

**UNITED STATES DISTRICT COURT
FOR THE
DISTRICT OF UTAH**



**LOCAL RULES OF
PATENT PRACTICE**

DECEMBER 2018

UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF UTAH

LOCAL PATENT RULES

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UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF UTAH

LOCAL PATENT RULES

PREAMBLE

These Local Patent Rules provide a standard structure for patent cases that will permit greater predictability and planning for the court and the litigants. These Rules also anticipate and address many of the procedural issues that commonly arise in patent cases. The court's intention is to eliminate the need for litigants and judges to address separately in each case procedural issues that tend to recur in the vast majority of patent cases.

The Rules require, along with a party's disclosures under Federal Rule of Civil Procedure 26(a)(1), meaningful disclosure of each party's contentions and support for allegations in the pleadings. Complaints and counterclaims in most patent cases are worded in a bare-bones fashion, necessitating discovery to flesh out the basis for each party's contentions. The Rules require the parties to provide the particulars behind allegations of infringement, non-infringement, and invalidity at an early date. Because Federal Rule of Civil Procedure 11 requires a party to have factual and legal support for allegations in its pleadings, early disclosure of the basis for each party's allegations will impose no unfair hardship and will benefit all parties by enabling a focus on the contested issues at an early stage of the case. The Rules' supplementation of the requirements of Rule 26(a)(1) and other Federal Rules is also appropriate due to the various ways in which patent litigation differs from most other civil litigation, including its factual complexity; the routine assertion of counterclaims; the need for the court to construe, and thus for the parties to identify, disputed language in patent claims; and the variety of ways in which a patent may be infringed or invalid.

The initial disclosures required by the Rules are not intended to confine a party to the contentions it makes at the outset of the case. It is not unusual for a party in a patent case to learn additional grounds for claims of infringement, non-infringement, and invalidity as the case progresses. After a reasonable period for fact discovery, however, each party must provide a final statement of its contentions on relevant issues, which the party may thereafter amend only "upon a showing of good cause and absence of unfair prejudice to opposing parties, made no later than fourteen (14) days of the discovery of the basis for the amendment." LPR 3.4.

The Rules also provide a standardized structure for claim construction proceedings, requiring the parties to identify and exchange position statements regarding disputed claim language before presenting disputes to the court. The Rules contemplate that claim construction will be done, in most cases, toward the end of fact discovery. The committee of lawyers and judges that drafted and proposed the Rules considered placing claim construction at both earlier and later spots in the standard schedule. The decision to place claim construction near the end of fact discovery is premised on the determination that claim construction is more likely to be a meaningful process that deals with the truly significant disputed claim terms if the parties have had sufficient time, via the discovery process, to ascertain what claim terms really matter and why and can identify (as the Rules require) which are outcome determinative. The Rules' placement of claim construction near the end of fact discovery does not preclude the parties from proposing or the court from requiring an earlier claim construction in a particular case. This may be appropriate in, for example, a case in which it is apparent at an early stage that the outcome will turn on one claim term or a small number of terms that can be identified without a significant amount of fact discovery.

1. SCOPE OF RULES

LPR 1.1 APPLICATION AND CONSTRUCTION

These Local Patent Rules ("LPR") apply to all cases filed in or transferred to this District after their effective date in which a party makes a claim of infringement, non-infringement, invalidity, or unenforceability of a utility patent. The court may apply all or part of the LPR to any case already pending on the effective date of the LPR. The court may sua sponte or upon motion modify the obligations and deadlines of the LPR based on the circumstances of any particular case when it will advance the just, speedy, and inexpensive determination of the action. If a party files a motion that raises claim construction issues prior to the claim construction proceedings provided for in Section 4 of these Patent Rules, the court may defer ruling on the motion until after entry of the claim construction ruling.

