims, 6.2 claims per case	
Case	Number of Claims Tried at Trial
National Oilwell DHT, LP v. Amega West Services, LLC No. 2-14-cv-01020 (E.D. Tex. Feb. 10, 2022)	6
The Chamberlain Group LLC v. Overhead Door Corporation et al. No. 2-21-cv-00084 (E.D. Tex. Mar. 11, 2022)	3
US Silica Co. v. Amberger Kaolinwerke Eduard Kick GmbH & Co. KG No. 2-20-cv-00298 (E.D. Tex. Mar. 25, 2022)	6
Seagen Inc. v. Daiichi Sankyo Co., Ltd. No. 2-20-cv-00337 (E.D. Tex. Apr. 08, 2022)	7
Longhorn HD LLC v. NetScout Systems, Inc. No. 2-20-cv-00349 (E.D. Tex. Apr. 21, 2022)	3
United Services Automobile Association v. PNC Bank, NA No. 2-20-cv-00319 (E.D. Tex. May. 13, 2022)	17
Lone Star Technological Innovations, LLC v. ASUS Computer International, Inc. et al. No. 6-19-cv-00059 (E.D. Tex. June 30, 2022)	Not listed
Koninklijke KPN NV v. Telefonaktiebolaget LM Ericsson et al. No. 2-21-cv-00113 (E.D. Tex. Aug. 26, 2022)	6
United Services Automobile Association v. PNC Bank NA No. 2-21-cv-00246 (E.D. Tex. Sept 16, 2022)	6
Hy-Ko Products Company, LLC v. The Hillman Group, Inc. No. 2-21-cv-00197 (E.D. Tex. Oct. 07, 2022)	5
SynQor, Inc. v. Vicor Corp. No. 2-14-cv-00287 (E.D. Tex. Oct. 26, 2022)	3
4. Central District of California – 3 cases, 2 reported, 11 claims, 5.5 claims per case	
Case	Number of Claims Tried at Trial
Seal4Safte, Inc. v. California Expanded Metal Products Co. No. 2-20-cv-10409 (C.D. Cal May. 10, 2022)	9
Panasonic Holdings Corporation v. Getac Technology Corp. et al. No. 8-19-cv-01118 (C.D. Cal June 08, 2022)	Not listed (3 patents)
Pavemetrics Systems, Inc. v. Tetra Tech, Inc. No. 2-21-cv-01289 (C.D. Cal Aug. 24, 2022)	3
5. Northern District of Illinois – 1 case, 0 reported, N/A claims per case	
Case	Number of Claims Tried at Trial
Sioux Steel Co. v. Prairie Land Millwright Services, Inc. No. 1-16-cv-02212 (N.D. Ill. Dec. 21, 2022)	Not listed (1 patent)

Table 2. Limitations on Asserted Claims/ Narrowing Requirements in Specific Cases

