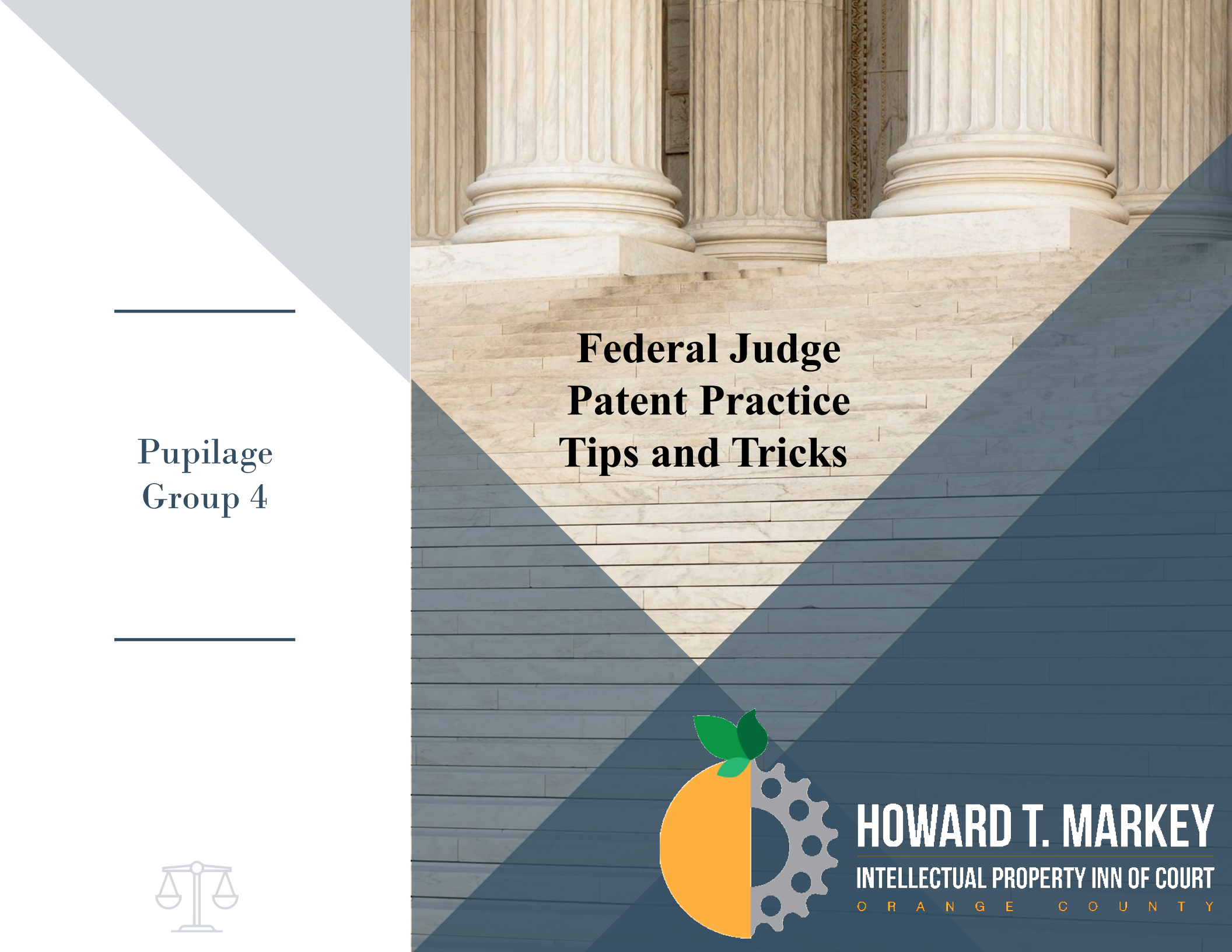
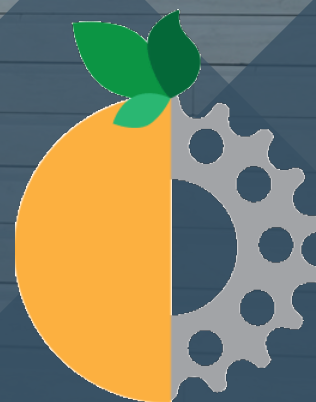

