



UNITED STATES DISTRICT COURT WESTERN DISTRICT OF TENNESSEE

LOCAL PATENT RULES

Effective September 20, 2019

**Amended in accordance with Administrative Order 2019-29
*Order Adopting Revisions to the Local Rules and Local Patent Rules
of the Western District of Tennessee***

I. SCOPE OF THE RULES

1.1 Title

These are the Local Patent Rules for the United States District Court for the Western District of Tennessee. They should be cited as “LPR____.”

1.2 Scope and Construction

These Local Patent Rules apply to all civil actions filed in, removed to, or transferred to this Court that allege infringement of a patent in a complaint, counterclaim, cross-claim, or third party claim, or that seek a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable. The Local Rules of this Court shall also apply to such actions, except to the extent that they are inconsistent with these Local Patent Rules. If the filings or actions in a case do not trigger the application of these Local Patent Rules under the terms set forth herein, the parties shall, as soon as such circumstances become known, meet and confer for the purpose of agreeing on the application of these Local Patent Rules to the case and promptly report the results of the meeting to the Court.

1.3 Commencing Discovery

For all actions pursuant to the Local Patent Rules, discovery is permitted to begin upon the filing of the answer or a motion under Rule 12 of the Federal Rules of Civil Procedure (each, an “Initial Response”), absent an order from the Court stating otherwise.

1.4 Cases Received after the Initial Response

If the Court obtains jurisdiction over an action subject to the Local Patent Rules after an Initial Response has been filed, the time for serving disclosures set forth in LPR 3.1, 3.5, 3.9, and 4.1 shall commence from the day the Court acquires jurisdiction, rather than the date the Initial Response is filed.

1.5 Modification of Obligations

The Court may modify the obligations or deadlines set forth in these Local Patent Rules based on the circumstances of any particular case, including, without limitation, the simplicity or complexity of the case as shown by the patents, claims, products, or parties involved. Such modifications shall, in most cases, be made at the Patent Scheduling Conference but may be made at other times by the Court *sua sponte* or upon a showing of good cause.

1.6 Effective Date

These Local Patent Rules take effect on September 19, 2011. For actions pending before the effective date, the Court will confer with the parties and apply these Local Patent Rules as the Court deems practicable.

II. GENERAL PROVISIONS

2.1 Governing Procedure

(a) Patent Scheduling Conference Notice. Within 7 business days after the Initial Response is filed, the parties shall jointly file a notice (“Patent Scheduling Conference Notice”) via the Court’s Electronic Case Filing system informing the Court whether:

- (1) the action is ripe to be scheduled for a Patent Scheduling Conference at the Court’s earliest convenience,
- (2) the requirements under these Local Patent Rules should be modified in any way and the requested modifications, and
- (3) any other case management issues have been identified that would impact any party’s ability to conform to these Local Patent Rules.

Before submitting the Patent Scheduling Conference Notice, the parties shall meet and confer to try to reach an agreement upon any issues to be raised with the Court.

(b) Planning Meeting. At least 14 days prior to the Patent Scheduling Conference, the parties shall confer to discuss and address in the Joint Planning Report and Proposed Scheduling Order the topics set forth in Federal Rule of Civil Procedure 26(f) and Local Rule 26.1(e), as well as the following topics:

- (1) Any modification to the deadlines set by these Local Patent Rules;
- (2) Any anticipated motions that might affect the deadlines set by these Local Patent Rules, including motions to dismiss, transfer, stay, for preliminary injunction, or to add or substitute parties, and a proposed briefing schedule;
- (3) Any issues that might be the proper subject of an early motion for summary judgment or partial summary judgment;
- (4) The field of the claimed invention(s), claims asserted, number of claim terms to be construed, and the allegedly infringing activity or product;

Local Patent Rules - Western District of Tennessee

- (5) Any modification to the limits on interrogatories and/or depositions set forth in the Federal Rules of Civil Procedure;
- (6) Any deviations from the form Patent Protective Order set forth in Appendix A to these Local Patent Rules;
- (7) 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;
- (8) Whether the parties will agree to the electronic exchange of pleadings, notices, discovery, and other mandated disclosures not otherwise served electronically via the Court's Electronic Case Filing system; and
- (9) Whether the parties agree that this action is appropriate for expedited treatment including the appropriateness of an expedited trial, consolidated claim construction and trial procedure, trial on limited issues, or a stipulation for post-trial mediation before the entry of judgment on the verdict.
- (10) The susceptibility of this action to resolution by Alternative Dispute Resolution.

(c) Joint Planning Report and Proposed Scheduling Order. At least 7 days prior to the Patent Scheduling Conference, the plaintiff, on behalf of all parties, must file with the Court a Joint Planning Report and Proposed Scheduling Order in the form provided in Appendix B to these Local Patent Rules or in any other form ordered by the Court. Statements made by the parties in the Joint Planning Report and Proposed Scheduling Order will be used for case management purposes only and shall not be used to limit or otherwise restrict a party's ability to seek relief from the Court at a later date with respect to issues addressed or not addressed in the Joint Planning Report and Proposed Scheduling Order.

(d) Patent Scheduling Conference.

- (1) Agenda. The general agenda for the Patent Scheduling Conference is set by Local Rule 16.1. The parties also should be prepared to discuss with the Court all of the matters addressed in the parties' Joint Planning Report and Proposed Scheduling Order, including the status of settlement discussions and the utilization of Alternative Dispute Resolution methods under Local Rule 16.3.
- (2) Technology at Issue. Each party should be prepared to discuss the technology at issue during the Patent Scheduling Conference. This includes the

Local Patent Rules - Western District of Tennessee

general technology at issue, the patent(s) in suit, and each accused apparatus, product, device, process, method, act, or other instrumentality of each opposing party that is accused of infringing (each, an “Accused Instrumentality”). In addition to the foregoing, each party opposing a claim of infringement is expected to bring a sample or representation (e.g., photographs, video, specifications, etc.) of each Accused Instrumentality.

(3) Attendance by Parties. All parties, including lead counsel and a representative with full authority for settlement purposes, shall attend the Patent Scheduling Conference. “Parties” means either the named individuals or, in the case of a corporation or similar legal entity, a person familiar with the facts of the case, including the patented technology or allegedly infringing technology. A party may move to modify the attendance of a party or party representative by detailing the reasoning for the modification. It is fully within the Court’s discretion to grant or deny in full or in part such motions.

2.2 Confidentiality

Discovery cannot be withheld on the basis of confidentiality, absent Court order. Pending entry of a protective order, discovery and disclosures deemed confidential by a party shall be produced to the adverse party for the eyes of outside counsel of record only, marked “Attorneys Eyes Only – Subject to Protective Order.” The discovery and disclosures so marked shall be used solely for purposes of the pending case and shall not be disclosed to the client or any other person.

Should the parties desire to have a protective order entered in a patent case, they shall present a stipulated protective order for the Court's consideration and entry at the Patent Scheduling Conference. In the absence of a stipulated protective order, a party that has designated discovery or disclosures for protection under this Rule or that desires to have a protective order entered in the case shall move the Court for the entry of the Patent Case Protective Order attached as Appendix A to these Rules. Upon entry of the Patent Case Protective Order, discovery and disclosures previously designated for protection under this Rule may be re-designated, disclosed, and used in accordance with the provisions of the protective order entered by the Court.

