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## VIII. PATENTS

### RULE 801. SCOPE

Unless otherwise ordered by the Court, these Rules apply to all civil actions filed in or transferred to this Court in which one or more parties (a) assert claims of patent infringement; (b) seek a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable; (c) seek an order pursuant to 35 U.S.C. § 256 directing the Director of Patents of the United States Patent Office to issue a certificate to correct an error regarding the identity of inventors; or (d) assert a claim pursuant to 35 U.S.C. § 292 for false marking. Section I of the Local Rules of this Court shall also apply to such actions, except to the extent that they are inconsistent with the Local Rules in this Section VIII.

### RULE 802. SCHEDULING CONFERENCE

Within seven (7) days after an Answer has been filed or, with respect to a case that has been transferred to this District, within seven (7) days after the case has been docketed, Plaintiff's counsel shall contact all counsel and Chambers to arrange a telephone conference between counsel for the parties and Chambers for the purpose of scheduling a Scheduling Conference. Counsel should be prepared to address the following issues during the Scheduling Conference:

- a. Proposed modification of the obligations or deadlines set forth in Section VIII of the Local Rules;
- b. The scope and timing of discovery, including expert witness disclosures and expert witness depositions, and limits on the total number of hours of fact witness depositions;
- c. The scope and timing of dispositive motions;
- d. Limits on the number of patent claims that can be construed by each party;
- e. The format of the Claim Construction Hearing, including whether the Court will hear live testimony, the order of presentation, and the estimated length of the hearing;
- f. How the parties intend to educate the Court on the patent(s) at issue;
- g. The need for any Confidentiality Order in accordance with L.R. 104.13;

- h. Whether any party intends to seek discovery of electronically stored information and whether the parties have reached an agreement on such discovery. (The Court will expect that counsel will have reviewed the Principles for the Discovery of Electronically Stored Information in Civil Cases, published on the Court's website.);
- i. Whether the parties unanimously consent to proceed before a United States Magistrate Judge;
- j. Whether the parties jointly request an early settlement or ADR conference; and
- k. The applicability and propriety of the form of Stipulated Order referenced in L.R. 104.13.

Unless justice requires otherwise, the Court will approve reasonable adjustments to the deadlines set forth in Section VIII of the Local Rules when (1) all parties agree to the adjustments; (2) a case involves particularly complex technologies or a large number of patents; (3) the parties include non-U.S. entities or individuals; or (4) a substantial portion of the testimonial or documentary evidence will require translation to English.

## **RULE 803. DISCOVERY**

### **1. Commencement**

Subject to L.R. 803.2, discovery shall be conducted in accordance with L.R. 104 and shall not commence until the issuance of a Scheduling Order.

### **2. Objections**

Except as provided in this Rule or as otherwise ordered, it shall not be a ground for objecting to an opposing party's discovery request (e.g., interrogatory, document request, request for admission, deposition question) that the discovery request or disclosure requirement is premature in light of, or otherwise conflicts with, Section VIII of the Local Rules. A party may object, however, to responding to the following categories of discovery requests on the ground that they are premature in light of the timetable provided in Section VIII of the Local Rules:

- a. Requests seeking to elicit a party's claim construction position;
- b. Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, or other instrumentality;

- c. Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art; and
- d. Requests seeking to elicit from an accused infringer the identification of any advice of counsel, and related documents.

Where a party properly objects to a discovery request as set forth above, that party shall provide the requested information on the date on which it is required to be provided to an opposing party under Section VIII of the Local Rules or as set by the Court, unless there are other legitimate grounds for objection.

## **RULE 804. DISCLOSURES**

### **1. Cases Involving Claims of Infringement**

Unless otherwise ordered by the Court, in all cases other than those arising under the Hatch-Waxman Act (21 U.S.C. § 355), in which a party has asserted a claim of patent infringement, the parties shall make the following disclosures.

