



UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS
OFFICE OF THE CLERK
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BOSTON, MASSACHUSETTS 02210

ROBERT M. FARRELL
CLERK OF COURT

AMENDED PUBLIC NOTICE
REVISION TO LOCAL RULE 16.6
OF THE UNITED STATES DISTRICT COURT

January 25, 2018

The Judges of this Court propose the following revisions to Local Rule 16.6 - Patent Proceedings. These amendments, attached to this notice, are presented for public comment. The comment period has been extended until February 26, 2018.

This amendment and the full Local Rules may be found on the court's website at <http://www.mad.uscourts.gov/general/rules-home.htm>.

Please send any public comments via email to: rules@mad.uscourts.gov

Robert M. Farrell
Clerk of Court

RULE 16.6 PATENT PROCEEDINGS

Delete existing LR 16.6 and Appendix and replace with this revision

- (a) **Applicability of Rule.** Except as otherwise provided in any federal rule or statute (including the Federal Rules of Civil Procedure and the Patent Act), the following procedures and deadlines shall govern all actions, including declaratory judgment actions, involving disputes over the infringement, validity, and/or enforceability of a United States patent. In the event of a conflict between this rule and another local rule of this court, this rule shall control.

The court may modify the obligations or deadlines set forth in this rule based on the circumstances of the particular case, including the simplicity or complexity of the case as shown by the patents, claims, products, or parties involved.

- (b) **Definitions.** As used in this rule, the following terms shall have the following meanings.
- (1) **Patentee.** The term “patentee” refers to the party that owns or otherwise has rights to assert the patent(s)-in-suit, such as an exclusive licensee.
 - (2) **Accused Infringer.** The term “accused infringer” refers to the party accused of infringement or, in the case of a declaratory judgment action, the party challenging the validity, enforceability, or infringement of the patent(s)-in-suit.
 - (3) **Real Party in Interest – Patentee.** The term “real party in interest,” when used with respect to the patentee, refers to any person or entity that, alone or in combination, owns a controlling interest in, or otherwise controls, the patentee or the patent(s)-in-suit, and to any person or entity that, alone or in combination, owns a controlling interest in, or otherwise controls, an entity that owns or controls the patentee or patent(s)-in-suit.
 - (4) **Real Party in Interest – Accused Infringer.** The term “real party in interest,” when used with respect to the accused infringer, refers to any person or entity that, alone or in combination, owns a controlling interest in, or otherwise controls, the accused infringer.
- (c) **Scheduling Procedures.** At the initial scheduling conference under L.R. 16.1 and 16.3, the court shall set a schedule in accordance with the following provisions.
- (1) **Trial.** The court shall schedule a trial (whether bench or jury) to be held within 24 months after the conference.
 - (2) **Claim Construction Hearing.** The court shall schedule a claim construction hearing to be held within 9 months after the conference.
 - (3) **Status Conferences.** The court may consider the need for periodic status conferences, including a status conference to be held after the claim construction

hearing but before the end of discovery. If the court schedules a post-*Markman*-hearing status conference, the parties shall meet and confer at least 14 days before the status conference to discuss the following issues:

- (A) the impact of the claim construction ruling, if the ruling is then available;
- (B) narrowing of the issues;
- (C) proposed adjustments to the Scheduling Order; and
- (D) whether all parties agree to seek mediation or other alternative dispute resolution pursuant to L.R. 16.4.

The parties shall file, at least 7 days before such a status conference, a joint statement addressing those issues.

- (4) **Fact Discovery.** The court shall set the close of fact discovery for no later than 15 months after the initial scheduling conference, or 60 days after entry of the court's ruling on claim construction, whichever is later.
 - (5) **Expert Discovery.** The court shall set the close of expert discovery for no later than 18 months after the initial scheduling conference or 90 days after the close of fact discovery, whichever is later.
- (d) **Automatic Patent-Related Disclosures.** In addition to the automatic required disclosures required by L.R. 26.2(a), the parties shall make the following additional disclosures:
- (1) **Patentee's Preliminary Patent-Related Disclosures.** Not later than 21 days after the initial scheduling conference under L.R. 16.1 and 16.3, or at such other time as the court may order, the patentee shall produce to all other parties (but not file) the following disclosures and documents:
 - (A) **Infringement Claim Charts.** Infringement claim charts identifying, with as much specificity as reasonably possible from publicly available information or other information then within the patentee's possession, custody, or control:
 - (i) each accused product and/or method;
 - (ii) the patent(s) and the claim(s) each product or method allegedly infringes;
 - (iii) an element-by-element description of where and how each element of each asserted claim is found in each accused product or method;
 - (iv) as to each element that the patentee contends is a means-plus-function term under 35 U.S.C. § 112, the identity of the structures,

acts, or materials in the accused product(s) or method(s) that perform the claimed function; and

- (v) whether each element of each asserted claim is asserted to be present literally or under the doctrine of equivalents.

