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January 13, 2011

BY ELECTRONIC MAIL

Secretary of the Committee on Rules of Practice and Procedure
Administrative Office of the United States Courts
One Columbus Circle, NE
Washington, D.C. 20544

Re: Form 18 to the Federal Rules of Civil Procedure

Dear Secretary,

We write with a suggested amendment to Form 18 to the Federal Rules of Civil Procedure (“Form 18”), in the form of the enclosed draft. By way of background, we provide the following comments.

Form 18 sets forth a sample complaint for patent infringement. The existing form is undeniably barebones—beyond a statement of jurisdiction, it requires only an assertion of patent ownership, a claim of infringement, an allegation of marking (if applicable), and a demand for relief.

In *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007) and *Ashcroft v. Iqbal*, 129 S.Ct. 1937 (2009), the Supreme Court emphasized that a properly-pled complaint “demands more than an unadorned, the-defendant-unlawfully-harmed-me accusation.” *Ashcroft*, 129 S.Ct. at 1949 (citing *Twombly*, 550 U.S. at 555). In the wake of the intensified pleading standards of *Twombly* and *Iqbal*, the minimalist boilerplate of Form 18 has come under increasing fire from courts around the country. See *Elan Microelectronics Corp. v. Apple, Inc.*, 2009 WL 2972374, *2 (N.D. Cal. Sept. 14, 2009) (noting that Form 18 “requires essentially nothing more than conclusory statements” and “is not easy to reconcile ... with the guidance of the Supreme Court in *Twombly* and *Iqbal*”) (ellipsis added); accord

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Sharafabadi v. University of Idaho, 2009 WL 4432367, *3 n.5 (W.D. Wash. Nov. 27, 2009). See also *Colida v. Nokia, Inc.*, 347 Fed. Appx. 568, 571 n.2 (Fed. Cir. Oct. 6, 2009) (noting that Form 18 “is not tailored to design patents and was last updated before the Supreme Court’s *Iqbal* decision”).

In the past, Form 18 has been challenged for not addressing complex infringement claims involving multiple or different types of products. See *Hewlett-Packard Co. v. Intergraph Corp.*, 2003 WL 23884794, *1 (N.D. Cal. Sept. 6, 2003) (“In light of these facts, Plaintiff’s claim must be read as follows: one or more of Defendants’ 4000-plus products directly infringes, contributorily infringes, or induces infringement of at least one claim in each of the patents-in suit. Form 16 [now Form 18] simply does not address a factual scenario of this sort.”). It is also notably silent on any theory of patent infringement besides direct infringement. See, e.g., *Halton Co. v. Streivor, Inc.*, 2010 WL 2077203, *3 (N.D. Cal. May 21, 2010); accord *Eolas Techs, Inc. v. Adobe Sys., Inc.*, 2010 WL 2026627, *3 (E.D. Tex. May 6, 2010).

Despite the limitations of Form 18, and mounting concern that, where applicable, the form is found wanting under *Twombly* and *Iqbal*—under Rule 84 of the Federal Rules of Civil Procedure, a court must accept as sufficient any pleading made in conformance with its terse requirements. *Id.* This has been troubling not only to district court judges, but to Judge Dyk of the United States Court of Appeals for the Federal Circuit (the court through which all patent appeals must pass, and certainly an experienced body to weigh in on this debate). In a separate opinion filed in *McZeal v. Sprint Nextel Corp.*, 501 F.3d 1354 (Fed. Cir. 2007), Judge Dyk—noting the limitations of a form which originated before the Second World War—commented that: “One can only hope that the rulemaking process will eventually result in eliminating the form, or at least in revising it to require allegations specifying which claims are infringed, and the features of the accused device that correspond to the claim limitations.” *Id.* at 1360 (Dyk, J., concurring in part and dissenting in part).

While troubling enough to provide fair notice of a would-be plaintiff’s claim when the allegation is one that a particular product (e.g. the electric motors used as an exemplar in the form) infringes a product patent, Form 18’s limitations are immediately apparent when the template is used—as is frequently the case—to accuse an entire website or channel of commerce of infringing, in some unspecified manner, a method or software patent. In such instances, Form 18 may regrettably “unlock the doors of discovery for a plaintiff armed with nothing more than conclusions.” *Iqbal*, 129 S.Ct. at 1950.

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This brings us to our present proposal, which is informed by Judge Dyk's admonition that a revised Form 18 should require "allegations specifying which claims are infringed, and the features of the accused devices that correspond to the claim limitations." *McZeal*, 501 F.3d at 1360 (Dyk, J., concurring in part and dissenting in part).

