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Commentary on Patent Litigation Best Practices: Section 101 Motions on Patentable Subject Matter Chapter

A Project of The Sedona Conference
Working Group on
Patent Litigation Best Practices (WG10)

SEPTEMBER 2016 PUBLIC COMMENT VERSION



The Sedona Conference Commentary on Patent Litigation Best Practices: Section 101 Motions on Patentable Subject Matter Chapter

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Patent Litigation Best Practices (WG10)*

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Preface

Welcome to the Public Comment Version of The Sedona Conference Commentary on Patent Litigation Best Practices: Section 101 Motions on Patentable Subject Matter Chapter, a project of The Sedona Conference Working Group on Patent Litigation Best Practices (WG10). This is one of a series of Working Group commentaries published by The Sedona Conference, a 501(c)(3) research and educational institute dedicated to the advanced study of law and policy in the areas of antitrust law, complex litigation, and intellectual property rights. The mission of The Sedona Conference is to move the law forward in a reasoned and just way.

WG10 was formed in late 2012 under the leadership of its now Chair Emeriti, the Honorable Paul R. Michel and Robert G. Sterne, to whom The Sedona Conference and the entire patent litigation community owe a great debt of gratitude. The mission of WG10 is “to develop best practices and recommendations for patent litigation case management in the post-[America Invents Act] environment.” The Working Group consists of around 200 active members representing all stakeholders in patent litigation.

The WG10 Section 101 Motions on Patentable Subject Matter drafting team was launched in 2015, and the draft Section 101 Motions on Patentable Subject Matter Chapter was a focus of dialogue at the WG10 Midyear Meeting in Miami in May 2015 and the WG10 Midyear Meeting in Pasadena in February 2016. The editors have reviewed the comments received through the Working Group Series review and comment process. The Chapter will be regularly updated to account for future significant developments impacting this topic.

The Chapter represents the collective efforts of many individual contributors. On behalf of The Sedona Conference, I thank in particular Gary Hoffman who has graciously and tirelessly served as the Editor-in-Chief for this and all Chapters in this Commentary on Patent Litigation Best Practices, and as the Chair of WG10. I also thank everyone else involved for their time and attention during the drafting and editing process, including: Patrick M. Arenz; William Atkins; Natalie Hanlon-Leh; R. Eric Hutz; Matthew Powers; Daniel Shih; and Mark Supko.

The Working Group was also privileged to have the benefit of candid comments by several judges with extensive patent litigation experience, including the Honorable Faith S. Hochberg (ret.), who is serving as Judicial Advisor for the Section 101 Motions on Patentable Subject Matter drafting team, and the Honorable Joy Flowers Conti and the Honorable Kent Jordan. The statements in this Commentary are solely those of the non-judicial members of the Working Group and do not represent any judicial endorsement of the recommended practices.

Following the Working Group Series review and comment process described above, the Commentary is published for public comment, including in-depth analysis at Sedona-sponsored conferences. After sufficient time for public comment has passed, the editors will review the public comments and determine what edits are appropriate for the final Commentary. Please send comments to comments@sedonaconference.org, or fax them to 602-258-2499. The Sedona Conference hopes and anticipates that the output of its Working Groups will evolve into authoritative statements of law, both as it is and as it should be.

Craig W. Weinlein
Executive Director
The Sedona Conference
September 2016

Foreword

In the two years since the Supreme Court's ruling in *Alice Corp. v. CLS Bank Int'l.*, there has been a significant increase in patentability challenges under 35 U.S.C. § 101 with hundreds of rulings on § 101 motions. Procedurally, these rulings have happened at a variety of stages, with an increasing majority happening pursuant to Fed. R. Civ. P. 12 (Rule 12) motions filed at an early stage of the case and prior to a case management conference. While a majority of the decisions to date have involved whether software and business methods are patent eligible as opposed to an abstract idea, there has also been a gradual increase in challenges involving laws of nature or natural phenomena.

The Sedona Conference's Working Group 10, therefore, wanted to develop Best Practices for when and how courts should decide § 101 challenges in a post-*Alice* environment, and how counsel can assist the courts in addressing such challenges in a fair and efficient manner. This includes addressing important issues such as the need for claim construction prior to ruling on a § 101 patentability challenge, the use of representative claims, and the need for discovery or factual development. These Best Practices, along with the accompanying Proposed Standing Order, are designed to assist courts in implementing optional procedures that would, if adopted, help the court and parties to identify § 101 patentability issues that can be addressed at an early stage of a case while ensuring the decision is based on sufficient evidence and adequate process.

The editors would like to express their appreciation to the members of the drafting team and the judicial advisors for all their valuable input and thoughtful commentary. This project required a significant time commitment by everyone and involved much discussion and compromise to reach consensus on both the Chapter and the Proposed Standing Order. The resulting work product is truly a team effort.

Gary M. Hoffman
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Section 101 Motions on Patentable Subject Matter “At a Glance”

Principle No. 1 – The court should consider establishing procedures requiring the parties to notify the court whether they intend to assert a § 101 patent eligibility challenge and to assist the court in evaluating the most appropriate stage of the case to decide that challenge. 1

Principle No. 2 – The court should, where appropriate, decide motions involving § 101 patent eligibility challenges early in the litigation provided the court is able to render a decision based on sufficient evidence and adequate process. 1

Section 101 Motions on Patentable Subject Matter “At a Glance”

Best Practice 1 – A court should consider implementing a case management schedule that requires the filing of all § 101 motions as early as practicable in light of the parties’ need for a full and fair opportunity to address the matters raised and the court’s ability to streamline discovery, motion practice, and trial preparation.....3

Best Practice 2 – The court should consider conducting a hearing to determine what procedure, if any, is best suited to resolve the motion, i.e., handling the motion as a Rule 12(b)(6) or Rule 12(c) motion, as an early summary judgment motion, or otherwise, and whether the time for responding to the motion should be expanded to allow the parties to follow the procedures set forth in these Best Practices.....3

Best Practice 3 – If the court concludes that the motion should not be decided under Rule 12, then the motion should be subject to the court’s normal procedures for handling summary judgment motions.....3

Best Practice 4 – A court should consider implementing procedures governing how and when claim construction issues should be addressed as part of an early § 101 challenge. Those procedures should require the parties to meet and confer to determine if either party requests construction of particular claim terms, to present their proposed constructions, the bases therefor, and explain how those terms would be dispositive of any § 101 issues, or to submit a joint statement identifying any claim construction issues.....5

Best Practice 5 – A court should consider implementing procedures requiring the parties to identify as part of a § 101 motion whether there are representative claims and any disputes about the identification thereof. Those procedures should require the parties to meet and confer to, e.g., identify potential representative claims and determine whether there are any agreements or disagreements regarding those potential representative claims.....7