Case	Starting # Claims	Narrowed # Claims	Stage When Required
Adobe Sys. v. Wowza Media Sys. LLC, 2013 WL 9541126 (N.D. Cal. May 6, 2013)	Unknown claims/5 patents	20 claims/5 patents	Prior to <i>Markman</i>
Fenster Family Patent Holdings, Inc., Elscint Ltd., 2005 WL 2304190 (D. Del. Sept. 20, 2005)	90 claims/8 patents	10 claims/8 patents	Mid-Discovery (prior to <i>Markman</i>)
Fujifilm Corp. v. Motorola Mobility LLC, 2015 WL 757575 (N.D. Cal. Feb. 20, 2015)	Unknown claims/5 patents	16 claims/5 patents	Initial
Data Treasury Corp. v. Wells Fargo & Co., 2006 WL 8464165 (E.D. Tex. Oct. 25, 2006) (Folsom, J.)	224 claims/6 patents	50 claims/6 patents 18 claims/6 patents	Prior to Infringement Contentions
Deere & Co. v. AGCO Corp., No. 1:18-cv-00827-CFC, Dkt. 72 at Ex. A (D. Del.)	200 claims/13 patents	39 claims/13 patents 20 claims/13 patents 10 claims/13 patents	Prior to Infringement Contentions Prior to <i>Markman</i> Post- <i>Markman</i>
Eagle Harbor Holdings, LLC v. Ford Motor Co., No. 3:11-cv-05503-BHS, Dkt. 186 (W.D. Wash. Nov. 25, 2013).	114 claims/10 patents	35 claims/10 patents	
Havco Wood Products, LLC v. Indus. Hardwood Products, Inc., 2011 WL 5513214 (W.D. Wis. Nov. 10, 2011), amended, 2012 WL 5199185 (W.D. Wis. Oct. 22, 2012)	135 claims/5 patents	15 claims/5 patents	Post- <i>Markman</i>
Hearing Components, Inc. v. Shure, Inc., 2008 WL 2485426 (E.D. Tex. June 13, 2008)	12 claims/3 patents	3 claims per patent/3 patents	Prior to <i>Markman</i> (and at trial)
Joao Control & Monitoring Sys., LLC v. Ford Motor Co., 2014 WL 106926 (E.D. Mich. Jan. 10, 2014)	Unlimited requested/5 patents	15 claims/5 patents against Ford 8 claims per patent against Chrysler	Mid-Discovery (prior to <i>Markman</i>)
In re Katz Interactive Call Processing Patent Litig., 639 F.3d 1303 (Fed. Cir. 2011)	1,975 claims/31 patents 50 defendant groups	40 claims per defendant initially 16 claims per defendant (max of 64 claims)	Initial Post-Discovery
Magna Mirrors of Am., Inc. v. SMR Auto. Mirrors UK Ltd., 2018 WL 11377450 (W.D. Mich. Feb. 28, 2018)	160 claims/10 patents	27 claims/10 patents	Prior to Infringement Contentions

Masimo Corp. v. Philips Elecs. N. Am. Corp., 918 F.Supp.2d 277 (D. Del. 2013)	95 claims/7 patents	30 claims/7 patents	Prior to <i>Markman</i>
Medtronic Minimed Inc. v. Animas Corp., 2013 WL 3322248 (C.D. Cal. Apr. 5, 2013)	255 claims/9 patents	4 claims per patent/9 patents 2 claims per patent/9 patents	Initial Post-Infringement Contentions
Memory Integrity, LLC v. Intel Corp., 2015 WL 6659674 (D. Or. Oct. 30, 2015)	118 claims/5 patents	15 claims/5 patents	Prior to <i>Markman</i>
Midwest Athletics & Sports All. LLC v. Xerox Corp., 545 F. Supp. 3d 16 (W.D.N.Y. 2021)	Unknown claims/20 patents	60 claims/20 patents 24 claims/20 patents 16 claims/20 patents 8 claims/8 patents 8 claims/4 patents	Prior to <i>Markman</i> Post- <i>Markman</i> Post-Discovery Post-Resolution of Dispositive Motions Trial
In re Neo Wireless, LLC Pat. Litig., 2022 WL 17077494 (E.D. Mich. Nov. 18, 2022)	65 claims/6 patents	36 claims/6 patents	Initial
Oasis Rsch., LLC v. Adrive, LLC, 2011 WL 7272473 (E.D. Tex. Sept. 13, 2011)	121 claims/4 patents	32 claims/4 patents	Mid-Discovery (prior to <i>Markman</i>)
ParkerVision, Inc. v. Intel Corp., No. 6:20-cv-00108-ADA, Dkt. 23 (W.D. Tex. June 26, 2020)	328 claims/8 patents	4 claims per patent	Post- <i>Markman</i>
Round Rock Research, LLC v. Dell Inc., 2012 WL 8017390 (E.D. Tex. Mar. 26, 2012)	82 claims/10 patents	40 claims/10 patents	Prior to <i>Markman</i>
Select Comfort Corp. v. Gentherm, Inc., 2014 WL 4976586 (D. Minn. Oct. 3, 2014)	Unknown claims/5 patents	15 claims/5 patents	Initial
Stamps.com Inc. v. Endicia, Inc., 437 F.App'x 897 (Fed. Cir. 2011)	629 claims/11 patents	15 claims/11 patents	Prior to <i>Markman</i>
Thought, Inc. v. Oracle Corp., 2013 WL 5587559 (N.D. Cal. Oct. 10, 2013)	102 claims/7 patents	32 claims/7 patents 16 claims/7 patents	Prior to <i>Markman</i> Post- <i>Markman</i>
Universal Elecs. Inc. v. Roku Inc., 2019 WL 1878351 (C.D. Cal. Mar. 14, 2019)	106 claims/9 patents	25 claims/9 patents	Mid-Discovery (prior to <i>Markman</i>)
Univ. of Virginia Pat. Found. v. Gen. Elec. Co., 2015 WL 6958073 (W.D. Va. Nov. 10, 2015)	170 claims/2 patents	25 claims for first patent 15 claims for second patent	Prior to <i>Markman</i>
Visto Corp. v. Little Red Wagon Techs., Inc., 2012 WL 7989618 (N.D. Tex. Oct. 18, 2012)	35 claims/5 patents	10 claims/5 patents	Prior to <i>Markman</i>