LPR 1.2 INITIAL ATTORNEY PLANNING CONFERENCE AND SCHEDULING ORDERS

The parties shall hold their conference pursuant to Fed. R. Civ. P. 26(f) no later than 35 (thirty-five) days after the filing of the first answer. The parties must discuss and address those

matters found in the form scheduling order located on the court's website <http://www.utd.uscourts.gov>. A completed proposed version of the scheduling order is to be presented to the court no later than seven (7) days after the Rule 26(f) conference unless the court otherwise directs. No later than fourteen (14) days after entry of the claim construction ruling, the parties must file a motion for proposed scheduling order governing the remaining pretrial obligations. A party may request the court enter a separate scheduling order for all non-patent causes of action.

LPR 1.3 FACT DISCOVERY

(a) The parties shall commence fact discovery upon the date for the Initial Attorney Planning Conference under LPR 1.2 and shall complete it twenty-eight (28) days after the date for exchange of claim terms and phrases under LPR 4.1.

(b) No later than fourteen (14) days after entry of the claim construction ruling a party may move to reopen fact discovery. In support of the motion, the moving party shall explain why the claim construction ruling or disclosure of intent to rely on opinions of counsel necessitates further discovery and identify the scope of such discovery.

(c) Discovery Concerning Opinions of Counsel:

- (1) A party shall disclose its intent to rely on advice of counsel and the following information to all other parties no later than seven (7) days after entry of the claim construction ruling:
 - a. All written opinions of counsel and a summary of oral opinions (including the date, the attorney, and recipient) upon which the party will rely;
 - b. All information provided to the attorney in connection with the advice;
 - c. All written attorney work product developed in preparing the opinion that the attorney disclosed to the client; and
 - d. Identification of the date, sender, and recipient of all written and oral communications with the attorney or law firm concerning the subject matter of the advice by counsel.
- (2) The substance of a claim of reliance on advice of counsel offered in defense to a charge of willful infringement, and other information within

the scope of a waiver of the attorney-client privilege based upon disclosure of such advice, is not subject to discovery until seven (7) days after entry of the claim construction ruling.

- (3) After advice of counsel information becomes discoverable under LPR 1.3(b), a party claiming willful infringement may take the deposition of any attorneys preparing or rendering the advice relied upon and any persons who received or claims to have relied upon such advice.
- (4) This Rule does not address whether materials other than those listed in LPR 1.3(c) are subject to discovery or within the scope of any waiver of the attorney-client privilege.

LPR 1.4 CONFIDENTIALITY

DUCivR 26-2 shall govern confidentiality in patent cases. Any party may move the court to modify the Protective Order provided for by DUCivR 26-2 for good cause. The filing of such a motion does not affect the requirement for, or timing of, any of the disclosures required by these Patent Rules.

LPR 1.5 CERTIFICATION OF DISCLOSURES

All disclosures made pursuant to LPR must be dated and signed by counsel of record (or by the party if unrepresented by counsel) and are subject to the requirements of Rules 11 and 26(g), and the sanctions available under Rule 37 of the Federal Rules of Civil Procedure.

LPR 1.6 ADMISSIBILITY OF DISCLOSURES

The contentions provided for in LPR 2.3 and 2.4 are inadmissible as evidence on the merits absent a showing that the disclosures were made in bad faith.

Comment

The purpose of the initial disclosures pursuant to LPR 2.3 – 2.5 is to identify the likely issues in the case, and to enable the parties to focus and narrow their discovery requests. Permitting use of the initial disclosures as evidence on the merits would defeat this purpose. A party may make reference to the initial disclosures for any other appropriate purpose.

LPR 1.7 RELATIONSHIP TO FEDERAL RULES OF CIVIL PROCEDURE

Except as provided in this paragraph or otherwise ordered, a party may not object to a discovery

request or decline to provide information otherwise required to be disclosed pursuant to FRCP 26(a)(1) because the discovery request or disclosure requirement is premature in light of or conflicts with these Patent Rules. A party may object to the following categories of discovery requests (or decline to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) on the ground that they are premature under the timetable provided in these Patent Rules. Once parties have made disclosures as required by these Patent Rules, the parties may conduct further discovery on these subjects;

- (a) requests for a party's claim construction position (LPR 4.1);
- (b) requests to the patent claimant for a comparison of the asserted claims and the accused apparatus, device, process, method, act, or other instrumentality (LPR 2.3);
- (c) requests to an accused infringer for a comparison of the asserted claims and the prior art (LPR 2.4-2.5);
- (d) requests to an accused infringer for its non-infringement contentions (LPR 2.4); and
- (e) discovery concerning opinions of counsel (LPR 1.3(c))

Federal Rule of Civil Procedure 26's requirements concerning supplementation of disclosure and discovery responses apply to all disclosures required under these Patent Rules. Federal Rule of Civil Procedure 37 and the related local rules provide the process and consequences for partial or incomplete disclosures under these Patent Rules.