Pupilage
Group 4



Federal Judge Patent Practice Tips and Tricks



HOWARD T. MARKEY
INTELLECTUAL PROPERTY INN OF COURT
O R A N G E C O U N T Y

Panel Members

- **Hon. John W. Holcomb**, U.S. District Court Judge, Central District of California
- **Christina Rayburn**, Partner, Hueston Hennigan
- **Nancy Olson**, U.S. District Court, Patent Program Law Clerk, Central District of California
- **Katy Carlyle**, U.S. District Court, Patent Program Law Clerk, Central District of California

Markman (Pre-Hearing)

- With required disclosure of claim construction positions, are practitioners sufficiently fulfilling this obligation?
- Do you feel that claim construction issues presented for decision have been sufficiently narrowed and clarified in order to permit efficient adjudication?
- Is there anything you have learned on the bench about how to craft an effective brief that you wish you had known as a practicing attorney?

Markman (Hearing)

- What role does the Markman *hearing* play in helping you arrive at a Markman *order*?
- Looking back at your years as a practicing attorney and now on the bench, do you think Markman hearings are growing or diminishing in importance?
- Some judges like to provide tentative rulings before a Markman hearing to help focus arguments at the hearing. What is your preferred practice with regard to tentative rulings? How far in advance should parties expect to receive a tentative—during the hearing or maybe beforehand? And how should parties address the tentative during the Markman hearing?

Markman (Hearing)

- Are there any “best practices” for the Markman hearing that you think the profession could most improve upon? For example, are attorneys responsive when questions are posed? Are attorneys sufficiently selective with regard to the positions they take and defend? Are attorneys presenting arguments in an accessible manner, especially when the arguments deal with highly technical subject matter?
- Are there any “worst practices” you think the profession needs to better avoid? For example, are attorneys sufficiently prepared with regard to their command of the subject matter? Do they use the court’s time efficiently at the hearing?
- One purpose of our Inn is to educate younger practitioners. How often do you see younger attorneys arguing at Markman hearings? Is the profession doing a good job of educating their successors in this important functionality?

Markman (Tutorials)

- What role do technology tutorials play in your courtroom? What does a “good” technology tutorial look like to you?
- Do you like to see physical demonstratives of the accused products during Markman, or do you find demonstratives an unhelpful distraction from the intrinsic evidence? Why?

Motions *In Limine* ("MILs")

- Do you (or other Judges) have any preferences or specific procedures for MILs (*e.g.*, limits on the number of MILs each party can file)?
- How should parties select issues of importance for MILs?
- Is a MIL an appropriate alternative to seek to limit or exclude expert testimony that is not supported by sufficient facts or data?
- Is a MIL an appropriate alternative to seek summary judgment?
- What are some of the weaker MILs that litigants should avoid?

Summary Judgment Motions ("SJ")

- Do you (or other Judges) have any preferences or specific procedures for summary judgment motions (*e.g.*, limits on the number of motions or timing of motions)?
- Are there situations where an early SJ motion would be appropriate? If so, how can the party raise that issue with the Court?
- How should parties select issues of importance for summary judgment?
- What are some best practices for presenting the issues to permit efficient adjudication?
- What are some of the weaker summary judgment motions that litigants should avoid?

Complaint Sufficiency: Pre-Suit Knowledge

- Whoever actively induces infringement of a patent shall be liable as an infringer. 35 U.S.C. § 271(b).
- Requires knowledge that the induced acts constitute patent infringement. *Global-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766 (2011).
- What are some interesting attempts you've seen to plead pre-suit knowledge and what result?

Complaint Sufficiency: Pre-Suit Knowledge

- Should a patent owner take pre-suit action, such as sending a cease-and-desist letter, to improve the sufficiency of the pre-suit knowledge allegations?
- But what if this pre-suit action might lead to a first-filed declaratory judgement action against the patent owner?

Complaint Sufficiency: Pre-Suit Knowledge

- No remedy by civil action against a medical practitioner who infringes a patent. 35 U.S.C. §§ 281, 287(c)(1).
- If a patent owner cannot sue for direct infringement and cannot establish pre-suit knowledge, is the patent owner effectively barred from suing?