Best Practice 6 – A court should consider requiring the parties to submit a joint statement to the court identifying potential issues regarding representative claims, and consider, where appropriate, conducting a hearing (either by telephone or in person) to determine whether and how to resolve any representative claim issues.....7

Best Practice 7 – A court should consider implementing procedures requiring the parties to meet and confer upon filing of a § 101 motion to determine whether factual development will be required to decide the extent of preemption or the scope of the “inventive step.” If so, the parties should also meet and confer to identify the parties’ contentions on those two issues and submit a joint statement to the court listing their respective contentions regarding preemption or “inventive step,” the relevance of those contentions, and the discovery (fact or expert) believed to be necessary or appropriate for that issue.....9

I. Introduction

In the two years since the Supreme Court's ruling in *Alice Corp. v. CLS Bank Int'l*,¹ there has been a significant increase in patentability challenges under § 101 and around 300 rulings from district courts on § 101 motions. Procedurally, these rulings have happened at a variety of stages, with an increasing majority happening pursuant to Fed. R. Civ. P. 12 (Rule 12) motions filed at an early stage of the case and prior to a case management conference.

The following sections address best practices for when and how courts should decide § 101 patentability challenges in a post-*Alice* environment, and how counsel can assist the courts in addressing such challenges in a fair and efficient manner. These Best Practices are tied to the Proposed Standing Order Governing Proceedings Relating To Patent Claim Eligibility ("Standing Order") attached as Appendix A to this Chapter. The proposed Standing Order is designed to assist courts in implementing procedures that would, if adopted, help the court and parties to identify § 101 patentability issues that can be addressed at an early stage of a case while ensuring the decision is based on sufficient evidence and adequate process.

The Working Group developed the following overarching Principles to guide the drafting of these Best Practice recommendations.

Principle No. 1 – The court should consider establishing procedures requiring the parties to notify the court whether they intend to assert a § 101 patent eligibility challenge and to assist the court in evaluating the most appropriate stage of the case to decide that challenge.

Principle No. 2 – The court should, where appropriate, decide motions involving § 101 patent eligibility challenges early in the litigation provided the court is able to render a decision based on sufficient evidence and adequate process.

This Chapter should not be interpreted as an explicit or implicit recommendation by WG10 that § 101 motions should be resolved earlier in the case as a matter of course. The purpose of the Chapter is to provide a streamlined process whereby those § 101 challenges that are suitable for early resolution can be identified as such by the courts earlier, and then resolved more fairly and efficiently, including possibly by entering the proposed Standing Order in these cases.

¹ *Alice Corp. v. CLS Bank Int'l*, 573 U.S. ____; 134 S. Ct. 2347 (2014).

II. Case Management Procedures for Section 101 Challenges

A significant number of § 101 patentability challenges post-*Alice* have been filed at an early stage in the case, such as Rule 12 motions or early summary judgment motions. Addressing such challenges at an early stage has a number of benefits, including saving both the court and the parties time and resources if the challenge is successful. The process, when properly applied, also quickly disposes of weak patents that do not meet the statutory standards. However, despite these potential benefits, care must be taken to ensure that the desire to conserve resources does not ignore the need for sufficient evidence and adequate process. Section 101 challenges are often raised as part of a Rule 12 motion that is filed prior to a case management conference. In other instances, § 101 challenges are raised at an early stage of a case but after the initial case management conference. Thus, the timing of when to actually hear the challenge is an important consideration in evaluating early § 101 patentability challenges.

There are also other major potential issues in deciding when to address a § 101 challenge as a Rule 12(b)(6) motion, a Rule 12(c) motion, or an early summary judgment motion. These issues revolve around whether the § 101 challenge can be decided without meaningful discovery or other processes. First, the construction of some claim terms may be required as part of the § 101 analysis. Depending on the parties' positions, claim construction may be relevant to either to the extent of preemption or to define the "inventive concept" required by *Mayo*² steps one and two respectively. Second, the extent of preemption caused by enforcement of the claims, which can be relevant to step one of the *Mayo* analysis, may require factual development.³ This may require expert testimony depending on the facts of the case and contentions of the parties. Third, the "inventive concept" requirement of *Mayo* may require factual development regarding whether the remaining limitations of a claim, after removal of the "abstract idea," are sufficiently inventive (individually or in combination). This analysis may often require an assessment of the prior art and expert testimony unless the parties stipulate or the court can take judicial notice of a fact that is sufficient to resolve the question, both of which will likely be rare.⁴

² *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 566 U.S. ____; 132 S. Ct. 1289 (2012). *Mayo* set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First is a determination whether the claims at issue are directed to one of those patent-ineligible concepts. If so, there is a determination of whether the elements of each claim, both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application. This second step has been described as a search for an "inventive concept," i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent on the ineligible concept itself.

³ The law with respect to the role of preemption as a separate inquiry in a § 101 patentability analysis is still unsettled and under development. For example, in *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015), the Federal Circuit found that questions on preemption were inherent in and resolved by the § 101 analysis. That is, where a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as was the case in *Ariosa*, preemption concerns were fully addressed and made moot. While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.

⁴ The law with respect to the role of expert testimony in early § 101 patentability challenges is also unsettled and under development. As a general principle of course any identified issues of fact that would be determinative of a patent

The purpose of these Best Practices and the proposed Standing Order are to help courts and counsel identify which § 101 challenges can be resolved early in a case without prejudicing the court's ability to render a decision based on sufficient evidence and adequate process. Similarly, procedures governing issues such as how and when these motions should be treated and what record development may be necessary will also be useful.

Best Practice 1 – A court should consider implementing a case management schedule that requires the filing of all § 101 motions as early as practicable in light of the parties' need for a full and fair opportunity to address the matters raised and the court's ability to streamline discovery, motion practice, and trial preparation.

Best Practice 2 – The court should consider conducting a hearing to determine what procedure, if any, is best suited to resolve the motion, i.e., handling the motion as a Rule 12(b)(6) or Rule 12(c) motion, as an early summary judgment motion, or otherwise, and whether the time for responding to the motion should be expanded to allow the parties to follow the procedures set forth in these Best Practices.

Best Practice 3 – If the court concludes that the motion should not be decided under Rule 12, then the motion should be subject to the court's normal procedures for handling summary judgment motions.