#### a) Initial Disclosure of Infringement Contentions

Thirty (30) days from the date of the Scheduling Order, any party claiming patent infringement shall serve on all parties an Initial Disclosure of Infringement Contentions, separately setting forth for each allegedly infringing party, the following information:

- i. Each claim of each patent in suit that is allegedly infringed by each allegedly infringing party, including for each claim the applicable statutory subsections of 35 U.S.C. § 271 asserted;
- ii. Separately for each allegedly infringed claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each allegedly infringing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus shall be identified by name or model number, if known. Each method or process shall be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;
- iii. A chart identifying specifically where each limitation of each asserted 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;

- iv. For each claim which is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement. Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described;
  - v. Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;
  - vi. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;
  - vii. The date of conception and the date of reduction to practice of each asserted claim;
  - viii. If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party shall identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim; and
  - ix. If a party claiming patent infringement alleges willful infringement, the basis for such allegation.
- b) Document Production Accompanying Initial Disclosure of Infringement Contentions

With the Initial Disclosure of Infringement Contentions, the party claiming patent infringement shall produce to each allegedly infringing party or make available for inspection and copying all documents relating to:

- i. Any offers to sell or efforts to market each claimed invention prior to the date of the application for the patent (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);
- ii. The standing of the party alleging infringement with respect to each patent upon which such allegations are based; and
- iii. A copy of the file history for each patent in suit.

c) Initial Disclosure of Invalidity Contentions in Defense of Infringement Claims

Sixty (60) days from the date of the Scheduling Order, each party opposing a claim of patent infringement shall serve on all parties its Invalidity Contentions, which shall contain the following information:

- i. 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);
- ii. Whether each item of prior art anticipates each asserted claim or renders it obvious. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness;
- iii. A chart 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
- iv. Any grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112 ¶(2), or enablement or written description under 35 U.S.C. § 112 ¶(1) of any of the asserted claims.

d) Document Production Accompanying Initial Disclosure of Invalidity Contentions

With the Initial Disclosure of Invalidity Contentions, the party opposing a claim of patent infringement shall produce or make available for inspection and copying a copy of any prior art identified in the Initial Disclosure of Invalidity Contentions that 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.

**2. Cases Seeking Declaratory Judgment of Invalidity**

Unless otherwise ordered by the Court, in all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is invalid, and there are no claims for patent infringement asserted by any party, the parties shall make the following disclosures.

a) Initial Disclosure of Invalidity Contentions

Thirty (30) days from the date of the Scheduling Order, the party seeking a declaratory judgment of invalidity shall serve upon each opposing party its Initial Disclosure of Invalidity Contentions that conform to L.R. 804.1.c.

b) Document Production Accompanying Initial Disclosure of Invalidity Contentions

With the Initial Disclosure of Invalidity Contentions, the party seeking a declaratory judgment that a patent is invalid shall produce or make available for inspection and copying the documents described in L.R. 804.1.d.

**3. Cases Arising Under the Hatch-Waxman Act (21 U.S.C. § 355)**

Unless otherwise ordered by the Court, in all cases alleging patent infringement based upon a Paragraph IV certification under 21 U.S.C. § 355, the parties shall make the following disclosures.

a) Initial Disclosure of Invalidity Contentions

Thirty (30) days from the date of the Scheduling Order, the Defendant shall serve upon the Plaintiff its Initial Disclosure of Invalidity Contentions that conform to L.R. 804.1.c.

b) Initial Disclosure of Non-Infringement Contentions

With the Initial Disclosure of Invalidity Contentions, the Defendant shall serve upon the Plaintiff its Initial Disclosure of Non-Infringement Contentions for any patents referred to in Defendants Paragraph IV Certification which shall include a claim chart identifying each claim in the patent at issue in the case and each limitation of each claim and shall specifically

identify for each claim which claim limitation(s) are literally absent from the Defendants allegedly infringing Abbreviated New Drug Application or New Drug Application.

c) Document Production Accompanying Initial Disclosures of Invalidity and Non-Infringement Contentions