2. PATENT INITIAL DISCLOSURES

Comment

LPR 2.3 – 2.5 supplement the initial disclosures required by Federal Rule of Civil Procedure 26(a)(1). As stated in the comment to LPR 1.6, the purpose of these provisions is to require the parties to identify the likely issues in the case, to enable them to focus and narrow their discovery requests. To accomplish this purpose, the parties' disclosures must be meaningful – as opposed to boilerplate and non- evasive. These provisions should be construed accordingly.

LPR 2.1 ACCUSED INSTRUMENTALITY DISCLOSURES

No later than seven (7) days after the defendant files its answer, a party claiming infringement shall disclose a list identifying each accused apparatus, product, device, process, method, act, or

other instrumentality (“Accused Instrumentality”) of the opposing party of which the party claiming infringement is aware. Each Accused Instrumentality 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.

LPR 2.2 INITIAL DISCLOSURES

The plaintiff shall provide its initial disclosures under Fed. R. Civ. P. 26(a)(1) (“Initial Disclosures”) no later than twenty-one (21) days after the defendant files its answer; provided, however, if the defendant asserts a counterclaim for infringement of another patent, the plaintiff’s Initial Disclosures shall be due no later than twenty-one (21) days after the plaintiff files its answer to that counterclaim. The defendant shall provide its Initial Disclosures no later than twenty-eight (28) days after the defendant files its answer; provided, however, if the defendant asserts a counterclaim for infringement of another patent, the defendant’s Initial Disclosures shall be due no later than twenty-eight (28) days after the plaintiff files its answer or other to that counterclaim. As used in this Rule, the term “document” has the same meaning as in Fed. R. Civ. P. 34(a):

- (a) A party asserting a claim of patent infringement shall for each asserted patent make available for inspection and copying, or serve control-numbered copies, with its Initial Disclosures the following non-privileged information in the party’s possession, custody or control:
 - (1) all documents concerning any disclosure, sale or transfer, or offer to sell or transfer, any item embodying, practicing or resulting from the practice of the claimed invention or portion of the invention prior to the date of application. Production of a document pursuant to this Rule is not an admission that the document evidences or is prior art under 35 U.S.C. § 102;
 - (2) all documents concerning the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application or a priority date otherwise identified, whichever is earlier;
 - (3) the file history from the U.S. Patent and Trademark Office for each patent on which a claim for priority is based;

- (4) all documents concerning ownership of the patent rights by the party asserting patent infringement;
 - (5) all licenses; and
 - (6) the date from which it alleges damages, if claimed, began to accrue; or, if that date is not known, how the date should be determined.
- (b) A party opposing a claim of patent infringement shall make available for inspection and copying, or serve control-numbered copies, with its Initial Disclosures the following non-privileged information in the party's possession, custody or control:
 - (1) documents or things sufficient to show the operation and construction of all aspects or elements of each Accused Instrumentality identified with specificity in the pleading or Accused Instrumentality Disclosures of the party asserting patent infringement;
 - (2) a copy of each item of prior art of which the party is aware and upon which the party intends to rely that allegedly anticipates each asserted patent and its related claims or renders them obvious or, if a copy is unavailable, a description sufficient to identify the prior art and its relevant details;
 - (3) the Accused Instrumentality; and
 - (4) an estimate for the relevant time frame of the quantity of each Accused Instrumentality sold and the gross sales revenue.