Very truly yours,

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Enclosures

PROPOSED REVISED FORM 18 OF THE FEDERAL RULES OF CIVIL PROCEDURE

UNITED STATES DISTRICT COURT
[NAME OF DISTRICT]
[NAME OF DIVISION]

[PLAINTIFF’S NAME],)
)
Plaintiff,)
)
v.) Case No.
)
[DEFENDANT’S NAME],)
)
Defendants.)

COMPLAINT

- 1. This is a complaint for patent infringement.
- 2. [Statement of Jurisdiction. See Fed. R. Civ. P. App., Form 7.]
- 3. On [Date], the United States Patent and Trademark Office issued U.S. Patent No.

[Number] (“Patent”) for [description of invention]. Plaintiff owned the patent throughout the period of Defendant’s infringing acts, and still owns the patent. A copy of Patent is attached as Exhibit [#].

[DIRECT PATENT INFRINGEMENT]

4. The defendant has infringed, and is still infringing, claim [Number(s)] of Patent by making, selling, and using [Accused Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/Instrumentality(ies)].

5. Defendant has infringed Claim [Number] by making, selling, and using [Accused Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/Instrumentality(ies)]. A chart identifying specifically where each element of Claim [Number] is found within each [Accused Product/Device/Process/Method/Act/Instrumentality] and whether that element is infringed literally or under the doctrine of equivalents is attached as Exhibit [#].

[Repeat for additional asserted claims.]

[INDUCED PATENT INFRINGEMENT]

6. [Third Party] has directly infringed Claim [Number] by making, selling, and using [Accused Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/Instrumentality(ies)]. A chart identifying specifically where each element of Claim [Number] is found within each [Accused Product/Device/Process/Method/Act/Instrumentality] and whether that element is infringed literally or under the doctrine of equivalents is attached as Exhibit [#].

7. At or before the time of Third Party's infringement of Claim [Number] of Patent, Defendant knew of Patent/deliberately disregarded a known risk that Patent existed.

8. Defendant purposely caused, urged, or encouraged [Third Party]'s to take certain acts that infringed Claim [Number] of Patent.

9. Defendant knew that causing, urging, or encouraging [Third Party] to take these acts would result in infringement of Claim [Number]

[Repeat for additional asserted claims.]

[CONTRIBUTORY PATENT INFRINGEMENT]

10. [Third Party] has directly infringed Claim [Number] by making, selling, and using [Accused Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/Instrumentality(ies)]. A chart identifying specifically where each element of Claim [Number] is found within each [Accused Product/Device/Process/Method/Act/Instrumentality] and whether that element is infringed literally or under the doctrine of equivalents is attached as Exhibit [#].

11. Defendant offered to sell or sold within the United States or imported into the United States [Component/Material/Apparatus] that constituted a material part of the Accused Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/ Instrumentality(ies).

12. Defendant knew that [Component/Material/Apparatus] was especially made or adapted for use in infringement of Patent.

13. [Component/Material/Apparatus] is not a staple article or commodity of commerce suitable for a substantial non-infringing use.

[Repeat for additional asserted claims.]

[JOINT PATENT INFRINGEMENT]

14. Defendant and [Third Party] together directly infringed Claim [Number] by making, selling, and using [Accused Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/Instrumentality(ies)]. A chart identifying specifically where each element of Claim [Number] is found within each [Accused Product/Device/Process/Method/Act/Instrumentality] and whether that element is infringed literally or under the doctrine of equivalents is attached as Exhibit [#].

15. Defendant directed or controlled the activities of [Third Party] that constituted its contribution to the direct infringement of Claim [Number] of Patent.

16. In performing the acts that constituted its contribution to the direct infringement of Claim [Number] of Patent, [Third Party] acted on behalf of Defendant as Defendant's agent/pursuant to a contract with Defendant.

[Repeat for additional asserted claims.]

17. Defendant has been harmed by the infringement of Patent described above.

18. Defendant will continue to engage in conduct that infringes Patent unless enjoined by this Court.

19. Plaintiff's [Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/Instrumentality(ies)] embodies Claim [Numbers] of Patent.

20. Plaintiff has complied with the statutory requirement of placing a notice on all [Product(s)/Device(s)/Process(es)/Method(s)/Act(s)/ Instrumentality(ies)] it manufactures and sells, and has given Defendant written notice of infringement.

PRAYER

Based on the foregoing, Plaintiff demands:

- A. A preliminary and final injunction against continuing infringement of Patent;
- B. Damages in an amount to be determined at trial;
- C. Interest and costs; and
- D. Any other and further relief ordered by the Court.

Dated: January 13, 2011

Respectfully

submitted,

/s/
[Counsel of Record]
[Address]
[Telephone number]
[E-mail address]

Attorneys for [Plaintiff]