With the Initial Disclosures of Invalidity and Non-Infringement Contentions, the Defendant shall produce or make available for inspection and copying and produce to the Plaintiff or make available for inspection and copying the documents described in L.R. 804.1.d, as well as a complete copy of the entire Abbreviated New Drug Application or New Drug Application that is the basis of the case in question and any document or thing that the Defendant intends to rely on in defense against any infringement contentions by Plaintiff.

d) Initial Disclosure of Infringement Contentions

Sixty (60) days from the date of the Scheduling Order, Plaintiff shall serve Defendant with an Initial Disclosure of Infringement Contentions for all patents referred to in Defendants Paragraph IV Certification, which shall contain all disclosures required by L.R. 804.1.a.

e) Document Production Accompanying Initial Disclosure of Infringement Contentions

Plaintiffs Initial Disclosure of Infringement Contentions shall be accompanied by the production of documents required under L.R. 804.1.b.

**4. Cases Seeking Correction of Inventors (35 U.S.C. § 256)**

Unless otherwise ordered by the Court, in all cases in which a party seeks an order directing the Director of Patents to correct the inventors on a certificate of patent pursuant to 35 U.S.C. § 256, the parties shall make the following disclosures.

a) Initial Disclosure of Contribution Contentions

Thirty (30) days from the date of the Scheduling Order, any party seeking an order directing the Director of Patents to correct a certificate of patent pursuant to 35 U.S.C. § 256 by adding to or replacing the inventors identified on the certificate shall serve the opposing parties a claim chart identifying each claim in the patent(s) at issue in the case to which the party alleges a person or persons, not named as inventor or joint inventor on certificate(s) of patent, made a significant contribution in conception and/or reduction to practice, describing the contribution made by the alleged inventor or joint inventor(s), and identifying the date each such contribution was made.

b) Document Production Accompanying Initial Disclosure of Contribution Contentions.

With the Initial Disclosure of Contribution Contentions, the party seeking correction of a certificate of patent shall produce or make available for inspection and copying and produce to opposing parties or make available for inspection and copying:

- i. All documents upon which the party asserts its standing to bring the claim(s) pursuant to 35 U.S.C. § 256; and
- ii. All documents reflecting the alleged inventor or joint inventor(s) contribution to the conception and/or reduction to practice of the inventions described in the claims identified in the Initial Disclosure of Contribution Contentions.

c) Documents Reflecting Conception and Reduction to Practice

Sixty (60) days from the date of the Scheduling Order, the opposing parties shall serve upon the disclosing party all documents reflecting or pertaining to the conception and reduction to practice of the inventions described in the claims identified in the Initial Disclosure of Contribution Contentions.

**5. Cases Alleging False Marking (35 U.S.C. § 292)**

Unless otherwise ordered by the Court, in all cases in which a party alleges false marking pursuant to 35 U.S.C. § 292, the parties shall make the following disclosures.

a) Initial Disclosure of False Marking Contentions

Thirty (30) days from the date of the Scheduling Order, any party asserting a claim of false marking pursuant to 35 U.S.C. § 292 shall serve the opposing parties a chart identifying each item or article that the party claims has been falsely marked, the patent numbers with which the item or article was allegedly marked, the alleged expiration date of each such patent, and, to the extent that the party contends that the item or article is not within the inventions claimed in each such patent, the basis for each such contention.

b) Response to Initial Disclosure of False Marking Contentions.

Sixty (60) days from the date of the Scheduling Order, the opposing parties shall serve upon the disclosing party a chart listing each item or article identified in the Initial Disclosure of False Marking, identifying all patent numbers with which those items and articles were marked and the periods of time during which they were so marked, the number of units of each item and article that were sold during each such period, and the basis for the opposing party's contention that the items and articles were within the inventions claimed in each such patent.



## **6. Amendment to Contentions**

A party may amend Contentions described in L.R. 804.1 through 804.5 upon written consent of all parties or, for good cause shown, upon leave of the Court.

