"The Work Will Teach You How To Do It": Lessons from Patent Litigation Courts' Use of Limits on Case Activity to Effectively Manage Litigation Costs

Michael C. Smith*

Table of Contents

I. Introduction 2

II. Types of Limits 3
- A. Initial motion practice 4
- B. Discovery 6
  - 1. Court-Ordered Disclosures 7
  - 2. Staging of Discovery 10
  - 3. Limits on Depositions 11
  - 4. Limits on Written Discovery 11
  - 5. Discovery Disputes 12
- C. Hearings 13
- D. Pretrial motion practice 13
  - 1. Motions for Summary Judgment 14
  - 2. Motions to Strike Expert Testimony 14
  - 3. Motions in Limine 15
  - 4. Exhibits 15
- E. Trial 16

III. Conclusion 17

* Mr. Smith is a partner in the Marshall office of Scheef & Stone, LLP, and is the editor of the EDTexweblog.com and TexIPLawBlog.com online blogs providing analysis and commentary on practice in Texas' federal courts, with a particular focus on intellectual property cases and practice in the Eastern District of Texas. This paper was submitted in partial fulfillment of the thesis requirement for the Executive LL.M in Litigation Management program at Baylor Law School. Prior to receiving his LL.M, Mr. Smith received his law degree from Baylor Law School and his bachelor's degree from East Texas State University (now Texas A&M University – Commerce). Mr. Smith also holds a master's degree in public affairs from the LBJ School of Public Affairs at The University of Texas at Austin, and a Master of Arts in World War II Studies from Arizona State University.

I. Introduction

At its essence, litigation management is the process of making decisions on what to do and what not to do in a case. And deciding *not* to do something can have significant benefits with respect to the cost of the litigation, both to parties and courts.

Calculated decisions to limit the activity in a case are not new—they are, in fact, routine in procedural rules, local rules, judge-specific orders, and agreements between parties. Regardless of the source, when used properly, they act to focus the activity in a case on higher priority matters and resolve cases in accordance with the overarching purpose of the rules, which under Federal Rule of Civil Procedure 1 is "to secure the just, speedy, and inexpensive determination of every action and proceeding."[1] And they do this in many cases over the objection of lawyers, who may understandably believe that *their* case will benefit from more time or work.

Additionally, in some cases, there are *de facto* limits which are not limits at all, but only additional requirements. But like the "glass tools only" tasks assigned by the king in the Brothers Grimm's *The Two Kings' Children* to the prince, upon the completion of which he could have the princess's hand in marriage, they serve principally—and often intentionally—to discourage or deter a party from going down a certain path.[2]

However, when used improperly, limitations can fail to save the parties money in the development of a case, and in the worst situations, unfairly limit the development and presentation of a case to the extent that the merits are affected because the court and the jury, as applicable, may not be provided with the necessary information to determine the appropriate resolution of the case.

In most cases, these limits will be imposed by courts and not the parties. This is in line with many commentators and courts, who have long noted that a principal cause of unnecessary delay, especially in complex litigation, is the absence of active judicial management and control.[3] As one court has noted, quoting a report dating back to 1960:

> [T]he absence of strong judicial control permits discovery to mushroom and issues to go unfocused; delay and obfuscation are more likely to be adopted as litigation tactics; bitterness and suspicion may more rapidly develop and persist between counsel. As a result, excessive motion practice and other examples of dilatory and overly litigious conduct proliferate, while incentives for

---

1 *See* FED. R. CIV. P. 1.

2 In *The Two Kings' Children*, the prince was required to, among other things, cut down a forest, clear out and restock a fish pond, clear the land, and build a castle, each in one day, and all using only glass tools. *See* Shonna Slayton, *Lessons from Grimm: How to Marry a Princess*, Shonna Slayton YA Author (July 22, 2019), https://shonnaslayton.com/lessons-from-grimm-how-to-marry-a-princess/. Few orders granting motions for leave include quite so daunting a set of prefiling requirements, but a similar intent can sometimes be discerned.

3 *See, e.g.,* MANUAL FOR COMPLEX LITIGATION, FOURTH, § 1.10.

> stipulations and other potentially expediting types of behavior are reduced.[4]

And at a workshop on the implementation of the Eastern District of Texas' Civil Justice Expense and Delay Reduction Plan in 1992, then-Chief U.S. District Judge Robert M. Parker of the Eastern District of Texas noted that there was another more pragmatic reason for limits on discovery to come from the court:

> We recognize that lawyers are placed, today, because you sue one another, in a position of overdoing discovery defensively. You are practicing defensive law today the same way the doctors have been practicing defensive medicine now for about 10 to 15 years because you started suing them. It has come full circle. But you cannot be held accountable for failing to do something if I tell you [that] you cannot do it. So, in that respect, it [limitations on discovery] is protective of lawyers.[5]

So where can courts and practitioners see which limitations have been successful in practice—especially in complex cases? An Estonian proverb states that "the work will teach you how to do it."[6] Thus, a good source for tested limitations is those used by judges who have handled large quantities of complex, but similar, litigation. Patent litigation, in particular, provides an example of civil litigation where a relatively small number of judges have handled a large number of similar cases and developed—often in consultation with each other—procedures that include limitations on activity in cases.

