

AIPLA's Model Patent Local Rules

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The Model Patent Local Rules are provided as general guidance for consideration during the formulation of local rules for use in patent cases. This work could contain typographical errors or technical inaccuracies, and AIPLA reserves the right to add, change, or delete its contents or any part thereof without notice.

Introduction

In the winter of 2013, the Patent Litigation Committee of the American Intellectual Property Law Association undertook the task of creating a set of AIPLA Model Patent Local Rules (“Rules”). A Subcommittee was formed to review the local rules of the U.S. District Courts, and make a suggestion for a uniform set of local rules that could be supported by the AIPLA.

One of the fundamental goals of the Rules is to provide a model set of jury instructions that would not be biased in favor of either the patent owner or the accused infringer. These models are intended as guidance only, and they should be tailored as appropriate in light of the complexity of any given case. These model rules are intended to supplement, and not to supercede, the Federal Rules of Civil Procedure, the local rules of the relevant court, any standing orders of the relevant court, and any court orders applicable in any given case.

September 2014

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Co-Chairs, Model Patent Local Rules Subcommittee
AIPLA Patent Litigation Committee

In 2017, the Patent Litigation Committee of the AIPLA commissioned a subcommittee to review and revise (as appropriate) the existing AIPLA Rules in view of intervening developments in patent law, the experience of litigants and courts with the existing Rules, and lessons learned from changes made to district court patent local rules throughout the country since 2014. The 2018 Model Patent Local Rules are the result of this effort.

January 2018

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Co-Chairs, Model Patent Local Rules Subcommittee
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1. CONTENTIONS

1-1. Infringement Contentions

A party claiming patent infringement must serve on all parties “Infringement Contentions” no later than fourteen (14) days after the Case Management Conference unless otherwise stated in the Scheduling Order. The Infringement Contentions shall contain the following information to the extent then known to the party asserting infringement:

(a) Identification of each claim of each patent in suit that is allegedly infringed by the opposing party, including for each claim the applicable statutory subsection of 35 U.S.C. § 271;

(b) Separately for each asserted claim, identification of each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party claiming infringement is aware. Each product, device, and apparatus must 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;

(c) 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 pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;¹

(d) Identification of whether each element of each asserted claim is claimed to be present in the Accused Instrumentality literally or under the doctrine of equivalents. For any claim under the doctrine of equivalents, the Infringement Contentions must include an explanation of each function, way, and result that is equivalent and why any differences are not substantial;

(e) For each claim that 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;

¹ Given that the Infringement Contentions are exchanged prior to discovery, this chart will likely be based solely on publicly available information. Prior to the service of Infringement Contentions, a party asserting infringement need only take reasonable steps as required by Rule of 11 of the Federal Rules of Civil Procedure to assert infringement in the Complaint. For example, prior to the service of Preliminary Infringement Contentions, a party asserting infringement need not go to the expense of reverse engineering every publicly available product because of the ready availability of information during discovery. If additional information is obtained during discovery, the Infringement Contentions should be diligently updated.

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

(g) If a party asserting patent infringement alleges willful infringement, the basis for such allegation;

(h) For each patent, the party's contention as to the applicability of pre- or post-AIA law regarding 35 U.S.C. § 102 and the basis for that contention.

(i) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own or its licensee's 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.

1-2. Unenforceability and Invalidity Contentions

(a) Each party opposing a claim of patent infringement or asserting invalidity or unenforceability shall serve upon all parties its "Unenforceability and Invalidity Contentions" within forty five (45) days after service of the Infringement Contentions. The Unenforceability and Invalidity Contentions shall contain the following information to the extent then known to the party asserting unenforceability or invalidity:

(i) Identification, with particularity, 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 must be identified by its title, date of publication, and where feasible, author and publisher.

(A) In cases subject to pre-AIA § 102, 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 or 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);

(B) In cases subject to post-AIA § 102, prior art under 35 U.S.C. § 102(a)(1) shall be identified by specifying the item offered for sale, in public use, or otherwise available to the public, the date the offer or use took place or the claimed invention was made available, and the identity of the person or entity which made the use or which made or received the offer, or the person or entity which made the claimed invention available or to whom it was made available. Prior art under 35 U.S.C. § 102(a)(2) shall be identified by its number, country of origin, and date of issue if it is a patent, or by its application number, country of origin, and filing date if it is a patent application. For prior art under 35 U.S.C. § 102(a)(2), the party asserting

validity should specify the effective filing date to which that party believes such patent or application is entitled;

(ii) A statement of whether each item of prior art allegedly anticipates each asserted claim or renders it obvious;

(iii) 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 pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function where the element is presented in the means plus function form;

(iv) A detailed statement of any grounds of invalidity based on indefiniteness under pre-AIA 35 U.S.C. § 112(2) or post-AIA 35 U.S.C. § 112(b), or enablement or written description under pre-AIA 35 U.S.C. § 112(1) or post-AIA 35 U.S.C. § 112(a);

(v) A statement of any grounds of invalidity based on eligibility under 35 U.S.C. § 101; and

(vi) For each patent, state your contention about the applicability of pre- or post-AIA law and the basis for that contention.

