

## APPENDIX B

# SUPPLEMENTAL RULES FOR PATENT CASES

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## 1.1 SCOPE OF SUPPLEMENTAL RULES

- (a) **Title and Citation.** The procedures governing all patent cases in which jurisdiction is based, in whole or in part, on 28 U.S.C. § 1338, shall be known as the "Supplemental Patent Rules." They shall be cited as "SPR \_\_\_\_."
- (b) **Court Discretion to Depart from Rules.** The court shall have the discretion to depart from the specific provisions of the Supplemental Patent Rules to the extent a particular case presents exceptional circumstances warranting such departure.
- (c) **Compliance.** In cases in which the Supplemental Patent Rules apply, the provisions herein shall bind the parties, and the parties may not seek to circumvent these provisions (e.g., by pursuing discovery into infringement and invalidity contentions through discovery requests seeking responses prior to the contentions process set out herein).
- (d) **Relationship to Other Rules.** For all matters not addressed by the Supplemental Patent Rules, the Federal Rules of Civil Procedure, other applicable Local Rules, and any applicable judicial orders shall govern.

## 2.1 PLEADING PATENT INFRINGEMENT CLAIMS OR COUNTERCLAIMS

- (a) **Special Pleading Requirements.** Any pleading containing patent infringement claims or counterclaims must contain:
- (1) a list of all products or processes (by model number, trade name, or other specific identifying characteristic) for which the claimant or counterclaimant has developed a good-faith basis for alleging infringement, as of the time of filing the pleading; and
  - (2) at least one illustrative asserted patent claim (per asserted patent) for each accused product or process.
- (b) **Scope of Discovery.** Discovery shall not be limited to the products and processes named in the complaint. The party asserting infringement may also engage in discovery into other products with reasonably similar features or other processes with reasonably similar steps.

## 3.1 SCHEDULING CONFERENCE, DISCOVERY PLAN, AND DISCOVERY ORDER

- (a) **Scheduling Conference/Discovery Plan.** In the absence of exceptional circumstances, not later than thirty (30) days after service of the last filed answer, the court will hold a patent case scheduling conference. Pursuant to the process set forth in Federal Rule of Civil Procedure 26(f), the parties shall meet and confer in advance of this conference. The parties' Rule 26(f) "Discovery Plan" shall address the following sections contained in the Civil Form 2,

Sample Discovery Plan: Date/Place of Conference; Counsel Present/Representing; Case Summary; Jurisdictional Questions; Type of Trial; Discovery Needed; Electronic Information Disclosures; Stipulation Regarding Claims of Privilege/Protection of Trial Preparation Materials; Interrogatories; Requests for Admission; Depositions; Disclosures of Claims Against Unnamed Parties; Joinder of Additional Parties; Amendment of Pleadings; Settlement Possibilities; Joint Statement Re Mediation; Trial Estimate; and Trial Date.

**(b) Protective Order.** Contemporaneous with the filing of the Discovery Plan, the parties may also submit:

(1) a jointly proposed protective order, or

(2) competing proposed protective orders accompanied by memoranda (5 pages or less) explaining the differences between the proposed orders and each party's justification for its proposal.

Jointly proposed protective orders are strongly preferred by the court.

**(c) Discovery Order.** The court will issue a discovery order promptly after the conference, which shall include a trial date. Subject to the demands of the court's docket, trial should be scheduled for no later than two (2) years after the date the complaint was filed. The court will also rule promptly after the conference on any proposed protective order(s).

**(d) Confidential Disclosures Pending Entry of Protective Order.** Prior to entry of a protective order, no party may delay disclosures under the Supplemental Patent Rules, or responses to discovery, on the ground of confidentiality. Confidential disclosures and discovery responses may be designated (by the producing party) as "outside attorneys' eyes only" until the entry of a protective order, at which point all information must be treated in accord with the terms of the protective order.

#### **4.1 GENERAL PROVISIONS GOVERNING PATENT DISCLOSURES**

**(a) Certification of Disclosures.** All statements, disclosures, or charts filed or served in accordance with the Supplemental Patent Rules shall be dated and signed by counsel of record. Counsel's signature shall constitute a certification that to the best of his or her knowledge, information, and belief, formed after an inquiry that is reasonable under the circumstances, the information contained in the statement, disclosure, or chart was complete and correct at the time it was made.

**(b) Admissibility of Disclosures.** Statements, disclosures, or charts governed by the Supplemental Patent Rules are admissible evidence to the extent permitted by the Federal Rules of Evidence or Procedure and any applicable judicial orders (e.g., orders adjudicating motions in limine). The statements, disclosures, or charts are also admissible in separate proceedings (e.g., Patent Office proceedings) to the extent permitted by the rules governing such proceedings.

(c) **Declaratory Judgment Actions.** The same disclosure process (including the same sequence of disclosures) shall apply in declaratory judgment actions in which the plaintiff is asserting noninfringement and/or invalidity and/or unenforceability of the patent(s)-in-suit. For example, in such actions the defendant-patentee will assert Preliminary Infringement Contentions pursuant to the schedule set out below. If infringement is not contested, the parties shall follow the same disclosure process, but shall limit their contentions and accompanying document productions to those issues that are in dispute.