Accordingly, this paper will examine common types of limits on case activity in civil litigation in federal courts—with particular emphasis on limitations by judges with large dockets of patent infringement cases—with the goal of identifying limits which meet the twin goals of reducing expense while avoiding unfairly truncating the presentation of the merits. As of late 2023, the Eastern District of Texas, the Western District of Texas, and the District of Delaware were the top three districts for patent infringement case filings,[7] thus the principal subjects for examination will be drawn from the practices of some of these districts' patent-laden judges.

II. Types of Limits

There are almost innumerable places in a case where a limit can be imposed on

---

[4] United States v. Am. Tel. & Tel. Co., 83 F.R.D. 323, 327 (D.D.C. 1979) (quoting the Report to the President and the Attorney General of the National Commission for the Review of Antitrust Laws and Procedures at 11–12 (1979)).

[5] Transcript, *Civil Justice Expense & Delay Reduction Workshop*, Feb. 4, 1992 at 64, https://edtexweblog.com/wp-content/uploads/2023/12/12272023154145.pdf.

[6] *See Estonian Wisdom – 25 Proverbs and Sayings*, ESTONIAN WORLD, Mar. 24, 2014, https://estonianworld.com/life/estonian-wisdom-25-proverbs-sayings/ ("The work will teach the worker").

[7] *See* Nisha Shetty, *Back with a Bang: Eastern District of Texas Is the Most Popular Patent Court,* IAM (Dec. 18, 2023), https://www.iam-media.com/article/back-bang-eastern-district-of-texas-the-*most-popular-patent-court*.

parties' activities. In general, these limits take the form of limits on the activity permitted or the time available to conduct it. Or, as previously noted, courts may also simply discourage activity by adding requirements which deter parties from engaging in it. The following stages of litigation provide a useful framework for analyzing provisions imposing these limitations.

A. Initial motion practice

Litigants generally enjoy the ability to draft largely unlimited initial pleadings, but from that point forward, many courts impose limitations on the length of filings. Most courts couch their limitations in terms of limits on the number of pages, although some courts go by the number of words. Frustrated by lawyers' creativity in finding ways around these limits, some rules have responded to attempts to evade page limits by including, for example, requirements regarding type size, line spacing, and margins.[8]

In addition to limits on the length of motions, courts may also restrict the types of motions that may be filed. They might, for example, prohibit the filing of certain types of motions after a certain point in time or conversely prohibit the filing of certain types of motions until a later point in time.[9]

As to the former, U.S. District Judge Alan D. Albright of the Western District of Texas requires that a motion to transfer a case "may be filed within 3 weeks after the CMC [case management conference] or within 8 weeks of receiving or waiving service of the complaint, whichever is later. Thereafter, a movant must show good cause for any delay and seek leave of court."[10] The order goes on to set discovery limits for such motions, as well as specific page limits for the briefing.[11]

As to the latter, U.S. District Judge Rodney Gilstrap of the Eastern District of Texas formerly had a requirement that if a party sought to assert in advance of claim construction that an asserted patent claim did not qualify as patent-eligible subject matter, it must obtain leave of court to file such a motion.[12] This requirement was superseded by an order which merely imposed additional requirements on motions asserting patent ineligibility before the court has issued its claim construction ruling.[13]

This "additional requirements" order is an illustration of a limitation that is not a limitation *per se*, but which adds requirements in order to deter a party from reflexively asserting certain claims. For example, Judge Gilstrap's standing order regarding subject matter eligibility contentions in patent cases requires any party alleging that an asserted claim does not qualify as patent-eligible subject matter to

---

8 *See* J. Alan D. Albright, Standing Order Governing Proceedings—Patent Cases (OGP) 4.3, at 11 (W.D. Tex., Waco Div. Apr. 4, 2023).

9 *See id.* at 2, 5

10 *See id.* at 5.

11 *Id.* at 5–6.

12 J. Rodney Gilstrap, *The Standing Order Regarding Motions Under 35 U.S.C. § 101 and Accompanying Certifications in Cases Assigned to United States District Judge Rodney Gilstrap*, at 2 (E.D. Tex, Nov. 10, 2015).

13 *Id.* at 1–2.

serve on all parties its detailed "Eligibility Contentions" within 45 days of receiving the plaintiff's contentions.[14] Judge Albright later included a similar—but not identical—requirement in his Order Governing Proceedings (OGP).[15] Because this timing is similar to the timing for invalidity contentions, it imposes a significant additional burden on a defendant precisely when it is preparing similar invalidity contentions, thus incentivizing it not to assert every possible invalidity or ineligibility claim.

A variation of this theme is Judge Albright's meet-and-confer requirement for early motions to dismiss indirect and willful infringement, which states that "[a]ny party seeking to dismiss claims of indirect or willful infringement before fact discovery must first meet and confer with the opposing party to discuss dismissing those allegations without prejudice, with leave to re-plead those allegations with specificity if supported by a good faith basis under Rule 11.[16] Under this agreement, the patent owner may re-plead those allegations within three months after fact discovery opens, and the parties agree to permit fact discovery on indirect and willful infringement during those three months."[17] This is a sort of "reverse glass tools" provision in that it is attempting to deter a party from *opposing* a request by providing the court's view on whether such a motion will be granted.

