

### **N.D. Ind. L.P.R. 1–1 Scope of the Patent Rules**

- (a) Applicability.** These rules govern cases in which jurisdiction is based, in whole or in part, on 28 U.S.C. § 1338. The court may depart from these rules in exceptional circumstances.
- (b) Compliance.** Litigants are expected to comply with these rules. They may not circumvent them by, for example, pursuing discovery into infringement and invalidity contentions by seeking discovery responses before completion of the preliminary contentions process outlined in N.D. Ind. L.P.R. 3-1.

**N.D. Ind. L.P.R. 2-1 Scheduling, Discovery, and Orders**

- (a) **Scheduling Conference.** The court will hold a scheduling conference within 30 days after the last answer is filed.
- (b) **Discovery Plan.** The parties must comply with Fed. R. Civ. P. 26(f) before the conference. Their discovery plan must address these topics:
- Date/place of conference;
  - Counsel present/parties represented;
  - Case summary;
  - Jurisdictional questions;
  - Type of trial;
  - Discovery needed;
  - Electronic-information disclosures;
  - Stipulation regarding privilege claims/protecting trial-preparation materials;
  - Interrogatories;
  - Requests for admission;
  - Depositions;
  - Joinder of additional parties;
  - Amending pleadings; and
  - Settlement possibilities/mediation.
- (c) **Protective Orders.** The court strongly prefers jointly proposed protective orders. They should be filed with the discovery plan. If the parties are unable to agree on a protective order, they may submit competing proposed protective orders accompanied by memoranda explaining the differences between the proposed orders and the party's

justification for its proposal. These memoranda may not exceed five pages.

- (d) Discovery Order.** The court will issue a discovery order promptly after the 16(b) conference and rule on any protective-order requests.
- (e) Confidential Disclosures.** Before a protective order is entered the parties may not delay making the disclosures these rules require—or responding to discovery—on confidentiality grounds. The producing party may designate confidential disclosures and discovery responses as “outside attorneys’ eyes only” until a protective order is entered. Once entered, all information must be treated according to the order’s terms.

**N.D. Ind. L.P.R. 3-1 Preliminary Disclosures**

- (a) **Preliminary Infringement Contentions.** Within 28 days after the last answer is filed, a party claiming patent infringement must serve on all parties its *preliminary infringement contentions*.
- (b) **Content.** The preliminary infringement contentions must include an infringement-claim chart for each accused product or process (the *accused instrumentality*). If two or more accused instrumentalities have the same relevant characteristics, they may be grouped together in the same chart. Each claim chart must contain the following contentions:
- (1) Each claim of each patent in suit that is allegedly infringed by the accused instrumentality;
  - (2) A specific identification of where each limitation of the claim is found within each accused instrumentality, including for each limitation that the party contends is governed by 35 U.S.C. § 112(f), the identity of the structures, acts, or materials in the accused instrumentality that performs the claimed function; and
  - (3) Whether each limitation of each asserted claim is literally present in the accused instrumentality or present under the doctrine of equivalents.
- (c) **Document Production.** The party asserting patent infringement must produce to each party (or make available for inspection and copying) the following documents with its preliminary infringement contentions and identify—by production number—which documents correspond to each category:
- (1) Documents demonstrating each disclosure, sale (or offer to sell), or any public use, of the claimed invention before the application date for each patent in suit or the priority date (whichever is earlier);
  - (2) All documents that were created on or before the application date for each patent in suit or the priority date (whichever is earlier) that demonstrate each claimed invention's conception and earliest reduction to practice;
  - (3) A copy of the certified Patent Office-file history for each patent in suit; and
  - (4) All documents demonstrating ownership of the patent rights by the party asserting infringement.

