

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



LOCAL RULES OF PATENT PRACTICE

DECEMBER 2020

UNITED STATES DISTRICT COURT FOR THE
DISTRICT OF UTAH

LOCAL PATENT RULES

Table of Contents

PREAMBLE 3

1. SCOPE OF RULES 4

 LPR 1.1 APPLICATION AND CONSTRUCTION 4

 LPR 1.2 INITIAL ATTORNEY PLANNING CONFERENCE AND SCHEDULING
 ORDERS..... 5

 LPR 1.3 FACT DISCOVERY..... 5

 LPR 1.4 CONFIDENTIALITY 7

 LPR 1.5 CERTIFICATION OF DISCLOSURES..... 7

 LPR 1.6 ADMISSIBILITY OF DISCLOSURES..... 7

 LPR 1.7 RELATIONSHIP TO FEDERAL RULES OF CIVIL PROCEDURE 8

2. PATENT INITIAL DISCLOSURES..... 9

 LPR 2.1 ACCUSED INSTRUMENTALITY DISCLOSURES 9

 LPR 2.2 INITIAL DISCLOSURES..... 9

 LPR 2.3 INITIAL INFRINGEMENT CONTENTIONS 11

 LPR 2.4 INITIAL NON-INFRINGEMENT, UNENFORCEABILITY, AND
 INVALIDITY CONTENTIONS..... 13

 LPR 2.5 DOCUMENT PRODUCTION ACCOMPANYING INITIAL
 INVALIDITY CONTENTIONS..... 14

 LPR 2.6 DISCLOSURE REQUIREMENT IN PATENT CASES INITIATED BY
 COMPLAINT FOR DECLARATORY JUDGMENT 15

3. FINAL CONTENTIONS	15
LPR 3.1 FINAL INFRINGEMENT, UNENFORCEABILITY AND INVALIDITY CONTENTIONS	15
LPR 3.2 FINAL NON-INFRINGEMENT CONTENTIONS.....	16
LPR 3.3 DOCUMENT PRODUCTION ACCOMPANYING FINAL INVALIDITY CONTENTIONS	16
LPR 3.4 AMENDMENT OF FINAL CONTENTIONS	16
LPR 3.5 FINAL DATE TO SEEK STAY	17
4. CLAIM CONSTRUCTION PROCEEDINGS	17
LPR 4.1 EXCHANGE OF PROPOSED CLAIM TERMS TO BE CONSTRUED ALONG WITH PROPOSED CONSTRUCTIONS	17
LPR 4.2 CLAIM CONSTRUCTION BRIEFS	18
LPR 4.3 CLAIM CONSTRUCTION HEARING	20
LPR 4.4 TUTORIAL.....	20
5. EXPERT WITNESSES.....	21
LPR 5.1 DISCLOSURE OF EXPERTS AND EXPERT REPORTS	21
LPR 5.2 DEPOSITIONS OF EXPERTS	21
LPR 5.3 PRESUMPTION AGAINST SUPPLEMENTATION OF REPORTS.....	22
6. DISPOSITIVE MOTIONS	22
LPR 6.1 FINAL DAY FOR FILING DISPOSITIVE MOTIONS	22
LPR 6.2 SUMMARY JUDGMENT	22
7. FINAL PRETRIAL CONFERENCE	23
LPR 7.1 NUMBER OF CLAIMS AND PRIOR ART REFERENCES TO BE PRESENTED TO THE FACT FINDER	23

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 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 must hold their conference pursuant to Fed. R. Civ. P. 26(f) no later than 35 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 7 days after the Rule 26(f) conference unless the court otherwise directs. No later than 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 must commence fact discovery upon the date for the Initial Attorney Planning Conference under LPR 1.2 and must complete it 28 days after the date for exchange of claim terms and phrases under LPR 4.1.
- (b)** No later than 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 must explain why the claim construction ruling or disclosure of intent to rely on

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 must file a Motion to Set Claim Construction Hearing. Either before or after the filing of Cross-Motions for Claim Construction, the court will 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 7 days before the hearing.

LPR 4.4 TUTORIAL

No later than 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 30 pages, or on DVD not to exceed 30 minutes. The parties may request to provide a live tutorial to the court as part of its submission. No argument are 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 are governed by this Rule;
- (b)** no later than 28 days after entry of the claim construction ruling, each party must 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 28 days after the date for initial expert reports, each party must 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 must 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 will not be any 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 must 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 must be completed no later than 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 must 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 must be filed no later than 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 must 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 must 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 3 claims per patent, and 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 must not file a motion to limit the number of asserted claims until the later of resolution of dispositive motions or 90 days prior to trial.

In its final pretrial disclosures, a party opposing infringement must 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 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 must not file a motion to limit the number of asserted prior art references until the later of resolution of dispositive motions or 90 days prior to trial.