Should a party desire to file materials designated for protection under this Rule with the Court before the entry of a protective order, the materials shall be filed under seal, and this Rule shall authorize the Clerk of Court to accept the sealed filing.

2.3 Relationship to Federal Rules of Civil Procedure and Local Civil Rules for the United States District Court, Western District of Tennessee

Local Patent Rules - Western District of Tennessee

A party may not object to discovery on the ground that it conflicts with or is premature under these Local Patent Rules, except to the following categories of requests and disclosures:

- (a) Requests for a party's claim construction position;
- (b) Requests for the same information required to be disclosed under Local Patent Rules 3.1-3.7; and
- (c) Requests that an accused infringer identify whether it intends to rely upon the opinion(s) of counsel as a defense against an allegation of willful infringement.

Federal Rule of Civil Procedure 26(e)'s requirements concerning the supplementation of disclosure and discovery responses apply to all disclosures required under these Local Patent Rules.

Parties may use stipulations provided for in Rule 29, if otherwise compliant with that Rule, to modify time periods or formats for service of contentions, production of documents, or other exchanges or information prescribed in these Local Patent Rules or a Scheduling Order entered pursuant hereto, and are not items required to be filed with the Court, provided that such modifications do not interfere with deadlines for Court filings or dates for Court proceedings such as the Claim Construction Hearing. Such stipulations need not be filed in the action, but no stipulation will be enforced by the Court unless memorialized between counsel.

III. PATENT DISCLOSURES

3.1. Initial Infringement Contentions

Within 21 days after the Initial Response is filed, and after consultation with each opposing party to identify and narrow the issues presented, a party claiming patent infringement shall serve on all parties Initial Infringement Contentions, which shall contain at least the following information:

- (a) Each claim of each patent in suit that is allegedly infringed by each opposing party, including for each claim, the applicable statutory subsection(s) of 35 U.S.C. § 271 ("Infringement of Patent") asserted;
- (b) Separately for each asserted claim, each Accused Instrumentality that each party claiming infringement contends infringes, including the name or model number if known;
- (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 35 U.S.C. § 112, ¶ 6, the identity of the corresponding structure and function and where such structure and function is found in the Accused Instrumentality;

- (d) 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(s) that contribute to or that are inducing direct infringement, including a description of the role of each relevant party if direct infringement is based on the

joint acts of multiple parties;

- (e) Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;
- (f) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and
- (g) If a party claiming patent infringement alleges willful infringement, the basis for such allegation.

3.2. Document Production Accompanying Initial Infringement Contentions

With the Initial Infringement Contentions, the party claiming patent infringement shall produce to each opposing party or make available for inspection and copying:

- (a) All documents concerning any disclosure, sale or transfer, or offer to sell or transfer of the claimed invention prior to the bar date under 35 U.S.C. § 102(b) and/or the date of invention for the patent in suit;
- (b) All documents evidencing the conception and first reduction to practice of each claimed invention created on or before the date of application for the patent in suit or the priority date identified pursuant to LPR 3.1(f), whichever is earlier;
- (c) A copy of the file history for each patent in suit (or so much thereof as is in the possession of the patentee) and any patent(s) or application(s) to which each patent in suit claims priority; and
- (d) All documents evidencing ownership of the patent rights by the party asserting patent infringement.

Nothing in these required disclosures shall be considered an admission that such disclosures are prior art or evidence of prior art under 35 U.S.C. §§ 102 or 103.

3.3. Initial Non-infringement Contentions

Within 28 days after service of the Initial Infringement Contentions, each party opposing a claim of patent infringement shall serve on all parties Non-infringement Contentions, which shall contain the following information:

- (a) A chart, responsive to the chart required by LPR 3.1(c), that identifies as to each identified element in each asserted claim (1) 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, and (2) for each limitation that such party contends is governed by 35 U.S.C. § 112, ¶6, the corresponding structure and function, (if different from that identified in LPR 3.1(c)), whether or not such structure and function are found in the Accused Instrumentality, and/or any basis for claiming that such limitation is invalid for indefiniteness; and

- (b) A statement that the proper parties have been served or, if the proper parties have not been served, a statement identifying the proper parties to the extent they are known.

3.4. Document Production Accompanying Initial Non-infringement Contentions

With its Non-infringement Contentions, the party opposing a claim of patent infringement shall produce or make available for inspection and copying:

- (a) Documents sufficient to support the statement(s) made in the chart required by LPR 3.3(a);
- (b) Documents sufficient to evidence the actual parties that make and sell the Accused Instrumentality or any other documents sufficient to support the statement(s) made in response to LPR 3.3(b); and
- (c) Documents sufficient to describe the structure, composition, and/or operation of the Accused Instrumentality.

3.5. Invalidity and Unenforceability Contentions

Within 90 days after the Initial Response is filed, and after consultation with each opposing party to identify and narrow the issues presented, each party asserting that a claim of a patent is invalid or unenforceable shall serve on all parties its Invalidity and Unenforceability Contentions, which shall contain at least the following information:

- (a) The identity 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 shall be identified by its title, date of publication, and, where feasible, author and publisher. 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 that made the use or that made and received the offer, or the person or entity that made the

Local Patent Rules - Western District of Tennessee

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) Whether each item of prior art anticipates each asserted claim or renders it obvious under 35 U.S.C. §§ 102 or 103. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness;
- (c) For each alleged item of prior art, a chart identifying specifically where each limitation of each asserted claim is found, including for each limitation that such party contends is governed by 35 U.S.C. § 112, ¶6, the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function;
- (d) Any grounds of invalidity based on 35 U.S.C. §§ 102 or 103, including invalidity contentions based on written description, enablement, indefiniteness, and/or best mode; and
- (e) The grounds for any charge that any of the asserted claims are unenforceable for inequitable conduct, including the identification of any information alleged to have been withheld, misstated, or otherwise misrepresented to the United States Patent Office; the basis for claiming such information was material to patentability; and the basis for claiming that the patentee withheld, misstated, or misrepresented such information with the requisite intent.

3.6. Document Production Accompanying Invalidity and Unenforceability Contentions

With its Invalidity and Unenforceability Contentions, any party opposing a claim of patent infringement shall produce or make available for inspection and copying:

- (a) A copy or sample of the prior art identified pursuant to LPR 3.5(a). To the extent any such item is not in English, an English translation of the portion(s) relied upon shall be produced. The producing party shall separately identify by production number which documents correspond to each invalidity category; and
- (b) All documents supporting any statement(s) made in response to LPR 3.5(e).

3.7 Validity and Enforceability Contentions

Local Patent Rules - Western District of Tennessee

Within 21 days after service of the Invalidity and Unenforceability Contentions, each party opposing a claim of inequitable conduct and/or invalidity shall serve on all parties Validity and Enforceability Contentions, which shall contain the following information:

- (a) A chart, responsive to the chart required by LPR 3.5(c), that identifies each limitation of each asserted claim that is missing from the asserted prior art;
- (b) A responsive statement explaining why the disclosures and statement required by LPR 3.5(e) do not render the asserted patents unenforceable;
- (c) All documents supporting the disclosures made in LPR 3.7(a)-(b) to the extent that they have not already been produced.