These Best Practices, the proposed Standing Order, and the *Three Proposed Tracks for Proceedings Relating To Patent Claim Eligibility*⁵ are intended to address instances where a court wishes to use its gatekeeping function to control the flow of § 101 motions as part of docket management while recognizing the benefit of the early resolution of these issues, which in many instances are case dispositive. Some district courts have already exercised their gatekeeping function with respect to other types of motions, particularly motions for summary judgment. Those efforts are discussed in more detail in the *WG10 Commentary on Patent Litigation Best Practices: Summary Judgment Chapter*.⁶ One such example is allowing an early summary judgment motion only by leave of the court after a showing of good cause following a letter briefing process.⁷ This process could be adapted for early § 101 motions by, for example, requiring that the letters address what, if any, claim construction is

eligibility motion would properly be an issue to be left to the jury in jury cases. Some argue that any disputed issue between the parties' respective experts should constitute such a fact dispute. Others would argue that there are certain categories of disputes between experts that fall outside of the scope of a fact dispute that should be left to the jury. There are cases on both sides of the issue, and it appears to be addressed on a case-by-case basis and not based on any blanket determination.

⁵ See Appendix B. The proposed time tables may need to be modified to be consistent with existing form scheduling or standing orders.

⁶ The Sedona Conference, *Commentary on Patent Litigation Best Practices: Summary Judgment Chapter*, THE SEDONA CONFERENCE (2015), available at <https://thesedonaconference.org/publication/The%20Sedona%20Conference%20Commentary%20on%20patent%20Litigation%20Best%20Practices%3A%20Summary%20Judgment%20Chapter> [hereinafter, *Sedona WG10 Summary Judgment Chapter*].

⁷ See *id.* at Sec. II (Early Summary Judgment).

necessary and what type of process should be required for determining the § 101 motion, taking into consideration the other factors identified in these Best Practices and the proposed Standing Order.⁸

Another such example is that the court should not stay discovery on issues unrelated to early patent eligibility motions unless both parties agree the issue is dispositive.⁹

These Best Practices, etc., however, are not meant to suggest that § 101 motions should be decided before any other issues as a matter of course. Should a court conclude that the factual underpinnings of a § 101 motion are narrow enough such that it should be decided earlier, then it should do so. Otherwise, the § 101 motion should be placed on the same timetable as regular summary judgment motions.

⁸ *See id.*

⁹ *See id.* (“Best Practice 18 –The court should not stay discovery on issues unrelated to early summary judgment motions unless both parties agree the issue is dispositive.”). As noted in the *Sedona WG10 Summary Judgment Chapter*:

Once a court decides to permit an early summary judgment motion, it faces the questions whether to permit discovery related to the motion, and whether to tailor the schedule to stay all unrelated discovery or other proceedings until the motion is decided. A general rule or practice of staying an action completely before deciding an early summary judgment motion is not advised because such a standard practice would all too frequently cause prejudicial delay if the motion is denied.

Id.

III. Claim Construction Issues and Representative Claims

A. CLAIM CONSTRUCTION

The resolution of a patentability challenge pursuant to § 101 often raises the significant question of whether and when a claim construction would assist the court. While claim construction is not a mandatory component of a § 101 analysis under *Alice*, the Federal Circuit has nonetheless cautioned that it may be “desirable—and often necessary—to resolve claim construction disputes prior to a § 101 analysis, for the determination of patent eligibility requires a full understanding of the basic character of the claimed subject matter.”¹⁰ Thus, the following Best Practices and the proposed Standing Order are intended to aid the court and counsel in determining whether a particular § 101 motion requires a claim construction, what term(s) should be construed, and when to consider that issue in relation to the § 101 analysis.

Best Practice 4 – A court should consider implementing procedures governing how and when claim construction issues should be addressed as part of an early § 101 challenge. Those procedures should require the parties to meet and confer to determine if either party requests construction of particular claim terms, to present their proposed constructions, the bases therefor, and explain how those terms would be dispositive of any § 101 issues, or to submit a joint statement identifying any claim construction issues.

District courts have taken different approaches in addressing claim construction as part of a § 101 challenge, particularly in response to Rule 12 motions or early summary judgment motions. Some courts have, under the right circumstances, carried out the § 101 analysis without claim construction where consideration of the patent, along with *Alice*'s guidance that claims that merely require generic computer implementation do not encompass patentable subject matter, made it sufficiently clear that the court could forego a claim construction analysis. Other courts have proceeded without claim construction where neither party sought claim construction. Other courts have addressed claim construction by simply accepting the patentee's proposed construction for purposes of the motion.¹¹

¹⁰ Bancorp. Servs., LLC v. Sun Life Assurance Co. of Canada, 687 F.3d 1266, 1273–74 (Fed. Cir. 2012).

¹¹ For cases where a court found claims to be invalid without claim construction, see *Everglades Game Techs., LLC v. Supercell, Inc.*, 2015 WL 4999654 (D. Del. Aug. 21, 2015) (holding that the patent provided sufficient guidance for the court to determine that it was directed to an abstract idea, avoiding claim construction). For cases where a court granted a Rule 12 motion where neither party sought claim construction, see *CyberFone Sys., LLC v. CNN Interactive Grp.*, 558 F. App'x 988, 992 (Fed. Cir. 2014) (holding that a patent claim was invalid under § 101 where the district court did not engage in claim construction, and where the plaintiff “d[id] not explain which terms require construction or how the analysis would change”); *Open Text S.A. v. Alfresco Software Ltd.*, 2014 WL 4684429, at *3 (N.D. Cal. Sept. 19, 2014) (finding that the parties' failure to argue claim construction confirmed to the court that it was unnecessary to engage in it before addressing § 101); *Loyalty Conversion Sys. v. Am. Airlines, Inc.*, 2014 WL 4364848, at *4 (E.D. Tex. Sep. 3, 2014) (granting motion for judgment on the pleadings where “there [were] no

Notwithstanding these approaches, there are also myriad cases that have denied early § 101 challenges because they raise claim construction issues. These motions are often denied where (1) “there are possible constructions of key claim terms that, if adopted, could render the claims subject matter eligible,” (2) “the factual record is not yet sufficiently developed, such that the general character of a patent and its limitations are unclear;” or (3) “the dispute concerns broader questions of the patent’s character.”¹²

These Best Practices and the proposed Standing Order are designed to help address how claim construction issues should be evaluated in the context of an early § 101 challenge and whether those issues are such that the court and parties would be better served by deferring the § 101 challenge to a later stage in the case. For example, courts could require the parties to conduct a meet and confer to identify the term(s) that require construction, their respective proposed constructions, and how those terms would be dispositive of any § 101 issues. This meet and confer could then be followed by a joint statement to the court listing any term proposed for construction, the parties’ respective proposed constructions and the bases therefor, and a statement by each party about the impact of the proposed constructions on the § 101 issues in the motion and what evidence is needed to resolve the construction. In addition, a court should consider conducting a hearing (either by telephone or in person) to determine whether and how to resolve those claim construction issues as part of the briefing process. Similarly, when claim construction and a § 101 challenge are being considered at the same time, counsel should consider, where appropriate, requesting a consolidated oral argument on any claim construction and § 101 issues. Where feasible and appropriate, a court should hold such a consolidated oral argument.