corresponding narrowing to no more than 60 prior art references as anticipatory and/or as part of an obviousness combination);

- No more than 10 claims shortly (e.g., 28 days) before the deadline for opening expert reports (and corresponding narrowing to no more than 25 prior art references as anticipatory and/or as part of an obviousness combination); and
- A final identification of claims and prior art to be tried as part of the pre-trial disclosure process.

Notes

1. In *Motorola Mobility v. Apple*, Judge Scola of the Southern District of Florida observed that: “This litigation now includes over 180 claims asserted from the 12 patents, and the parties dispute the meaning of over 100 terms from those claims. . . . [T]he parties agree that the case needs to be simplified, ‘primarily through [plaintiff] voluntarily agreeing to drop patents and claims from the case.’ . . . Without a hint of irony, the parties now ask the Court to mop up a mess they made by holding a hearing to reduce the size and complexity of the case.” *Motorola Mobility v. Apple*, No. 1:12-cv-20271-SCOLA, Dkt. 182 at 1 (S.D. Fla. Apr. 10, 2013).
2. In *re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1310-13 (Fed. Cir. 2011).
3. See Table 1.
4. Some admit as much. For instance, in *Masimo Corp. v. Philips Electronics North America Corp.*, the plaintiff itself said that “reduction was necessary” and admitted it “never intended to present all presently asserted claims to the jury.” *Masimo Corp. v. Philips Elecs. N. Am. Corp.*, 918 F.Supp.2d 277, 284 (D. Del. 2013).
5. See, e.g., *Network Prot. Scis., LLC v. Fortinet, Inc.*, 2013 WL 1949051, at *2 (N.D. Cal. May 9, 2013) (prior art search for 50 claims is “bone-crushing burden”); *Realtime Data, LLC v. Packeteer, Inc.*, 2009 WL 10667516, at *1-*2 (E.D. Tex. Mar. 16, 2009) (acknowledging practice of “limiting asserted claims in patent cases for the purpose of manageability” and “when the number of claims is so large as to make the case inefficient and unmanageable”); *Data Treasury Corp. v. Wells Fargo & Co.*, 2006 WL 8464165, at *2 (E.D. Tex. Oct. 25, 2006) (managing large number of asserted claims through discovery, claim construction, dispositive motions, and trial is “extremely burdensome on both the parties and the Court”); *Oasis Research, LLC v. Adrive, LLC*, 2011 WL 7272473, at *2 (E.D. Tex. Sept. 13, 2011) (limiting the number of claims aids in

efficiency); *Motorola Mobility v. Apple*, No. 1:12-cv-20271-SCOLA, Dkt. 182 at 1 (S.D. Fla. Apr. 10, 2013) (noting court’s expenditure of considerable resources due to “size and complexity of the case”).