3.8 Final Contentions

- (a) Final Infringement Contentions. Within 14 days after the Court's Claim Construction Ruling is issued, each party claiming patent infringement shall serve on all parties Final Infringement Contentions, containing the information required by LPR 3.1.
- (b) Final Non-infringement Contentions, Final Invalidity and Unenforceability Contentions. Within 14 days after the Court's Claim Construction Ruling is issued, each party asserting non-infringement, invalidity, or unenforceability of a patent claim shall serve on all other parties Final Non-infringement Contentions and Final Invalidity and Unenforceability Contentions, containing the information required by LPR 3.3 and 3.5. With the Final Invalidity and Unenforceability 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 3.6, to the extent not previously produced. If any such item is not in English, an English translation of the portion(s) relied upon shall be produced. The producing party shall separately identify by production number which documents correspond to each category.
- (c) Final Validity and Enforceability Contentions. Within 45 days after the Court's Claim Construction Ruling is issued, each party claiming patent infringement must serve on all parties Final Validity and Enforceability Contentions containing the information required by LPR 3.7.
- (d) Amendments to Final Contentions. A party may amend the Final Contentions required under LPR 3.8(a)-(c) only by order of the Court upon a showing of good cause and absence of unfair prejudice, made in timely fashion, following discovery of the basis for such amendment. The duty to supplement discovery

responses does not excuse the need to obtain leave of Court to amend contentions.

3.9 Disclosure Requirements for Patent Cases for Declaratory Judgment of Invalidity

In all cases in which a party files a complaint or other pleading seeking declaratory judgment that a patent is invalid, LPR 3.1-3.4 shall not apply unless and until a claim for patent infringement is made by a party in the Initial Response. If the defendant does not assert a claim for patent infringement in its Initial Response, the party seeking declaratory judgment of invalidity shall make its required disclosures under LPR 3.5 and 3.6 within 30 days after the Initial Response is filed. All other deadlines and requirements under the Local Patent Rules shall remain the same. This Rule 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.

3.10 Disclosure Requirements for Patent Cases Arising under 21 U.S.C. § 355 (commonly referred to as “the Hatch-Waxman Act”)

The following provisions apply to all patents subject to a Paragraph IV certification in cases arising under 21 U.S.C. § 355 (commonly referred to as “the Hatch-Waxman Act”). These provisions take precedence over any conflicting provisions in LPR 3.1-3.8 for all cases arising under 21 U.S.C. § 355.

- (a) Production of New Drug Application. At or before the Patent Scheduling Conference, Defendant(s) shall produce to Plaintiff(s) the entire Abbreviated New Drug Application or New Drug Application that is the basis of the case in question.
- (b) Invalidity Contentions. Within 14 days after the Patent Scheduling Conference, Defendant(s) shall provide to Plaintiff(s) written Invalidity Contentions for any patents referred to in Defendant(s) Paragraph IV Certification. At a minimum, these Invalidity Contentions should include those items required by LPR 3.5(a)-(d).
- (c) Production of Materials Supporting Invalidity Contentions. Any Invalidity Contentions disclosed under LPR 3.10(b) shall be accompanied by the production of any document or thing that each Defendant intends to rely on to show invalidity. At a minimum, this disclosure should comply with LPR 3.6(a).
- (d) Non-infringement Contentions. Within 30 days after the Patent Scheduling Conference, Defendant(s) shall provide to Plaintiff(s) the written basis for their Non-infringement Contentions for any patents referred to in Defendant(s) Paragraph IV Certification, which shall include a claim chart as required by LPR

3.3(a) identifying each claim at issue in the case and each limitation of each claim at issue. The claim chart shall specifically identify for each claim which claim limitation(s) are literally absent from the Defendant(s) allegedly infringing Abbreviated New Drug Application or New Drug Application.

- (e) Production of Materials Supporting Non-infringement Contentions. Any Non-infringement Contentions disclosed under LPR 3.10(d) shall be accompanied by the production of any document or thing that each Defendant intends to rely on in defense against any infringement contentions by Plaintiff(s), including those items required by LPR 3.4(a).
- (f) Infringement Contentions. Within 45 days after the disclosure of the Non-infringement Contentions as required by LPR 3.10(d), Plaintiff(s) shall provide Defendant(s) with Infringement Contentions for all patents referred to in Defendant(s) Paragraph IV Certification, including, at a minimum, those items required by LPR 3.1.
- (g) Production of Materials Supporting Infringement Contentions. Any Infringement Contentions disclosed under LPR 3.10(f) shall be accompanied by the production of documents required under LPR 3.2.

3.11. Amending and Supplementing Contentions

Unless otherwise ordered by the Court, the parties' contentions and responses shall have the same binding effect on a party as a response to an interrogatory made under Rule 33 of the Federal Rules of Civil Procedure. The parties' disclosures and responses may be amended or supplemented without leave of Court until the Final Contentions are due under LPR 3.8(a)-(c); provided, however, that after submission of the exchange of claim terms under LPR 4.1(c), additional claims in the patent(s) in suit may not be asserted without obtaining leave from the Court for good cause shown.

3.12. Final Date to Seek Stay Pending Reexamination

Absent exceptional circumstances, no party may file a motion to stay the lawsuit pending reexamination in the United States Patent Office after the due date for service of that party's Final Contentions.

IV. CLAIM CONSTRUCTION PROCEEDINGS

4.1 Exchange of Proposed Terms for Construction

- (a) Preliminary Identification of Claim Terms to be Construed. Within 95 days after

the Initial Response is filed, each party shall serve on each other party a list of claim terms that the party contends should be construed by the Court and identify any claim terms that the party contends should be governed by 35 U.S.C. §112, ¶6.

- (b) Meet and Confer. 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 Pre-hearing Statement.
- (c) Final Identification of Claim Terms to be Construed. Within 115 days after the Initial Response is filed, each party shall serve on each other party a final list of claim terms that the party contends should be construed by the Court, including any claim terms that the party contends should be governed by 35 U.S.C. §112, ¶6.

4.2 Exchange of Preliminary and Final Claim Constructions and Evidence

- (a) Preliminary Claim Construction. Within 14 days after the exchange of the lists, pursuant to LPR 4.1(c), the parties shall simultaneously exchange a Preliminary Proposed Constructions of each term identified by any party for claim construction. Each such Preliminary Claim Construction shall also, for each term that any party contends is governed by 35 U.S.C. § 112, ¶6, identify the structure(s), act(s), or material(s) corresponding to that term's function.
- (b) Supporting Materials. 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 preliminary proposed construction and designate any supporting extrinsic evidence, including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses, including expert witnesses. Extrinsic evidence shall be identified by production number or by producing a copy if not previously produced. The parties shall further identify any fact witness, including a brief description of the subject matter of each witness' anticipated testimony.
- (c) Final Claim Construction. Within 7 days after the deadline for completion of Expert Claim Construction Discovery, pursuant to LPR 4.3(c), or 50 days after the exchange of Preliminary Claim Constructions, pursuant to LPR 4.2(a), in the event that no expert is identified, the parties shall simultaneously exchange final proposed constructions of each term identified by any party for claim construction. Each such Final Claim Construction shall also, for each term that any party contends is governed by 35 U.S.C. § 112, ¶6, identify the structure(s), act(s), or material(s) corresponding to that term's function. The parties shall also

identify the information set forth in LPR 4.2(b) as well as any expert testimony the party intends to rely upon in support of its Final Claim Construction.