In some instances, the § 101 patentability challenge may raise only a small subset of claim construction issues that would otherwise have to be resolved as part of a full claim construction analysis. Where this is the case, the court may want to address that subset prior to a full claim construction to be efficient and resolve appropriate § 101 patentability challenges at an early stage in the case.

disputed issues of claim construction that would affect the proper analysis of the patentability of the asserted claims, and no other issues of fact that [were] material to the section 101 question”); *Cogent Med., Inc. v. Elsevier Inc.*, 70 F. Supp. 3d 1058, 1062 (N.D. Cal. 2014) (finding that claim construction was not necessary before ruling on motion to dismiss). For cases where a court accepted the patentee’s proposed construction, see *Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1349 (Fed. Cir. 2014) (affirming dismissal at the pleading stage, noting that “even when construed in a manner most favorable to the patentee, none of the patentee’s claims amount to significantly more than the abstract idea”); *Gammino v. AT&T Co.*, 2015 WL 5234028, at *2 (D. Del. Sept. 8, 2015) (granting Rule 12(c) motion by accepting the plaintiff’s construction for purposes of analysis); *Genetic Techs. Ltd. v. Lab. Corp. of Am.*, 2014 WL 4379587, at *5–6 (D. Del. Sept. 3, 2014) (granting motion to dismiss where even under the plaintiff’s construction the claim was invalid); *Gametec LLC v. Zynga, Inc.*, 2014 WL 1665090, at *3 (N.D. Cal. Apr. 25, 2014) (“When a § 101 motion is brought, as here, before formal claim construction, the court will adopt the patentee’s proffered construction.”).

¹² See *Boar’s Head Corp. v. Direct Apps., Inc.*, 2015 WL4530596, at *7 (E.D. Cal. July 27, 2015). See also *Execware, LLC v. B.J.’s Wholesale Club Inc.*, 2015 WL5734434, at *3 (D. Del. Sept. 30, 2015) (denying motion due to need for claim construction and directing any renewed motion to be filed “only after the parties have been afforded an opportunity to take discovery related to any factual issues that may affect the § 101 inquiry”); *Phoenix Licensing LLC v. Century Link, Inc.*, 2015 WL5786582 (E.D. Tex. Sept. 30, 2015) (denying motion to dismiss where claim construction was essential to resolution of scope of patents).

B. REPRESENTATIVE CLAIMS

One aspect of a § 101 determination that may benefit from the development and adoption of best practices and the proposed Standing Order is the use of representative claims. The use of representative claims as a proxy for a claim-by-claim analysis of patent eligibility is a well-accepted practice, and indeed in many cases it is a practical necessity. In a litigation involving multiple patents, each of which may have anywhere from a handful to hundreds of different claims, typically there is neither sufficient time nor sufficient briefing pages available to undertake a thorough analysis of patentability with respect to each and every claim. Yet even though this practice has been used quite often, it is not always free of controversy. Thus, the following Best Practices and proposed Standing Order are intended to aid the court and counsel addressing the representative claim issue in an efficient and timely manner.

Best Practice 5 – A court should consider implementing procedures requiring the parties to identify as part of a § 101 motion whether there are representative claims and any disputes about the identification thereof. Those procedures should require the parties to meet and confer to, e.g., identify potential representative claims and determine whether there are any agreements or disagreements regarding those potential representative claims.

Best Practice 6 – A court should consider requiring the parties to submit a joint statement to the court identifying potential issues regarding representative claims, and consider, where appropriate, conducting a hearing (either by telephone or in person) to determine whether and how to resolve any representative claim issues.

Like claim construction, district courts have taken different approaches in addressing the issue of representative claims in the context of early § 101 motions. The easiest case is when the parties agree both on the use of representative claims and on which claims are representative. Notwithstanding the potential risk that each side faces by putting all of their validity eggs in one proverbial basket, the parties will often be motivated by efficiency considerations to reach agreement on the representative claims on which the § 101 determination will be made as to all asserted claims. Likewise, in the interests of judicial economy, district courts often strongly encourage the parties to agree on representative claims when a facially legitimate § 101 defense has been raised. Conversely, a failure of the parties to agree on representative claims may negatively influence a district court's willingness to take up the § 101 issue early in the case, particularly where there is a relatively large number of asserted claims.

The more challenging case is when the parties disagree about the use of representative claims, in which case the district court must grapple with the question of whether it is advisable, or even permissible, to order the use of representative claims for the § 101 analysis. The law is clear that patent validity must be determined on a claim-by-claim basis, and consequently there may be due process concerns if a district court were to mandate the use of representative claims. On the other hand, various district courts, such as the Eastern District of Texas, now routinely require the plaintiff to limit the number of claims being asserted in a case (with a corresponding requirement that the defendant(s) limit the number of prior art references being relied upon). Such claim limiting

orders would appear to raise the same concerns as mandating the use of representative claims for § 101 purposes, and the authors are not aware of such an order being stricken down on due process grounds.

If a district court decides to order the use of representative claims over a party's objection, the judge should take particular care to ensure that the selected claims are indeed fairly representative of the other asserted claims. For instance, it may be advisable to select at least one of each type of asserted claim (e.g., system, method, means-plus-function), though there may be instances where the limitations in corresponding system and method claims are sufficiently analogous that one type of claim may be sufficiently representative of both. The court should also attempt to ensure that all significant, potentially "non-abstract" limitations are fairly reflected in the representative claims such that the selected claims adequately support consideration of key elements both individually and as an ordered combination. Although the question of whether certain claims are indeed representative of the other asserted claims would appear to be an issue of law, the court may wish to encourage—or at least not discourage—the submission of evidence from the parties, such as declarations of experts or persons of ordinary skill in the art, to assist in identifying the representative claims. Finally, a court should take care to document the basis for the selection of the representative claims in sufficient detail to enable appellate review.

These Best Practices and proposed Standing Order are designed to help address whether there are any particular issues regarding the use of representative claims in the context of an early § 101 challenge and whether those issues are such that the court and parties would be better served by deferring the § 101 challenge to a later stage in the case. This process can be assisted by requiring the parties conduct a meet and confer to discuss the representative claim issue, including the claims that the parties agree are representative, any disagreement regarding potential representative claims, and the reasons for that disagreement. This meet and confer could be followed by a joint statement by the parties identifying this information and, where appropriate, followed by a hearing (either by telephone or in person). This hearing should, where appropriate, be combined with a hearing to resolve any potential claim construction issues prior to a *Markman* hearing.

IV. Need for Discovery or Factual Development

As litigants and district court judges continue to grapple with the substantive and procedural implications of the evolving law on patent eligibility, it appears likely that additional factual development or expert testimony will play an increasing role in § 101 challenges. The following Best Practices and the proposed Standing Order are intended to address these issues.

