# Contents

About the Contributors ........................................... xi
Preface ............................................................. xix
Acknowledgments .................................................. xxi
Foreword ............................................................ xxiii
Introduction ......................................................... xxv

Chapter 1
Putting ADR to Work in IP Disputes: When and How to Do It ......................................................... 1

James F. Davis
Introduction—The ADR Landscape .............................. 2
I. Overview of ADR Tools ........................................ 2
II. Intellectual Property Infringement Suits ...................... 5
III. Being a Worthy Advocate in Mediation .................... 6
IV. Stumbling Blocks in Mediation Advocacy .................. 10
V. Case Histories—Using ADR to Win Your Client’s IP Dispute ......................................................... 14
Conclusion ............................................................ 29

Chapter 2
The Multifaceted ADR Clause—Why It Deserves More Attention Than It Gets ................................. 31

David W. Hill and Ronald A. Bleeker
Introduction .......................................................... 31
I. What Rules and Procedures Do You Want? ............... 33
   A. Devising Ad Hoc Rules for an IP Dispute ............ 34
   B. Mediating an IP Dispute under Established Rules ... 35
   C. Arbitration of an IP Dispute under Established Rules ......................................................... 38
II. Specifying an ADR Institution ................................ 42
III. Customizing Your ADR Clause ........................................... 44
   A. Place (“Seat”) of the Arbitration ............................... 44
   B. Number of Arbitrators .......................................... 45
   C. Issues for Resolution ........................................... 48
   D. Language of the Arbitration .................................... 49
   E. Choice of Law in the Arbitration ............................... 49
   F. Time Limits ....................................................... 50
   G. Information Exchanges ......................................... 52
   H. Award of Costs, Fees, Damages ............................... 54
IV. ADR with Other Forms of IP ............................................. 55
   A. Trademarks and Copyrights .................................... 55
   B. Trade Secrets/Know-how ....................................... 56
V. Raising the ADR Issue In the Negotiation Process ............... 57

Conclusion ................................................................. 59

Chapter 3
Early Case Assessment: A Strategic Tool for the
   Early Resolution and Management of Intellectual
   Property Cases .............................................................. 61
   Cynthia Raposo and Harrie Samaras
Introduction ................................................................. 61
I. What Is Early Case Assessment (ECA)? ......................... 62
II. Why Use ECA? ......................................................... 64
III. A Framework for Performing ECA ............................... 65
   A. Steps to Consider for an Early Case Assessment
      Analysis .............................................................. 66
   B. ECA Detailed Analysis ........................................... 68
IV. Post-Resolution: Loop-Back Process (“Prevention”) ......... 105
V. ECA Executive Summary ............................................ 106
Conclusion ................................................................. 107
Appendix: CPR’s ECA Toolkit .......................................... 109

Chapter 4
Mediation: One Judge’s Perspective (Or Infusing Sanity
   into Intellectual Property Litigation) ............................... 133
   Magistrate Judge Mary Pat Thynge
Introduction ................................................................. 134
I. What Mediation Really Is ............................................. 138
II. The “Other” ADR ....................................................... 140
III. Why Mediation in IP Cases? ....................................... 141
<table>
<thead>
<tr>
<th>Chapter</th>
<th>Title</th>
</tr>
</thead>
<tbody>
<tr>
<td>IV.</td>
<td>Timing Is Everything</td>
</tr>
<tr>
<td>V.</td>
<td>The Fifth “P”: Don’t Prejudge the Case</td>
</tr>
<tr>
<td>VI.</td>
<td>Jump-Starting the Process</td>
</tr>
<tr>
<td>VII.</td>
<td>Working with Your Mediator</td>
</tr>
<tr>
<td>VIII.</td>
<td>Preparing for Mediation</td>
</tr>
<tr>
<td></td>
<td>A. Initial Conferences</td>
</tr>
<tr>
<td></td>
<td>B. Whom to Include (or Exclude)</td>
</tr>
<tr>
<td></td>
<td>C. Preparing an Effective Mediation Statement</td>
</tr>
<tr>
<td></td>
<td>D. Counsel’s “Homework” before the Mediation Session</td>
</tr>
<tr>
<td></td>
<td>E. Making the Most of the Mediation Session</td>
</tr>
<tr>
<td>IX.</td>
<td>Closing the Deal</td>
</tr>
<tr>
<td>Conclusion</td>
<td></td>
</tr>
</tbody>
</table>