## 5.1 PRELIMINARY PATENT DISCLOSURES

(a) **Preliminary Infringement Contentions.** Not later than forty-five (45) days after service of the last filed answer, a party claiming patent infringement shall serve on all parties its "Preliminary Infringement Contentions." The "Preliminary Infringement Contentions" shall include an infringement claim chart for each accused product or process ("Accused Instrumentality"). However, if certain Accused Instrumentalities have the same relevant characteristics, they can be grouped together in the same chart.

(1) Each claim chart shall contain the following contentions:

(A) Each claim of each patent in suit that is allegedly infringed by such Accused Instrumentality;

(B) For each claim, an identification of the subsection(s) of 35 U.S.C. § 271 that are asserted;

(C) A specific identification of where each limitation of the claim is found within each Accused Instrumentality, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function; and

(D) Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality.

(2) In addition to the claim chart(s), the "Preliminary Infringement Contentions" shall also include the following contentions:

(A) For each claim which is alleged to have been indirectly infringed, an identification of any direct infringement, the identity of the known direct infringer(s), and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement;

(B) To the extent that the alleged direct infringement is based on joint acts of multiple parties, the identity of each such party and the role of each such party in the direct infringement;

(C) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

(D) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that it practices (or practiced) the claimed invention, the party shall identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that practices (or practiced) that particular claim, and the date(s) that the party began and (if completed) ended such practicing of the claimed invention.

**(b) Document Production Accompanying Preliminary Infringement Contentions.**

With the Preliminary Infringement Contentions, the party asserting patent infringement shall produce to each opposing party or make available for inspection and copying:

(1) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, or any public use of, the claimed invention prior to the date of application for each patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102;

(2) 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 for each patent in suit or the priority date identified pursuant to SPR 5.1(a), whichever is earlier;

(3) A copy of the file history for each patent in suit;

(4) All documents evidencing ownership of the patent rights by the party asserting patent infringement; and

(5) If a party identifies its own practicing instrumentalities pursuant to SPR 5.1(a), documents sufficient to show the operation of any aspects or elements of such instrumentalities the patent claimant relies upon as embodying any asserted claims.

The producing party shall separately identify by production number(s) which documents correspond to each category.

**(c) Preliminary Invalidity Contentions.** Not later than forty-five (45) days after service of the Preliminary Infringement Contentions, each party opposing a claim of patent infringement shall serve on all parties its "Preliminary Invalidity Contentions," which shall contain the following contentions:

(1) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country

of origin, and date of issue. Each prior art publication shall be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in, and the circumstances surrounding, the making of the invention before the patent applicant(s);

(2) Whether each item of prior art anticipates each asserted claim or renders it obvious and, if obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of combinations of prior art showing obviousness, and an explanation of why a person of skill in the art would find obvious the asserted claim(s) in light of such combinations (e.g., reasons for combining references);

(3) A chart (or charts) identifying where specifically in each alleged item of prior art each limitation of each asserted claim is found, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and

(4) Any other asserted grounds of invalidity of any asserted claim(s), including contentions based on 35 U.S.C. § 101 or 35 U.S.C. § 112.

**(d) Document Production Accompanying Preliminary Invalidity Contentions.** With the Preliminary Invalidity Contentions, the party opposing a claim of patent infringement shall produce or make available for inspection and copying:

(1) Documents sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its SPR 5.1(a) chart(s); and

(2) A copy or sample of the prior art identified pursuant to SPR 5.1(c) which does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon shall be produced.

The producing party shall separately identify by production number(s) which documents correspond to each category.

## **6.1 CLAIM CONSTRUCTION PROCEEDINGS**

**(a) Exchange of Proposed Terms for Construction.** Not later than fourteen (14) days after service of the Preliminary Invalidity Contentions, or not later than sixty (60) days after

service of the Preliminary Infringement Contentions in those actions in which validity is not at issue (and SPR 5.1(c) does not apply), each party shall serve on all other parties a list of claim terms which that party contends should be construed by the court, and identify any claim term which that party contends should be governed by 35 U.S.C. § 112(6).