Best Practice 7 – A court should consider implementing procedures requiring the parties to meet and confer upon filing of a § 101 motion to determine whether factual development will be required to decide the extent of preemption or the scope of the “inventive step.” If so, the parties should also meet and confer to identify the parties’ contentions on those two issues and submit a joint statement to the court listing their respective contentions regarding preemption or “inventive step,” the relevance of those contentions, and the discovery (fact or expert) believed to be necessary or appropriate for that issue.

Substantively, the different aspects of the analytical framework articulated by the Supreme Court in *Alice* (as first set forth in *Mayo*) lend themselves to expert evidence and fact discovery to varying degrees. In fact, some would appear to require such evidentiary support in all but the most straightforward cases.

The first step of the analysis, which requires determining whether a claim at issue is directed to a law of nature, natural phenomenon, or abstract idea,¹³ is arguably the least amenable to expert testimony or fact discovery. The vast majority of post-*Alice* § 101 decisions have dealt with claims that are allegedly directed to abstract ideas as opposed to other forms of non-patentable subject matter; and in addressing the “abstract idea” issue the courts generally appear to adopt an approach akin to Justice Stewart’s famous “I know it when I see it” obscenity standard, or compare the alleged “abstract idea” at issue with what was found to be abstract in an earlier case. So while it is certainly conceivable that fact discovery or expert testimony could be relevant, this issue seems unlikely to need such discovery or be the subject of conflicting expert testimony in the majority of cases.¹⁴

By contrast, the second step of the analysis, which looks at whether a disputed claim recites an “inventive concept” sufficient to ensure that the claim “amounts to significantly more than a patent upon the [patent ineligible concept] itself,”¹⁵ is replete with issues of the type that would benefit from at least some factual or expert support. For instance, factual evidence or expert testimony may be highly relevant on the issue of whether additional elements in a claim are themselves “inventive”

¹³ *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2355 (2014).

¹⁴ As noted in footnote 4, *supra*, the law regarding this issue is unsettled and under development.

¹⁵ *Id.*

rather than “obvious, already in use, or purely conventional,”¹⁶ much like is commonly done in the context of anticipation and obviousness defenses based on the prior art. Similarly, fact discovery or expert testimony may be useful for determining whether a claim “wholly preempts” or “monopolizes” the use of a patent-ineligible abstract idea, law of nature, or natural phenomenon, as such a determination would seem to require evidence regarding the extent to which the challenged claim does or does not encompass applications or uses other than those to which the patent at issue is directed. To be sure, many of the post-*Alice* decisions appear to gloss over the evidentiary support for such “inventive concept” determinations, but it would appear to be the rare case in which disputes over such issues can properly be determined based only on the contents of the challenged patent and the parties’ pleadings.

Further, expert testimony may play a role in claim construction as to whether certain claims are representative, which is a threshold issue that is often confronted in the context of § 101 challenges, particularly when presented in the context of a motion to dismiss or motion for judgment on the pleadings. Courts vary in their receptiveness to expert testimony on disputed claim construction issues, but most will at least permit the parties to introduce such “extrinsic evidence” even if the court is unlikely to ultimately rely on it.

If factual development is required to decide the extent of preemption or the scope of the “inventive step,” the parties should meet and confer and exchange Ineligibility Contentions identifying the parties’ contentions on those two issues and submit a joint statement to the court listing their respective contentions regarding preemption or “inventive step,” the relevance of those contentions, and the discovery (fact or expert) believed to be necessary or appropriate for that issue. For a proposed listing of information that should be included in the parties’ Ineligibility Contentions, *see* Appendix A: Proposed Standard Order, Sect. A-1-3. (Eligibility Proceedings Initial Conference—Content) and Sect. A-2. (Ineligibility Contentions).

¹⁶ *Mayo Collaborative Servs. v. Prometheus Labs, Inc.*, 132 S. Ct. 1289, 1299 (2012).

Appendix A: Proposed Standing Order Governing Proceedings Relating To Patent Claim Eligibility

A-1. Challenges to Eligibility of Patent Claims

This Standing Order addresses the procedures governing challenges to or affirmations¹⁷ of the subject matter eligibility of the claims of a United States Patent under 35 U.S.C. § 101. These challenges or affirmations may be asserted (a) pursuant to Fed. R. Civ. P. 12(b)(6) by parties that have not yet answered in a suit, (b) pursuant to Fed. R. Civ. P. 12(c) by parties that may have answered in a suit, or (c) pursuant to Fed. R. Civ. P. 56 by parties that have conducted an adequate amount of discovery in a suit. These procedures are designed to permit the earliest resolution of such § 101 challenges while still providing the Court with sufficient information to resolve them appropriately.

Therefore, it is **ORDERED** that in all cases assigned to _____, the following procedures will govern any challenges to the subject matter eligibility of the claim of any United States Patent wherein any party seeks expedited or advanced consideration of the issue pursuant to Fed. R. Civ. P. 12(b)(6) or pursuant to Fed. R. Civ. P. 12(c).

A-1-1. Parties That Must Comply with This Standing Order

Any party that intends to move under Fed. R. Civ. P. 12(b)(6) or 12(c) to challenge or affirm the eligibility of any claim of any United States Patent pursuant to 35 U.S.C. § 101 or to address another party's challenge or affirmation must strictly observe the procedures set forth in this Standing Order.

If any party has filed and served a fully-compliant Notice of Intent to Challenge Eligibility of Patent Claims, all parties must observe the procedures set forth in this Standing Order.

A-1-2. Notice of Intent to Resolve Eligibility of Patent Claims Required

Notice Required As Early As Practicable. Parties are required, through the procedures set forth in this section, to notify the Court as early as practicable of their intentions to challenge or

¹⁷ WG10 considered whether or not this Proposed Standing Order should be directed only at the procedures governing motions by the accused infringer challenging patent subject matter eligibility, or whether it should also be directed at motions by the patent owner seeking affirmation of patent subject matter eligibility. In general, the patentee is unlikely to ask for early consideration on this issue if there were a significant risk of losing such a motion, so the chances of streamlining the case by early consideration are less than they are likely to be if the accused infringer is pressing for early consideration on this issue. In the event, however, that the patentee can make a solid case for early consideration on the issue of patent subject matter eligibility and why such early resolution would be case dispositive or significantly case narrowing, then it should be within the court's discretion to allow for this possibility in its case scheduling and determining the timing that is most appropriate in terms of fairness and judicial economy. This Proposed Standing Order is drafted accordingly.

seek affirmation of the eligibility under 35 U.S.C. § 101 of any claim of any United States Patent. Parties are further required, through the procedures set forth in this section, upon receiving a Notice of Intent to Resolve Eligibility of Patent Claims, to exchange as early as practicable either or both of (a) time and place information and/or (b) time and teleconference information, wherein the parties are available to confer in order to facilitate the earliest possible scheduling of a conference among the parties regarding the challenge or affirmation of the eligibility of claims of a United States Patent.