Complaint Sufficiency: Eligibility

- Determinations of patent eligibility often turn on facts and claim construction.
- Should courts first evaluate patent eligibility on the pleadings or after claim construction? What is the better approach?

Complaint Sufficiency: Eligibility

What are some best practices for:

- drafting a complaint to survive a motion to dismiss for patent ineligibility?
- drafting a motion to dismiss for patent ineligibility?
- responding to a motion to dismiss for patent ineligibility?

Complaint Sufficiency: Eligibility

- Please share some examples of interesting attempts that have come close to surviving a motion to dismiss for ineligibility but failed to do so.
- Was there anything else they could have done to survive?

Complaint Sufficiency: Eligibility

- Do you have any advice for patent drafters concerning how they might provide explanations supporting patent eligibility while minimizing the risk that those explanations lead to narrow claim constructions?

Maneuvering Before Answering

- For a motion to stay the case, would you grant a stay before a PTAB decision to institute review? Also, how much delay after filing a complaint is acceptable?
- What do you see as the most important factor to consider in a motion to transfer venue?
- Since all Rule 12(b) motions should be brought at once, how often do you see winning motions with multiple grounds?

Inequitable Conduct

- “To prevail on an inequitable conduct defense, a defendant must establish both the materiality of the withheld reference and the applicant’s intent to deceive the PTO.” *Aventis Pharma v. Hospira*, 675 F.3d 1324 (Fed. Cir. 2012).
- Inequitable conduct is often asserted early without much factual support. *Exergen* discusses the pleading standard under Rule 9(b). This sort of pleading is hard without discovery.
- Should the defense be asserted earlier with thinner facts regarding intent, or later with stronger facts?
- What are some examples of weaker inequitable conduct theories that you prefer litigants avoid?

Questions

WIKIPEDIA
The Free Encyclopedia

John W. Holcomb

John William Holcomb (born 1963)^[1] is a United States district judge of the United States District Court for the Central District of California.

Education

Holcomb was born in 1963 in Olean, New York. He attended Massachusetts Institute of Technology on a Naval Reserve Officers Training Corps scholarship, graduating in 1984 with a Bachelor of Science in civil engineering. He spent five years as an active duty military officer, then jointly attended Harvard Law School and Harvard Business School, receiving a JD–MBA in 1993. Holcomb received his law degree with cum laude honors.^[2]

Military service

Holcomb served in the United States Navy from 1980 to 1989, and he was on active duty as a commissioned officer from 1984 to 1989.^[2] His service included time as a Surface Warfare Officer aboard the battleship USS New Jersey (BB-62).

Legal career

After receiving his JD–MBA, Holcomb served as a law clerk to Judge Ronald Barliant of the United States Bankruptcy Court for the Northern District of Illinois from 1993 to 1994. From 1994 to 1997, he was an associate with Irell & Manella. He practiced intellectual property law at Knobbe Martens from 1997 to 2018. In 2019 he was briefly a sole practitioner, before joining Greenberg Gross in Costa Mesa, California, where he focused on intellectual property and bankruptcy litigation. He left Greenberg Gross after becoming a fed

Federal judicial

On September 20, 2019, P intent to nominate Holcor judge of the United States California. On November 2 Senate. President Trump n by Judge Dean Pregerson,

Donald John Trump is an American politician, media personality, and businessman who served as the 45th president of the United States from 2017 to 2021.

John W. Holcomb



Judge of the United States District Court for the Central District of California

Incumbent

Assumed office

September 18, 2020

Appointed by Donald Trump

Preceded by Dean Pregerson

Personal details

Born 1963 (age 59–60)
Olean, New York, U.S.

Education Massachusetts Institute of

ology (SB)

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28, 2016.^[3] On January 3, the President under Rule 2 of the Senate.^[4] On February 13 the Senate.^[5] On June 17, 2020, his nomination was reported to the Senate. On September 15, 2020, his nomination was reported to the Senate by a 83–13 vote, and confirmed later that day by a 83–13 vote of the Senate commission on September 15, 2020.