An example of a provision which is neither a limitation nor a "glass tools only" deterrent is the statement in Judge Albright's OGP to the effect that "[t]o the extent it may promote early resolution, the Court encourages the parties to exchange license and sales information, but any such exchange is optional during the pre-*Markman* phase of the case."[18] This was a requirement in Judge Albright's original OGP, but was later dropped in favor of a "the Court encourages" reference.[19]

This illustrates that statements in such orders fall on a continuum: from outright prohibition, to "additional requirements," to simple admonitions, or mere statements of encouragement or preference—to say nothing of procedural requirements which contain no substantive limitations. This is, of course, typical for judge-specific rules, standing orders, or case-specific orders. But where the orders address issues in complex cases that are heard in high volume, as is the case with patent cases heard by the referenced courts, the statements are often not just reflections of idiosyncratic preferences by judicial officers which may reflect only a response to a single unwanted action by a past litigant. Instead, they may well reflect the judge's considered policy on an issue encountered on a regular basis. And as experienced practitioners may know—they may be the latest in a series of provisions refining the court's approach as smart lawyers identify issues with (or loopholes in) the prior

---

[14] *See* J. Rodney Gilstrap, *The Standing Order Regarding Subject Matter Eligibility Contentions Applicable to All Patent Infringement Cases Assigned to Chief District Judge Rodney Gilstrap*, at 1 (E.D. Tex., July 25, 2019).

[15] *See* Albright, *supra* note 8, at 2.

[16] FED. R. CIV. P. 11.

[17] *See* Albright, *supra* note 8, at 6.

[18] *Id.* at 3.

[19] *Id.*

approach.

B. Discovery

One of the most common limitations in civil litigation is limitations on discovery. The discovery process in civil litigation has become an enormous source of expense and delay, playing a disproportionate role in the resolution of disputes.[20] But there has been significant pushback from the courts and practitioners in recent years, with numerous courts implementing limitations on discovery practice in order to save both the parties' and the courts' resources.[21]

A prominent example of this was the federal courts of the Eastern District of Texas' adoption, on December 20, 1991, of an innovative Civil Justice Expense and Delay Reduction Plan, pursuant to the Civil Justice Reform Act of 1991 (CJRA), 28 § U.S.C. 471 *et seq*.[22] Enacted by a Congress concerned by the increasing cost of civil litigation, the CJRA required each U.S. district court to implement a CJRA plan to improve litigation management. Even though the Eastern District was not one of the pilot districts initially required to produce a plan under the CJRA, then-Chief Judge Robert M. Parker of Tyler appointed an advisory group in accordance with the statute, reviewed that group's recommendations, and promulgated what became known locally as "the Plan" on behalf of the judges of the Eastern District of Texas.[23] The Plan created an innovative system of mandatory disclosures and tracked case assignments which drastically limited discovery, which had previously been essentially unlimited.[24]

But why did the court adopt its own Plan voluntarily? In one of a series of workshops conducted around the district in the weeks following the adoption of the Plan, Judge Parker provided an explanation:

> We have, in response to provisions of the Civil Justice Reform Act, elected to adopt our own plan and be an early implementation district. The alternative to that would have been to adopt a model plan that will be generated by The Judicial Conference. We do not know what the model plan would be, but once again we elected to have an impact on the course we took.[25]

U.S. District Judge Sam B. Hall, Jr. of the Eastern District's Marshall and Texarkana Divisions explained the purpose of the Plan in a 1993 opinion:

> The Court notes its concern that civil litigation must become more

---

20 *See* Brittany K.T. Kauffman, *Initial Disclosures: The Past, Present, and Future of Discovery,* 51 AKRON L. REV. 783, 784 (2017).

21 *See, e.g.,* Albright, *supra* note 8, at 3.

22 Michael C. Smith, *Man With the Plan: Successful Eastern District Practice Requires Understanding History*, TEXAS LAWYER (Apr. 11, 2011), chrome-extension://efaidnbmnnnibpcajpcglclefindmkaj/https://edtexweblog.com/wp-content/uploads/2020/08/2148-Texas-Lawyer-Plan-article.pdf.

23 *Id.* at 24.

24 *Id.*

25 *See* Civil Justice Expense & Delay Reduction Workshop, *supra* note 5, at 7–8.

> cost-effective by reducing what Judge Edith H. Jones of the Fifth Circuit Court of Appeals has termed the "transactional costs" of litigation, so that there is a higher ratio between claims or judgments paid and attorneys' fees and other costs incurred in litigation. A recent study by the Rand Institute for Civil Justice concluded that our legal system incurred $16–19 billion in transaction costs to deliver $14–16 billion in compensation to plaintiffs. Further, of all the money paid in compensation, the successful plaintiff received about 56% in net compensation, while the system consumed the rest. The Plan seeks to reduce these transactional costs by containing the amount of discovery permitted in a given case and the time permitted for such pretrial activity. By enacting the Civil Justice Expense and Delay Reduction Plan, the Eastern District has attempted to balance the needs of the parties for legitimate discovery against the costs of that discovery to litigants and to our society at large.[26]

In his opinion, Judge Hall cited Parkinson's Law, which states that "[w]ork expands so as to fill the time available for its completion."[27] Professor Parkinson's observation was directed at his experience with the nature of bureaucracy while serving as a British Army staff officer during World War II.[28] Whatever the reason for the additional work—which Parkinson cynically believed was to multiply the number of subordinates and enhance prestige, and which, as noted above, Judge Parker believed was possibly related to "defensive lawyering" and others might attribute to the influence of the billable hour—in many cases the overall cost of the litigation can be limited to the benefit of both parties and the court by limiting either the work to be performed or the time available for its completion.