No party may, without leave of Court or a superseding order, file a motion challenging the eligibility of any claim of any United States Patent until (i) it has served all other parties with a Notice of Intent to Resolve Eligibility of Patent Claims that complies with this Standing Order and (ii) the later of:

- (a) twenty-one days after the date of service on all parties of a fully-compliant Notice of Intent to Resolve Eligibility of Patent Claims;
- (b) fourteen days after the date that all parties have either conferred in response to the Notice of Intent to Resolve Eligibility of Patent Claims or served a written response waiving the right to participate in the conference; or
- (c) seven days after the date that all parties have been served with Ineligibility Contentions pursuant to this Standing Order.

Form and Content of Notice. A Notice of Intent to Resolve Eligibility of Patent Claims will not comply with this Standing Order unless it (i) identifies each claim of each United States Patent whose eligibility will be resolved in a motion under Fed. R. Civ. P. 12(b)(6), 12(c), or 56; (ii) identifies both (a) time and place information and (b) time and teleconference information wherein the noticing party's counsel is available to Meet and Confer during the seven days after the date of service on all parties of the otherwise, fully-compliant Notice of Intent to Resolve Eligibility of Patent Claims; and (iii) identifies the noticing party's initial positions regarding:

- (a) the necessity of claim construction for resolving claim eligibility;
- (b) which challenged claims should be treated as representative claims;
- (c) the necessity of opinion evidence, including expert testimony, for resolving claim eligibility; and
- (d) the necessity, scope, and proposed schedule for any discovery for resolving claim eligibility.

A-1-3. Eligibility Proceedings Initial Conference

Timing. Any party receiving a Notice of Intent to Resolve Eligibility of Patent Claims must either (i) waive its conference rights by serving an affirmative written notice to all parties of its intent not to participate in the Eligibility Proceedings Initial Conference or (ii) confer with the noticing party in person—or via teleconference—at the earliest practicable time.

The parties are expected to cooperate in the scheduling of the Eligibility Proceedings Initial Conference. No party may unreasonably delay in scheduling the Eligibility Proceedings Initial Conference. A party's failure to respond to a timely and fully-compliant Notice of Intent to Resolve the Eligibility of Patent Claims is a waiver of its conference rights under this provision.

Participation. The noticing party must participate in the Eligibility Proceedings Initial Conference; all other parties that have not waived their right to participate must also participate.

Content. The parties are expected to discuss their initial positions on, and in good faith attempt to come to agreement as to:

- (a) the necessity of claim construction for resolving claim eligibility;
- (b) which pertinent claims should be treated as representative claims for purposes of the ineligibility proceedings, such that a determination of the eligibility of a representative claim is sufficient to determine the eligibilities of each non-representative claim for which the representative claim is deemed representative;
- (c) the necessity of expert testimony for resolving claim eligibility;
- (d) the necessity, scope (including proposed interrogatories, requests for production, requests for admission, and deposition notices), and proposed schedule for any discovery for resolving claim eligibility;
- (e) a proposed deadline for the service of Ineligibility Contentions;
- (f) proposed deadlines for any briefing;
- (g) whether the Court should resolve the eligibility of the pertinent claims (1) at a time relative to the service of the initial complaint when the Court customarily decides motions challenging the pleadings brought under Fed. R. Civ. P. 12, (2) at a time relative to the service of the initial complaint when the Court customarily decides motions for summary judgment brought under Fed. R. Civ. P. 56, or (3) at a time during which discovery is underway, on an expedited basis relative to the time this Court customarily decides motions for summary judgment brought under Fed. R. Civ. P. 56; and
- (h) for each representative claim and for each pertinent claim for which there is no other claim representative of it, confer regarding the factual and legal bases for their respective positions on the eligibility or ineligibility of the claim, including:
 - (i) each abstract idea, natural phenomenon, or law of nature identified by the party serving Ineligibility Contentions the basis for that party's contention that the abstract idea, natural phenomenon, or law of nature is preempted by the claim, and the basis for the opposing party's response to the identification of abstract ideas, natural phenomenon or law of nature;

(ii) each inventive concept distinguishing the claim from the abstract ideas, natural phenomena, or laws of nature identified by the party serving Ineligibility Contentions; and

(iii) each claim term whose construction is material to determining (a) whether the claim preempts an identified abstract idea, natural phenomenon, or law of nature or (b) whether an inventive concept distinguishes the claim from an identified abstract idea, natural phenomenon, or law of nature.

The parties must, in good faith, attempt to reach agreements regarding the scope of the identified abstract ideas, natural phenomena, laws of nature, and inventive concepts over which the parties conferred.

A-1-4. Eligibility Proceedings Joint Initial Conference Statement

The parties that have participated in the Eligibility Proceedings Initial Conference must jointly serve on all parties and jointly file with this Court a written statement identifying:

- (a) the parties' agreed and disputed positions on the necessity of claim construction in connection with the eligibility proceedings;
- (b) the parties' agreed and disputed positions as to which pertinent claims should be treated as representative claims for purposes of resolving eligibility;
- (c) the parties' agreed and disputed positions on the necessity of expert testimony in connection with the eligibility proceedings;
- (d) the parties' agreed and disputed positions on the necessity of any discovery for resolving claim eligibility, including positions as to the schedule of such discovery, including positions as to the scope of such discovery, and including proposed interrogatories, requests for production, requests for admission, and depositions;
- (e) the parties' agreed and disputed positions on the deadlines for:
 - (i) service of Ineligibility Contentions;
 - (ii) service of proposed constructions of Claim terms (if any); and
 - (iii) service and filing of briefs;
- (f) the parties' agreed and disputed positions on proposed schedules for a hearing in connection with the eligibility proceedings;
- (g) the parties' agreed and disputed positions on the preferred time relative to the service of the initial complaint for the Court to resolve the eligibility of the pertinent claims; and
- (h) all other related, material issues that would affect the scheduling of the deadlines and timing of events in connection with the eligibility proceedings.

A-1-5. Proposed Eligibility Proceedings Scheduling Order

The parties must jointly serve and file, along with the Eligibility Proceedings Joint Initial Conference Statement, proposed orders for this Court to enter that will govern the eligibility proceedings, formatted such that the portions of the Order resolving the parties' disputed positions may be either expressly endorsed, expressly denied, or impliedly denied by the Court.

See **Attachment A** for sample formatting.

The Court is not obligated to adopt agreed positions as to any aspect of the Proposed Eligibility Proceedings Scheduling Order.