References

- ↑ United States Senate Committee on the Judiciary: Questionnaire for Judicial Nominees: John Holcomb ([https://www.judiciary.senate.gov/imo/media/doc/John%20Holcomb%20Senate%20Questionnaire%20\(PUBLIC\).pdf](https://www.judiciary.senate.gov/imo/media/doc/John%20Holcomb%20Senate%20Questionnaire%20(PUBLIC).pdf))
- ↑ "President Donald J. Trump Announces Judicial Nominees and United States Marshal Nominee" *White House*, September 20, 2019 (<https://trumpwhitehouse.archives.gov/presidential-actions/president-donald-j-trump-announces-judicial-nominees-united-states-marshal-nominee-5/>) ⓘ This article incorporates text from this source, which is in the public domain.
- ↑ "Nine Nominations Sent to the Senate Today", *White House*, November 21, 2019 (<https://trumpwhitehouse.archives.gov/presidential-actions/nine-nominations-sent-senate-5/>)
- ↑ "PN1298 – Nomination of John W. Holcomb for The Judiciary, 116th Congress (2019–2020)" (<https://www.congress.gov/nomination/116th-congress/1298>). *www.congress.gov*. January 3, 2020. Retrieved January 4, 2020.
- ↑ "Eleven Nominations Sent to the Senate", *White House*, February 13, 2020 (<https://trumpwhitehouse.archives.gov/presidential-actions/eleven-nominations-sent-senate-2/>)
- ↑ United States Senate Committee on the Judiciary: Nominations for June 17, 2020 (<https://www.judiciary.senate.gov/meetings/06/17/2020/nominations>)
- ↑ Results of Executive Business Meeting – July 23, 2020, Senate Judiciary Committee (<https://www.judiciary.senate.gov/imo/media/doc/Results%20of%20Executive%20Business%20Meeting%20July%2023,%202020.pdf>)
- ↑ On the Cloture Motion (Motion to Invoke Cloture: John W. Holcomb to be U.S. District Judge for the Central District of California) United States Senate, September 15, 2020 (https://www.senate.gov/legislative/LIS/roll_call_votes/vote1162/vote_116_2_00173.htm)
- ↑ On the Nomination (Confirmation: John W. Holcomb, of California, to be U.S. District Judge for the Central District of California) (https://www.senate.gov/legislative/LIS/roll_call_lists/roll_call_vote_confirmation.cfm?congress=116&session=2&vote=00175) United States Senate, September 15, 2020
- ↑ John W. Holcomb (<https://www.fjc.gov/node/8898346>) at the *Biographical Directory of Federal Judges*, a public domain publication of the Federal Judicial Center.

External links

- ↑ John W. Holcomb (<https://www.fjc.gov/node/8898346>) at the *Biographical Directory of Federal Judges*, a public domain publication of the Federal Judicial Center.
- ↑ John Holcomb ([https://ballotpedia.org/John_Holcomb_\(California\)](https://ballotpedia.org/John_Holcomb_(California))) at *Ballotpedia*



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Christina Von der Ahe Rayburn Partner

Partner

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[vCard](#)

[Print Profile](#)

Education

Harvard Law School (J.D., 2007) cum laude

Stanford University (B.A.S., 2004, Mechanical Engineering and Political Science) with distinction

Clerkships

Hon. Andrew J. Guilford, U.S. District Court for the Central District of California

Admissions

California

United States Patent and Trademark Office

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—Benchmark Litigation, 40 & Under Hot List

“A lifelong ability to translate issues that people might not understand into plain English, to explain things in simple terms.”

—Daily Journal

"A fierce advocate."

—Los Angeles Business Journal

Christy Von der Ahe Rayburn litigates high-profile, high-stakes technology disputes for companies of all sizes, including Amazon.com, Monster Energy, BlackBerry, ClearOne, and Acorn Technologies. Described by clients as “a fierce advocate” and “intensely brilliant at understanding the detail and complexity of the subject matter while retaining a clear view of the big issues and its impact on strategy,” she has a depth of experience in patent, copyright, and trade secret litigation at every stage.

