

# PATENT LOCAL RULES

## 1. Scope of Rules

### 1.1 Title.

These are the Local Rules of Practice for Patent Cases before the United States District Court for the Southern District of California. They should be cited as “Patent L.R. \_\_\_\_\_.”

### 1.2 Effective Date.

These Patent Local Rules take effect on December 1, 2009, and will apply to any case filed thereafter.

### 1.3 Scope and Construction.

These Patent Local Rules apply to all civil actions filed in or transferred to this court which allege infringement of a utility patent in a complaint, counterclaim, cross-claim or third party claim, or which seek a declaratory judgment that a utility patent is not infringed, is invalid or is unenforceable. The court may accelerate, extend eliminate, or modify the obligations or deadlines set forth in these Patent Local Rules based on the court’s schedule or the circumstances of any particular case, including, without limitation, the complexity of the case or the number of patents, claims, products, or parties involved. If any motion filed prior to the Claim Construction Hearing provided for in Patent L.R. 4.5 raises claim construction issues, the court may, for good cause shown, defer the motion until after completion of the disclosures, filings, or ruling following the Claim Construction Hearing. The Civil Local Rules of this court also apply to these actions, except to the extent they are inconsistent with these Patent Local Rules.

### 1.4 Application of Rules When No Specified Triggering Event.

If the filings or actions in a case do not trigger the application of these Patent Local Rules, as soon as any party ascertains that circumstances exist to make applications of these Patent Local Rules appropriate to the case, that party should notify the assigned magistrate judge so the matter may be scheduled for a Case Management Conference.

### 1.5 Notice of Related Patent Case.

Civil Local Rule 40.1 applies to patent cases. The parties must notify the Court of any other cases in the district involving the same patent.

## 2. General Provisions

### 2.1 Governing Procedure.

- a. **Early Neutral Evaluation (“ENE”) Conference.** Within sixty (60) days of a defendant making its first appearance in the case, counsel and the parties will appear before the assigned magistrate judge for an ENE conference pursuant to Civ. L.R. 16.1.c.1. No later than twenty-one (21) days before the ENE, the parties will meet and confer pursuant to Fed. R. Civ. P. 26(f).

If no settlement is reached at the ENE Conference, the magistrate judge will proceed with the Initial Case Management Conference. At the end of the conference, the magistrate judge must prepare a case management order which will include:

1. A discovery schedule, including an initial date for the substantial completion of document discovery including electronically stored information (“ESI”), and a later date for the completion of all fact discovery;
2. A date for the Claim Construction Hearing within nine(9) months of the date of a defendant’s first appearance;
3. A trial date within eighteen (18) months of the date the complaint was filed, if practicable, for “standard” cases (defined as typically having one or two defendants and one or two patents); and, within twenty-four (24) months for complex cases, if practicable;
4. A dispositive motion filing cutoff date to include any motions addressing any Daubert issues;
5. A date for the Mandatory Settlement Conference; and
6. All other pretrial dates, as required in Civ. L.R. 16.1.d.2, as appropriate.

**b. Initial Case Management Conference.** When the parties confer with each other pursuant to Fed. R. Civ.P 26(f), in addition to matters covered by Fed. R. Civ.P 26, the parties must discuss and address in the Joint Discovery Plan filed pursuant to Fed. R. Civ. P. 26(f), the following topics:

1. Proposed modification of the deadlines provided for in these Patent Local Rules, and the effect of any such modification on the date and time of the Claim Construction Hearing, if any;
2. The need for and specific limits on discovery relating to claim construction, including depositions of percipient and expert witnesses; and
3. The need, if any, to phase damage discovery.