6. See, e.g., *Joao Control & Monitoring Sys., LLC v. Ford Motor Co.*, 2014 WL 106926, at *4 (E.D. Mich. Jan. 10, 2014) (noting “waste of time and resources” to construe terms for “a multitude of claims that Plaintiff may later elect not to pursue”); *Universal Elecs. Inc. v. Roku Inc.*, 2019 WL 1878351, at *3 (C.D. Cal. Mar. 14, 2019) (absent claim limitations, defendant “would be required to develop its non-infringement defenses, invalidity defenses, and damages theories on all the asserted claims, and to work with experts in preparing expert reports on those issues as to all the asserted claims, even though only a fraction of the 100-plus asserted claims will proceed to trial”).
7. *Memory Integrity, LLC v. Intel Corp.*, 2015 WL 6659674, at *3 (D. Or. Oct. 30, 2015) (plaintiff acknowledging “that it must reduce asserted claims at some point in these proceedings”); *Magna Mirrors of Am., Inc. v. SMR Auto. Mirrors UK Ltd.*, 2018 WL 11377450, at *3 (W.D. Mich. Feb. 28, 2018) (noting that it would be unfair for a plaintiff to “hold a claim or patent in reserve all the way to the eve of trial”).
8. See, e.g., *Fed. R. Civ. P. 16(c)(2)(P)*; *Stamps.com Inc. v. Endicia, Inc.*, 437 F.App’x 897, 900-02 (Fed. Cir. 2011) (affirming order narrowing from 629 claims across 11 patents to 15 asserted claims); *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1310-13 (Fed. Cir. 2011) (affirming requirement that plaintiff narrow to 40 asserted claims per defendant group, and further narrowing to 16 claims per group at close of fact discovery, from 1,975 claims across 31 patents against 165 defendants from 50 defendant groups); *Memory Integrity LLC v. Intel Corp.*, No. 3:15-cv-00262-SI, Dkt. 152 at 2 (D. Or. Oct. 30, 2015) (recognizing “court’s authority to impose a limit on the number of claims” in patent litigation) (citing *Stamps.com*, 437 F.App’x at 902).

Some have questioned whether claim narrowing runs afoul of a patent owner’s due process rights. See, e.g., Sloane Kyrakis, *Statutory and Constitutional Problems with Judicially-Imposed Patent-Claim Limitations*, 28 *J. Intell. Prop. L.* 187 (2021). The Federal Circuit, however, has recognized that such limits are permissible so long as the court “le[aves] open the door for the assertion of additional claims on a showing of need.” *Stamps.com Inc. v. Endicia, Inc.*, 437 F.App’x 897, 902 (Fed. Cir. 2011); *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1312 (Fed. Cir. 2011) (no due process issue with court’s limits on asserted claims

