

PROPOSED LOCAL RULE ____

SCHEDULING AND PROCEDURES IN PATENT INFRINGEMENT CASES

(A) Disclosures Where the Complaint Asserts a Claim for Patent Infringement

In actions in which the Complaint asserts a claim for patent infringement, the parties shall make the following disclosures:

(1) Preliminary Infringement Disclosures

No later than 21 days after a defendant has filed its Answer to the patent infringement claim, the plaintiff shall serve on that defendant (but not file) the following:

- (a) A claim chart identifying specifically:
 - (i) where each limitation of each asserted claim is found within each of the accused product(s), device(s) or method(s).
 - (ii) For each limitation that plaintiff contends is governed by 35 U.S.C. § 112(6) (means-plus-step or function) the identity of the structure(s), act(s), element(s), step(s), or material(s) in the accused product(s) or device(s) that corresponds to the structure identified in the patent specification that performs the claimed function.
- (b) The plaintiff must also disclose whether each limitation of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the accused product(s), device(s) or method(s).
- (c) In addition to the above disclosures, plaintiff must produce, or make available for inspection and copying, the following (together with any English translations of such documents completed prior to the date of such disclosures):
 - (i) a copy of the file history for each patent;

- (ii) a copy of the foreign counterparts for each patent asserted;
- (iii) all licenses (current or expired) for each patent;
- (iv) all rulings in any other cases in which the patents have been asserted regarding claim construction, validity, infringement, license defense, enforceability, and any other defenses;
- [(v) all documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application or the priority date identified in each patent.]*

(2) Preliminary Invalidity and Non-Infringement Disclosures

No later than 30 days after service of the plaintiff's Preliminary Infringement Disclosure, the defendant to which plaintiff's disclosures are directed shall serve (but not file) its Preliminary Invalidity and Non-Infringement Disclosures, including the following:

- (a) To the extent these items are in the defendant's possession, custody, or control, one sample of each accused product(s) or device(s). If a sample is not available or would be unduly burdensome to produce, defendant will make available for plaintiff's inspection the accused product(s) or device(s) (this does not limit plaintiff's right to seek other samples and drawings through discovery).
- (b) Documents reflecting the quantity of each of the accused infringing product(s) or device(s) that it made, sold, and/or imported in the United States

* A provision requiring the production of documents relating to conception and reduction to practice was not included in the proposal distributed for review and comment to state and local bar IP bar associations. After comments were received and addressed, however, Judge O'Grady reviewed the draft proposal and suggested the inclusion of such a provision. Accordingly, the provision has been added, in brackets, so that the judges may consider it.

during the six years prior to the filing of the complaint, or since the issuance of the patent, whichever is later.

(c) Each item or combination of prior art that defendant contends anticipates each asserted claim.

(d) Each item or combination of prior art that defendant contends renders each asserted claim obvious.

(e) A chart identifying specifically in each alleged item of prior art where each limitation of each asserted claim is found, including for each limitation that defendant contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), element(s), step(s), or material(s) in each item of prior art that corresponds to the structure identified in the patent that performs the claimed function.

(f) Any grounds upon which the defendant asserts that any of the asserted claims are invalid for any reason other than prior art.

(g) A copy of each item of prior art identified by the defendant that does not appear in the file history of the patent(s) at issue (together with any English translations of such documents completed prior to the date of such disclosures).

(3) Confidentiality

If any document or information produced under this Rule is deemed confidential by the producing party and if the Court has not entered a protective order, until a protective order is issued by the Court, the document shall be marked “Confidential” or with some other confidential designation (e.g., “Confidential – Outside Attorneys Eyes Only”) by the disclosing party and disclosure of the confidential document or information shall be limited to each party’s

outside attorney(s) of record and the employees of such outside attorney(s). If a party is not represented by an outside attorney, disclosure of the confidential document or information shall be limited to one designated “in house” attorney, whose identity and job functions shall be disclosed to the producing party five (5) days prior to any such disclosure, in order to permit any motion for protective order or other relief regarding such disclosure. The person(s) to whom disclosure of a confidential document or information is made under this local rule shall keep it confidential and use it only for purposes of litigating the case.