**(b) Exchange of Preliminary Claim Constructions and Extrinsic Evidence, and Conference of the Parties.**

(1) Not later than fourteen (14) days after the exchange of the proposed terms for construction pursuant to SPR 6.1(a), the parties shall simultaneously exchange proposed constructions of each term identified by either party for claim construction. Each such "Preliminary Claim Construction" shall also, for each term which any party contends is governed by 35 U.S.C. § 112(6), identify the function of that term and the structure(s), act(s), or material(s) corresponding to that term's function;

(2) At the same time the parties exchange their respective Preliminary Claim Constructions, each party shall also identify all references from the specification or prosecution history that support its proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses. Extrinsic evidence shall be identified by production number or by producing a copy if not previously produced. With respect to any supporting witness, percipient or expert, the identifying party shall also provide a description of the substance of that witness' proposed testimony that includes a listing of any opinions to be rendered in connection with claim construction;

(3) Not later than fourteen (14) days after the exchange of the Preliminary Claim Constructions, the parties shall thereafter meet and confer for the purposes of limiting the terms in dispute by narrowing or resolving differences and facilitating the ultimate preparation of a Joint Claim Construction and Prehearing Statement. The parties shall also jointly identify no more than ten (10) disputed terms per patent in suit, for inclusion in the Joint Claim Construction and Prehearing Statement. In the event of a dispute as to which terms to include in the Joint Claim Construction and Prehearing Statement, each side shall be presumptively limited to five (5) disputed terms per patent in suit, which limit can only be altered by leave of court.

**(c) Joint Claim Construction and Prehearing Statement.** Not later than fourteen (14) days after they meet and confer pursuant to SPR 6.1(b)(3), the parties shall complete and file a Joint Claim Construction and Prehearing Statement. This statement shall address no more than ten (10) disputed terms per patent in suit, and shall contain the following information:

(1) The construction of those terms on which the parties agree;

(2) Each party's proposed construction of each disputed term, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on

which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses;

(3) The anticipated length of time necessary for the Claim Construction Hearing; and

(4) Whether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and for each witness, a summary of his or her testimony including, for any expert, each opinion to be offered related to claim construction.

**(d) Completion of Claim Construction Discovery.** Not later than twenty-one (21) days after the filing of the Joint Claim Construction and Prehearing Statement, the parties shall complete all discovery relating to claim construction, including any depositions with respect to claim construction of any witnesses, including experts, identified in the Joint Claim Construction and Prehearing Statement.

**(e) Claim Construction Briefs.**

(1) Not later than twenty-one (21) days after the deadline for completion of claim construction discovery as set forth in section (d) above, the parties shall file their respective opening briefs and any evidence supporting their claim constructions. Each party's opening brief may not exceed thirty (30) pages absent prior leave of court;

(2) Not later than fourteen (14) days after service of an opening brief, each opposing party shall file its responsive brief and supporting evidence. Each party's responsive brief may not exceed twenty (20) pages absent prior leave of court;

(3) Further briefing (including reply and surreply briefing) is not permitted without prior leave of court.

**(f) Claim Construction Hearing.** Not later than sixty (60) days after service of responsive briefs, and subject to the convenience of the court's calendar, the court will conduct a claim construction hearing if the court believes a hearing is necessary for construction of the claims at issue. The court may also order in its discretion a tutorial hearing, to occur before, or on the date of, the claim construction hearing. The court will work expeditiously to issue a prompt claim construction order after the hearing.

## **7.1 FINAL PATENT DISCLOSURES**

**(a) Final Infringement Contentions.**

(1) Not later than twenty-one (21) days after service of the court's claim construction order, any party asserting infringement must serve on all parties its "Final Infringement

Contentions," which shall include the party's final statement of all contentions required by SPR 5.1(a). A party may not assert at trial any infringement contentions not set out in its Final Infringement Contentions;

(2) To the extent the Final Infringement Contentions identify additional accused products or processes not set out in the Preliminary Infringement Contentions, such amendment must be supported by good cause (e.g., discovery of previously unavailable information) and the party asserting infringement must include a separate statement providing the specific grounds establishing such good cause. The accused infringer may move to exclude such amendment on the ground that good cause does not exist. Such motion must be filed within fourteen (14) days after service of the Final Infringement Contentions. If such motion is filed (or if filed not granted), the amendment will be effective.

**(b) Final Invalidation Contentions.**

(1) Not later than twenty-one (21) days after service of the Final Infringement Contentions, each accused infringer must serve on all parties its "Final Invalidation Contentions," which must include that party's final statement of all contentions required by SPR 5.1(c). The party may not assert at trial any invalidity contentions not set out in its Final Invalidation Contentions;

(2) To the extent the Final Invalidation Contentions identify additional prior art, such amendment must be supported by good cause (e.g., discovery of previously unavailable information) and the accused infringer must include a separate statement providing the specific grounds establishing such good cause. The party asserting infringement may move to exclude such amendment on the ground that good cause does not exist. Such motion must be filed within fourteen (14) days after service of the Final Invalidation Contentions. If such motion is not filed (or if filed not granted), the amendment will be effective.

## **8.1 EXPERT DISCOVERY**

Expert discovery on issues other than claim construction will proceed as follows:

**(a) Expert Reports.**

(1) Opening expert reports on issues for which the parties will bear the burden of proof at trial will be due forty-five (45) days after service of the Final Invalidation Contentions, or, in cases in which invalidity is not at issue, forty-five (45) days after service of the Final Infringement Contentions;

(2) Rebuttal expert reports will be due forty-five (45) days after service of the opening expert reports.

**(b) Completion of Expert Depositions.** Completion of expert depositions will occur no later than forty-five (45) days after service of the rebuttal expert reports.