A-1-6. Entry of Eligibility Proceedings Scheduling Order

The Court will enter an order that will govern the eligibility proceedings. In all cases, parties moving to challenge (or responding to a motion to affirm) the eligibility of any claim of a United States Patent will be responsible for serving ineligibility contentions as governed by this Standing Order. If the Court orders that claim construction is appropriate in connection with the eligibility proceedings, then such claim construction will be governed by this Standing Order. If the Court orders that discovery is appropriate in connection with the eligibility proceedings, then such discovery will be governed by this Standing Order. If the Court orders that opinion evidence, such as expert declarations, is appropriate in connection with the eligibility proceedings, then the admissibility and challenges thereto of such evidence will be governed by this Standing Order.

A-2. Ineligibility Contentions

Any party moving to challenge, or responding to a motion to affirm, the eligibility of a claim of a United States patent must serve fully-compliant Ineligibility Contentions to all parties in the litigation in accordance with this Standing Order. The courts may consider whether to require service of Ineligibility Contentions after the entry of the Eligibility Contentions Scheduling Order, or to require them earlier to provide a basis for a more meaningful and detailed meet and confer about eligibility in the A-1-3 Eligibility Proceedings Initial Conference.

A-2-1. Service of Ineligibility Contentions

The party serving Ineligibility Contentions must serve on all parties a set of written contentions that, for each representative claim and for each pertinent claim for which there is no other claim representative of it, set forth the serving party's position as to:

- (a) each abstract idea, natural phenomenon, and law of nature identified by the party serving Ineligibility Contentions and the basis for contending that the abstract idea, natural phenomenon, and law of nature is preempted by the claim;
- (b) for each abstract idea, natural phenomenon, and law of nature identified by the party serving Ineligibility Contentions, whether the parties were able to reach an agreement as to its scope and, if not, the nature of the disagreement as to scope;
- (c) for each abstract idea, natural phenomenon, and law of nature identified by the party serving Ineligibility Contentions, the sources of evidence on which the party intends to rely in support of its positions as to scope and as to the propriety of classifying any identified abstract idea as an abstract idea, the propriety of classifying any identified natural phenomenon as a natural phenomenon, and the propriety of classifying any identified law of nature as a law of nature;
- (d) the nature of the disagreement regarding whether the claim is distinguished from the identified abstract ideas, natural phenomena, and/or laws of nature by any inventive concept; and
- (e) each claim term whose construction the party serving Ineligibility Contentions believes may be material to determining (a) whether the claim preempts an identified abstract idea, natural phenomenon, or law of nature or (b) whether an inventive concept distinguishes the claim from an identified abstract idea, natural phenomenon, or law of nature.

Ineligibility Contentions must contain a Certificate of Conference at the time of service in order to comply with this Standing Order.

A-3. Claim Construction Contentions

A-3-1. Exchange of Proposed Terms and Claim Elements for Construction

If the Court's Eligibility Proceedings Scheduling Order permits dedicated claim construction in connection with the eligibility proceedings, then in accordance with the Eligibility Proceedings Scheduling Order, each party must promptly serve on all parties a written communication that identifies the claim terms it proposes for construction in connection with the eligibility proceedings.

A-3-2. Exchange of Proposed Claim Constructions and Extrinsic Evidence

Within seven days after the date on which claim terms proposed for construction have been served by the parties, each party must serve on all parties a written communication that identifies its proposed construction of each claim term proposed by any party for construction in connection with the eligibility proceedings and that identifies all extrinsic evidence in support of its proposed constructions.

A-3-3. Joint Claim Construction

Within seven days after the date on which proposed constructions have been served by the parties, the parties must file a written statement to the Court identifying each party's proposed construction of each term that has been proposed for construction in connection with the eligibility challenge. The parties will be expected to engage in good faith efforts to reduce the number of disputes regarding the construction of claim terms, and are permitted to stipulate to proposed constructions solely for the purpose of resolving the eligibility challenge, without prejudice to any party's right to propose alternative constructions of claim terms for purposes unrelated to the eligibility challenge.

A-3-4. Disputed Claim Construction Issues

For those terms whose constructions are disputed, the parties are permitted to submit briefing in support of their proposed constructions and in opposition to other parties' proposed constructions, but must do so in the same filing wherein merits are argued.

A-4. Ineligibility Discovery

A-4-1. Discovery Pertaining to Claim Construction

If the Court's Eligibility Proceedings Scheduling Order permits discovery in connection with claim construction, the parties must serve written discovery and deposition notices sufficiently in advance of the deadline set forth in the Eligibility Proceedings Scheduling Order. Parties receiving discovery requests in connection with claim construction issues relating to the eligibility challenge are obligated to timely respond irrespective of whether the parties have conferred under Fed. R. Civ. P. 26. The parties must meet and confer in good faith to resolve any discovery disputes prior to the filing of any motion to compel discovery.

A-4-2. Discovery Pertaining to Opinion Evidence

If the Court's Eligibility Proceedings Scheduling Order permits discovery in connection with opinion evidence including expert testimony, the parties must serve written discovery and deposition notices promptly and sufficiently in advance of the deadline set forth in the Eligibility Proceedings Scheduling Order. Parties receiving discovery requests in connection with opinion evidence relating to the eligibility challenge are obligated to timely respond irrespective of whether the parties have conferred under Fed. R. Civ. P. 26.

A-4-3. Expert Declarations Must Be Exchanged

If any party will be relying on an expert opinion in connection with an eligibility challenge, a declaration setting forth such opinions must be served on all parties on or before the date specified in the Court's Eligibility Proceedings Scheduling Order.

A-5. Evidence in Ineligibility Proceedings

All evidence relied upon in connection with the eligibility challenge must be admissible under the Federal Rules of Evidence.

A-5-1. Challenges to Opinion Evidence

Parties may request that this Court exclude from consideration in connection with the eligibility challenge any opinion that is not admissible, but the request must be made in the same filing wherein claim construction and merits are argued.

A-6. Hearing and Decision on Ineligibility Challenge

A-6-1. Substantive Briefing Schedule Strictly Enforced

The parties must commence substantive briefing relating to the ineligibility challenge sufficiently in advance of the deadline specified in the Ineligibility Challenge to permit all parties the benefit of the maximum number of days allowed to research, draft, serve, and file responsive and reply briefing. A party challenging the eligibility of a claim of a United States Patent who fails to timely commence substantive briefing will be deemed to have waived its rights under Fed. R. Civ. P. 12(b)(6) and 12(c) with respect only to the instant eligibility proceedings and will need to pursue the instant eligibility proceedings under Fed. R. Civ. P. 56, if at all, and will be further deemed to have waived the opportunity under this Standing Order to have this Court consider eligibility on an expedited basis under Fed. R. Civ. P. 56.

No party challenging the eligibility of a claim of a United States Patent may assert a position that was not previously and timely disclosed in its Ineligibility Contentions.