There are several types of discovery limitations that courts have found helpful.

1. Court-Ordered Disclosures

One of the ways to limit costs in discovery—or anywhere else in civil litigation—is by limiting what the parties can fight about. Initial disclosures, which consist of a court-ordered set of discovery requests, are one tool many courts have found effective in reducing costs.[29] In the early 1990s, an amendment to Rule 26 of

---

[26] R&D Business Systems v. Xerox Corp., 150 F.R.D. 87, 89–90 (E.D. Tex. 1993) (internal citations omitted).

[27] *Id.* at 90 n.3.

[28] The Editors of Encyclopedia Britannica, *C. Northcote Parkinson,* ENCYCLOPEDIA BRITANNICA (July 26, 2024), https://www.britannica.com/biography/C-Northcote-Parkinson (Accessed 20 August 2024).

[29] *See* Andrei Iancu et al., *Real Reasons the Eastern District of Texas Draws Patent Cases – Beyond Lore and Anecdote*, 14 SMU Sci. & Tech. L. Rev. 299, 309 (2011) (explaining how the Eastern District of Texas was a "trailblazer in setting out and implementing local patent rules" to "promote the certainty of process and effective management of patent disputes" and "improve the structure and predictability of patent litigation."). For instance, the United States District Court for the Eastern District of Texas adopted a "[Model] Order Focusing Patent Claims and Prior Art to Reduce Costs" as an appendix to its Local Rules to "streamline[] the issues in [a] case to promote a 'just, speedy,

the Federal Rules of Civil Procedure (FRCP) was proposed to include mandatory initial disclosures as a discovery mechanism.[30] The Advisory Committee observed that "where jurisdictions had mandatory disclosures, litigants saved both time and expense, particularly if they met and conferred about the disclosures before engaging in further discovery."[31]

Consistent with this, the Eastern District of Texas' 1991 CJRA Plan's mechanism "required each party, without awaiting a discovery request, to provide certain mandatory disclosures within 30 days after the defendant filed an answer or other responsive pleading in the case. These disclosures included a computation of damages and, most importantly, a copy of all documents "likely to bear significantly on any claim or defense." [32]

But mandatory disclosure in Rule 26 sparked significant opposition nationwide. Opponents claimed that it interfered with the adversary system, and the final rule adopted on December 1, 1993, provided only for disclosure of documents "that are relevant to disputed facts alleged with particularity in the pleadings," with even that provision optional.[33]

National uniformity returned in the 2000 amendments, but at a cost. In 2000, the standard for the required disclosure in Rule 26 was watered down to information that a party "may use to support its claims or defenses,"—meaning that the disclosure obligation extended only to what a party found helpful.[34] The chair of the civil rules committee described the change, writing that "[t]he beginning was a strong disclosure rule that could be, and was, defeated by local option. The next step is a diluted disclosure rule that cannot be defeated by local option. Perhaps in several more years the time will come for a strong disclosure rule that cannot be defeated by local option."[35]

As a result of the 2000 amendments, the initial disclosures in Rule 26 of the FRCP are of little use to litigants, standing alone, and must be supplemented by other forms of written disclosure, the exact wording of which can be the subject of costly dispute in each case. Nonetheless, the mechanism is one that numerous judges and attorneys have found effective. Following the 1993 amendment, which contained a relatively broad disclosure requirement, the FJC commissioned a nationwide study to

---

and inexpensive determination' of th[e] action, as provided by Federal Rule of Civil Procedure 1," https://www.txed.uscourts.gov/sites/default/files/forms/ModelPatentOrder.pdf.

30 FED. R. CIV. P. 26.

31 Kauffman, *supra* note 20, at 788.

32 Smith, *supra* note 22; "[L]ikely to bear significantly on any claim or defense" was the 1990 test for whether information had to be disclosed, and was the precursor to the 1993 disclosure standard "relevant to disputed facts alleged with particularity in the pleadings." FED. R. CIV. P. 26 (1990); FED. R. CIV. P. 26 (1993).

33 FED. R. CIV. P. 26(a)(1)(B) (1993); *see* Kauffman, *supra* note 20, at 785.

34 FED. R. CIV. P. 26.

35 Memorandum from Paul V. Niemeyer, Chair, Advisory Comm. on Civil Rules, to the Hon. Alicemarie H. Stotler, Chair, Comm. on Rules of Prac. and Proc. 7 (May 18, 1998) (on file with author).

look at the effects of mandatory disclosures on litigation.[36] The findings were generally positive, with attorneys who reported an effect being more likely to say initial disclosures decreased: (1) their client's overall litigation expenses; (2) the time from filing to disposition; (3) the amount of discovery; and (4) the number of discovery disputes.[37] Similarly, they were also more likely to report that initial disclosures increased overall procedural fairness, fairness of outcome, and prospects for settlement.[38] In the end, as one commentator noted, "the obligation to disclose is not fundamentally different from the obligation to respond to interrogatories, and can actually serve to enhance the ability of advocates to play a useful role in the managerial judge's task of scheduling discovery."[39]