LPR 2.3 INITIAL INFRINGEMENT CONTENTIONS

A party claiming patent infringement must serve on all parties "Initial Infringement Contentions" containing the following information no later than thirty-five (35) days after the defendant's Initial Disclosure under LPR 2.2:

- (a) identification of each claim of each asserted patent 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 Instrumentality of which the party claiming infringement is aware. Each Accused Instrumentality 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(f), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;
- (d) 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 Initial Infringement Contentions must include an explanation of each function, way, and result that is alleged to be 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. If alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described;
- (f) for any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;
- (g) the basis for any allegation of willful infringement; and
- (h) 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 embodies or practices the claimed invention, the party must identify, separately for each asserted patent, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim, including whether there has been marking pursuant to statute.

Without leave of court, a party claiming patent infringement must limit the allegedly infringed claims to ten (10) per asserted patent. If during discovery a party claiming patent infringement discovers an Accused Instrumentality that was not previously disclosed or known, the party claiming patent infringement may, as required by the Federal Rules of Civil Procedure, supplement the infringed claims per an asserted patent by withdrawing an equal number of asserted claims and providing the information for the newly asserted claim required by this paragraph 2.3 within fourteen (14) days of discovery, except for good cause shown.

LPR 2.4 INITIAL NON-INFRINGEMENT, UNENFORCEABILITY AND INVALIDITY CONTENTIONS

Each party opposing a claim of patent infringement or asserting invalidity or unenforceability shall serve upon all parties its “Initial Non-Infringement, Unenforceability and Invalidity Contentions” no later than fourteen (14) days after service of the Initial Infringement Contentions. Such Initial Contentions shall be as follows:

- (a) Non-Infringement Contentions shall contain a chart, responsive to the chart required by LPR 2.3(c), that identifies for each identified element in each asserted claim, to the extent then known by the party opposing infringement, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality and, if not, the reason for such denial and the relevant distinctions.
- (b) Invalidity Contentions must contain the following information to the extent then known to the party asserting invalidity:
 - (1) identification, with particularity, of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent publication shall be identified by its number, country of origin, and date of issue. Every other 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(a)(1) (effective Mar. 16, 2013) or 35 U.S.C. §§ 102(a)–(b) & (g) (2012) 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. A challenge to inventorship under 35 U.S.C. § 101 shall identify the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived;
 - (2) a statement of whether each item of prior art allegedly anticipates each asserted claim or renders it obvious. If a combination of items of prior art allegedly makes a claim obvious, each such combination, and the reasons to combine such items must be identified;
 - (3) a chart identifying specifically where, 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(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; and

- (4) a detailed statement of any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(b) or lack of enablement or lack of written description under 35 U.S.C. § 112(a).
- (c) Unenforceability contentions shall identify the acts allegedly supporting and all bases for the assertion of unenforceability.

Without leave of court, a party asserting invalidity must limit prior art references to twelve (12) per asserted patent.

LPR 2.5 DOCUMENT PRODUCTION ACCOMPANYING INITIAL INVALIDITY CONTENTIONS

With the Initial Non-Infringement, Unenforceability and Invalidity Contentions under LPR 2.3, the party opposing a claim of patent infringement or asserting invalidity or unenforceability shall supplement its Initial Disclosures and, in particular, must produce or make available for inspection and copying:

- (a) any additional documentation showing the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its LPR 2.4 chart; and
- (b) a copy of any additional items of prior art identified pursuant to LPR 2.3, including for foreign art any translation in the party's possession, custody, or control that does not appear in the file history of the asserted patent(s).

LPR 2.6 DISCLOSURE REQUIREMENT IN PATENT CASES INITIATED BY COMPLAINT FOR DECLARATORY JUDGMENT

In a case initiated by a complaint for declaratory judgment in which a party files a pleading seeking a judgment that a patent is not infringed, is invalid, or is unenforceable, LPR 2.1 and 2.3 shall not apply unless a party makes a claim for patent infringement. If no claim of infringement is made, the party seeking a declaratory judgment must for each declaration for relief being sought

comply with LPR 2.4 and 2.5 no later than forty-nine (49) days after the defendant's Initial Disclosures.