4.3 Expert Claim Construction Discovery

- (a) Initial Expert Claim Construction Reports. Within 14 days after the exchange of Preliminary Claim Constructions, pursuant to LPR 4.2(a), any party planning to use an expert witness at the Claim Construction Hearing shall identify that witness and produce a copy of the expert's curriculum vitae and any expert report or declaration the party intends to rely upon.
- (b) Rebuttal Expert Claim Construction Reports. Within 14 days after the disclosure of Initial Expert Claim Construction Reports, pursuant to LPR 4.3(a), any party planning to use a rebuttal expert witness at the Claim Construction Hearing shall identify that witness and produce a copy of the expert's curriculum vitae and any expert report or declaration the party intends to rely upon.
- (c) Completion of Expert Discovery. Within 14 days after the disclosure of Rebuttal Expert Claim Construction Reports, pursuant to LPR 4.3(b), the parties shall complete any depositions of any experts identified under LPR 4.3.

4.4 Claim Construction Briefs

- (a) Opening Claim Construction Briefs. Within 14 days after exchanging Final Claim Constructions, pursuant to LPR 4.2(c), the parties shall contemporaneously file and serve their Opening Claim Construction Briefs and any evidence supporting claim construction, including witness testimony or declarations.
- (b) Responsive Claim Construction Briefs. Within 30 days after the Opening Claim Construction Briefs are filed, the parties shall contemporaneously file and serve Responsive Claim Construction Briefs and any evidence supporting claim construction, including any responding experts' certifications or declarations.
- (c) Length. Without prior approval of the Court, all memoranda related to Claim Construction Briefs shall be limited to 25 pages. Appendices of evidentiary, statutory, or other materials are excluded from these page limitations and may be bound separately from the memorandum.

4.5 Joint Claim Construction and Prehearing Statement

Within 7 days after the Responsive Claim Construction Briefs are filed, pursuant to LPR 4.4(b), the parties shall complete and file a Joint Claim Construction and Prehearing Statement, which

Local Patent Rules - Western District of Tennessee

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 intrinsic evidence that supports 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 all witnesses, including experts;
- (c) An identification of the terms that each party contends (i) would require a disposition of the case in its favor and/or (ii) will be substantially conducive to promoting settlement. For any such terms, each party shall also include a brief statement, not to exceed one page, supporting or refuting the contention that the construction of those terms will be dispositive or promote settlement. The Court may, at its option, solicit additional briefing regarding the dispositive nature of any terms prior to the Claim Construction Hearing or upon issuing its claim constructions.
- (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 a brief description of the subject matter of each witness' anticipated testimony; and
- (f) A list of other issues that might appropriately be taken up at a prehearing conference prior to the Claim Construction Hearing and, if not previously set, proposed dates for any such prehearing conference.

4.6 Claim Construction Hearing

Subject to the convenience of the Court's calendar, the Court shall conduct a Claim Construction Hearing within 30 days after the Responsive Claim Construction Briefs are filed to the extent the parties or the Court believe a hearing is necessary for construction of the claims at issue. Prior to the Claim Construction Hearing, the parties shall contact the Court to make arrangements for any use of courtroom technology, such as demonstrations, PowerPoint® presentations, or evidence presentation programs. At the Claim Construction Hearing, the parties shall submit the best available specimens of patented technology and allegedly infringing activity (e.g. products, schematics, photos, product information sheets).

4.7 Close of Fact Discovery; Status Conference

Unless otherwise ordered by the Court, fact discovery for all actions subject to these Local Patent Rules shall close no later than 30 days after the Court's Claim Construction Ruling is issued. The parties shall also appear for a Status Conference (in person or telephonically, at the option of the Court) within 30 days of that Ruling.

In addition to updating the Court regarding the status of the pending litigation, each party shall inform the Court whether mediation of the dispute is appropriate during the Status Conference. The Court, at its option, may refer any case subject to these rules to mediation under Local Rule 16.3 upon request of one or both the parties or *sua sponte*. Any party objecting to the Court selecting its case for mediation may file a motion to be relieved of the obligation as required by Local Rule 16.3(e). A failure to participate in good faith in the mediation may expose a party and/or its counsel to sanctions.

4.8 Advice of Counsel

Unless otherwise ordered by the Court, 90 days before the close of fact discovery, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall produce or make available for inspection and copying any written advice and documents related thereto. Regardless of the deadline for the close of fact discovery, if a party relies on advice of counsel, the opposing party shall be afforded an adequate opportunity to obtain discovery pertaining to such advice.

A party who does not comply with the requirements of this LPR 4.8 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.

V. EXPERT DISCOVERY

5.1. Disclosure of Experts and Expert Reports

Unless the Court orders otherwise:

- (a) Scope. For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule;
- (b) Initial Expert Witness Disclosures. Within 60 days after the Court's Claim Construction Ruling is issued, each party shall make its Initial Expert Witness Disclosures required by Rule 26 of the Federal Rules of Civil Procedure on issues for which it bears the burden of proof; and

- (c) Rebuttal Expert Witness Disclosures. Within 30 days after service of the Initial Expert Witness Disclosures, pursuant to LPR 5.1(b), each party shall make its Rebuttal Expert Witness Disclosures required by Rule 26 of the Federal Rules of Civil Procedure on issues for which the opposing party bears the burden of proof.

5.2. Depositions of Experts

Within 40 days after service of Rebuttal Expert Witness Disclosure, depositions of expert witnesses shall be completed.

5.3. Presumption against Supplementation of Reports

Amendments to, or supplementation of, 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.

VI. DISPOSITIVE MOTIONS AND TRIAL

6.1. Filing Dispositive Motions

All dispositive motions shall be filed within 14 days after the scheduled date for the end of expert discovery as provided in LPR 5.1 and 5.2.

6.2. Trial

Unless otherwise ordered by the Court, and subject to the convenience of the Court's calendar, a Trial on all cases subject to these Local Patent Rules shall be conducted within 120 days after the deadline for filing dispositive motions.

APPENDIX A

STIPULATED PATENT CASE PROTECTIVE ORDER

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
DIVISION**

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)	
Plaintiff,)	
)	
v.)	Case No.
)	
)	
Defendant.)	
)	

[STIPULATED]¹ PATENT CASE PROTECTIVE ORDER

[If by stipulation.] The parties to this Stipulated Patent Case Protective Order have agreed to the terms of this Order. Accordingly, it is ORDERED:

[If not fully by stipulation.] A party to this action has moved that the Court enter a protective order. The Court has determined that the terms set forth herein are appropriate to protect the respective interests of the parties, the public, and the Court. Accordingly, it is ORDERED:

1. Scope. All disclosures, affidavits, and declarations and exhibits thereto, deposition testimony and exhibits, discovery responses, documents, electronically stored information, tangible objects, information, and other things produced, provided, or disclosed in the course of this action, which may be subject to restrictions on disclosure under this Order, and information derived directly therefrom (hereinafter referred to collectively as "documents"), shall be subject to this Order as set forth below. As there is a presumption in favor of open and public judicial proceedings in the federal courts, this Order shall be strictly construed in favor of public disclosure and open proceedings wherever possible. The Order is also subject to the Local Rules of this District and the Federal Rules of Civil Procedure on matters of procedure and calculation of time periods.

2. Form and Timing of Designation. A party may designate documents as confidential and restricted in disclosure under this Order by placing or affixing the words "CONFIDENTIAL - SUBJECT TO PROTECTIVE ORDER" (hereinafter referred to as "CONFIDENTIAL") or

¹ Counsel should include or delete language in brackets as necessary to the specific case.