## **7. Advice of Counsel**

Unless otherwise ordered by the Court, not later than thirty (30) days after entry of the Court's claim construction order, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall:

- a. Produce or make available for inspection and copying any written advice and documents related thereto for which the attorney-client and work product protection have been waived;
- b. Provide a written summary of any oral advice and produce or make available for inspection and copying that summary and documents related thereto for which the attorney-client and work product protection have been waived; and
- c. Serve a privilege log identifying any documents other than those identified in L.R. 804.7.a above, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the advice which the party is withholding on the grounds of attorney-client privilege or work product protection.
- d. A party who does not comply with the requirements of this L.R. 804.7 shall not be permitted to rely on advice of counsel for any purpose absent a stipulation of all parties or by order of the Court.

# **RULE 805. CLAIM CONSTRUCTION**

## **1. Cases Involving Claims of Infringement**

Unless otherwise ordered by the Court, in all cases other than those arising under the Hatch-Waxman Act (21 U.S.C. § 355), in which a party has asserted a claim of patent infringement:

- a) Sixty (60) days from the date of the Scheduling Order, the party asserting infringement shall serve on each alleged infringing party a Claim Chart containing the following information:

- i. Each claim of any patent in suit which the party alleges was infringed;
  - ii. Separately for each allegedly infringed claim, the identity of each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each allegedly infringing party;
  - iii. Whether such infringement is claimed to be literal or under the doctrine of equivalents;
  - iv. Where each element of each infringed claim is found within each Accused Instrumentality; and
  - v. If the party alleging infringement wishes to preserve the right to rely on that party’s own apparatus, product, device, process, method, act, or other instrumentality as evidence of commercial success, the party must identify, separately for each claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.
- b) Sixty (60) days from the date of the Scheduling Order, the party asserting infringement shall also serve on each alleged infringing party a Proposed Claim Construction Statement containing the following information for each claim in issue:
- i. Identification of any special or uncommon meanings of words or phrases in the claim;
  - ii. All references from the specification that support, describe, or explain each element of the claim;
  - iii. All material in the prosecution history that describes or explains each element of the claim; and
  - iv. Any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises, as permitted by law.
- c) Ninety (90) days from the date of the Scheduling Order, the alleged infringing parties shall serve upon the party claiming infringement a Responsive Claim Chart containing the following:

- i. 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);
- ii. Whether the prior art anticipates the claim or renders it obvious. If a combination of prior art references makes a claim obvious, that combination must be identified;
- iii. Where, specifically, within each item of prior art each element of the claim is found;
- iv. All grounds of invalidity other than anticipation or obviousness of any of the claims listed in the Claim Chart. This identification must be as specific as possible. For example, each party asserting an enablement defense must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention, specifically citing information or materials obtained in discovery to the extent feasible. Each party asserting an enablement defense must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention; and
- v. If the claimant has alleged willful infringement, the date and a document reference number for each opinion of counsel upon which the party relies to support a defense to the willfulness allegation, including, but not limited to, issues of validity and infringement of any patent in suit.

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- d) Ninety (90) days from the date of the Scheduling Order, the alleged infringing parties shall serve upon the party claiming infringement a Responsive Claim Construction Statement containing the following:
- i. Identification of any special or uncommon meanings of words or phrases in the claim in addition to those disclosed in the Proposed Claim Construction Statement;
  - ii. All references from the specification that support, describe, or explain each element of the claim in addition to or contrary to those described in the Proposed Claim Construction Statement;
  - iii. All material in the prosecution history that describes or explains each element of the claim in addition to or contrary to those described in the Proposed Claim Construction Statement; and
  - iv. Any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises, as permitted by law.
- e) Amendment of a Claims Chart or a Responsive Claims Chart may be made only on stipulation of all parties or by Order of the Court, which shall be entered only upon a showing of excusable subsequent discovery of new information or extraordinary good cause.
- f) One hundred twenty (120) days from the date of the Scheduling Order, the parties, having met and conferred on claim construction, shall file a Joint Claim Construction Statement which shall contain the following information:
- i. The construction of those claims and terms on which the parties agree;
  - ii. Each party's proposed construction of each disputed claim and term, supported by the same information that is required in the respective claim construction statements; and
  - iii. For any party who proposes to call one or more witnesses at any claim construction hearing, the identity of each such witness, the subject matter of his or her testimony, and an estimate of the time required for the testimony.