3. FINAL CONTENTIONS

LPR 3.1 FINAL INFRINGEMENT, UNENFORCEABILITY AND INVALIDITY CONTENTIONS

A party claiming patent infringement must serve on all parties "Final Infringement Contentions" containing the information required by LPR 2.3 (a)–(h) no later than twenty-one (21) weeks after the due date for service of Initial Infringement Contentions. Each party asserting invalidity or unenforceability of a patent claim shall serve on all other parties, within fourteen(14) days after the Final Infringement Contentions are due, "Final Unenforceability and Invalidity Contentions" containing the information required by LPR 2.4 (b) and (c). Final Infringement Contentions may rely on no more than eight(8) asserted claims, from the set of previously-identified asserted claims, per asserted patent without an order of the court upon a showing of good cause and absence of unfair prejudice to opposing parties. Final Unenforceability and Invalidity Contentions may rely on no more than ten (10) prior art references, from the set of previously-identified prior art references, per asserted patent without an order of the court upon a showing of good cause and absence of unfair prejudice to opposing parties.

LPR 3.2 FINAL NON-INFRINGEMENT CONTENTIONS

Each party asserting non-infringement of a patent claim shall serve on all other parties "Final Non-infringement Contentions" no later than twenty-eight (28) days after service of the Final Infringement Contentions, containing the information called for in LPR 2.4(a).

LPR 3.3 DOCUMENT PRODUCTION ACCOMPANYING FINAL INVALIDITY CONTENTIONS

With the Final Invalidity Contentions, the party asserting invalidity of any patent claim shall produce or make available for inspection and copying: a copy or sample of all prior art identified pursuant to LPR 3.1, to the extent not previously produced, that does not appear in the file history of the patent(s) at issue. If any such item is not in English, an English translation of the portion(s) relied upon must be produced. The translated portion of the non-English prior art must be sufficient to place in context the particular matter upon which the party relies.

The producing party shall separately identify by control-number which documents correspond to each claim.

LPR 3.4 AMENDMENT OF FINAL CONTENTIONS

A party may amend its Final Infringement Contentions; or Final Non-infringement, or Unenforceability and Invalidity Contentions only by order of the court upon a showing of good cause and absence of unfair prejudice to opposing parties, made no later than fourteen (14) days of the discovery of the basis for the amendment. An example of a circumstance that may support a finding of good cause, absent undue prejudice to the non-moving party, includes a claim construction by the court different from that proposed by the party seeking amendment.

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

LPR 3.5 FINAL DATE TO SEEK STAY

Absent exceptional circumstances, no party may file a motion to stay the lawsuit pending reexamination or other post-grant proceedings in the U.S. Patent and Trademark Office after the due date for service of the Final Non-infringement Contentions pursuant to LPR 3.2.

4. CLAIM CONSTRUCTION PROCEEDINGS

LPR 4.1 EXCHANGE OF PROPOSED CLAIM TERMS TO BE CONSTRUED ALONG WITH PROPOSED CONSTRUCTIONS

- (a) No later than fourteen (14) days after service of the Final Contentions pursuant to LPR 3.1 and LPR 3.2, each party shall serve a list of (i) the claim terms and phrases the court should construe; (ii) proposed constructions; (iii) identification of any claim element that is governed by 35 U.S.C. § 112(f); and (iv) a description of the function of that element, and the structure(s), act(s), or material(s) corresponding to that element, identified by column and line number of the asserted patent(s).
- (b) No later than seven (7) days after the exchange of claim terms and phrases, the parties must meet and confer and agree upon no more than ten (10) terms or

phrases to submit for construction by the court. No more than ten (10) terms or phrases may be presented to the court for construction absent prior leave of court upon a showing of good cause. The assertion of multiple non-related patents shall, in an appropriate case, constitute good cause. If the parties are unable to agree upon ten (10) terms, then five (5) shall be allocated to all plaintiffs and five (5) to all defendants. For each term to be presented to the court, each party must certify in its Cross-Motion for Claim Construction whether a term construction in a party's favor may be dispositive of an issue and explain why.

Comment

In some cases, the parties may dispute the construction of more than ten terms. But because construction of outcome-determinative or otherwise significant claim terms may lead to settlement or entry of summary judgment, in the majority of cases the need to construe other claim terms of lesser importance may be obviated. The limitation to ten claim terms to be presented for construction is intended to require the parties to focus upon outcome-determinative or otherwise significant disputes.