(B) Disclosures in Declaratory Judgment Actions

In actions in which the Complaint seeks a declaratory judgment of patent invalidity or non-infringement, the disclosure requirements of subsections (A) (1) and (2) above apply as if the action had been initiated by the declaratory judgment defendant/patent holder, except that the Preliminary Infringement Disclosures required by subsection (A)(1) shall be made 21 days after the declaratory judgment defendant/patent holder files a counter-claim for infringement. If the declaratory judgment defendant/patent holder does not assert a counter-claim for patent infringement, then only the requirements of subsection (A)(2) shall apply and such disclosures shall be made by the declaratory judgment plaintiff/potential infringer 21 days after the filing of the Answer.

(C) Supplementation of Preliminary Disclosures

The parties shall supplement their disclosures under sections (A) and (B) above in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing. In the event that a party amends or supplements its preliminary disclosures later than 30 days before the close of

fact discovery, the opposing party, without limiting any other remedies, may seek leave of Court for supplemental discovery limited to issues raised by such amended or supplemental disclosures.

(D) Scheduling Order

The initial pretrial scheduling conference in cases raising issues of patent infringement should result in a specially tailored Scheduling Order. A template for such a Scheduling Order as well as a Model Scheduling Time Table are set forth in the Appendix.

(E) Additional Items for Consideration by the Court and the Parties

In addition to the parties' obligations under Fed. R. Civ. P. 26(f), the parties in cases raising issues of patent infringement shall consider and address in their initial conference pursuant to Fed. R. Civ. P. 26(f) any modifications to the Sample Scheduling Order disclosed in the Appendix, including the following issues:

- (1) Whether claim construction is necessary, and, if so, the process for identifying disputed claim terms, exchanging proposed claim constructions, and claim construction briefing.
- (2) The timing of and procedure for the claim construction hearing, including:
 - (a) whether the Court should decide claim construction through live testimony at a hearing, or based solely on the papers and attorney argument; and
 - (b) the timing of any claim construction hearing relative to summary judgment, expert discovery, and the close of fact discovery.
- (3) The need for tutorials on the relevant technology, including:
 - (a) the form and scope of any such tutorials; and
 - (b) the timing for such tutorials.

(4) The identification of dispositive issues that may lead to an early resolution of the litigation.

(5) Whether a claim construction order before the close of expert discovery and prior to the filing of dispositive motions would encourage resolution of the litigation.

APPENDIX

MODEL SCHEDULING TIME TABLE FOR PATENT INFRINGEMENT CASES

<u>EVENT</u>	<u>APPROXIMATE DAYS FROM RULE 16 CONFERENCE</u>
1. Parties' Stipulated Protective Order	(5-10)
2. Motions for Protective Order if Parties Fail to Agree on a Stipulated Protected Order	(10-14)
3. Simultaneous Exchange of Claim Terms to be Construed and Proposed Constructions	(14-21)
4. Parties' Opening Claim Construction Briefs	(28-35)
5. Parties' Reply Claim Construction Briefs	(42-49)
6. Joint Claim Construction Statement	(56-63)
7. Exchange of Technology Tutorial Information	(66-69)
8. Claim Construction Hearing (no more than 1 day – up to 3.5 hours each)	(70-80)
9. Fact Discovery Cut Off and disclosure of experts	(113-123)

10. First Expert Report	(120-130)
11. Rebuttal Expert Report	(141-151)
12. Close of Expert Discovery	(155-160)
13. Dispositive Motion Cut-off	(162-167)
14. Final Pretrial Conference	(205-215)
15. Trial	(230-245)

APPENDIX

SAMPLE SPECIAL SCHEDULING ORDER FOR PATENT INFRINGEMENT CASES

This appendix sets forth a Sample Scheduling Order for claim construction and related procedures in cases raising issues of patent infringement [with suggested timing in brackets]. The parties may propose modifications to the Sample Scheduling Order and the Court may modify the Sample Scheduling Order at its discretion.

