FIRESIDE CHAT – INSIGHTS FROM THE BENCH

Moderator:
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Gunn, Lee & Cave, P.C.

Panelist:
HON. XAVIER RODRIGUEZ, *San Antonio*
Judge, U.S. District Court
Western District of Texas

State Bar of Texas
INTELLECTUAL PROPERTY LITIGATION
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CHAPTER 6

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BIOGRAPHICAL INFORMATION

A. Education

- J.D., St. Mary's University School of Law
- B.S.Ch.E., The University of Texas at Austin

B. Professional Activities

- Fellow, Texas Bar Foundation
- Fellow, San Antonio Bar Foundation
- Director, San Antonio Bar Association

C. Selected Publications

- "Brand Protection After Tiffany v. Costco," TexasBarCLE: Intellectual Property Law Workshop: Trademarks in IP, February 2021 (co-authored with Oren Gelber and Michael Moore).
- "Copyright Trolls: Ethical Issues," TexasBarCLE: 16th Annual Advanced Intellectual Property Litigation, October 2020.
- "Trademark Applications Worth Talking About," TexasBarCLE: 33rd Annual Advanced Intellectual Property, February 2020.
- "Litigating a Case with More than Just Patents," TexasBarCLE: 15th Annual Advanced Patent Litigation, July 2019.
- "Impressions of a TTAB Oral Argument Hearing From a First-Time Advocate," State Bar of Texas IP Section, Newsletter, August 2018 at 16–19.
- "Texas Supreme Court Update," State Bar of Texas Litigation Section, News for the Bar, November 2017.
- "Impact of Apple v. Samsung on Design Patent Enforcement," TexasBarCLE: 13th Annual Advanced Patent Litigation, July 2017
- "Practical Trial & Motions Tips," San Antonio Bar Association Seminar: Bench Motions & Trials IX, May 2017 (co-authored with Judge Michael Mery).
- "Gorsuch's Appointment Could Affect the Deference Given to the USPTO Under Chevron and Auer," State Bar of Texas IP Section, Newsletter, May 2017 at 17–19.
- "Texas Supreme Court Update," State Bar of Texas Litigation Section, News for the Bar, March 2017.
- "Texas Supreme Court Update," State Bar of Texas Litigation Section, News for the Bar, November 2016.

- "Three Precedential Trademark Cases from Fall 2015," State Bar of Texas IP Section, Newsletter, February 2016 at 8–9.

D. Selected Presentations

- TexasBarCLE: Federal Court Practice Course, May 2021 (course director)

- A Rubric of Rights: Copyright and Trademark Protection for Fictional Characters, IIPLA Virtual IP Summit 2020, October 2020 (co-presented with Stephen J. Strauss and Alexandra Arneri)

- Counterfeiting is Bigger than Handbags: Public Health and Economic Risks, Southwest Fulbright Symposium, San Antonio, Texas, April 2019

- Trademarks in Entertainment Law, Law Society for Sports, Entertainment, and Media, San Antonio, Texas, March 2019

- *The Crossroads of* Intellectual Property and Energy Law, Society of Oil and Gas Students, St. Mary's University School of Law, San Antonio, Texas, March 2019

- *Trademarks in Professional Sports*, San Antonio Young Lawyers Association, AT&T Center, San Antonio, Texas, January 2019

- A Primer on Trademarks, Counterfeit Pharma Seminar, San Antonio, Texas, February 2018

- An Introduction to Trademarks, State Bar of Texas Pro Bono IP Workshop, El Paso, Texas, January 2018 (co-authored with Marylauren Ilagan)

- Intellectual Property Issues for Health Law Practitioners, San Antonio Bar Association Health Law Section, San Antonio, Texas, March 2017

- An Introduction to Trademarks, State Bar of Texas Pro Bono IP Workshop, Corpus Christi, Texas, January 2017 (co-authored with Darrian Campbell)

U.S. DISTRICT JUDGE XAVIER RODRIGUEZ
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BIOGRAPHICAL INFORMATION

Born in San Antonio, Texas, Judge Rodriguez received his bachelor's degree from Harvard University, a master's degree from the University of Texas LBJ School of Public Affairs and a Doctor of Jurisprudence degree from the University of Texas Law School. Prior to assuming the bench, he was a partner in the international law firm of Fulbright & Jaworski (now known as Norton Rose Fulbright). He was board certified in labor and employment law by the Texas Board of Legal Specialization. He served in the U.S. Army Reserve Judge Advocate General's Corps and has served on the board of directors of several charitable organizations across Texas.

Judge Rodriguez is a frequent speaker on continuing legal education seminars and has authored numerous articles regarding employment law, discovery, and arbitration issues. He is the editor of Essentials of E-Discovery (TexasBarBooks 2d ed. 2021). He is a member of The Sedona Conference Judicial Advisory Board, the Georgetown Advanced E-Discovery Institute Advisory Board, the EDRM Global Advisory Council, and serves as the Distinguished Visiting Jurist-in-Residence and adjunct professor of law at the St. Mary's University School of Law. He was elected to membership in the American Law Institute and is a Fellow of the American Bar Foundation and the Texas Bar Foundation.