LPR 4.2 CLAIM CONSTRUCTION BRIEFS

- (a) No later than thirty-five (35) days after the exchange of terms set forth in LPR 4.1, the parties shall file simultaneous Cross-Motions for Claim Construction, which may not exceed twenty-five (25) pages absent prior leave of court. The briefs shall identify any intrinsic evidence with citation to the Joint Appendix under LPR 4.2(b) and shall separately identify any extrinsic evidence a party contends supports its proposed claim construction. If a party offers a sworn declaration of a witness to support its claim construction, the party must promptly make the witness available for deposition.
- (b) On the date for filing the Cross-Motions for Claim Construction, the parties shall file a Joint Appendix containing the patent(s) in dispute and the prosecution history for each patent. The prosecution history must be paginated, contain an index, be text searchable and have each document bookmarked in the PDF filing, and all parties must cite to the Joint Appendix when referencing the materials it contains. Any party may file a separate appendix to its claim construction brief containing other supporting materials. It must be paginated, contain an index, be text searchable and have each document bookmarked in the PDF filing.
- (c) No later than twenty-eight (28) days after filing of the Cross-Motions for Claim

Construction, the parties shall file simultaneous Responsive Claim Construction Briefs, which may not exceed twenty-five (25) pages absent prior leave of court. The briefs shall identify any intrinsic evidence with citation to the Joint Appendix under LPR 4.2(b) and shall separately identify any extrinsic evidence a party contends supports its proposed claim construction. If a party offers a sworn declaration of a witness to support its claim construction, the party must promptly make the witness available for deposition. The brief shall also describe all objections to any extrinsic evidence identified in the Cross-Motions for Claim Construction.

- (d) No reply or surreply briefs shall be filed unless requested by the court.
- (e) The presence of multiple alleged infringers with different products or processes shall, in an appropriate case, constitute good cause for allowing additional pages in the Cross-Motions for Claim Construction or Responsive Claim Construction Briefs or for allowing separate briefing as to different alleged infringers.
- (f) No later than seven (7) days after filing of the Responsive Claim Construction briefs, the parties shall file (1) a joint claim construction chart that sets forth each claim term and phrase addressed in the Cross-Motions for Claim Construction; each party's proposed construction, and (2) a joint status report containing the parties' proposals for the nature and form of the claim construction hearing pursuant to LPR 4.3. The document shall also be submitted to the court in Word Perfect or MS Word format. The chart should include a series of columns listing the complete language of each disputed claim term, each party's proposed claim constructions in separate columns, a column for the court to enter its claim construction and a reference to where the dispute term appears in the asserted patent. "Agreed" entered in the column for the court's construction will indicate agreed claim constructions.

Comment

The committee opted for simultaneous claim construction briefs rather than consecutive briefs, concluding that simultaneous briefing will allow all parties a better opportunity to explain their positions in the most expedient manner. Given the extensive disclosure required under these rules and the requirement to file the Joint Appendix with the Cross-Motions for Claim Construction, the committee believed all parties would have an understanding of each other's positions prior to briefing.

LPR 4.3 CLAIM CONSTRUCTION HEARING

Concurrent with the filing of the Responsive Claim Construction Briefs, a party shall file a Motion to Set Claim Construction Hearing. Either before or after the filing of Cross-Motions for Claim Construction, the court shall issue an order describing the schedule and procedures for a claim construction hearing. Any exhibits, including demonstrative exhibits, to be used at a claim construction hearing must be exchanged no later than seven (7) days before the hearing.

LPR 4.4 TUTORIAL

No later than fourteen (14) days after the filing of the Responsive Claim Construction Briefs, a party may submit to the court a tutorial summarizing and explaining the technology at issue either in writing or in presentation form such as PowerPoint not to exceed thirty (30) pages, or on DVD not to exceed thirty (30) minutes. The parties may request to provide a live tutorial to the court as part of its submission. No argument shall be permitted in the tutorial. The parties may not rely upon any statement made in the tutorial in other aspects of the litigation. If the court considers an early claim construction in connection with a dispositive motion for summary judgment, a party may submit or the court may require the tutorial to be submitted at that time.