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- where patentee made no showing “that some of its unselected claims presented unique issues as to liability or damages”).
9. *ParkerVision, Inc. v. Intel Corp.*, No. 6:20-cv-00108-ADA, Dkt. 23 (W.D. Tex. June 26, 2020).
 10. *Deere & Co. v. AGCO Corp.*, No. 1:18-cv-00827-CFC, Dkt. 72 at Ex. A (D. Del. Mar. 20, 2019).
 11. *VLSITech. LLC v. Intel Corp.*, No. 1:18-cv-00966-CFC, Dkt. 136 (D. Del. Apr. 22, 2019).
 12. *Memory Integrity, LLC v. Intel Corp.*, 2015 WL 6659674, at *3 (D. Or. Oct. 30, 2015).
 13. *Eagle Harbor Holdings, LLC v. Ford Motor Co.*, No. 3:11-cv-05503-BHS, Dkt. 186 (W.D. Wash. Nov. 25, 2013).
 14. See *Keranos, LLC v. Silicon Storage Tech., Inc.*, 2013 WL 5763738, at *4 (E.D. Tex. Aug. 5, 2013) (limit of “two or three prior art references” per claim “routine”); *Unwired Planet LLC v. Google Inc.*, 2013 WL 5592896, at *4 (D. Nev. Oct. 10, 2013) (ordering reduction in asserted claims, and noting that “[u]nlike anticipation in which a single prior art reference contains every element of the patent claim, . . . obviousness may be based on a combination of two or more prior art references, and it often is” (emphasis in original)).
 15. Courts have reasoned that narrowing after the parties have exchanged contentions and core technical documents is appropriate because, at that time, the plaintiff has had the opportunity to determine which of its claims raise distinct issues of infringement or invalidity. *Univ. of Virginia Pat. Found. v. Gen. Elec. Co.*, 2015 WL 6958073, at *6 (W.D. Va. Nov. 15, 2015); *Fleming v. Cobra Elecs. Corp.*, 2013 WL 1760273, at *3 (D. Idaho Apr. 24, 2013) (claim narrowing may be appropriate where “the plaintiff has conducted the discovery necessary to determine what claims are dispensable”).
 16. Requiring at least some narrowing prior to Markman also reduces the risk that the court will expend resources construing claim terms in claims that are not ultimately tried. See, e.g., *Universal Elecs. Inc. v. Roku Inc.*, 2019 WL 1878351, at *2 (C.D. Cal. Mar. 14, 2019) (“The weight of authority holds that claim limitation is proper prior to claim construction, particularly where defendants have already served invalidity contentions.”); *Arctic Cat, Inc. v. Polaris Indus. Inc.*, 2015 WL 3756409, at *4 (D. Minn. June 12, 2015) (“the vast majority of courts that have ordered claim reduction have done so prior to claim construction” and acknowledging that “reduction after claim construction is too late in the litigation”); *Memory Integrity LLC v. Intel Corp.*, 2015 WL 6659674, at *3 (D. Or. Oct. 30, 2015) (collecting cases); *Joao*, 2014 WL 106926, at *4 (“It would be a waste of time and resources to conduct a claim construction hearing for a multitude of claims that Plaintiff may later elect not to pursue during the claim selection process.”); *Masimo Corp. v. Philips Elecs. N. Am. Corp.*, 918 F. Supp. 2d 277, 284 (D. Del. 2013) (“[E]arly claim reduction is warranted before claim construction briefing and summary judgment motions are filed.”); *Oasis Research, LLC v. Adrive, LLC*, 2011 WL 7272473, at *2 (E.D. Tex. Sept. 13, 2011) (holding “that limiting the amount of claims asserted by Plaintiff is appropriate at this time to aid in efficiency and narrowing the claims prior to claim construction”); *Hearing Components, Inc. v. Shure, Inc.*, 2008 WL 2485426 (E.D. Tex. June 13, 2008) (ordering plaintiff to select no more than three representative claims from each patent before claim construction).
 17. *Scheduling Order for Hatch-Waxman Patent Infringement Cases*, D. Del., J. Connolly (Revised Apr. 26, 2022), at 2.
 18. *Id.* at 18.
 19. *Id.* at 2, 18.
 20. *Id.* at 22 (citing *In re Katz*, 639 F.3d at 312). The Eastern District of Texas has likewise issued a [Model] Order Focusing Patent Claims and Prior Art to Reduce Costs, which requires patentees to “assert no more than 10 claims from each [asserted] patent and not more than a total of 32 claims” by the close of claim construction discovery, and further narrowing to “no more than a total of 16 claims” before expert reports. <https://txed.uscourts.gov/sites/default/files/forms/ModelPatentOrder.pdf>. As another example, the Northern District of Illinois amended its Local Patent Rules in 2018 to require that plaintiffs limit the number of claims in their Initial Infringement Contentions and narrow further in their Final Infringement Contentions. *Local Patent R., N.D. Ill.* (Am. Oct. 26, 2018). Plaintiffs may identify “no more than 25 claims of each patent. . . [and] no more than 50 claims total” in their Initial Infringement Contentions. *Id.* at 6. In Final Infringement Contentions, plaintiffs must narrow the asserted claims to “no more than 10 claims per patent and no more than 20 claims overall.” *Id.* at 10.
 21. In 2013, the Advisory Council for the United States Court of Appeals for the Federal Circuit issued a “Model Order Limiting Excess Patent Claims and Prior Art.” <https://patentlyo.com/media/docs/2013/07/model-order-excess-claims.pdf>. The Model Order, prepared and approved by then-Chief Judge Rader of the Federal Circuit, several prominent district court judges, litigators, and law professors, was posted to the Federal Circuit Advisory Council’s web page (hosted on the Federal Circuit’s website) and then promptly removed
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and replaced with a note stating that it was “removed since the court has not sponsored or endorsed the orders. In light of the court’s determination, the advisory council should not be viewed as having sponsored

or endorsed these orders on behalf of the court.” See <https://www.jdsupra.com/post/documentViewerEmbed.aspx?fid=2748985a-ec14-4ebb-bb14-2bd6b908f0e9&height=720&width=581>.

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