An example of a case-specific order which provides a robust disclosure requirements is Judge Gilstrap's form discovery orders, which include mandatory disclosures that continue to largely track the district's original CJRA Plan, requiring disclosure of basic information regarding the case, including a copy of all documents "that are relevant to the pleaded claims or defenses involved in this action."[40]

Notable here are two things. First, the disclosures extend beyond what a party "may use to support its claims or defenses"—in fact, a local rule dating back to 2000 and before that to the 1991 Plan itself specifically states that this standard includes information that would not support the disclosing party's position in the case.[41] Second, by its use of the language "relevant to the pleaded claims or defenses involved in this action," the order makes initial disclosures coextensive with the scope of discovery—as the 1991 Plan did.[42] That this is intended is made clear by a footnote in the version of the order applicable in patent cases, which states that "[t]he Court anticipates that this disclosure requirement will obviate the need for requests for production."[43]

A particularly fertile area for court-ordered disclosures is disclosures tailored to the type of case. For example, many courts hearing patent cases require the parties to provide detailed infringement and invalidity contentions, either via local rules or case-specific orders.[44] These requirements were originally developed by the Northern District of California in the late 1990s but have become the model for similar local

---

36 *See* Thomas E. Willging, Donna Stienstra, & John Shapard, *An Empirical Study of Discovery and Disclosure Practice Under the 1993 Federal Rule Amendments*, 39 B.C.L REV. 525 (1998).

37 *Id.*

38 *Id.* at 562–63.

39 Paul D. Carrington, *Learning from the Rule 26 Brouhaha: Our Courts Need Real Friends*, 156 F.R.D. 295, 309 (1994).

40 J. Rodney Gilstrap, *Sample Discovery Order for Nonpatent Cases*, at 3 (E.D. Tex., Marshall Div.).

41 E.D. TEX. LOCAL RULE CV-26(d)(1).

42 Gilstrap, *Sample Discovery Order for Nonpatent Cases*, *supra* note 40, at 3.

43 J. Rodney Gilstrap, *Sample Discovery Order for Patent Cases Assigned to Judge Rodney Gilstrap and Judge Roy Payne*, at 5 (E.D. Tex., Marshall Div.).

44 *See Eastern District of Texas Local Patent Rules*, https://www.txed.uscourts.gov/?q=patent-rules; Albright*, supra* note 8, at 2.

rules or provisions in orders in individual cases nationwide.[45] But as the number of courts adopting them has increased, so have the local variations. Most notably, while most courts limit parties' ability to amend disclosures in most cases to when they can show "good cause" for the amendment, Judge Albright's OGP allows parties to amend without leave of court in most cases until eight weeks after the claim construction hearing.[46]

U.S. District Judge Colm Connolly of Delaware follows the majority rule in requiring good cause for amendment, but provides a "reverse glass tools" provision identifying the grounds he considers would constitute good cause.[47] "Non-exhaustive examples of circumstances that may, absent undue prejudice to the non-moving party, support a finding of good cause include (a) recent discovery of material prior art despite earlier diligent search and (b) recent discovery of nonpublic information about the Accused Instrumentality that was not discovered, despite diligent efforts, before the service of the Infringement Contentions."[48] This standard is consistent with that applied by other patent judges, but moves the test into the text of the rule (here an order) itself.

But patent litigation is by no means the only area of the law where standard disclosures have been adopted. For employment cases, the Initial Discovery Protocols for Employment Cases Alleging Adverse Action, published in November 2011, replace initial disclosures with initial discovery specific to employment cases alleging adverse action.[49] They list a specific set of documents and information that must be provided automatically by both sides within 30 days of the defendant's responsive pleading or motion.[50] Judges using the Protocols report "how easy it is to screen eligible cases and issue the order as well as the reduction in combat over document requests."[51] More recently, some courts have expanded the concept to other types of employment cases.[52]

2. Staging of Discovery

Some courts stage discovery—with discovery only allowed on certain topics prior to a certain date. For example, Judge Albright's OGP states that "[e]xcept with regard to venue, jurisdictional, and claim construction-related discovery, all other

---

45 James Ware & Brian Davy, *The History, Content, Application and Influence of the Northern District of California's Patent Local Rules*, 25 SANTA CLARA COMPUTER & HIGH TECH. L.J. 965, 966 (2009).

46 *See* Albright, *supra* note 8, at 12 n.13.

47 J. Colm Connolly, *Scheduling Order for Non-Hatch-Waxman Patent Cases in Which Infringement is Alleged*, at 9 (D. Del., Revised Apr. 18, 2022).

48 *Id.*

49 FED. JUDICIAL CTR., PILOT PROJECT REGARDING INITIAL DISCOVERY PROTOCOLS FOR EMPLOYMENT CASES ALLEGING ADVERSE ACTION (2011).

50 *Id.* at 2.

51 Laura McNabb, *Pilot Project Reduces Delay and Cost in Federal Litigation*, 41 LITIG. 3 (Spring 2015) at 55, 57.

52 *Initial Discovery Protocols for Fair Labor Standards Act Cases Not Pleaded as Collective Actions*, (S.D. Tex., Houston Div. Revised Mar. 2019).

discovery shall be stayed until after the *Markman* [claim construction] hearing."[53] But as courts sometimes do, he then provides guidance as to the situations in which discovery would nonetheless be permitted. "Notwithstanding this general stay of discovery," he writes, "the Court will permit limited discovery by agreement of the parties, or upon request, where exceptional circumstances warrant it. For example, if discovery outside the United States is contemplated via the Hague [Convention], the Court is inclined to allow such discovery to commence before the *Markman* hearing."[54] Again, this is a sort of "reverse glass tools" provision attempting to deter a party from *opposing* a motion by providing the court's view.