(vii)

(b) Unenforceability contentions shall identify the acts allegedly supporting and the bases for the assertion of unenforceability.

1-3. Amendments

Amendment of the Infringement Contentions or the Invalidity Contentions may be made only by order of the Court upon a timely showing of good cause. Non-exhaustive examples of circumstances that may, absent undue prejudice to the non-moving party, support a finding of good cause include:

(a) A claim construction by the Court different from that proposed by the party seeking amendment;

(b) Recent discovery of material, prior art despite earlier diligent search; and

(c) Recent discovery of nonpublic information about the Accused Instrumentality which was not discovered, despite diligent efforts, before the service of the Infringement Contentions.

The duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.

1-4. Contentions in Declaratory Judgment of Invalidity Cases

(a) In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is invalid, Patent Rules 1-1 and 2-1 shall 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 its answer to the complaint, no later than 14 days after the defendant serves its answer, or 14 days after the Case Management Conference, whichever is later, the party seeking a declaratory judgment of invalidity shall serve upon each opposing party its Invalidity Contentions that conform to Patent Rule 1-2 and produce or make available for inspection and copying the documents described in Patent Rule 2-2(a)(ii) and 2-2(b).

(b) This Patent Rule 1-4 shall not apply to cases in which a request for a declaratory judgment that a patent is invalid is filed in response to a complaint for infringement of the same patent.

2. DISCLOSURES – DOCUMENT PRODUCTION

2-1. With Infringement Contentions

(a) With the disclosure of Infringement Contentions, the party asserting patent infringement shall produce to each opposing party or make available for inspection and copying the following documents that are in such party's possession, custody, or control:

(i) Documents sufficient to show the first disclosure to a third party, or first sale of or first offer to sell, or first public use of, the claimed invention prior to the date of application for the patent(s)-in-suit. A party's production of a document as required herein is not an admission that any document or disclosure constitutes or evidences prior art;

(ii) For any patent-in-suit that may be subject to pre-AIA law, all documents evidencing the conception and reduction to practice of the claimed invention;

(iii) A copy of the file history for the patent(s)-in-suit;

(iv) Documents evidencing the chain of title of the patent(s)-in-suit ; and

(v) If a party identifies any instrumentalities that it contends practice the patent(s)-in-suit, documents sufficient to show the operation of any aspects or elements of each such instrumentality.

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

2-2. With Unenforceability and Invalidity Contentions

(a) With the disclosure of Unenforceability and Invalidity Contentions, the party asserting patent invalidity and/or unenforceability shall produce or make available for inspection and copying the following documents that are in such party's possession, custody, or control:

(i) Technical documentation sufficient to show the operation, composition, or structure of any aspects or elements of each Accused Instrumentality identified by the party asserting patent infringement in its Infringement Contentions, if applicable; and

(ii) A copy of the prior art identified in the Invalidity Contentions which does not appear in the file history of the patent(s)-in-suit. To the extent any such item is not in English, any English translations in the possession, custody, or control of the disclosing party shall also be produced.

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

2-3. Opinions of Counsel

(a) Unless otherwise ordered by the Court, not later than 60 days after service of invalidity contentions, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall:

(i) Produce any written advice and documents related thereto for which the attorney-client privilege and work product protection have been waived;

(ii) 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 privilege and work product protection have been waived; and

(iii) Serve a privilege log identifying any documents other than those identified in subpart (a)(i) 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.

(b) A party who does not comply with these requirements 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.

3. CLAIM CONSTRUCTION PROCEEDINGS

3-1. Exchange of Proposed Terms for Construction

(a) At a time set by the Court, or if no time is set by the Court not later than 30 days after service of the “Unenforceability and Invalidity Contentions” pursuant to Patent Rule 1-2, or not later than 60 days after service upon it of the “Infringement Contentions” pursuant to Patent Rule 1-1 in those actions where validity is not at issue, or, 30 days after the defendant serves an answer in cases where both Patent Rule 1-1 and 1-2 are inapplicable, each party shall serve on each other party 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 pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f).

(b) 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 the 10 terms likely to be most significant to resolving the parties’ dispute for each set of related patents. The 10 term limit applies to related patents; each unrelated set of patents has an independent 10 term limit. For purposes of these Patent Rules, a patent and any continuation, continuation-in-part, divisional, reexamined or reissued patent that claims priority to the same patent application are considered “related.”