(B) Prosecution History. Copies of the prosecution histories for each asserted patent, including any parent applications and provisional applications from which the asserted patents descend and to which each asserted patent claims priority. The patentee shall also produce any non-privileged documents in its possession, custody, or control concerning the conception and reduction to practice of the invention claimed in the asserted patents, including but not limited to lab notebooks (electronic or otherwise).

(C) Ownership Evidence. Evidence (including, without limitation, any licenses or assignments) sufficient to establish that the patentee owns the asserted patent(s) or has the authority to assert the patent(s).

(D) Real Parties in Interest. Evidence sufficient to establish the identity of all real parties in interest to the patentee and the asserted patent(s).

(2) Conference Concerning Preliminary Patent Disclosures. Not later than 21 days after the patentee's preliminary disclosures, the parties shall meet and confer about the following issues:

(A) the sufficiency of the patentee's disclosures under subsection (d)(1); provided, however, that those disclosures, as well as the accused infringer's disclosures in subsection (d)(4), are preliminary and may be amended with leave of court during the discovery period; and

(B) a plan for the accused infringer's compliance with the disclosure requirements of subsection (d)(4), including the feasibility of, and procedures for, production or inspection of exemplary samples of the accused products and methods, technical documents, and/or source code.

(3) Effect of Incomplete or Disputed Disclosures. The parties' failure to agree on the sufficiency of the patentee's disclosures or a plan for the accused infringer's compliance with its disclosure obligations shall not entitle the accused infringer to avoid or delay its disclosure obligations in subsection (d)(4).

(4) Accused Infringer's Preliminary Production of Technical Documents, Source Code, and Samples of Accused Products. Not later than 21 days after the conference required under subsection (d)(2), and subject to any agreement of the parties as to the contours of production or inspection, the accused infringer shall produce to the patentee (but not file) the following disclosures and documents:

- (A) **Technical Documents.** Documents sufficient to show the composition, operation, construction, and performance of the accused products and/or methods.
- (B) **Samples.** Sufficient samples of the accused products (or products that perform or were produced by the accused methods). When production is not practicable, the accused infringer shall permit inspection of the accused product(s) or method(s), provided that the accused infringer is only required to permit inspection of a method that continues to be practiced in the ordinary course of business.
- (C) **Source Code.** Source code, if relevant, subject to any protective order or procedures on which the parties may agree.
- (D) **Noninfringement Claim Charts.** Noninfringement charts identifying specifically which elements of the asserted claims each accused product or method fails to practice.
- (E) **Invalidity Claim Charts – Anticipation or Obviousness.** Invalidity claim charts identifying all prior art that such party contends anticipates or renders obvious the patent claims identified by the patentee.
 - (i) For each such prior-art reference, the accused infringer shall specify whether it anticipates or renders the asserted claim obvious and shall also identify specifically where in each alleged reference each element of each asserted claim can be found. For each element that the accused infringer contends is a means-plus-function term under 35 U.S.C. § 112, the chart shall include the identity of the structures, acts, or materials in each prior-art reference that perform the claimed function.
 - (ii) If the accused infringer asserts that a combination of prior-art references renders a claim obvious, then the accused infringer shall identify each such combination and the reason to combine the references. For each combination, the accused infringer shall identify specifically where in the combination of references each element of each asserted claim can be found. For each element that the accused infringer contends is a means-plus-function term under 35 U.S.C. § 112, the chart shall include the identity of the structures, acts, or materials in each combination that performs the claimed function. If applicable, the accused infringer shall also identify the primary and secondary references in each such combination.
- (F) **Other Grounds for Invalidity.** Any asserted grounds of invalidity based on patentability under 35 U.S.C. § 101, indefiniteness under 35 U.S.C.

§ 112, or enablement or written description under 35 U.S.C. § 112 of any of the asserted claims.

- (G) **Supporting Documents.** Any documents relevant to the invalidity defenses and/or the identity of any such supporting documents produced by the patentee.
 - (H) **Identity of Real Parties in Interest.** The identity of all real parties in interest to the accused infringer.
- (5) **Amendments to Preliminary Patent-Related Disclosures.** The preliminary patent-related disclosures of subsections (d)(1) and (d)(4) may be amended and supplemented only by leave of court upon a timely showing of good cause, which shall be construed liberally. Non-exhaustive examples of circumstances that may, absent undue prejudice to the non-moving party, support a finding of good cause include:
- (A) a claim construction by the court that is different from that proposed by the party seeking amendment;
 - (B) discovery of material prior art that was not available, despite diligent efforts, before the service of the invalidity contentions; and
 - (C) discovery of nonpublic information about the asserted infringement that was not available, despite diligent efforts, before the service of the infringement claim charts.