The provision also provides an illustration of the "the work will teach you how to do it" proverb noted previously. Only a court that sees a large number of patent cases will have the critical mass of experience in cases involving discovery under the Hague Convention to have developed an opinion on whether such discovery should be permitted prior to a specific stage—unique to that type of litigation—in the litigation. But with the benefit of that opinion, the parties can avoid the expense of disputed motions.

3. Limits on Depositions

FRCP Rule 30(a)(2)(A)(i) already imposes a limit of ten oral and written depositions in cases, but some courts impose further limits.[55] The Eastern District of Texas' Plan separated cases into five tracks in terms of permissible discovery, but in most cases, it limited oral depositions to three per side, absent court approval.[56] In other cases, however, courts define deposition limits in terms of hours of deposition time, thus giving parties the flexibility to take more depositions of shorter duration where appropriate.[57] Courts may also provide multiple "caps" on deposition time——for example, authorizing up to fourteen hours of party depositions (both 30(b)(1) and 30(b)(6)) and twenty-one hours of third party depositions per side, and exempting depositions of experts from the time limits—other than the seven-hour cap of FRCP Rule 30(d)(1).[58] These separate caps can allow parties to identify specifically where additional deposition time is needed while protecting against excessive activity.

Courts may also impose specific limitations on conduct in depositions, including prohibiting speaking objections and specifying a required form for objections.[59]

4. Limits on Written Discovery

Limits on written discovery may be the most common discovery restriction, with courts limiting the permissible number of interrogatories, requests for production,

---

53 *See* Albright, *supra* note 8, at 3.
54 *Id.*
55 FED. R. CIV. P. 26.
56 Smith, *supra* note 1.
57 *See* Gilstrap, *Sample Discovery Order for Nonpatent Cases*, *supra* note 40, at 4; *see* Albright, *supra* note 8, at 3.
58 FED. R. CIV. P. 30.
59 *See* Albright, *supra* note 8, at 9.

and/or requests for admissions.[60] In multiparty cases, the court may require co-parties to share discovery or provide for a shared and a per-party limit.

5. Discovery Disputes

A common area for local and judge-specific rules is in how discovery disputes—uniformly disliked by courts—are presented. These requirements typically impose requirements to meet and confer before a request for relief may be made, as well as requirements for the request itself.

A single order establishes the procedures for raising discovery disputes before Judge Gilstrap and U.S. District Judge Robert W. Schroeder III, who share responsibility for the Marshall and Texarkana Divisions of the Eastern District of Texas.[61] It limits discovery-related motions and responses to seven pages with no more than five pages of attachments and lops off the reply and surreply briefs that would otherwise be available under the local rules, as well as the "in-person" requirement for the pre-filing "meet-and-confer."[62] It also adds to the local rule's requirement for a prefiling meet-and-confer—which must include both lead and local counsel—a second meet-and-confer, which must take place within seventy-two hours of the motion's being set for a hearing.[63] This second meet-and-confer must also include both lead and local counsel, but it expressly prohibits "the involvement or participation of other attorneys."[64] The commentary to the order explains why:

> This second conference is limited to only lead and local counsel to encourage a frank exchange by those hopefully best equipped to judge both the merits and practical necessity of the dispute. This limitation on participants avoids the sort of one-upmanship sometimes exhibited by junior attorneys seeking to impress their superiors at the expense of efficient dispute resolution. This process also ensures that the court may reliably assign ultimate responsibility to the lead attorney for the outcome of the conference efforts.[65]

Again, the order reflects the courts' identification of a pattern of conduct "sometimes" exhibited by certain groups of attorneys in certain contexts in certain types of cases. This identification comes from repeat experience with similar issues in similar types of cases.

In Judge Albright's court, discovery motions are, in fact, prohibited entirely.[66] Instead, the parties have a conference—usually telephonic—with the court.[67] Judge

---

60 *See* Albright, *supra* note 8, at 3; *see also* Albright, *supra* note 8, at 5 (setting numerical limits on venue and jurisdiction discovery).

61 J. Rodney Gilstrap and J. Robert W. Schroeder, *Standing Order Regarding "Meet and Confer" Obligations Relating to Discovery Disputes*, (E.D. Tex. Mar. 11, 2020).

62 *Id.* at 1.

63 *Id.*

64 *Id.* at 1–2.

65 *Id.* at 3.

66 *See* Albright, *supra* note 8.

67 *See* Albright, *supra* note 8.

Albright's OGP also provides a detailed procedure for the submission of the dispute before the hearing.[68]

In Delaware, U.S. District Judge Gregory B. Williams requires a letter to the court identifying the dispute, followed by three-page letters from each side submitted shortly before a telephonic conference with the court.[69] This is a blend of both approaches, with abbreviated written presentations ahead of a less formal hearing.