5. EXPERT WITNESSES

LPR 5.1 DISCLOSURE OF EXPERTS AND EXPERT REPORTS

Unless the court orders otherwise,

- (a) expert witness disclosures and depositions shall be governed by this Rule;
- (b) no later than twenty-eight (28) days after entry of the claim construction ruling, each party shall make its initial expert witness disclosures required by Federal Rule of Civil Procedure 26 on issues for which it bears the burden of proof;
- (c) no later than twenty-eight (28) days after the date for initial expert reports, each party shall make its rebuttal expert witness disclosures required by Federal Rule of Civil Procedure 26 on the issues for which the opposing party bears the burden of proof.

(d) Expert Reports Generally:

(1) Every expert report shall begin with a succinct statement of the opinions the expert expects to give at trial.

(2) Unless leave of court is applied for and given, there shall be no expert testimony at trial on any opinion not fairly disclosed in that expert's report.

(3) Unless leave of court is applied for and given, an expert shall not use or refer to at trial any evidence, basis or grounds in support of the expert's opinion not disclosed in the expert's report, except as set forth below.

LPR 5.2 DEPOSITIONS OF EXPERTS

Depositions of expert witnesses shall be completed no later than thirty-five (35) days after exchange of expert rebuttal reports.

LPR 5.3 PRESUMPTION AGAINST SUPPLEMENTATION OF REPORTS

Amendments or supplementation to expert reports after the deadlines provided herein are presumptively prejudicial and shall not be allowed absent prior leave of court upon a showing of good cause that the amendment or supplementation could not reasonably have been made earlier and that the opposing party is not unfairly prejudiced. This rule does not preclude or excuse supplementation required by the Rules of Civil Procedure when there are changes in factual support or legal precedent necessitating such supplementation.

6. DISPOSITIVE MOTIONS

LPR 6.1 FINAL DAY FOR FILING DISPOSITIVE MOTIONS

All dispositive motions shall be filed no later than twenty-eight (28) days after the scheduled date for the end of expert discovery.

Comment

This Rule does not preclude a party from moving for summary judgment at an earlier stage of the case if circumstances warrant. It is up to the trial judge to determine whether to consider an "early" summary judgment motion. See also LPR 1.1 (judge may defer a motion raising claim construction issues until after claim construction hearing is held).

LPR 6.2 SUMMARY JUDGMENT

Whenever construction of a term may be dispositive of an issue, any motion for partial summary judgment on that issue must be filed at the same time the moving party files its Cross-Motion for Claim Construction. See LPR 4. All other dispositive motions shall be filed within the time provided in LPR 6.1. All motions for summary judgment in patent cases subject to these rules must comply with local rule DUCivR 56-1.

7. FINAL PRETRIAL CONFERENCE

LPR 7.1 NUMBER OF CLAIMS AND PRIOR ART REFERENCES TO BE PRESENTED TO THE FACT FINDER

In its final pretrial disclosures, a party asserting infringement shall reduce the number of asserted claims to a manageable subset of previously-identified asserted claims. As a general rule, the court considers a manageable number to be three (3) claims per patent, and ten (10) claims total if more than one patent is being asserted. Except upon a showing of good cause, including principles of proportionality applying to the need for pretrial discovery, a party opposing infringement shall not file a motion to limit the number of asserted claims until the later of resolution of dispositive motions or ninety (90) days prior to trial.

In its final pretrial disclosures, a party opposing infringement shall reduce the number of prior art references—and any combinations thereof—to be asserted in support of anticipation or obviousness theories to a manageable subset of previously identified prior art references. As a general rule, a manageable number of references per claim is no more than three (3) references. A party opposing infringement must also identify how these references will be used, i.e., as anticipatory or in combination, against each asserted claim. Absent extraordinary circumstances, a party asserting infringement shall not file a motion to limit the number of asserted prior art references until the later of resolution of dispositive motions or ninety (90) days prior to trial.