**c. Settlement Conferences**

1. The judge conducting the settlement conference may require the parties or representatives of a party other than counsel, who have authority to negotiate and enter into a binding settlement, be present at the settlement conference.
2. When ordered to appear, each party, claims adjusters for insured defendants, in addition to any other representatives with “full authority” to enter into a binding settlement, as well as the principal attorney(s) responsible for the litigation, must be present and legally and factually prepared to discuss and resolve the case at the Settlement Conference. Any variation from this Rule or special arrangements desired in cases must be proposed no later than twenty-one (21) days in advance of the settlement conference to the settlement judge.
3. “Full authority” means that the individuals at the settlement conference be authorized to fully negotiate settlement terms and to agree at that time to any settlement terms acceptable to the parties, and to bind the party, without the need to call others not present at the conference for authority or approval.

4. No later than fourteen (14) days before the settlement conference, each party will designate in writing to all other parties, the person(s) and their title(s) or position(s) with the party who will attend and have settlement authority at the conference.

## **2.2 Confidentiality**

If any document or information produced under these Patent Local Rules 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 will be marked “Confidential” or with some other confidential designation (such as “Confidential-Outside Attorneys Eyes Only”) by the disclosing party and disclosure of the confidential document or information will be limited to each party’s outside attorney(s) of record and the employees of such outside attorney(s). An approved model form of protective order is available on the Court’s website ([www.casd.uscourts.gov](http://www.casd.uscourts.gov)) and may be amended by the Court over time as deemed appropriate.

If a party is not represented by an outside attorney, disclosure of the confidential document or information will be limited to a designated “in house” attorney, whose identity and job functions will be disclosed to the producing party five court days prior to any such disclosure. The person(s) to whom disclosure of a confidential document or information is made under this Patent Local Rule will keep it confidential and use it only for purposes of litigating the case.

A document may not be filed under seal unless authorized by an order entered by the judge before whom the hearing or proceeding related to the proposed sealed document will take place.

## **2.3 Certification of Initial Disclosures.**

All statements, disclosures, or charts filed or served in accordance with these Patent Local Rules must be dated and signed by counsel of record. Counsel’s signature will 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, that information contained in the statement, disclosure, or chart is complete and correct at the time it is made.

## **2.4 Admissibility of Disclosures.**

Statements, disclosures, or charts governed by these Patent Local Rules are admissible to the extent permitted by the Federal Rules of Evidence or Federal Rules of Civil Procedure. However, the statements or disclosures provided for in Patent Local Rules 4.1 and 4.2 are not admissible for any purpose other than in connection with motions seeking an extension or modification of the time periods within which actions contemplated by these Patent Local Rules must be taken.

## **2.5 Relationship to Federal Rules of Civil Procedure.**

Except as provided in this paragraph or as otherwise ordered, it will not be a legitimate ground for objecting to an opposing party's discovery request (*e.g.*, interrogatory, document request, request for admission, deposition question), or declining to provide information otherwise required to be disclosed pursuant to Fed. R. Civ. P. 26(a)(1), that the discovery request or disclosure requirement is premature in light of, or otherwise conflicts with, these Patent 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 the Patent 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 an opinion of counsel, and related documents, upon which a party intends to rely for any patent-related claim or defense.

Where a party properly objects to a discovery request as set forth above, that party must provide the requested information on the date on which it is required to provide, the requested information to an opposing party under these Patent Local Rules, unless another legitimate ground for objection exists.

## **2.6 Model Order for Electronically Stored Information (“ESI”)**

The Court has approved a Model Order for ESI that applies to all Patent Cases in this District as defined in Patent L.R. 1.3 unless otherwise ordered by a judge assigned to the case. The Model Order is available on the Court's website, and may be amended by the Court over time as deemed appropriate.

## **3. Patent Disclosures**

### **3.1 Disclosure of Asserted Claims and Infringement Contentions.**

Not later than fourteen (14) days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.” Separately for each opposing party, the “Disclosure of Asserted Claims and Infringement Contentions” must contain the following information:

- a. Each claim of each patent in suit that is allegedly infringed by each opposing party;

- b. Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware. This identification must be as specific as possible. Each product, device and apparatus must be identified by name or model number, if known. Each method or process must 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;
- c. A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element 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;
- d. 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.
- e. Whether each element of each asserted claim is claimed to be literally present and/or present under the doctrine of equivalents in the Accused Instrumentality;
- f. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;
- g. If a party claiming patent infringement asserts or 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 must 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
- h. If a party claiming infringement alleges willful infringement, the basis for such allegation.