Ms. Rayburn is deeply invested in her clients’ cases, paying close attention to strategic decisions at every step. According to a former colleague and retired judge, Ms. Rayburn “has a unique drive for excellence that she consistently achieves.” As a member of the patent bar and as a Stanford-trained mechanical engineer, Ms. Rayburn is quick to understand the technology at issue in her clients’ matters. More importantly, she is able to translate that technical understanding into clear and effective oral and written communications to stakeholders, judges, and juries. As co-counsel once noted, “Christy simplified the issues such that eight people in the Marshall Division of the Eastern District of Texas readily grasped why infringement was apparent.” Clients and judges alike have praised her ability to marshal the relevant facts and explain a case to them clearly and concisely.

In June 2017, Ms. Rayburn argued before the California Supreme Court, challenging California’s 2016 death penalty initiative measure (Proposition 66). Her work on that matter and others earned her the American Inns of Court 2017 Sandra Day O’Connor Award for Professional Service, presented at the United States Supreme Court.

Ms. Rayburn is a founding member of the Howard T. Markey Intellectual Property Inn of Court in Orange County, and has served that organization as its secretary, membership chair, programs chair, and member of the board. Ms. Rayburn serves as a member of the Steering Committee for the ABA Death Penalty Representation Project.

Before joining Hueston Hennigan, Ms. Rayburn was a partner at Orrick, Herrington & Sutcliffe LLP, where she represented clients such as Oracle, Foxconn, and Facebook.

Experience

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Read more

Co. Shure's Patent Invalid After Trial," *Law360*; "ClearOne Beats Rival Microphone Maker's Design Patent Claims," *Bloomberg*).

Won a \$25 million trial victory for **Acorn Semi, LLC** in a patent infringement case against Samsung relating to its semiconductor technology. (See "Samsung Hit With \$25M Semiconductor IP Verdict In EDTX," *Law360*).

As co-lead counsel, won a motion for preliminary injunction for **ClearOne Inc.** in a patent infringement suit, enjoining a large, multinational competitor's manufacture, marketing, and sale of a competing, infringing product. Then won a motion for contempt against the same competitor for releasing a new product in violation of the preliminary injunction.

Obtained summary judgment of non-infringement in favor of **Amazon.com, Inc.** against claims for patent infringement brought by serial patent litigant MasterObjects, Inc. (See "Amazon Beats Patent Claims After Alsup 'Misstated' Its Motion," *Law360*).

Show More

Obtained outright dismissal of patent infringement lawsuit asserted against **Amazon.com, Inc.** in the Western District of Texas.

Won a Federal Circuit appeal upholding a PTAB *Inter Partes Review* decision affirming the validity of a **ClearOne Inc.** patent.

Representing **Monster Energy Company** in connection with patent and trademark matters against Vital Pharmaceuticals, Inc.

Representing **Palantir Technologies** in a case involving misappropriation of trade secrets and other wrongful conduct.

Secured a victory for **BlackBerry Corp.** and **BlackBerry Ltd.** in civil extortion and unfair competition claims leveled against it by MobileIron, forcing it to pay Blackberry's legal fees and drop its lawsuit.

Obtained favorable settlement for **a leading fitness equipment company** – including admissions of patent validity, intentional copying and an agreement to immediately cease using its patented leaderboard technology – after prevailing on an *Alice* challenge and virtually every other motion. (See "Peloton, Flywheel Settle Legal Disputes Over Fitness Bike Tech," *Wall Street Journal*; "Peloton, Flywheel Agree To End Patent Fight Over Bike Tech," *Law360*).

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Represented

Oracle in its ongoing high-profile copyright litigation against Google regarding the Android operating system.

Obtained summary judgment and an attorney's fees award for **Nvidia** on claims of patent infringement related to graphics processor chips.

Won summary judgment on behalf of **Oracle** in a patent infringement case related to pharmacovigilance software.

Defended **Foxconn** and **Hon Hai** in patent infringement matter relating to electrical connectors.

Defended **Bosch**, **Foxconn**, and **Hon Hai** before the U.S. International Trade Commission in patent infringement matter relating to automotive Body Control Modules.

Represented **Brocade Communications Systems** at trial in patent infringement and trade secret misappropriation suit against A10 Networks.

Consulted **portfolio analytics company** on patent infringement matters during successful acquisition.

Defended several **joint defendants** across multiple jurisdictions in e-commerce-related patent infringement matter.