"ATTORNEYS EYES ONLY - SUBJECT TO PROTECTIVE ORDER" (hereinafter referred to as "ATTORNEYS EYES ONLY") on the document in a manner that will not interfere with the legibility of the document and that will permit complete removal of the designation. Documents shall be designated prior to or at the time of the production or disclosure of the documents. When a tangible object is produced for inspection, subject to protection under this Order, a photograph thereof shall be produced at the time of inspection labeled with the designation CONFIDENTIAL or ATTORNEYS EYES ONLY. Thereafter, any information learned or obtained as a result of the inspection shall be subject to protection under this Order in accordance with the applicable designation. When electronically stored information is produced, which cannot itself be marked with the designation CONFIDENTIAL or ATTORNEYS EYES ONLY, the physical media on which such electronically stored information is produced shall be marked with the applicable designation. The party receiving such electronically stored information shall then be responsible for labeling any copies that it creates thereof, whether electronic or paper, with the applicable designation. By written stipulation, the parties may agree temporarily to designate original documents that are produced for inspection CONFIDENTIAL or ATTORNEYS EYES ONLY even though the original documents being produced have not themselves been so labeled. All information learned in the course of such an inspection shall be protected in accordance with the stipulated designation. The copies of documents that are selected for copying during such an inspection shall be marked CONFIDENTIAL or ATTORNEYS EYES ONLY as required under this Order and, thereafter, the copies shall be subject to protection under this Order in accordance with their designation. The designation of documents for protection under this Order does not mean that the document has any status or protection by statute or otherwise, except to the extent and for the purposes of this Order.

3. Documents Which May be Designated CONFIDENTIAL. Any party may designate documents as CONFIDENTIAL upon making a good faith determination that the documents contain information protected from disclosure by statute or that should be protected from disclosure as confidential business or personal information, medical or psychiatric information, trade secrets, personnel records, or such other sensitive commercial information that is not publicly available. Public records and documents that are publicly available may not be designated for protection under this Order.

4. **Documents Which May be Designated ATTORNEYS EYES ONLY.** Any party may designate documents as ATTORNEYS EYES ONLY upon making a good faith determination that the documents contain information protected from disclosure by statute or that should be protected from disclosure as trade secrets or other highly sensitive business or personal information, the disclosure of which is likely to cause significant harm to an individual or to the business or competitive position of the designating party.

5. **Depositions.** Deposition testimony shall be deemed CONFIDENTIAL or ATTORNEYS EYES ONLY only if designated as such. Such designation shall be specific as to the portions of the transcript or any exhibit designated for protection under this Order. Thereafter, the deposition testimony and exhibits so designated shall be protected, pending objection, under the terms of this Order. By stipulation read into the record, the parties may agree temporarily to designate an entire deposition and the exhibits used therein for protection under this Order, pending receipt and review of the transcript. In such a circumstance, the parties shall review the transcript within thirty (30) days of the receipt thereof and specifically designate the testimony and exhibits that will be protected under this Order. Thereafter, only the specifically designated testimony and exhibits shall be protected under the terms of this Order.

6. **Protection of Confidential Material.**

(a) **Protection of Documents Designated CONFIDENTIAL.** Documents designated CONFIDENTIAL under this Order shall not be used for any purpose whatsoever other than the prosecution or defense of this action and of any appeal thereof. The parties and counsel for the parties shall not disclose or permit the disclosure of any documents designated CONFIDENTIAL to any third person or entity, except as set forth in subparagraphs (1)-(7). Subject to these requirements, the following categories of persons may be allowed to review documents that have been designated CONFIDENTIAL:

- (1) **Outside Counsel of Record.** Outside counsel of record for the parties and employees and agents of counsel who have responsibility for the preparation and trial of the action.
- (2) **Parties.** Parties and employees of a party to this Order.

- (3) The Court. The Court and its personnel.
- (4) Court Reporters and Recorders. Court reporters and recorders engaged for depositions.
- (5) Persons Creating or Receiving Documents. Any person who authored or recorded the designated document and any person who has previously seen or was aware of the designated document.
- (6) Consultants, Investigators, and Experts. Consultants, investigators, and experts employed by the parties or counsel for the parties to assist in the preparation and trial of this action or proceeding, but only after such persons have completed the certification contained in Attachment A, Acknowledgment of Understanding and Agreement to be Bound.
- (7) Others by Consent. Other persons only by written consent of the producing party or upon order of the Court and on such conditions as may be agreed or ordered. All such persons shall execute the certification contained in Attachment A, Acknowledgment of Understanding and Agreement to be Bound.

(b) Protection of Documents Designated ATTORNEYS EYES ONLY. Documents designated ATTORNEYS EYES ONLY under this Order shall not be used for any purpose whatsoever other than the prosecution or defense of this action, and of any appeal thereof. The parties and counsel for the parties shall not disclose or permit the disclosure of any documents designated ATTORNEYS EYES ONLY to any third person or entity, except as set forth in subparagraphs (1)-(6). Subject to these requirements, the following categories of persons may be allowed to review documents that have been designated ATTORNEYS EYES ONLY.

- (1) Outside Counsel of Record. Outside counsel of record for the parties and employees and agents of counsel who have responsibility for the preparation and trial of the action.
- (2) The Court. The Court and its personnel.

- (3) Court Reporters and Recorders. Court reporters and recorders engaged for depositions.
- (4) Persons Creating or Receiving Documents. Any person who authored or recorded the designated document and any person who has previously seen or was previously aware of the designated document.
- (5) Consultants, Investigators and Experts. Consultants, investigators, or experts employed by the parties or counsel for the parties to assist in the preparation and trial of this action or proceeding, but only after such persons have completed the certification contained in Attachment A, Acknowledgment of Understanding and Agreement to Be Bound.
- (6) Others by Consent. Other persons only by written consent of the producing party or upon order of the Court and on such conditions as may be agreed or ordered. All such persons shall execute the certification contained in Attachment A, Acknowledgment of Understanding and Agreement to Be Bound.

(c) **Control of Documents.** Counsel for the parties shall take reasonable and appropriate measures to prevent unauthorized disclosure of documents designated for protection under this Order. Counsel shall maintain the originals of the forms signed by persons acknowledging their obligations under this Order for a period of one (1) year after dismissal of the action, the entry of final judgment and/or the conclusion of any appeals arising therefrom.

(d) **Copies.** All copies of documents designated for protection under this Order, or any individual portion of such a document, shall be marked with the designation CONFIDENTIAL or ATTORNEYS EYES ONLY if the words do not already appear on the copy. All such copies shall be entitled to the protection of this Order. The term "copies" shall not include indices, electronic databases, or lists of documents, provided these indices, electronic databases, or lists do not contain substantial portions or images of the text of designated documents or otherwise disclose the substance of the designated documents.

(e) **Inadvertent Production.** Inadvertent production of any document or information

without a designation of CONFIDENTIAL or ATTORNEYS EYES ONLY shall be governed by Federal Rules of Evidence Rule 502.

7. Filing of CONFIDENTIAL or ATTORNEYS EYES ONLY Documents under Seal.

The Court highly discourages the manual filing of any pleadings or other papers under seal. To the extent that a pleading or other paper references an exhibit designated for protection under this Order, then the pleading or other paper shall refer the Court to the particular exhibit filed under seal without disclosing the contents of any confidential information.

(a) Before any exhibit designated for protection under this Order is filed under seal with the Clerk, the filing party shall first consult with the party that originally designated the document for protection under this Order to determine whether, with the consent of that party, the exhibit or a redacted version of the exhibit may be filed with the Court not under seal.