- g) One hundred twenty (120) days from the date of the Scheduling Order, the parties shall file and serve opening briefs with supporting evidence and identification of any proposed Claim Construction Hearing witnesses.
- h) One hundred fifty (150) days from the date of the Scheduling Order, the parties shall file and serve any responsive brief and supporting evidence directly rebutting their opponents supporting evidence and identifying any additional proposed Claim Construction Hearing witnesses.

## 2. Cases Seeking Declaratory Judgment of Invalidity

Unless otherwise ordered by the Court, in all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is invalid and there are no claims for patent infringement asserted by any party:

- a) Sixty (60) days from the date of the Scheduling Order, the party asserting invalidity shall serve on each alleged infringing party a Claim Chart containing the following information:
  - i. 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);
  - ii. Whether the prior art anticipates the claim or renders it obvious. If a combination of prior art references makes a claim obvious, that combination must be identified;
  - iii. Where, specifically, within each item of prior art each element of the claim is found; and

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- iv. All grounds of invalidity other than anticipation or obviousness of any of the claims listed in the Claim Chart. This identification must be as specific as possible. For example, each party asserting an enablement defense must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention, specifically citing information or materials obtained in discovery to the extent feasible. Each party asserting an enablement defense must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention.
  
  - b) Sixty (60) days from the date of the Scheduling Order, the party asserting invalidity shall also serve on each opposing party a Proposed Claim Construction Statement containing the following information for each claim in issue:
    - i. Identification of any special or uncommon meanings of words or phrases in the claim;
    - ii. All references from the specification that support, describe, or explain each element of the claim;
    - iii. All material in the prosecution history that describes or explains each element of the claim; and
    - iv. Any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises, as permitted by law.
  
  - c) Ninety (90) days from the date of the Scheduling Order, the opposing parties shall serve upon the party claiming invalidity a Responsive Proposed Claim Construction Statement containing the following:
    - i. Identification of any special or uncommon meanings of words or phrases in the claim in addition to those disclosed in the Proposed Claim Construction Statement;
    - ii. All references from the specification that support, describe, or explain each element of the claim in addition to or contrary to those described in the Proposed Claim Construction Statement;

- iii. All material in the prosecution history that describes or explains each element of the claim in addition to or contrary to those described in the Proposed Claim Construction Statement; and
  - iv. Any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises, as permitted by law.
- d) Amendment of a Claims Chart or a Responsive Claims Chart may be made only on stipulation of all parties or by Order of the Court, which shall be entered only upon a showing of excusable subsequent discovery of new information or extraordinary good cause.
- e) One hundred twenty (120) days from the date of the Scheduling Order, the parties, having met and conferred on claim construction, shall file a Joint Claim Construction Statement which shall contain the following information:
- i. The construction of those claims and terms on which the parties agree;
  - ii. Each party's proposed construction of each disputed claim and term, supported by the same information that is required in the respective claim construction statements; and
  - iii. For any party who proposes to call one or more witnesses at any claim construction hearing, the identity of each such witness, the subject matter of his or her testimony, and an estimate of the time required for the testimony.
- f) One hundred twenty (120) days from the date of the Scheduling Order, the parties shall file and serve opening briefs with supporting evidence and identification of any proposed Claim Construction Hearing witnesses.
- g) One hundred fifty (150) days from the date of the Scheduling Order, the parties shall file and serve any responsive brief and supporting evidence directly rebutting their opponents supporting evidence and identifying any additional proposed Claim Construction Hearing witnesses.