In 2011, Judge Rodriguez was awarded the Rosewood Gavel Award for outstanding judicial service from the St. Mary's University School of Law. In 2017, he received the State Bar of Texas Gene Cavin Award for Excellence in CLE, recognizing his long-term contributions to continuing legal education. In 2021, he was presented the Texas Bar Foundation's Samuel Pessarra Outstanding Jurist Award and the TexasBarCle's Pat Nester Innovation in Professional Development Award. He is the Immediate Past Chair of the State Bar of Texas Litigation Section, Past Chair of the State Bar of Texas Labor and Employment Law Section and Past Chair of the State Bar of Texas Continuing Legal Education Committee.

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A. INTRODUCTION

Effective advocacy requires practice, continuing education, and willingness to improve. Lawyers have facts and issues that they want to present to the court. Those facts and issues are often developed with the benefit of months, if not years. Courts might have the benefit of a few days or weeks, albeit split across hundreds of other cases.

Intellectual property litigation is complex. Patent and trade secret cases are inherently technical, and all intellectual property cases have unique practices and procedures (e.g., *Markman*[1] hearings, technical and survey experts, special venue rules).

It behooves an intellectual property attorney to consider the needs of the court so that the attorney can best present his/her case. This article and the accompanying presentation present several insights, which intellectual property attorneys should consider and implement in the development and presentation of their cases.

B. DISCUSSION

1. Emergency relief in trade secret cases

Consider a common scenario in trade secret disputes: an employee/owner of the plaintiff leaves the plaintiff and starts a competing business or begins working for a competitor. The plaintiff company is furious and wants to stop the bleeding—or fear of bleeding—as quickly as possible. The plaintiff wants the defendants (e.g., ex-employee, competitor) to immediately return customer information, financial information, marketing plans, and the like.

In this scenario, the plaintiff often rushes to the courthouse and seeks a temporary restraining order (TRO) and/or a preliminary injunction. These emergency forms of relief are taxing on the parties, as well as the court. Given the resources the court must devote to the emergency motion(s), courts often disfavor the immediacy sought. As opposed to some practices in state courts, federal courts are generally loathe to grant restraining orders on an ex parte basis.

Litigants should think carefully before pursuing this emergency relief. They should ask themselves whether the emergency relief is truly necessary to solve the problem(s) at hand.

2. Requests for forensic exams of any and all devices

The second issue concerns requests for forensic exams of any and all devices owned or in the custody/possession of the opposing party. These requests are not uncommon in the scenario described above. More broadly, they are often sought in other intellectual property litigation, as well.

Parties requesting the forensic exams often do so like a treasure-hoarding dragon. They request everything under the sun in hopes of capturing any and all evidence. They do so even if they never review the forensic records (whether intentionally, or haphazardly). These requests are highly demanding of all responding parties, both large and small. An electronic device might have thousands, or even millions of pages of electronic files. And a company of ten employees may easily have on the magnitude of thirty subject devices (e.g., laptop/desktop, smart phones, tablets). The files add up, and the cost to prepare those forensic copies is significant.

Courts are cognizant of and sensitive to the burden placed on the responding party. As a result, the requesting party should evaluate which devices truly necessitate forensic copies. For example, the defendant ex-employee is more likely to possess a key device than an employee in an unrelated department.

3. Tension in discovery between state and federal court

Texas state court appellate decisions have interpreted the discovery rules and Texas Supreme Court discovery opinions in a very restrictive manner. For example, requests for a forensic examination of hard drives and cell phones generally must establish that other efforts have been exhausted, that relevant information has been demonstrated to exist, and that safeguards have been established that protect the disclosure of non-relevant and potentially private data. On the other hand, federal courts have not been so restrictive in requiring the production of relevant electronically stored information, especially in theft of trade secret cases.

4. Explain the consequences of the requested claim construction

Patent litigants spend significant resources identifying and advocating for specific claim constructions. However, they rarely explain the consequences of a claim construction to the court. At the end of the *Markman* hearing, the court knows the proposed constructions and arguments for/against, but the court is left wondering what will happen to the case if a particular construction is adopted.

[1] *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

Judges want to know, and attorneys should tell them, what will happen in the case if a particular claim construction is adopted. Will the case settle? Is the court likely going to grant summary judgment for one of the parties?

5. Show and tell

At *Markman* hearings, attorneys often rely heavily on PowerPoint presentations emphasizing claim language and arguments supporting the proposed constructions. There is a void, however, in the presentation of the accused articles and claimed inventions. Judges often benefit from demonstration of the technology.

For ease of understanding, and improved advocacy, consider using more "show and tell" at *Markman* hearings.

C. CONCLUSION

Most IP cases are presented carefully and effectively. The best advocates are always looking to improve. Adopting the suggestions discussed above will help any advocate. Additional suggestions will be discussed at the live presentation.