A-6-2. Hearing

The Court at its option and its convenience will notice a hearing on the issues that have been briefed in connection with the eligibility challenge. If testimony and evidence must be considered in connection with the eligibility challenge, the noticed hearing will be an evidentiary hearing. The parties may, on an agreed basis, elect to have the issue decided without a hearing if the parties agree that the Court need not hear any testimony.

A-6-3. Decision

The Court will consider the arguments and admissible evidence of all parties. The Court will issue an order granting, in full or in part, or denying, in full or in part, the motions pertaining to the eligibility of claims of United States Patents. The Court may resolve claim construction issues if the Court deems such resolution necessary to reach any conclusions concerning the eligibility of claims of United States Patents. The Court may resolve issues relating to the admissibility of evidence if the Court deems resolution of such issues necessary to reach any conclusions concerning the eligibility of claims of United States Patents.

Attachment A

Below are examples of the sufficient formatting in a Proposed Order for Court resolution of the disputed aspects of eligibility proceedings, with examples of the Court's input in boldface.

Limited discovery in connection with this eligibility challenge has been requested by at least one party to this litigation, and this request for limited discovery will be [**X**] GRANTED only in connection with claim construction, [] GRANTED only in connection with expert testimony, [] GRANTED in connection with both claim construction and expert testimony, [] DENIED.

At least one party to this litigation has requested that this Court consider for purposes of this eligibility challenge Claim 1 of U.S. Patent No. 5,443,036 to be a Representative Claim for claims 2, 3, and 4 of U.S. Patent No. 5,443,036, and this request will be [**X**] GRANTED, [] DENIED.

Appendix B: Three Proposed Tracks for Proceedings Relating to Patent Claim Eligibility

	Rule 12 Track	Expedited Rule 56 Track	Conventional Rule 56 Track	File?
Complaint	Day 0	Day 0	Day 0	Yes
Notice	Before Day 21	Before Day 21	Before/During Discovery	Yes
Initial Conference	Notice + 7 Days (Before Day 28)	Notice + 7 Days (Before Day 28)	Notice Date + 7 Days	N/A
Joint Statement with Proposed Order	Notice + 14 Days (Before Day 35)	Notice + 14 Days (Before Day 35)	Notice + 14 Days	Yes
Pre-Exchange Conference	Order + 7 Days (Before Day 42)	Order + 14 Days (Before Day 49)	Order + 21 Days	N/A
Ineligibility Contentions	Order + 14 Days (Before Day 49)	Order + 21 Days (Before Day 56)	Order + 42 Days	No
Proposed Terms for Construction	Order + 3 Days (Before Day 38)	Order + 21 Days (Before Day 56)	Order + 56 Days	No
Proposed Constructions	Order + 7 Days (Before Day 42)	Order + 35 Days (Before Day 70)	Order + 77 Days	No
Joint Claim Constructions	Order + 10 Days (Before Day 45)	Order + 42 Days (Before Day 77)	Order + 91 Days	Yes
Expert Decl.	Order + 14 Days (Before Day 49)	Order + 35 Days (Before Day 70)	Order + 77 Days	No
Close of § 101 Discovery	N/A	Order + 70 Days (Before Day 105)	Per Rule 16(b) Order	N/A
Opening Brief	Order + 21 Days (Before Day 56)	Order + 77 Days (Before Day 112)	Per Rule 16(b) Order	Yes
Responsive Brief	Order + 42 Days (Before Day 77)	Order + 98 Days (Before Day 133)	Brief + 21 Days	Yes
Reply Briefing	Order + 56 Days (Before Day 91)	Order + 102 Days (Before Day 147)	Response + 14 Days	Yes
Hearing	Court's Convenience	Court's Convenience	Court's Convenience	N/A

The Sedona Conference Working Group Series & WGS Membership Program

**“DIALOGUE
DESIGNED
TO MOVE
THE LAW
FORWARD
IN A
REASONED
AND JUST
WAY.”**

The Sedona Conference was founded in 1997 by Richard Braman in pursuit of his vision to move the law forward in a reasoned and just way. Richard’s personal principles and beliefs became the guiding principles for The Sedona Conference: professionalism, civility, an open mind, respect for the beliefs of others, thoughtfulness, reflection, and a belief in a process based on civilized dialogue, not debate. Under Richard’s guidance, The Sedona Conference has convened leading jurists, attorneys, academics, and experts, all of whom support the mission of the organization by their participation in conferences and the Sedona Conference Working Group Series (WGS). After a long and courageous battle with cancer, Richard passed away on June 9, 2014, but not before seeing The Sedona Conference grow into the leading nonpartisan, nonprofit research and educational institute dedicated to the advanced study of law and policy in the areas of complex litigation, antitrust law, and intellectual property rights.

The WGS was established to pursue in-depth study of tipping point issues in the areas of antitrust law, complex litigation, and intellectual property rights. It represents the evolution of The Sedona Conference from a forum for advanced dialogue to an open think tank confronting some of the most challenging issues faced by our legal system today.

A Sedona Working Group is created when a “tipping point” issue in the law is identified, and it has been determined that the bench and bar would benefit from neutral, nonpartisan principles, guidelines, best practices, or other commentaries. Working Group drafts are subjected to a peer review process involving members of the entire Working Group Series including—when possible—dialogue at one of our regular season conferences, resulting in authoritative, meaningful, and balanced final commentaries for publication and distribution.

The first Working Group was convened in October 2002 and was dedicated to the development of guidelines for electronic document retention and production. Its first publication, *The Sedona Principles: Best Practices Recommendations & Principles Addressing Electronic Document Production*, has been cited favorably in scores of court decisions, as well as by policy makers, professional associations, and legal academics. In the years since then, the publications of other Working Groups have had similar positive impact.

Any interested jurist, attorney, academic, consultant, or expert may join the Working Group Series. Members may participate in brainstorming groups, on drafting teams, and in Working Group dialogues. Membership also provides access to advance drafts of WGS output with the opportunity for early input. For further information and to join, visit the “Working Group Series” area of our website, <https://thesedonaconference.org/wgs>.

The Sedona Conference Working Group 10 on Patent Litigation Best Practices—List of Steering Committee Members and Judicial Advisors

The Sedona Conference's Working Group 10 on Patent Litigation Best Practices Steering Committee Members and Judicial Advisors are listed below. Organizational information is included solely for purposes of identification.

The opinions expressed in publications of The Sedona Conference's Working Groups, unless otherwise attributed, represent consensus views of the Working Groups' members. They do not necessarily represent the views of any of the individual participants or their employers, clients, or any organizations to which they may belong, nor do they necessarily represent official positions of The Sedona Conference. Furthermore, the statements in each publication are solely those of the non-judicial members of the Working Group; they do not represent judicial endorsement of the opinions expressed or the practices recommended.

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