**Chapter 5**

**Preparing to Successfully Mediate an Intellectual Property Dispute: A Guide for Counsel and Clients**

_Hildy Bowbeer_

| I.      | The Case for Mediation                                              |
| II.     | In the Beginning, There Was the Business Objective                  |
| III.    | Timing and Strategies—Sooner, or Later?                            |
|         | A. Bridging the Information Gap                                     |
|         | B. Managing the Message                                             |
|         | C. Avoiding the Preemptive Strike                                   |
|         | D. Case Events                                                      |
|         | E. Party Events                                                     |
| IV.     | Practical Considerations for Selecting Your Mediator               |
| V.      | Location, Location, Location                                        |
| VI.     | Structuring the Mediation—Format and Length                        |
| VII.    | Preparing for a Case-Dispositive Event                              |
|         | A. Selecting the Negotiation Team: Who Belongs?                     |
|         | B. Rolling Up Your Sleeves                                         |
|         | C. Preparing the Mediation Statement—Strategies and Considerations  |
|         | D. Preparing the Opening Statement: What Information Will You Convey?|
| VIII.   | The Devil Is In the Details                                         |
| IX.     | The Fine Print                                                      |
| X.      | A Final Thought about the Long View                                  |
Chapter 6
Mastering the Use of a Special Master in Intellectual Property Litigation

Don W. Martens

Introduction .................................................. 210

I. Appointing and Using a Master in IP Cases .......... 211
   A. Deciding to Appoint a Master ....................... 211
   B. Selecting the Master ................................. 216
   C. What Belongs in the Order of Appointment? ...... 217
   D. Preliminary Conference ............................ 220
   E. Hearing .................................................. 221
   F. Master’s Report ....................................... 222
   G. Preparing Objections to the Master’s Report .... 222
   H. Using a Trial Master .................................. 223

II. Using a Discovery Master ............................. 224
   A. Why Use a Discovery Master? ....................... 224
   B. Using a Master to Expedite Resolution of
      Discovery Disputes .................................... 225
   C. Using a Master to Manage Discovery ............... 227

III. Using a Master in Patent Cases ..................... 227
   A. Using a Markman Master ............................ 228
      1. Deciding Whether to Use a Markman Master ... 229
      2. When to Appoint a Markman Master .......... 230
      3. What to Cover at the Preliminary Conference .. 231
      4. What to Include in the Briefing ................. 232
      5. Making the Most of the Tutorial ............... 232
      6. Consider the Benefits of a Tentative Ruling ... 233
      7. Preparing for the Hearing ......................... 233
      8. Filing Objections to the Markman Master’s
         Report .................................................. 234
   B. Using a Master for Patent Summary Judgment
      Motions .................................................. 234
   C. Using a Master for Patent Damages ............... 235

IV. Using a Master in Copyright Cases ................ 236
   A. Determining Software Copyright Infringement .... 236
   B. Determining Copyright Infringement in
      Non-Software Cases .................................. 237
   C. Determining Copyright Damages ................... 237
Chapter 8
The Skillful Appellate Mediation Advocate: What You Need to Know about Mediating Patent Cases at the Federal Circuit

Wendy Levenson Dean, Harrie Samaras, and Dina Leytes

Introduction ............................................................... 301

I. Evolution of the Court’s Mediation Program .......... 302

II. Benefits of Patent Mediation at the Appellate Stage ... 303
    A. Appellate Mediation: Why Is It Worth Your Client’s Time? 303
    B. Management of Relative Costs ............................. 306
    C. Preservation, Enhancement, and Development of Business Relationships 307
    D. Avoidance of Unpredictable Results—Certainty ... 307
    E. Maintenance of Privacy: Confidentiality ............. 308
    F. Achievement of Efficient Resolution: Timeliness 309
    G. Achievement of Global Resolution of Multiple Litigation/Multiple Parties: It’s Not Just the Federal Circuit Appeal 309

III. What You Need to Know About the Mediation Process, from Docketing to Mediation ..................... 310
    A. What Is “Mandatory” about Mandatory Mediation? 310
    B. Docketing Statements ...................................... 311
    C. Review of Rulings on Appeal ............................ 313
    D. Preliminary Discussions with Counsel ............... 313
    E. Scheduling ...................................................... 314
    F. Appointing the Mediator .................................. 314
    G. Preparing the Confidential Mediation Statement .. 315
    H. The Mediation Session ..................................... 316
    I. Subsequent Sessions ....................................... 317
    J. Resolution or Panel Decisions ........................... 318
    K. Do Not Try to Predict Settlement ..................... 318

IV. Practice Tips for Effective Appellate Mediation ...... 320
    A. Effective Practices .......................... 320
    B. Ineffective Practices .............................. 321
    C. Why Your Mediation Skills Matter ................. 322
Conclusion ................................................................. 324
Appendix A: Appellate Mediation Program Guidelines ...... 325
Appendix B: Docketing Statement .............................. 331

Chapter 9
The USITC: An Alternative Approach (Not Just an Alternative Forum) for Resolving IP Disputes ...... 335
Hon. Theodore R. Essex and James R. Holbein

I. Overview of the Commission—An Alternative Approach for Resolving IP Disputes ................. 336
II. How Did We Get Here? The Legislative Development of Section 337 .............................. 338
III. Section 337 Practice .................................................. 342
IV. Points for the Bar to Consider in USITC Practice ........ 343
V. Section 337 Mediation Program—An Alternative Approach to Trial at the Commission ........ 348
VI. Advantages of the Mediation Program—Resolution and Case Management ....................... 348
VII. Factors to Consider in Mediating Section 337 Cases ........ 350
Conclusion ................................................................. 352

Index ................................................................. 353