(b) Where agreement is not possible or adequate, an exhibit designated for protection under this Order shall be filed electronically under seal in accordance with the Electronic Case Filing procedures of this Court.

(c) Where filing electronically under seal is not possible or adequate, before an exhibit designated for protection under this Order is filed with the Clerk, it shall be placed in a sealed envelope marked CONFIDENTIAL or ATTORNEYS EYES ONLY, and the envelope shall also display the case name, docket number, a designation of what the exhibit is, the name of the party on whose behalf it is submitted, and the name of the attorney who has filed the exhibit on the front of the envelope. A copy of any exhibit filed under seal shall also be delivered to the judicial officer's chambers.

(e) To the extent that it is necessary for a party to discuss the contents of any document designated for protection under this Order in a pleading or other paper filed with this Court, then such portion of the pleading or other paper shall be filed under seal. In such circumstances, counsel shall prepare two versions of the pleading or other paper: a public and a sealed version. The public version shall contain a redaction of references to CONFIDENTIAL or ATTORNEYS EYES ONLY documents. The sealed version shall be a full and complete version of the pleading or other paper and shall be filed with the Clerk under seal as above. A copy of the unredacted pleading or other

paper also shall be delivered to the judicial officer's chambers.

8. Challenges by a Party to a Designation for Protection under this Order. Any CONFIDENTIAL or ATTORNEYS EYES ONLY designation is subject to challenge by any party or non-party with standing to object (hereafter "party"). Before filing any motions or objections to a designation for protection under this Order with the Court, the objecting party shall have an obligation to meet and confer in a good faith effort to resolve the objection by agreement. If agreement is reached confirming or waiving the CONFIDENTIAL or ATTORNEYS EYES ONLY designation as to any documents subject to the objection, the designating party shall serve on all parties a notice specifying the documents and the nature of the agreement.

9. Action by the Court. Applications to the Court for an order relating to any documents designated for protection under this Order shall be by motion under Local Rule 7.1 and any other procedures set forth in the presiding judge's standing orders or other relevant orders. Nothing in this Order or any action or agreement of a party under this Order limits the Court's power to make any orders that may be appropriate with respect to the use and disclosure of any documents produced or used in discovery or at trial.

10. Use of Confidential Documents or Information at Trial. Absent order of the Court, all trials are open to the public, and there will be no restrictions on the use at trial of any document designated for protection under this Order. If a party intends to present at trial documents designated for protection under this Order, or information derived therefrom, such party shall provide advance notice to the party designating the documents for protection under this Order at least seven (7) days before the commencement of trial by identifying the documents or information at issue as specifically as possible (i.e., by Bates number, page range, deposition transcript lines, etc.). Upon motion of the party designating the document for protection under this Order, the Court may thereafter make such orders as are necessary to govern the use of such documents or information at trial.

11. Obligations on Conclusion of Litigation.

(a) **Order Remains in Effect.** Unless otherwise agreed or ordered, this Order shall remain in force after dismissal or entry of final judgment not subject to further appeal.

(b) Return of Documents Designated for Protection Under this Order. Within thirty (30) days after dismissal or entry of final judgment not subject to further appeal, all documents designated for protection under this Order, including copies as defined in ¶6(d), shall be returned to the producing party unless: (1) the document has been offered into evidence or filed without restriction as to disclosure; (2) the parties agree to destruction in lieu of return; or (3) as to documents bearing the notations, summations, or other mental impressions of the receiving party, that party elects to destroy the documents and certifies to the producing party that it has done so. Notwithstanding the above requirements to return or destroy documents, counsel may retain copies of all pleadings, motions, orders, written discovery, and other papers filed with the Court or exchanged by the parties even though they may contain documents designated for protection under this Order. Counsel may also retain attorney work product, including an index which refers or relates to documents designated for protection under this Order, so long as that work product does not duplicate verbatim substantial portions of the text or images of documents designated for protection under this Order. This work product shall continue to be subject to the protections of this Order in accordance with the applicable designation. An attorney may use his or her work product in a subsequent litigation provided that its use does not disclose or use documents designated for protection under this Order.

(c) Return of Documents Filed under Seal. After dismissal or entry of final judgment not subject to further appeal, the Clerk may elect to return to counsel for the parties or, after notice, destroy documents filed or offered at trial under seal or otherwise restricted by the Court as to disclosure.

12. Order Subject to Modification. This Order shall be subject to modification by the Court on its own motion or on motion of a party or any other person with standing concerning the subject matter. Motions to modify this Order shall be served and filed under Local Rule 7.1 and the presiding judge's standing orders or other relevant orders.

13. No Prior Judicial Determination. This Order is entered based on the representations and agreements of the parties and for the purpose of facilitating discovery. Nothing herein shall be construed or presented as a judicial determination that any documents designated for protection under this Order are entitled to protection under Rule 26(c) of the Federal Rules of Civil Procedure,

or otherwise, until such time as the Court may rule on a specific document or issue.

14. Persons Bound. This Order shall take effect when entered and shall be binding upon all counsel and their law firms, the parties, and persons made subject to this Order by its terms.

IT IS SO ORDERED, this ____ day of _____, _____.

s/ _____
U.S. DISTRICT JUDGE /
U.S. MAGISTRATE JUDGE

[Delete signature blocks if not wholly by consent]

**WE SO MOVE/STIPULATE
and agree to abide by
terms of this Order.**

Counsel for Plaintiff

Counsel for Defendant

ATTACHMENT A

ACKNOWLEDGEMENT OF UNDERSTANDING AND AGREEMENT TO BE BOUND

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
DIVISION**

)	
)	
Plaintiff,)	
)	
v.)	Case No.
)	
)	
Defendant.)	

ACKNOWLEDGMENT OF UNDERSTANDING AND AGREEMENT TO BE BOUND

The undersigned hereby acknowledges that he/she has read the Protective Order entered in the above-captioned action and attached hereto, understands the terms thereof, and agrees to be bound by its terms. The undersigned submits to the jurisdiction of the United States District Court for the Western District of Tennessee in matters relating to the Protective Order and understands that the terms of the Protective Order obligate him/her to use documents designated **CONFIDENTIAL - SUBJECT TO PROTECTIVE ORDER or ATTORNEYS EYES ONLY – SUBJECT TO PROTECTIVE ORDER** in accordance with the Order solely for the purposes of the above-captioned action, and not to disclose any such documents or information derived directly therefrom to any other person, firm, or concern.

The undersigned acknowledges that violation of the Protective Order may result in penalties for contempt of court.

Name _____ (Print): ____

Job Title: _____

Employer: _____

Business Address: _____

I declare under penalty of perjury that the foregoing is true and correct.

Signature: _____

Date: _____

APPENDIX B

JOINT PLANNING REPORT AND PROPOSED SCHEDULE

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
_____ DIVISION**

,)	
)	
Plaintiff,)	
)	
v.)	Case No.
)	
,)	
)	
Defendant.)	

