

**UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS**

PUBLIC NOTICE

**REGARDING PROPOSED LOCAL RULE 16.1.P
CONCERNING SCHEDULING AND PROCEDURES FOR PATENT CASES**

The judges of the United States District Court for the District of Massachusetts have been presented with a rule proposal developed by a Task Force of the Boston Patent Law Association to provide special scheduling and procedures for cases involving claims of patent infringement. The provisions of the proposed rule have been developed, according to its proponents, to "help provide certainty and order to patent litigation and are intended to be neutral as between patentee and accused infringer."

The judges have found great merit in the proposal and accordingly have directed that a version, edited to conform to the Local Rule format, be the subject of public notice for comment. Those commenting may wish to address as well whether an expedited schedule for setting patent infringement cases down for an initial scheduling conference should be adopted, for example by requiring under Local Rule 16.1(A) that a scheduling conference for a case raising questions of patent infringement be convened within 30 days of the appearance of a defendant.

Copies of the proposed rule are available for inspection in the offices of the Clerk in courthouses in Boston, Worcester and Springfield. The public notice and proposed rule also has been posted under "Announcements" on the court's website at www.mad.uscourts.gov.

Members of the bar and the public are invited to comment as to proposed Local Rule 16.1.P. Comments should be received no later than October 17, 2008 and may be addressed to:

Helen M. Costello
Operations Manager
United States Courthouse
1 Courthouse Way - Suite 2300
Boston, MA 02210

August 14, 2008

**PROPOSED
LOCAL RULE 16.1.P
SCHEDULING AND PROCEDURES IN PATENT INFRINGEMENT CASES**

**(A) Additional Items for Consideration by the Court
and the Parties**

In addition to the parties' obligations under Fed. R. Civ. P. 26 (f) and LR 16.1, the parties in cases raising issues of patent infringement shall consider and address in their joint statement under L.R. 16.1 the following issues:

- (1) The timing for disclosing initial infringement and invalidity positions;
- (2) The process for identifying disputed claim terms, exchanging proposed claim constructions, and claim construction briefing;
- (3) The timing of and procedure for the claim construction hearing, including:
 - (a) whether the Court will decide claim construction through live testimony at a hearing or based on the papers and attorney argument; and
 - (b) the timing of claim construction relative to summary judgment, expert discovery, and the close of fact discovery.
- (4) The need for tutorials on the relevant technology, including:
 - (a) the form and scope of any such tutorials; and
 - (b) the timing for such tutorials.

(5) The identification of dispositive issues that may lead to an early resolution of the litigation.

(6) Whether the court should authorize the filing under seal of any documents that contain confidential information.

(7) Procedures for, and limits (if any) to be placed on, the preservation and discovery of electronically stored information, including:

- (a) whether preservation and discovery of electronically stored information should be limited to that located on the parties' active computer systems or extended to backup systems;
- (b) the identification of key persons, if any, who should have their electronically stored information produced;
- (c) whether production of electronically stored information should be limited to discrete time periods;
- (d) whether costs of producing electronically stored information should be shifted, particularly costs of preserving and producing information stored on backup systems.

(B) Scheduling Order

The Scheduling Conference in cases raising issues of patent infringement should result in a special tailored Scheduling Order. A template for such a Scheduling Order is set forth as a default in the Appendix.

APPENDIX

SAMPLE SPECIAL SCHEDULING ORDER FOR PATENT INFRINGEMENT CASES

This appendix sets forth a sample scheduling order for claim construction and related procedures in patent cases [*with suggested timing in brackets*]. These procedures should be viewed as supplementing, not replacing, the LR 16.1 schedule. The Court and parties may incorporate such suggested procedures into the LR 16.1 scheduling order.

(A) Preliminary Disclosures

(1) Preliminary Infringement Disclosure

No later than _____ [30] days after the Rule 16 Case Management Conference, the patentee shall serve and file preliminary disclosure of the claims infringed. The patentee shall specify which claims are allegedly infringed and identify the accused product(s) or method(s) that allegedly infringe those claims. The patentee shall also specify whether the alleged infringement is literal or falls under the doctrine of equivalents. If the patentee has not already done so, the patentee shall produce all documents supporting its contentions and/or identify any such supporting documents produced by the accused infringer. Such disclosures may be amended and supplemented up to _____ [30] days before the date of the Markman Hearing. After that time, such disclosures may be amended or

supplemented only pursuant to ¶ D(1) or by leave of court, for good cause shown.

The patentee may use a table such as that represented below.