(A) Protective Order

The parties will submit a stipulated protective order by _____ [5-10 days after the Rule 16 Conference]. Should the parties fail to agree on a stipulated protective order, the matter shall be brought before the Court by motion no later than _____ [10-14 days after the Rule 16 Conference].

(B) Claim Construction (a.k.a. “Markman Hearing”) Proceedings

(1) No later than 5:00 p.m. _____ [14-21 days after the Rule 16 Conference], the parties shall exchange (but not file) a list of claim terms to be construed and proposed constructions. The proposed constructions are not binding on either party and cannot be cited by either party.

(2) Within 5 days of the exchange of claims to be construed and proposed constructions, the parties shall meet and confer to agree on the claim terms to be construed and shall file a joint statement of the claim terms to be construed and each party’s proposed construction of such terms. The proposed constructions are not binding but may be cited.

(3) No later than 5:00 p.m. _____ [14 days after exchanging the list of claims required in (B)(1)], the parties shall file opening claim construction briefs. Each brief

shall contain a list of terms construed, the party's proposed construction of each term, and evidence and argument supporting each construction.

(4) No later than 5:00 p.m. _____ [14 days following the filing of opening claim construction briefs], the parties shall file reply claim construction briefs.

(5) No later than 5:00 p.m. _____ [14 days following the filing of reply claim construction briefs], the parties shall finalize the list of disputed terms for the Court to construe. The parties shall prepare and file a joint claim construction and prehearing statement (hereafter the "joint statement") that identifies both agreed and disputed terms.

(a) The joint statement shall note the anticipated length of time necessary for the claim construction hearing and whether any party proposes to call witnesses, including a statement that such extrinsic evidence does not conflict with intrinsic evidence. Without leave of Court, the claim construction hearing shall be limited to no more than one day with each party receiving up to three hours and thirty minutes (3.5 hours) to present their case.

(b) The joint statement shall also indicate whether the parties wish to present tutorials on the relevant technology and the form of such tutorials. If the parties wish to present a technology tutorial, then the parties shall make that recommendation at the Rule 16 Conference. If the Court grants permission, then the parties should provide tutorials in the form of briefs, declarations, computer animations, slide presentations, or other media, the parties shall exchange such materials on _____ [approximately 1-4 days before the claim construction hearing]. Alternatively, the parties may present tutorials through presentations by the attorneys or experts at the claim construction hearing.

(c) The joint statement shall include a proposed order addressing how the parties propose to present their arguments at the claim construction hearing, which may be term-by-term or party-by-party, depending on the issues in the case.

(d) The joint statement shall identify no more than ten (10) claim terms to be construed and shall prioritize the disputed terms in order of importance. A party may request by motion that the Court construe more than ten claim terms, but the party must provide a detailed statement of reasons and prioritize the terms based on order of importance.

(e) The joint statement shall include a joint claim construction chart, noting each party's proposed construction of each term, and supporting evidence. The parties must identify the following in the joint statement:

- (i) the construction of agreed claims and terms;
- (ii) each side's construction of disputed claims and terms, if any;
- (iii) each side's rebuttal to the proposed construction submitted by the opposing party, if any; and
- (iv) if disputed claims and terms exist, each proposed witness at the claim-construction hearing together with a brief description of the witness's testimony.

(C) The Claim Construction Hearing (a.k.a. "Markman Hearing")

The Markman Hearing will be held on _____ [70-80 days after the Rule 16 Conference].

(D) After the Claim Construction Hearing

In the event that a ruling on claim construction has not issued 30 days prior to the close of expert discovery, and upon motion or stipulation of the parties, the Court may grant additional time for supplemental expert discovery not to exceed thirty (30) days after the ruling on claim construction. Such additional expert discovery, including expert reports and depositions, shall be limited to issues of infringement, invalidity, damages, or unenforceability specifically dependent on the claim construction.

(E) Expert Discovery

Expert discovery, including expert reports and depositions, shall be scheduled to close by 5:00 p.m. on _____ [165-170 days after the Rule 16 Conference].

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