### **3.2 Document Production Accompanying Disclosure.**

With the “Disclosure of Asserted Claims and Infringement Contentions,” the party claiming patent infringement must produce to each opposing party or make available for inspection and copying, the following documents in the possession, custody or control of that party:

- a. 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, the claimed invention prior to the date

of application for the patent in suit. A party's production of a document as required within these rules does not constitute an admission that such document evidences or is prior art under 35 U.S.C. §102;

- b. 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 the patent in suit or the priority date identified pursuant to Patent L.R. 3.1.e, whichever is earlier;
- c. A copy of the file history for each patent in suit and each application to which a claim for priority is made under Patent L.R. 3.1.e.
- d. Documents sufficient to evidence ownership of the patent rights by the party asserting patent infringement; and
- e. If a party identifies instrumentalities pursuant to Patent L.R. 3.1.g, documents sufficient to show the operation of any aspects of elements of such instrumentalities the patent claimant relies upon as embodying any asserted claims.

The producing party must separately identify by production number which documents correspond to each category. If the documents identified above are not in the possession, custody or control of the party charged with production, that party must use its best efforts to obtain all responsive documents and make a timely disclosure.

### **3.3 Invalidity Contentions.**

Not later than sixty (60) days after service upon it of the "Disclosure of Asserted Claims and Infringement Contentions," each party opposing a claim of patent infringement must serve on all parties its "Invalidity Contentions," which must contain the following information:

- a. The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. This includes information about any alleged knowledge or use of the invention in this country prior to the date of invention of the patent. Each prior art patent must be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. §102(b) must 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 that made the use or that made and received the offer, or the person or entity that made the information known or to whom it was made known. Prior art under 35 U.S.C. §102(f) must 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) must 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);

- b. 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;
- c. A chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element 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;
- d. Any grounds of invalidity based on indefiniteness under 35 U.S.C. §112(2) of any of the asserted claims;
- e. Any grounds of invalidity based on lack of written description, lack of enabling disclosure, or failure to describe the best mode under 35 U.S.C. §112(1).

### **3.4 Document Production Accompanying Invalidity Contentions**

With the “Invalidity Contentions,” the party opposing a claim of patent infringement must produce or make available for inspection and copying:

- a. Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of any Accused Instrumentality identified by the patent claimant in its Patent L.R. 3.1.c chart; and
- b. A copy of each item of prior art identified pursuant to Patent L.R. 3.3.a 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 must be produced.

### **3.5 Disclosure Requirements in Patent Cases for Declaratory Relief.**

- a. **Invalidity Contentions if No Claim of Infringement.** In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable, Patent Local Rules 3.1 and 3.2 will not apply unless and until a claim for patent infringement is made by a party. If the defendant does not assert a claim for patent infringement in answer to the complaint, no later than fourteen (14) days after the Initial Case Management Conference the party seeking a declaratory judgment must serve upon each opposing party Invalidity Contentions that conform to Patent L.R. 3.3 and produce or make available for inspection and copying the documents described in Patent L.R. 3.4.
- b. **Inapplicability of Rule.** This Patent L.R. 3.5 does not apply to cases in which a request for declaratory judgment that a patent is not infringed, is invalid, or is unenforceable, is filed in response to a complaint for infringement of the same patent.

### **3.6 Amended and Final Contentions.**

- a. As a matter of right, a party asserting infringement may serve Amended Infringement Contentions no later than the filing of the parties' Joint Claim Construction Chart. Thereafter, absent undue prejudice to the opposing party, a party asserting infringement may only amend its infringement contentions:
  1. If, not later than thirty (30) days after service of the court's Claim Construction Ruling, the party asserting infringement believes in good faith that amendment is necessitated by a claim construction that differs from that proposed by such party; or
  2. Upon a timely motion showing good cause.
  
