

UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF UTAH

LOCAL PATENT RULES

PREAMBLE..... 3

1. SCOPE OF RULES..... 4

 LPR 1.1 APPLICATION AND CONSTRUCTION..... 4

 LPR 1.2 INITIAL ATTORNEY PLANNING CONFERENCE AND SCHEDULING
 ORDERS..... 4

 LPR 1.3 FACT DISCOVERY 5

 LPR 1.4 CONFIDENTIALITY 6

 LPR 1.5 CERTIFICATION OF DISCLOSURES..... 6

 LPR 1.6 ADMISSIBILITY OF DISCLOSURES..... 6

 LPR 1.7 RELATIONSHIP TO FEDERAL RULES OF CIVIL PROCEDURE..... 6

2. PATENT INITIAL DISCLOSURES..... 7

 LPR 2.3 INITIAL INFRINGEMENT CONTENTIONS 9

 LPR 2.4 INITIAL NON-INFRINGEMENT, UNENFORCEABILITY AND
 INVALIDITY CONTENTIONS 11

 LPR 2.5 DOCUMENT PRODUCTION ACCOMPANYING INITIAL INVALIDITY
 CONTENTIONS 12

 LPR 2.6 DISCLOSURE REQUIREMENT IN PATENT CASES INITIATED BY
 COMPLAINT FOR DECLARATORY JUDGMENT..... 12

3. FINAL CONTENTIONS..... 13

 LPR 3.1 FINAL INFRINGEMENT, UNENFORCEABILITY AND INVALIDITY
 CONTENTIONS 13

 LPR 3.2 FINAL NON-INFRINGEMENT CONTENTIONS 13

 LPR 3.3 DOCUMENT PRODUCTION ACCOMPANYING FINAL INVALIDITY
 CONTENTIONS 13

 LPR 3.4 AMENDMENT OF FINAL CONTENTIONS 14

 LPR 3.5 FINAL DATE TO SEEK STAY 14

4. CLAIM CONSTRUCTION PROCEEDINGS 14

 LPR 4.1 EXCHANGE OF PROPOSED CLAIM TERMS TO BE CONSTRUED
 ALONG WITH PROPOSED CONSTRUCTIONS 14

 LPR 4.2 CLAIM CONSTRUCTION BRIEFS 15

 LPR 4.3 CLAIM CONSTRUCTION HEARING 17

 LPR 4.4 TUTORIAL 17

5. EXPERT WITNESSES..... 17

 LPR 5.1 DISCLOSURE OF EXPERTS AND EXPERT REPORTS 17

 LPR 5.2 DEPOSITIONS OF EXPERTS..... 18

 LPR 5.3 PRESUMPTION AGAINST SUPPLEMENTATION OF REPORTS..... 18

6. DISPOSITIVE MOTIONS 18

 LPR 6.1 FINAL DAY FOR FILING DISPOSITIVE MOTIONS 18

LPR 6.2 SUMMARY JUDGMENT 19

7. FINAL PRETRIAL CONFERENCE 19

 LPR 7.1 NUMBER OF CLAIMS AND PRIOR ART REFERENCES TO BE
 PRESENTED TO THE FACT FINDER 19

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 FRCivP 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;

(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.