(c) If, after meeting and conferring as required by subsection (b), either party believes it is necessary to ask the court to construe more than 10 terms total (10 per case), the Joint Claim Construction and Prehearing Statement shall contain a statement setting forth each party’s position on whether additional terms should be construed.

3-2. Exchange of Preliminary Claim Constructions and Extrinsic Evidence

(a) Not later than 14 days after the exchange of the lists pursuant to Patent Rule 3-1, 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 pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f), identify the structure(s), act(s), or material(s) corresponding to that term’s function.

(b) 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.

(c) The parties shall thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a Joint Claim Construction and Prehearing Statement.

3-3. Joint Claim Construction and Prehearing Statement

Not later than 14 days after the parties exchange their respective “Preliminary Claim Constructions,” the parties shall complete and file a Joint Claim Construction and Prehearing Statement, which shall contain the following information:

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

(b) 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;

(c) An identification of the terms whose construction will be most significant to the resolution of the case, including identification of any term whose construction will be case or claim dispositive or substantially conducive to promoting settlement, and the reasons therefor;

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

(e) Whether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and for each expert witness, a declaration stating any opinions to be rendered in connection with claim construction if called as an expert witness. If a party did not disclose an expert witness under Patent Rule 3-2(b), that party may nonetheless provide a declaration for terms for which the opposing party provided a disclosure under Patent Rule 3-2(b).

3-4. Completion of Claim Construction Discovery

(a) Not later than 30 days after service and 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, other than experts, identified with the Preliminary Claim Constructions (Patent Rule 3-2) or Joint Claim Construction and Prehearing Statement (Patent Rule 3-3).

(b) Unless otherwise ordered by the Court, any discovery from an expert witness who submitted a certification or declaration under Patent Rule 3-3(e) shall be concluded within 30 days after service and filing of the Joint Claim Construction and Prehearing Statement.

3-5. Claim Construction Briefs

(a) Not later than 45 days after serving and filing the Joint Claim Construction and Prehearing Statement, the parties shall contemporaneously file and serve their opening *Markman* briefs and any evidence supporting claim construction, including experts' certifications or declarations ("Opening *Markman* Submissions").

(b) Not later than 30 days after the filing of the Opening *Markman* Submissions, the parties shall contemporaneously file and serve responding *Markman* briefs and any evidence supporting claim construction, including any responding experts' certifications or declarations.

3-6. Claim Construction Hearing

Subject to the convenience of the Court's calendar, two weeks following submission of the briefs and evidence specified in Patent Rule 3-5(b), the Court shall conduct a Claim Construction Hearing, unless the Court believes a hearing is unnecessary for construction of the claims at issue.

4. MISCELLANEOUS ITEMS

4-1. Case Management Conference Requirements

(a) When the parties confer pursuant to Fed. R. Civ. P. 26(f), in addition to the matters covered by Fed. R. Civ. P. 26, the parties shall discuss and address the following topics in the joint discovery plan:

(i) Proposed modification of the obligations or deadlines set forth in these Patent Rules to ensure that they are suitable for the circumstances of the particular case;

(ii) Limits on the number of claim terms that may be construed by each party;²

(iii) The scope and timing of any claim construction discovery including disclosure of and discovery from any expert witness permitted by the court;

(iv) 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;

(v) How the parties intend to educate the Court on the technology at issue;

(vi) Whether pre- or post-AIA law regarding 35 U.S.C. § 102 is applicable to each patent-in-suit;

(vii) The need for a protective order and if necessary a proposed protective order identifying any disputed provisions; and

(viii) Whether the Court should limit the number of asserted claims and prior art references.

4-2. Fixed Schedule

The deadlines set in these Patent Rules are fixed, unless modified by the Court in response to a motion or stipulation for the modification.

4-3. Expert [Report] Deadlines

(a) Within 45 days after the close of fact discovery, each party shall disclose its expert reports pursuant to Fed. R. Civ. P. 26(a)(2)(B), on issues on which the party bears the burden of proof.

² If not provided elsewhere in the model rules.

(b) Responsive expert reports pursuant to Fed. R. Civ. P. 26(a)(2)(B), on which the opposing party bears the burden of proof, shall be served within 45 days after service of the opening expert reports.

(c) The deadline for the completion of expert discovery shall be 30 days after service of the responsive expert reports.

4-4. Mandatory Settlement Conferences

Unless otherwise directed by the Court, the Local Rules or other applicable standing orders, the parties shall confer regarding Alternative Dispute Resolution and submit a plan to the Court within 14 days after the Rule 26(f) conference. All plans shall include a settlement conference within 90 days after the Scheduling Conference and another settlement conference within 45 days after the Court's claim construction ruling.

5. ACKNOWLEDGMENTS

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