Provisions can also rule certain discovery in or out prospectively, eliminating expensive discovery fights. For example, Judge Albright's OGP states that "the Court will not require general search and production of email or other electronically stored information (ESI) related to email (such as metadata), absent a showing of good cause."[70] Judge Williams similarly requires that parties review the court's Default Standard for Discovery, Including Discovery of Electronically Stored Information("ESI").[71]

C. Hearings

Hearings can be limited in availability as well as length or even how they are conducted. Some courts also use the availability of hearings as a tool to encourage the participation of younger lawyers in cases, which can be seen as another way to drive down cost by allowing law firms to defer the presentation of issues by more expensive lawyers. While limitations on the availability of hearing are often driven primarily by the need to conserve a busy judge's time, they can also serve the salutary purpose of focusing disputes and limiting the cost to parties of preparing for and attending hearings.

D. Pretrial motion practice

Another common place for limitations is in pretrial motion practice. As with initial dispositive motions, many courts limit either by number of motions, number of pages of dispositive motions, or number of motions directed to the admissibility of testimony or evidence.[72]

Some courts impose more creative limits on other aspects of pretrial practice, including potential limits on the number of exhibits or hours of deposition testimony a party can designate. Depending on when such limits come into a fact, a party may see substantial savings, avoiding the cost of designating and responding to far more exhibits or designations of deposition testimony that the party could reasonably expect to actually use at trial.

---

68 *See* Albright, *supra* note 8, at 4–5.

69 *See* J. Gregory B. Williams, *Scheduling Order [Patent, (Non-ANDA)]*, at 5–7 (D. Del.).

70 *See* Albright, *supra* note 8, at 3.

71 Williams, *supra* note 69, at 1.

72 In claim construction proceedings in patent cases, also known as *Markman* hearings, veteran patent judges will typically have other limitations, including limits of page numbers and the numbers of terms to be considered. *See* Albright, *supra* note 8, at 7–8.

1. Motions for Summary Judgment

Numerical limits of some kind on motions for summary judgment are routine in many courts. Judge Albright's OGP, for example, notes that he does not limit the number of motions but does have a page limit.[73] The Eastern District of Texas local rules similarly do not limit the number of motions but do provide both a per motion and an overall cap on pages.[74]

One interesting limitation is that used by Judges Williams and Connolly in Delaware, which requires a party filing multiple summary judgment motions to "rank" their motions to indicate the order in which the party wishes the court to review its pending motions.[75] "The Court will review the party's summary judgment motions in the order designated by the party.[76] If the Court decides to deny a motion filed by the party, barring exceptional reasons determined *sua sponte* by the Court, the Court will not review any lower ranked summary judgment motions filed by the party."[77]

In practice, this presents the party filing the motions with a conflict between the likelihood a motion might be granted and the importance of an issue in a motion. Motions likely to be granted might be relegated to a lower position simply to ensure that a key issue is considered by the court.

2. Motions to Strike Expert Testimony

Some courts also impose limits on motions to strike expert testimony in addition to any existing limitations on written motion practice contained in local rules. For example, Judge Gilstrap limits parties to one motion to strike per expert witness, notwithstanding the number of reports the expert witness may generate and serve.[78] The rationale for the rule is that "[a]llowing separate and serial motions to strike on any or all reports an expert might generate would make the page limits imposed on such motions, in effect, a nullity, and it would unfairly increase the workload imposed on the opposing party and the Court."[79] If a party wishes to file more than one motion to strike per expert, the requesting party may file a motion not to exceed three pages seeking leave to file more than one motion for an expert at least two weeks before such motions are due, with any response likewise limited to three pages a week later.[80]

Judge Connolly—but not Judge Williams—applies a corresponding rule from his summary judgment practice to motions to strike expert testimony. In most cases, the first denial of a motion to strike an expert will result in no consideration of other

---

73 Albright, *supra* note 8, at 9.
74 E.D. TEX. L. R. CV-7(a)(1–3).
75 *See* Williams, *supra* note 69, at 21; *see also* Connolly, *supra* note 47, at 14.
76 *Id.*
77 Williams, *supra* note 69, at 14–15; Connolly, *supra* note 47, at 21.
78 J. Rodney Gilstrap, *Standing Order on the Number of Motions to Strike Expert Testimony (Including Daubert Motions) Filed in Civil Cases Assigned to Judge Rodney Gilstrap in the Marshall and Texarkana Divisions*, (E.D. Tex., Marshall/Texarakana Div. Aug. 25, 2023).
79 *Id.* at n.1.
80 *Id.* at 1–2.

motions.[81] In addition, in a creative extension of both the "one strike you're out" and "glass tool" mechanisms, if a party does not cross-examine the expert at trial on the grounds of a denied motion, Judge Connolly cautions parties that "the Court will reduce by an appropriate amount the time allotted to that party at trial."[82]

3. Motions in Limine

Courts also sometimes limit motions in limine. For example, like many judges, Judge Williams imposes a numerical limit of three motions per party, with limited briefing.[83] Judge Gilstrap recently began imposing a set of twenty-six standard limine rulings to be applied to all parties and allowing the parties to propose and argue—if opposed—up to five additional motions.[84] The subjects of the standard rulings are not controversial and reflect the court's standard practices, but, like mandatory disclosures, eliminate the need for the parties to meet and confer over precise language. The order also ensures that parties—at least those who ensure they are familiar with the court's standing orders—will know that certain subjects will or won't be permissible at trial. This can greatly assist counsel in advising their clients when preparing a trial strategy to not rely on an argument which will not be allowed at trial.