JOINT PLANNING REPORT AND PROPOSED SCHEDULE

Pursuant to Local Rule 16.1, a scheduling conference was held on [insert date]. Present were _____, counsel for plaintiff, and _____, counsel for defendant. Prior to the scheduling conference, on [insert date], the parties met and conferred in compliance with Federal Rule of Civil Procedure 26(f). The following dates are established as the final deadlines for:

INITIAL DISCLOSURES PURSUANT TO FED. R. CIV. P. 26(a)(1): [insert date]

PATENT RELATED DISCLOSURES:

Proposed Schedule: [*Counsel shall include dates for all disclosures required by the Local Patent Rules for the Western District of Tennessee to the extent such disclosures have not already been made. See, e.g., Appendix D, Sample Local Patent Rules Timeline.*]

Proposed Departures: [*If the parties are advocating a departure from the dates set forth in the Patent Local Rules, set forth the basis for said departure.*]

MOTIONS:

MOTIONS TO JOIN PARTIES: [insert date]

MOTIONS TO AMEND PLEADINGS: [insert date]

MOTIONS TO DISMISS: [insert date]

The parties anticipate filing the following additional motions:

- i. [Preliminary Injunction / Other]
 - a. Proposed Briefing Schedule:

The following issues may be the proper subject of an early motion for summary judgment or partial summary adjudication:

- i. [Inventorship or Indefiniteness / Invalidating sale, offer for sale, or display Other]
 - a. [Describe Basis]

NATURE OF DISPUTE:

- a. Description of the Field of the Claimed Invention:
- b. Claims asserted:
- c. Number of Claim Terms to be Construed: The parties anticipate requesting that the Court construe _____ claim terms.
- d. Description of the Allegedly Infringing Activity or Product:
- e. Description of Any Potentially Non-infringing Alternative Designs:
- f. Stipulation of Non-infringement: The parties **HAVE/HAVE NOT** stipulated that the above-described designs do not infringe the patents in issue.

COMPLETING ALL DISCOVERY: [insert date]

WRITTEN DISCOVERY: [insert date]

DEPOSITIONS: [insert date]

If the parties anticipate needing to propound interrogatories and/or take depositions in excess of the number provided in the Federal Rules of Civil Procedure, set forth the proposed limit and basis for the request:

The parties **HAVE/HAVE NOT** agreed to an electronic discovery plan. Absent agreement by the parties, the default standard for e-discovery set forth in Local Rule 26.1(e) applies.

The parties anticipate the following discovery issues:

EXPERT WITNESS DISCLOSURES PURSUANT TO FED. R. CIV. P. 26(a)(2):

DISCLOSURE OF PLAINTIFF'S (OR PARTY WITH BURDEN OF PROOF) RULE 26(A)(2) EXPERT INFORMATION: [insert date]

DISCLOSURE OF DEFENDANT'S (OR OPPOSING PARTY) RULE 26(A)(2) EXPERT INFORMATION: [insert date]

EXPERT WITNESS DEPOSITIONS: [insert date]

MOTIONS TO EXCLUDE EXPERTS UNDER F.R.E. 702/DAUBERT MOTIONS: [insert date]

SUPPLEMENTATION UNDER RULE 26(e)(2): [insert date]

FILING DISPOSITIVE MOTIONS: [insert date]

PROTECTIVE ORDER:

- a. The parties **HAVE/HAVE NOT** agreed to the form Patent Case Protective Order set forth in Appendix A to the Local Patent Rules.
- b. The parties **DO/DO NOT** plan to submit an alternative proposed protective order for adoption by the Court.
- c. Identify any issues the Court should be aware of with respect to the confidentiality

concerns of the parties:

CLAIM CONSTRUCTION HEARING: The parties propose the following format for the Claim Construction Hearing:

- a. Order of presentation:
- b. Anticipated number of witnesses:
- c. Anticipated length of hearing:

ELECTRONIC EXCHANGE: The parties **HAVE/HAVE NOT** consented, pursuant to Fed. R. Civ. P. 5(b)(2)(E), to the electronic exchange of pleadings, notices, discovery, and other mandated disclosures not otherwise served electronically via the Court's Electronic Case Filing system.

OTHER RELEVANT MATTERS:

As required by Local Rule 26.1(e), the parties have conferred as to whether they will seek discovery of electronically stored information ("e-discovery") and [have agreed that e-discovery is not appropriate in this case and therefore they will not seek e-discovery] / [have reached an agreement regarding e-discovery and hereby submit the parties' e-discovery plan for the Court's approval] / [have not reached an agreement regarding e-discovery and will comply with the default standards described in Local Rule 26.1(e) until such time, if ever, the parties reach an agreement and the Court approves the parties' e-discovery plan].

[Pursuant to agreement of the parties, if privileged or protected information is inadvertently produced, the producing party may, by timely notice, assert the privilege or protection and obtain the return of the materials without waiver.]

No depositions may be scheduled to occur after the discovery deadline. All motions, discovery requests, or other filings that require a response must be filed sufficiently in advance of

the discovery deadline to enable the opposing party to respond by the time permitted by the Rules prior to that date.

Prior to filing any *Daubert* motion or motion to compel discovery, the Parties must first move for a telephonic conference with the Court to discuss, outline, and narrow the *Daubert*- and/or discovery-related issues before filing formal motions. Motions to compel discovery are to be filed and served by the discovery deadline or within 30 days of the default or the service of the response, answer, or objection that is the subject of the motion, if the default occurs within 30 days of the discovery deadline, unless the time for filing of such motion is extended for good cause shown, or the objection to the default, response, answer, or objection is waived. When the Parties move for a telephonic conference concerning *Daubert* and/or discovery issues, they must set out any relevant deadlines and provide at least two, mutually agreed on dates and times the telephonic conference may take place.

This case is set for a [jury] / [non-jury] trial. The pretrial order deadline, pretrial conference date, and trial date will be set by separate Order. The parties anticipate the trial will last approximately [insert number] days.

The parties are ordered to engage in ADR before the close of discovery. Within 7 days of completion of ADR, the parties shall file a notice confirming that the ADR was conducted and indicating whether it was successful or unsuccessful, without disclosing the parties' respective positions at the ADR.

Pursuant to Local Rule 7.2(a)(1)(A), all motions, except motions pursuant to Fed. R. Civ. P. 12, 56, 59, and 60, shall be accompanied by a proposed order in a word processing format sent to the ECF mailbox of the presiding judge.

Pursuant to Local Rule 7.2(a)(1)(B), the parties are required to consult prior to filing any motion (except motions filed pursuant to Fed. R. Civ. P. 12, 56, 59, and 60).

The opposing party must file a response to any opposed motion. Pursuant to Local Rule

7.2(a)(2), a party's failure to respond timely to any motion, other than one requesting dismissal of a claim or action, may be deemed good grounds for granting the motion.

Neither party may file an additional reply to any motion, other than a motion filed pursuant to Fed. R. Civ. P. 12(b) or 56. As provided by Local Rule 7.2(c), if a party believes that a reply is necessary, it shall file a motion for leave to file a reply accompanied by a memorandum setting forth the reasons for which a reply is required within seven days of service of the response. Pursuant to Local Rules 12.1(c) and 56.1(c), a party moving for summary judgment or to dismiss may file a reply within 14 days after being served with the response in opposition to the motion.

The parties [do] / [do not] consent to trial before the Magistrate Judge.

Counsel have met and conferred and have made good faith efforts to discuss, in person and/ or by telephone, each of the topics listed in Attachment A, and will be prepared to address these topics at the Case Management Conference ("CMC").

This order has been entered after consultation with the parties. Absent good cause shown, the deadlines set by this order will not be modified or extended.

IT IS SO ORDERED.

PRESIDING UNITED STATES JUDGE

ATTACHMENT A TO JOINT PLANNING REPORT AND PROPOSED SCHEDULE

Counsel have met and conferred and have made good faith efforts to discuss, in person and/ or by telephone, each of the topics listed in LPR 2.1(b) and in the Checklist below, and will be prepared to address these topics at the Scheduling Conference.