CLAIM LIMITATION	ACCUSED COMPONENT	BASIS OF INFRINGEMENT CONTENTION

(2) Preliminary Invalidity and Non-Infringement Disclosures

No later than _____ [60] days after service of the patentee's preliminary infringement contentions, the accused infringer shall serve and file Preliminary Invalidity and Non-Infringement Contentions. The accused infringer shall identify prior art that anticipates or renders obvious the identified patent claims in question and, for each such prior art reference, shall specify whether it anticipates or is relevant to the obviousness inquiry. If applicable, the accused infringer shall also specify any other grounds for invalidity, such as indefiniteness, best mode, enablement, or written description. If the accused infringer has not already done so, the accused infringer shall produce documents relevant to the invalidity defenses and/or identify any such supporting documents produced by the patentee. Further, if the accused infringer has not

already done so, the accused infringer shall produce documents sufficient to show operation of the accused product(s) or method(s) that the patentee identified in its preliminary infringement disclosures. Such disclosures may be amended and supplemented up to ____ [30] days before the date of the Markman Hearing. After that time, such disclosures may be amended or supplemented only pursuant to ¶ D(1) or by leave of court, for good cause shown, except that, if the patentee amends or supplements its preliminary infringement disclosures, the accused infringer may likewise amend or supplement its disclosures within ____ [30] days of service of the amended or supplemented infringement disclosures.

The accused infringer may use the charts shown below.

CLAIM LIMITATION	PRIOR ART OR OTHER EVIDENCE	BASIS OF INVALIDITY CONTENTION

CLAIM LIMITATION	ACCUSED COMPONENT	BASIS OF NON- INFRINGEMENT CONTENTION

(3) Disclosures in Declaratory Judgment Actions

In declaratory judgment actions initially filed by potential infringers (*i.e.*, as opposed to being stated by way of answer, counterclaim, or other response to a first-filed complaint for patent infringement), the disclosure requirements of subsections (A)(1) and (2) above apply as if the action had been initiated by the patent holder, except that (a) the preliminary infringement disclosure of the declaratory judgment defendant/patent holder shall be due not less than 90 days after the Rule 16 Case Management Conference and (b), if the declaratory judgment defendant/patent holder does not state a claim for infringement, then only the declaratory judgment plaintiff/potential infringer's disclosure requirements shall apply.

(B) Claim Construction Proceedings

(1) No later than _____ [120] days after completion of the preliminary disclosures, the parties shall simultaneously exchange a list of claim terms to be construed and proposed constructions.

(2) No later than _____ [20] days after exchanging the list of claims, the parties shall simultaneously exchange and file preliminary claim construction briefs. Each brief shall contain a list of terms construed, the party's proposed construction of each term, and evidence and argument supporting each construction. Absent leave of court, preliminary claim

construction briefs shall be limited to _____ [25] pages, double spaced, of at least 12-point Times New Roman font or equivalent, including footnotes.

(3) No later than _____ [10] days following exchange and filing of the preliminary claim construction briefs, parties shall simultaneously exchange reply briefs. Absent leave of court, reply briefs shall be limited to _____[15] pages, double spaced, of at least 12-point Times New Roman font or equivalent, including footnotes.

(4) No later than _____ [15] days following exchange and filing of the reply briefs, the parties shall finalize the list of disputed terms for the court to construe. The parties shall prepare and file a joint claim construction and prehearing statement (hereafter the "joint statement") that identifies both agreed and disputed terms.

(a) The joint statement shall note the anticipated length of time necessary for the claim construction hearing and whether any party proposes to call witnesses, including a statement that such extrinsic evidence does not conflict with intrinsic evidence.

(b) The joint statement shall also indicate whether the parties will present tutorials on the relevant technology, the form of such tutorials, and the timing for such tutorials in relation to the claim

construction hearing. If the parties plan to provide tutorials in the form of briefs, declarations, computer animations, slide presentations, or other media, the parties shall exchange such materials _____ [5] days before the claim construction hearing. In the alternative, the parties may present tutorials through presentations by the attorneys or experts at the claim construction hearing.

- (c) The joint statement shall include a proposed order in which parties will present their arguments at the claim construction hearing, which may be term-by-term or party-by-party, depending on the issues in the case.
- (d) The joint statement shall limit the number of claim terms to be construed and shall prioritize the disputed terms in order of importance. The Court suggests that, ordinarily, no more than ten (10) terms per patent be identified as requiring construction.
- (e) The joint statement shall include a joint claim construction chart, noting each party's proposed construction of each term, and supporting evidence. The parties may use the form shown below.

TERM	PATENTEE'S CONSTRUCTION	ACCUSED INFRINGEMENT'S CONSTRUCTION	COURT'S CONSTRUCTION

(C) The Claim Construction Hearing (a.k.a. "Markman Hearing")

The Court shall schedule a hearing date promptly after the filing of the joint claim construction statement.

(D) After the Hearing

(1) If necessary, the parties may amend their preliminary infringement/non-infringement and invalidity disclosures, noting whether any infringement or invalidity contentions are withdrawn, within [30] days after the Court's ruling on the claim construction.

(2) If the fact discovery period has expired before a ruling on claim construction, and upon motion or stipulation of the parties, the Court may grant additional time for discovery. Such additional discovery shall be limited to issues of infringement, invalidity, or unenforceability dependent on the claim construction.

(E) Expert Discovery

(1) Ordinarily, expert discovery, including expert reports and depositions, shall be scheduled to occur after the close of fact discovery.

(2) If expert discovery has been substantially conducted before a claim construction ruling, then the Court may grant additional time for supplemental expert discovery. Such additional discovery shall be limited to issues of infringement, invalidity, or unenforceability dependent on the claim construction.