- (d) **Safe Harbor.** Producing documents under this rule is not an admission that the document is – or constitutes – prior art under 35 U.S.C. § 102.
- (e) **Preliminary Invalidity Contentions.** Within 28 days after receiving the preliminary infringement contentions, each party opposing the patent-infringement claim must serve on all parties its *preliminary invalidity contentions*. These contentions must include a chart (or charts) identifying each allegedly invalid claim, and each item of prior art that anticipates or renders each claim obvious. Claim charts must contain the following contentions:
- (1) How and under what statutory section the item qualifies as prior art,
  - (2) Whether the prior-art item anticipates or renders each allegedly invalid claim obvious,
  - (3) A specific identification of where in the prior-art item each limitation of each allegedly invalid claim is found, including for each limitation alleged to be governed by 35 U.S.C. § 112(f), where the corresponding structures, acts, or materials are found in the prior-art item that performs the claimed function, and
  - (4) Why, if obviousness is alleged, the prior art renders the allegedly invalid claims obvious, including why combining the identified items of prior art demonstrate obviousness, and explain why a person of skill in the art would find the allegedly invalid claims obvious in light of such combinations (e.g., reasons for combining references).
  - (5) A statement identifying with specificity any other asserted grounds of invalidity of any allegedly invalid claims, including contentions based on 35 U.S.C. §§ 101, 112, or 251.
- (f) **Document Production.** The party opposing a patent-infringement claim must produce to all parties (or make available for inspection and copying) the following documents with its preliminary invalidity contentions. The producing party must separately identify by production number which documents correspond to which category.
- (1) Documents sufficient to show the operation of any aspects or elements of an accused instrumentality identified by the patent claimant in its preliminary infringement contentions charts; and

- (2) A copy or sample of the prior art identified under N.D. Ind. L.P.R. 3(e). If these items are not in English, an English translation of the portions relied upon must be produced.
- (g) **Declaratory-judgment Actions.** The same disclosure process (including the same disclosure sequence) applies in declaratory-judgment actions in which the plaintiff is asserting non-infringement, invalidity, or unenforceability of the patent(s) in suit. For example, in such actions the defendant-patentee will assert preliminary infringement contentions under the schedule set out above. If infringement is not contested, the parties seeking a declaratory judgment must comply with N.D. Ind. L.P.R. 3-1(c) and 3-1(f) within 28 days after the last answer is filed.

**N.D. Ind. L.P.R. 4-1 Claim-construction Proceedings**

- (a) **Exchanging Terms.** Within 14 days after receiving the preliminary invalidity contentions (or within 42 days after receiving the preliminary infringement contentions in those actions in which validity is not at issue), each party must serve on all other parties a list of claim terms that the party contends should be construed by the court (terms for construction), and identify any claim term that the party contends should be governed by 35 U.S.C. § 112(f).
- (b) **Exchanging Preliminary Claim Constructions and Extrinsic Evidence; Parties' Conference.**
- (1) Within 14 days after the proposed terms for construction are exchanged, the parties must exchange proposed constructions of each term (preliminary claim construction[s]). Each preliminary claim construction must also, for each term which any party contends is governed by 35 U.S.C. § 112(f), identify the function of that term and the structures, acts, or materials corresponding to that term's function.
- (2) When the parties exchange their preliminary claim constructions, they must also identify all references from the specification or prosecution history that support its construction and designate any supporting extrinsic evidence including:
- (A) dictionary definitions;
- (B) citations to learned treatises and prior art, and
- (C) testimony of percipient and expert witnesses.
- (3) Within 14 days after the preliminary claim constructions are exchanged, the parties must meet and confer to limit the terms in dispute by narrowing or resolving differences and plan to prepare a *joint claim-construction and prehearing statement*. The parties must also jointly identify no more than ten disputed terms per patent in suit, unless the court grants more for inclusion in the joint claim-construction and prehearing statement. If a dispute arises as to which terms to include in the joint claim-construction and prehearing statement, each side must be presumptively limited to five disputed terms per patent in suit. This limit may only be altered by leave of court.
- (c) **Joint Claim-construction and Prehearing Statement.** Within 14 days after they meet

and confer, the parties must complete and file a *joint claim-construction and prehearing statement*. This statement must address the disputed terms and contain the following information:

- (1) The construction of those terms on which the parties agree;
  - (2) Each party's construction of each disputed term (with the identity of all references from the specification or prosecution history that support its construction) and the identity of any extrinsic evidence known to the party on which it intends to rely either to support its construction or to oppose another party's construction, including 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) If witnesses are to be called 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 witness, a report containing the expert's claim-construction opinions and the reasons for them.
- (d) **Completing Claim-construction Discovery.** Within 21 days after the *joint claim-construction and prehearing statement* is filed, the parties must complete all discovery relating to claim construction, including witness depositions.
- (e) **Claim-construction Briefs**
- (1) **Opening Briefs.** Within 14 days after completing claim-construction discovery, the parties must file their respective opening briefs and any evidence supporting their claim constructions.
  - (2) **Length.** Opening briefs may not exceed 30 pages without leave of court.
  - (3) **Response Briefs.** Within 21 days after receiving an opening brief, each opposing party must file any response briefs and supporting evidence.
  - (4) **Length.** Response briefs may not exceed 20 pages without leave of court.
  - (5) **Additional Briefs.** Reply and surreply briefs are not permitted without leave of court.

- (f) **Joint Claim-construction Chart.** Within 7 days of the last-filed response brief, the parties must file a *joint claim-construction chart*, in the format set forth in Appendix D, containing:
- (1) a column listing each disputed claim term, with the disputed language in bold type;
  - (2) a column in which agreed construction of any claim language material to the dispute is explained; and
  - (3) separate columns for each party's proposed construction of the disputed claim term, briefly stated, with supporting citations to the specification, prosecution history or extrinsic evidence relied upon.
- (g) **Claim-construction Hearing.** When necessary to construe the claims, the court will endeavor to conduct a claim-construction hearing within 63 days after briefing is complete.
- (h) **Tutorial Hearings.** The court may order a tutorial hearing to occur before, or during, the claim-construction hearing.
- (i) **Orders.** The court will work expeditiously to issue a prompt claim-construction order after the hearing.

**N.D. Ind. L.P.R. 5-1 Final Patent Disclosures****(a) Final Infringement Contentions.**

- (1) *Due Date.*** Within 28 days after the court's claim-construction order is entered, any party asserting infringement must serve on all parties its final infringement contentions.
- (2) *Contents.*** Parties may not assert at trial any infringement contentions not set out in its final infringement contentions.
- (3) *Amendments.*** Final infringement contentions may not identify additional accused products or processes not contained in the preliminary infringement contentions without good cause (e.g., discovery of previously undiscovered information or an unanticipated claim-construction ruling). The party asserting infringement must include a separate statement outlining the specific grounds that it claims constitute good cause for the amendment.
- (4) *Exclusion.*** Accused infringers may seek to exclude amendments on grounds that good cause does not exist.
- (5) *Due Date.*** Motions to exclude must be filed within 14 days after receiving the final infringement contentions.
- (6) *Failure to Object.*** Unopposed amendments are deemed effective.

**(b) Final Invalidity Contentions.**

- (1) *Due Date.*** Within 21 days after receiving the final infringement contentions, each accused infringer must serve on all parties its final invalidity contentions.
- (2) *Contents.*** Final invalidity contentions must include that party's final statement of all contentions. The party may not assert at trial any invalidity contentions not contained in its final invalidity contentions.
- (3) *Amendments.*** If the final invalidity contentions identify additional prior art, the amendment must be supported by good cause (e.g., discovery of previously undiscovered information or an unanticipated claim-construction ruling) and the accused infringer must include a separate statement providing the specific grounds establishing good cause for the amendment.

- (4) **Exclusion.** The party asserting infringement may seek to exclude the amendment on grounds that good cause does not exist.
- (5) **Due Date.** Motions to exclude must be filed within 14 days after receiving the final invalidity contentions.
- (6) **Failure to Object.** Unopposed amendments are deemed effective.

**N.D. Ind. L.P.R. 6-1 Expert Discovery**

- (a) **Applicability.** This rule governs expert discovery in patent cases.
- (b) **Exception.** This rule does not apply to claim construction.
- (c) **Reports.**
  - (1) **Opening Reports.** Opening expert reports on issues the proponent will bear the burden of proof at trial are due within 28 days after receiving the final invalidity contentions or, in cases in which invalidity is not at issue, within 28 days after receiving the final infringement contentions.
  - (2) **Rebuttal Reports.** Rebuttal expert reports are due 28 days after receiving opening expert reports.
- (d) **Depositions.** Expert depositions must be completed within 35 days after receiving an expert's rebuttal report.