Discovery

- What are the core technical documents?
- Does any party intend to request production of electronic mail? If so, why? How many custodians should be searched? What methods will be used to search for electronic documents (e.g., key word searches, predictive coding)?
- If sourcecode is going to be produced, when, where, and how will it be made available?

Claim Construction

- What are the 1 or 2 most important claim terms requiring construction?
- Should the Court consider a "super-early" limited claim construction hearing on those most important terms?

Narrowing the Case

- Will there be any point(s) in the case where it may be appropriate to limit/reduce the number of accused devices/functionalities, asserted patents, asserted claims, invalidity defenses (including obviousness combinations), and prior art references?
- Are there products that are not colorably different than the currently-accused products that Plaintiff expects or Defendant should expect will be added to the case?
- Should damages or any other portion of the case be bifurcated?

Related Cases

- What related cases are pending, in any Court, and what is their filing date and current status?
- Does Plaintiff plan to file additional related cases and, if so, on what schedule and how should that plan affect how this case will proceed?
- Has any patent-in-suit been litigated before and how soon is Plaintiff willing to produce the results of any such litigation, including settlement agreements?

Remedies

- What initial revenue/ sales information does Plaintiff need to assess the value of the case and how soon is Defendant willing to produce such information?

- What type of relief is Plaintiff seeking: lost profits, reasonable royalties, injunction, and/ or any other form of relief?
- If applicable to the case, what does Plaintiff contend is the "smallest saleable unit"?
- Has the patent been licensed or offered for any license and how soon is Plaintiff willing to produce licensing information?

Motions to Dismiss/Transfer/Stay

- Have any of these motions been filed and/ or does any party anticipate filing such a motion?
- Will the parties consent to magistrate judge jurisdiction at least for the limited purpose of resolving these motions?²
- Should discovery and other exchanges of information be stayed during pendency of these motions?

Other Matters

- Are any post-grant review procedures underway or planned that might affect the manner in which this case should proceed?

²The identify of any party or parties declining to consent should not be disclosed to the Court at any point, only the fact that there is not unanimous consent.

APPENDIX C

JOINT CLAIM CONSTRUCTION TABLE

JOINT CLAIM CONSTRUCTION TABLE

[CASE CAPTION AND NUMBER]

<u>Claim No., Patent No.</u>				
Disputed Claim Terms <i>(Entire Claim Provided for Context. Only Underlined Claim Terms are Discussed by the Parties)</i>	Plaintiffs' Proposed Construction/Importance to Outcome	Plaintiffs' Citation to Intrinsic and Extrinsic Evidence	Defendant's Proposed Construction/Importance to Outcome	Defendant's Citation to Intrinsic and Extrinsic Evidence

APPENDIX D

SAMPLE LOCAL PATENT RULES TIMELINE

SAMPLE LOCAL PATENT RULES TIMELINE
(detailed schedule through claim construction)

	Responsive Pleading (RP)	Timeline	Proposed Date
LPR 2.1(a)	Patent Scheduling Conference Notice	<i>within 7 days after the RP is filed, the parties shall jointly file</i>	
	Patent Scheduling Conference (PSC)		<i>this conference is not necessarily going to occur prior to the Planning Meeting</i>
LPR 2.1(b)	Planning Meeting	<i>at least 14 day prior to the PSC</i>	
LPR 2.1(c)	Joint Planning Report and Proposed Schedule	<i>at least 7 days prior to the PSC</i>	
LPR 3.1-3.2	Initial Infringement Contentions	<i>Within 21 days after the RP is filed, a party . . . shall serve on all parties</i>	
LPR 3.3-3.4	Initial Non-infringement Contentions	<i>within 28 days after service of the <u>Initial Infringement Contentions</u></i>	
LPR 3.5-3.6	Invalidity and Unenforceability Contentions	<i>within 90 days after the RP is filed</i>	
LPR 4.1(a)	Preliminary Identification of Claim Terms to be Construed	<i>within 95 days after the RP is filed</i>	
LPR 3.7	Validity and Enforceability Contentions	<i>within 21 days after service of the <u>Invalidity and Unenforceability Contentions</u></i>	
LPR 4.1(c)	Final Identification of Claim Terms to be Construed	<i>within 115 days after the RP is filed</i>	
LPR 4.2(a)-(b)	Preliminary Claim Constructions and Supporting Material	<i>within 14 days after the exchange of <u>4.1(c) lists</u></i>	
LPR 4.3(a)	Initial Expert Claim Construction Reports	<i>within 14 days after the exchange of <u>Preliminary Claim Constructions</u></i>	
LPR 4.3(b)	Rebuttal Expert Claim Construction Reports	<i>within 14 days after disclosure of <u>Initial Expert Claim Construction Reports</u></i>	
LPR 4.3(c)	Completion of Expert Discovery	<i>within 14 days after the disclosure of <u>Rebuttal Expert Claim Construction Reports</u></i>	
LPR 4.2(c)	Final Claim Construction	<i>within 7 days after the completion of <u>Expert Claim Construction Discovery</u>, pursuant to LPR 4.3(c), or 50 days</i>	

		<i>after the exchange of <u>Prelim. Claim Constructions</u></i>	
LPR 4.4(a)	Opening Claim Construction Briefs	<i>Within 14 days after exchanging <u>Final Claim Constructions</u></i>	
LPR 4.4(b)	Responsive Claim Construction Briefs	<i>Within 30 days after the <u>Opening Claim Construction Briefs</u> are filed</i>	
LPR 4.5	Joint Claim Construction and Prehearing Statement	<i>within 7 days after the <u>Responsive Claim Construction Briefs</u> are filed</i>	
LPR 4.6	Claim Construction Hearing (CCR)	<i>within 30 days after the <u>Responsive Claim Construction Briefs</u> are filed</i>	
LPR 4.8	Production of Written Advice of Counsel	<i>at least 90 days prior to the <u>close of fact discovery</u></i>	
	Court's Claim Construction Ruling (CCCR)		<i>there is no deadline for the Court's Claim Construction Ruling</i>
LPR 3.8(a)	Final Infringement Contentions	<i>within 14 days after the CCCR is issued</i>	
LPR 3.8(b)	Final Non-infringement Contentions, Final Invalidity and Unenforceability Contentions	<i>within 14 days after the CCCR is issued</i>	
LPR 4.7	Close of Fact Discovery	<i>no later than 30 days after CCCR</i>	
LPR 4.7	Status Conference	<i>within 30 days of that ruling [CCCR]</i>	
LPR 3.8(c)	Final Validity and Enforceability Contentions	<i>within 45 days after the CCCR is issued</i>	
LPR 5.1(b)	Initial Expert Witness Disclosures	<i>within 60 days after the CCCR is issued</i>	
LPR 5.1(c)	Rebuttal Expert Witness Disclosures	<i>within 30 days after service of <u>Initial Expert Witness Disclosures</u></i>	
LPR 5.2	Completion of Depositions of Experts	<i>within 40 days after service of <u>Rebuttal Expert Witness Disclosures</u></i>	

LPR 6.1	Filing Dispositive Motions	<i>within 14 days after <u>end of expert discovery</u></i>	
LPR 6.2	Trial	<i>within 120 days after the <u>deadline for filing dispositive motions</u></i>	