- b. As a matter of right, a party opposing a claim of patent infringement may serve "Amended Invalidity Contentions" no later than the completion of claim construction discovery. Thereafter, absent undue prejudice to the opposing party, a party opposing infringement may only amend its validity contentions:
  1. if a party claiming patent infringement has served "Amended Infringement Contentions," and the party opposing a claim of patent infringement believes in good faith that the Amended Infringement Contentions so require;
  2. if, not later than fifty (50) days after service of the court's Claim Construction Ruling, the party opposing infringement believes in good faith that amendment is necessitated by a claim construction that differs from that proposed by such party; or
  3. upon a timely motion showing good cause.

This rule does not relieve any party from its obligations under Fed.R. Civ.P 26 to timely supplement disclosures and discovery responses.

### **3.7 Advice of Counsel**

Not later than thirty (30) days after filing of the Claim Construction Order, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason must:

- a. Produce or make available for inspection and copying the opinion(s) and any other documentation relating to the opinion(s) as to which that party agrees the attorney-client or work product protection has been waived; and
- 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 other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the opinion(s) which the party is withholding on the grounds of attorney-client privilege or work product protection.



A party who does not comply with the requirements of Patent L.R. 3.7 will not be permitted to rely on advice of counsel for any purpose, absent a stipulation of all parties or by order of the court, which will be entered only upon showing of good cause.

## 4. Claim Construction Proceedings

### 4.1 Exchange of Preliminary Claim Construction and Extrinsic Evidence.

- a. Not later than fourteen (14) days after the service of the “Invalidity Contentions” pursuant to Patent L.R. 3.3, the parties will simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which the parties have identified for claim construction purposes. Each such “Preliminary Claim Constructions” will also, for each element which any party contends is governed by 35 U.S.C. §112(6), identify the structure(s), act(s), or material(s) described in the specification corresponding to that element.
- b. Simultaneously with exchange of the “Preliminary Claim Constructions,” the parties must also provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses they contend support their respective claim constructions. The parties must identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, percipient or expert, the parties must also provide a brief description of the substance of that witness’s proposed testimony.
- c. Not later than fourteen (14) days after the service of the “Preliminary Claim Constructions” pursuant to Patent L.R. 4.1.a, the parties will simultaneously exchange “Responsive Claim Constructions” identifying whether the responding party agrees with the other party’s proposed construction, or identifying an alternate construction in the responding party’s preliminary construction, or setting forth the responding party’s alternate construction.
- d. Simultaneous with exchange of the “Responsive Claim Constructions” pursuant to Patent L.R. 4.1.c, the parties must also provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses they contend support any responsive claim constructions. The parties must identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, percipient or expert, the parties must also provide a brief description of the substance of that witness’s proposed testimony.
- e. The parties must thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a Joint Claim Construction Chart, Worksheet and Hearing Statement.

### 4.2 Joint Claim Construction Chart, Worksheet and Hearing Statement.

Not later than fourteen (14) days after service of the “Responsive Claim Constructions” pursuant to Patent L.R. 4.1.c, the parties must complete and file a Joint Claim Construction Chart, Joint Claim Construction Worksheet and Joint Hearing Statement.