### **3. Cases Arising Under the Hatch-Waxman Act (21 U.S.C. § 355)**

Unless otherwise ordered by the Court, in all cases alleging patent infringement based upon a Paragraph IV certification under 21 U.S.C. § 355:

- a) Sixty (60) days from the date of the Scheduling Order, the Defendant shall serve the Plaintiff with a Claim Chart containing the following:
  - i. 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);
  - ii. Whether the prior art anticipates the claim or renders it obvious. If a combination of prior art references makes a claim obvious, that combination must be identified;
  - iii. Where, specifically, within each item of prior art each element of the claim is found; and
  - iv. All grounds of invalidity other than anticipation or obviousness. This identification must be as specific as possible. For example, each party asserting an enablement defense must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention, specifically citing information or materials obtained in discovery to the extent feasible. Each party asserting an enablement defense must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention.
- b) Sixty (60) days from the date of the Scheduling Order, the Defendant shall serve the Plaintiff with a Proposed Claim Construction Statement containing the following information for each claim in issue:
  - i. Identification of any special or uncommon meanings of words or phrases in the claim;



- ii. All references from the specification that support, describe, or explain each element of the claim;
  - iii. All material in the prosecution history that describes or explains each element of the claim; and
  - iv. Any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises, as permitted by law.
- c) Ninety (90) days from the date of the Scheduling Order, the Plaintiff shall serve upon the Defendant a Responsive Proposed Claim Construction Statement containing the following:
- i. Identification of any special or uncommon meanings of words or phrases in the claim in addition to those disclosed in the Proposed Claim Construction Statement;
  - ii. All references from the specification that support, describe, or explain each element of the claim in addition to or contrary to those described in the Proposed Claim Construction Statement;
  - iii. All material in the prosecution history that describes or explains each element of the claim in addition to or contrary to those described in the Proposed Claim Construction Statement; and
  - iv. Any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions, and citations to learned treatises, as permitted by law.
- d) Amendment of a Claims Chart or a Responsive Claims Chart may be made only on stipulation of all parties or by Order of the Court, which shall be entered only upon a showing of excusable subsequent discovery of new information or extraordinary good cause.
- e) One hundred twenty (120) days from the date of the Scheduling Order, the parties, having met and conferred on claim construction, the parties shall file a Joint Claim Construction Statement which shall contain the following information:
- i. The construction of those claims and terms on which the parties agree;

- ii. Each party’s proposed construction of each disputed claim and term, supported by the same information that is required in the respective claim construction statements; and
  - iii. For any party who proposes to call one or more witnesses at any claim construction hearing, the identity of each such witness, the subject matter of his or her testimony, and an estimate of the time required for the testimony.
  - f) One hundred twenty (120) days from the date of the Scheduling Order, the parties shall file and serve opening briefs with supporting evidence and identification of any proposed Claim Construction Hearing witnesses.
  - g) One hundred fifty (150) days from the date of the Scheduling Order, the parties shall file and serve any responsive brief and supporting evidence directly rebutting their opponents supporting evidence and identifying any additional proposed Claim Construction Hearing witnesses.
4. **Cases Seeking Correction of Inventors (35 U.S.C. § 256) and Cases Alleging False Marking (35 U.S.C. § 292)**

Sixty (60) days from the date of the Scheduling Order, the parties, having met and conferred on claim construction, shall report to the Court as to whether there are any contested issues of claims construction and, if so, shall propose a schedule for serving Claim Construction Statements and Responsive Claim Construction Statements and filing a Joint Claim Construction Statement, opening claim construction briefs, and responsive claim construction briefs.

#### **RULE 806. CERTIFICATION OF DISCLOSURES.**

All statements, disclosures, and charts served in accordance with L.R. 804 and L.R. 805 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 is complete and correct at the time it is made.

#### **RULE 807. MOTIONS FOR STAY PENDING REEXAMINATION**

No motion for stay pending reexamination of a patent by the Central Reexamination Unit (“CRU”) of the USPTO shall be considered unless accompanied by a copy of (1) the Reexamination Order and (2) the First Office Action issued by the CRU.