Defended **several joint defendants** across multiple jurisdiction in a second e-commerce-related patent infringement matter.

Represented plaintiff in obtaining favorable settlement of patent infringement matter relating to **sporting goods equipment**.

Obtained favorable settlement for defendant in patent infringement matter related to **flooring technology**.

Argued before the California Supreme Court in a challenge to California's Proposition 66 that achieved a favorable reinterpretation of that initiative statute.

Achieved favorable settlement for technology company in contract dispute matter.

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40 & Under Hot List, Benchmark Litigation (2021, 2022)

Key Lawyer for General Commercial Disputes, Legal 500

Named to the Southern California Rising Stars list (2018, 2020, 2021)

Leaders of Influence: Thriving in Their 40s, Los Angeles Business Journal

Activities

Steering Committee, ABA Death Penalty Representation Project

Kevin Schraven

Subject: REMINDER ABOUT THE GROUP 4 Meeting - Howard T. Markey IP Inn of Court - NEXT TUESDAY!!!!
Location: TBD - WE SHOULD HAVE A LOCATION SOON

Start: Tue 3/28/2023 6:00 PM
End: Tue 3/28/2023 8:00 PM

Recurrence: (none)

Meeting Status: Meeting organizer

Organizer: Kevin Schraven

Required AttendeesKevin Schraven; echatlynn@rcsc-ip.com; rbenson@orrick.com; ken.parker@haynesboone.com; lsavit@onellp.com; jweir@wbiplaw.com; dstein@brownrudnick.com; bill@brownwegner.com; cheryl.burgess@knobbe.com; ddaybell@orrick.com; shashi_kewalramani@cacd.uscourts.gov; tking@hueston.com; matt@lappleubell.com; Hans.p.smith@gmail.com; Spencer Ririe; dburk@law.uci.edu; kcanavera@perkinscoie.com; john.sganga@knobbe.com; benjaminlin28@gmail.com; cbright@swlaw.com; Monica.arnold@armondwilson.com; mchow@orrick.com; Christy.Lea@knobbe.com; jchern@orrick.com; eric.malmgren@knobbe.com; sfeldmann@bakerlaw.com; aflior@swlaw.com; jennak@judicategwest.com; taylor.king@wdc.com; mbrandt@leydig.com; jiaxiao.zhang@kirkland.com; jessica_hudak@edwards.com; emil@mccabeali.com; yungmoon@gmail.com; kaiya_avery@cacd.uscourts.gov; ATakouche@stradlinglaw.com; marin@cioncaip.com; johanneshsu@orrick.com; allardchu@gmail.com; Martin Carbajal; nancy_olson@cacd.uscourts.gov; bwilliamson@omm.com; John Holcomb; kasuega@crowell.com; abrody@gibsondunn.com; lindakrolop@me.com; jason.lao@haynesboone.com; hoh@omm.com; AndrewGuilford@JudicateWest.com; brian.claassen@knobbe.com; david.clark@haynesboone.com; taylorfoss@gmail.com; baraa.kahf@knobbe.com; ckempner@pandpimports.com; gliu@onellp.com; cwestin@omm.com; shanle@stradlinglaw.com; eleach@orrick.com; tsai.jennifer.c@gmail.com; james_selna@cacd.uscourts.gov; sheila.swaroop@knobbe.com; joe.re@knobbe.com; kmartinez@sidley.com; lwtower@gmail.com; crayburn@hueston.com; sbali@sycr.com; David_Carter@cacd.uscourts.gov; Bali, Salil

Optional Attendees:Joe Re; Dan Burk

Markey Inn of Court Members,

Resending to correct to Tuesday.

Pupillage Group 4 will be presenting a program on: **Federal Judge Patent Practice Tips and Tricks (e.g., panel of federal judges touching on Markman and MSJ)** this Tuesday!!!!

I will send a new meeting invite once we know where the meeting will be held. I will start collecting final RSVPS and names of guests/proxies at that time. For now, please plan to make it.

Virtual attendance will only be possible by contacting me directly by email.

Our Inn is now a Multiple Activity Provider. Given the very legal educational nature of our programs, this program will very likely be eligible for 1 hour of MCLE credit with the California Bar.

Thank you very much!

Kevin Schraven, Secretary