- a. The Joint Hearing Statement must include an identification of the terms whose construction will be most significant to the resolution of the case up to a maximum of ten (10) terms. The parties must also identify any term among the ten (10) whose construction will be case or claim dispositive. If the parties cannot agree on the ten (10) most significant terms, the parties must identify the ones which they do agree are most significant and then they may evenly divide the remainder with each party identifying what it believes are the remaining most significant terms. However, the total terms identified by all parties as most significant cannot exceed ten (10). For example, in a case involving two (2) parties, if the parties agree upon the identification of five (5) terms as most significant, each may only identify two (2) additional terms as most significant; if the parties agree upon eight (8) such terms, each party may only identify only one (1) additional term as most significant.
- b. The Joint Claim Construction Chart must have a column listing complete language of disputed claims with the disputed terms in bold type and separate columns for each party’s proposed construction of each disputed term. Each party’s proposed construction of each disputed claim term, phrase, or clause, must identify all references from the specification or prosecution history that support that construction, and identify any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction of the claim or to oppose any party’s proposed construction of the claim, 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. For every claim with a disputed term, each party must identify with specificity the impact of the proposed constructions on the merits of the case.
- c. The parties’ Joint Claim Construction Worksheet must be in the format set forth in Appendix A and include any proposed constructions to which the parties agree, as well as those in dispute. The parties must jointly submit the Joint Claim Construction Worksheet on computer disk in both Word and WordPerfect format or in such other format as the court may direct.
- d. The Joint Hearing Statement must include:
  1. The anticipated length of time necessary for the Claim Construction Hearing;
  2. Whether any party proposes to call one or more witnesses, including experts, at the Claim Construction Hearing, the identify of each such witness, and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert; and
  3. The order of presentation at the Claim Construction Hearing.
- e. At the court’s discretion, within seven (7) days of the submission of the Joint Claim Construction Chart, Joint Claim Construction Worksheet and Joint Hearing Statement, the court will hold a status conference with the parties, in person or by telephone, to

discuss scheduling, witnesses and any other matters regarding the Claim Construction Hearing.

#### **4.3 Completion of Claim Construction Discovery.**

Not later than twenty-eight (28) days after service and filing of the Joint Claim Construction Chart, Joint Claim Construction Worksheet and Joint Hearing Statement, the parties must complete all discovery, including depositions of any percipient or expert witnesses that they intend to use in the Claim Construction Hearing. Fed.R.Civ. P. 30 applies to depositions taken pursuant to Patent L.R. 4.3, except as to experts. An expert witness identified in a party's Joint Hearing Statement pursuant to Patent L.R. 4.2.c, may be deposed on claim construction issues. The identification of an expert witness in the Joint Hearing Statement may be deemed good cause for a further deposition on all substantive issues.

#### **4.4 Claim Construction Briefs.**

- a. Not later than fourteen (14) days after close of claim construction discovery, the parties will simultaneously file and serve opening briefs and any evidence supporting their claim construction.
- b. Not later than fourteen (14) days after service of the opening briefs, the parties will simultaneously file and serve briefs responsive to the opposing party's opening brief and any evidence directly rebutting the supporting evidence contained in the opposing party's opening brief.
- c. Absent leave of Court, the provisions of Civ. L.R. 7.1.h for length of briefs for supporting and reply memoranda will apply to the length of opening and responsive claim construction briefs.

#### **4.5 Claim Construction Hearing.**

Not later than twenty-eight (28) 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.

Attached as Appendix B is a time line illustrating the exchange and filing deadlines set forth in these Patent Local Rules.

## APPENDIX A: APPROVED FORM OF JOINT CLAIM CONSTRUCTION WORKSHEET

### JOINT CLAIM CONSTRUCTION WORKSHEET

PATENT CLAIM	AGREED PROPOSED CONSTRUCTION	PLAINTIFF'S PROPOSED CONSTRUCTION	DEFENDANT'S PROPOSED CONSTRUCTION	COURT'S CONSTRUCTION
1. Claim language as it appears in the patent <b>with terms and phrases to be construed in bold.</b>	Proposed construction if the parties agree.	Plaintiff's proposed construction if parties disagree.	Defendant's proposed construction if parties disagree.	Blank column for Court to enter its construction.
2. Claim language as it appears in the patent <b>with terms and phrases to be construed in bold.</b>	Proposed construction if the parties agree.	Plaintiff's proposed construction if parties disagree.	Defendant's proposed construction if parties disagree.	Blank column for Court to enter its construction.
3. Claim language as it appears in the patent <b>with terms and phrases to be construed in bold.</b>	Proposed construction in the parties agree.	Plaintiff's proposed construction if parties disagree.	Defendant's proposed construction if parties disagree.	Blank column for Court to enter its construction

## APPENDIX B: TIMELINE FOR PATENT CASES IN THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF CALIFORNIA