4. Exhibits

Some courts restrict the number of exhibits. For example, Judge Gilstrap recently began limiting the number of exhibits in civil cases.[85] "Too often in today's practice the Court finds itself confronted with hundreds or even thousands of proposed exhibits at the pretrial conference," he wrote in the standing order implementing the requirement.[86] "It appears that each side designates every possible document as an exhibit to ensure it does not overlook something important. While of some comfort to the designating party, such practice is overly burdensome to the Court and to the party obligated to review the documents for objection."[87] His order sets a limit of sixty joint exhibits and twenty-five exhibits per side (seventy-five joint and thirty per side in patent cases).[88]

As Judge Gilstrap notes, it is, in fact, frequently the practice of busy litigators to begin the exhibits and deposition designation process by designating almost every document produced in the case as an exhibit, as well as, in many cases, virtually the

---

81 Connolly, *supra* note 47, at 21–22.

82 *Id.* at 22.

83 *See* Williams, *supra* note 69, at 16.

84 Gilstrap, J. Rodney, *Standing Order On Motions in Limine in Cases Involving Allegations of Patent Infringement And/Or Breach of Frand Obligations, as Well as Declaratory Judgment Actions Which Relate to the Same*, at 1–4 (E.D. Tex., Marshall Div. Aug. 11, 2023). A corresponding order in civil cases has 18 topics.

85 Gilstrap, J. Rodney, *Standing Order On The Number and Use of Pre-Admitted Exhibits in Civil Cases Assigned to Chief Judge Rodney Gilstrap*, (E.D. Tex., Marshall Div. Aug. 8, 2023).

86 *Id.*

87 *Id.*

88 *Id.*

entirety of each deposition taken in a case.[89] This forces opposing counsel to review and object to each document and much of the deposition testimony, as well as cross-designate other testimony, after which squads of junior attorneys meet and confer on the objections, typically with no knowledge whether or how the exhibit is to be used, and even less discretion to withdraw form objections. That the court is aware of the questionable utility of such "meet-and-confer" sessions is clear from the previously-cited commentary to the discovery "meet-and-confer" rule where Judges Gilstrap and Schroeder noted the "one-upmanship" sometimes exhibited by junior attorneys seeking to impress their superiors at the expense of efficient dispute resolution.[90]

Such limits, which can include limits of hours of deposition testimony, save parties the enormous costs of cross designating and objecting and meeting and conferring on exhibits and deposition cuts which are highly unlikely to ever be used at trial by simply ruling them out from the outset, forcing parties to prioritize their exhibits before beginning the pretrial disclosure and meet and confer process. While a source of much potential grumbling among the bar about the additional up-front work required, such provisions will result in significant savings to clients—except where the case settles immediately after pretrial disclosures. This is because, at that point, the additional expense of compliance would not yet have been counterbalanced by the substantial savings in the ensuing meet and confer process.

E. Trial

Finally, most courts impose some sort of limitations at trial. The most common limitation is a limit on trial time, sometimes by the use of a chess clock, so that parties are aware how much time they have used and have remaining. Some courts justify stringent time limitations during trial by providing extensive attention to the case before trial, ruling on the admissibility of documents before a jury has been empaneled, and dispensing with time-consuming foundation requirements.

Courts may also impose limitations on the evidence itself, either by, again, limiting the number of exhibits which may be used, or how witness testimony can be presented. For example, some courts have a rule that a witness may only be called once and that all questioning by both sides must occur during that initial round of testimony or limit successive rounds of redirect and recross.[91] Other courts allow a defendant to defer its substantive questioning until its case in chief, even if a witness is called by the plaintiff first.[92] But trial practice has seen few recent limitations that affect cases the way that recent pretrial limitations do. In most cases, the trial "limitations" are, in actuality, simple procedural requirements which, while perhaps specific to the judge in question, are unlikely to be completely novel.

---

89 *Id.*

90 J. Rodney Gilstrap and J. Robert W. Schroeder, *supra* note 61, at 3.

91 *See*, *e.g.,* Judge Maryellen Noreika, Preferences & Procedures for Civil Cases (Sep. 2019), at 4, https://www.ded.uscourts.gov/sites/ded/files/Preferences%20and%20Procedures%20for%20Civil%20Cases.pdf.pdf.

92 LNP Eng'g Plastics, Inc. v. Miller Waste Mills, Inc., 77 F. Supp. 2d 514, 528 (D. Del. 1999) (same witness allowed to be recalled by the defense after originally being called by the plaintiff).

III. Conclusion

At the conclusion of the 1992 workshop on the newly-adopted limitations in the Eastern District's CJRA, U.S. District Judge Joe Fisher observed that lawyers with ambivalent feelings about the subject reminded him of "the boy that had mixed emotions when his mother-in-law drove his new Cadillac over the cliff."[93]

When confronted with stringent limitations on case activity imposed by a court, lawyers can perhaps be excused for having similar mixed emotions. It may be asking too much for the participants in a case to voluntarily accept significant limitations on their ability to prepare and present their cases. But these limitations from courts can play a critical role in allowing cases to be developed at a reasonable cost and in a reasonable period of time.

[93] *Civil Justice Expense & Delay Reduction Plan Workshop*, supra note 5, at 68.