The duty to supplement discovery responses does not excuse the need to obtain leave of court to amend disclosures. If one party is allowed to amend its disclosures, the opposing party(s) may, within 28 days, serve responsive amended disclosures.

- (6) **Default Protective Order.** Until a case-specific protective order is entered, the following default protective order shall govern the handling of confidential information:

Documents and information that either party in good faith believes are confidential may be produced in discovery with the designation “Confidential Pursuant to the Court’s Default PO.” Until such time as the designation is altered or removed by the parties’ agreement or by court order, a so-designated document may only be accessed by the parties’ outside counsel, the court, and their personnel.

- (7) **Relation to Other Discovery and Procedures.** Nothing in these subsections shall limit the parties’ rights to conduct, and obligations to respond to, other discovery, including interrogatories, requests for production of documents, requests for admissions, and depositions. All stages of disclosure and discovery are subject to

a motion by any party for court intervention. Nothing in this subsection shall limit the parties' rights to challenge or amend the confidentiality designations of any documents and information produced under subsections (d)(1)-(5).

(e) Claim Construction Proceedings.

(1) Joint Statement.

- (A)** Not later than 21 days after completion of the automatic patent-related disclosures of subsections (d)(1)-(4), the parties shall simultaneously exchange a list of claim terms to be construed and their proposed constructions.
- (B)** Within 7 days of the exchange of claim terms, the parties shall confer to see if agreement can be reached on the construction of claim terms and the number of claims to be considered.
- (C)** The parties may jointly present to the court no more than 10 claim terms for construction; provided, however, that, for good cause, either party, after conferring with the other parties, may petition the court to increase the number of claim terms for construction. Factors supporting good cause include, without limitation, the complexity of the patented technology, the number of asserted claims and patents, the lack of relation among the asserted patents, the number and complexity of invalidity defenses, and the number and diversity of accused products or methods.
- (D)** Within 14 days after the exchange of claim terms, the parties shall prepare and file a joint statement of the number of claims and terms to be construed. The joint statement shall include a joint claim construction chart listing the claim terms in the order in which the parties would like the court to construe them and noting each party's proposed construction of each term. The parties may use the form shown below.

TERM	PATENT OWNER'S CONSTRUCTION	ACCUSED INFRINGER'S CONSTRUCTION	COURT'S CONSTRUCTION

- (2) Opening Claim Construction Briefs.** Not later than 21 days after filing the joint statement, the parties shall simultaneously exchange and file opening claim construction briefs.

- (3) **Expert Testimony.** A party that wishes to rely on expert testimony to support claim construction must include with its opening brief an expert declaration. The offering party must make the expert available for deposition not later than 21 days before the responsive due date. Either party may cite to the expert deposition testimony in its responsive brief. Other than the initial declaration and deposition testimony, no further expert testimony shall be permitted unless the court requests further testimony or for good cause shown.
 - (4) **Responsive Briefs.** Not later than 45 days following exchange and filing of the opening claim construction briefs, the parties shall simultaneously exchange and file responsive briefs. This 45-day response period is intended to allow for deposition of opposing experts.
 - (5) **Page Limits.** Absent leave of court, the page limits of L.R. 7.1(b)(4) shall apply to all briefs.
 - (6) **Tutorials.** At the court's request, the parties may exchange and file tutorials, preferably in the form of a short video or slide presentation, at least 14 days before the claim construction hearing. The court may also, at its own election, seek an independent third party to educate the court on the disputed technology.
 - (7) **Hearing.** Unless the court orders otherwise, the claim construction hearing shall proceed by attorney argument only. A party wishing to present live witness testimony (expert or otherwise) at the hearing must first obtain the court's approval, to be decided in the court's discretion. The court may also order an evidentiary hearing *sua sponte*.
- (f) **Reliance on Advice of Counsel.**
- (1) **Disclosure of Written Opinion.** Not later than 45 days after entry of the court's claim construction ruling, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason must produce the opinion(s) and any other documentation relating to the opinion as to which that party agrees the attorney-client or work-product protection has been waived;
 - (2) **Disclosure of Oral Advice.** If a party is relying on oral advice, such party must provide a written summary of any oral advice and produce or make available for inspection and copying any documents related to, or supporting, the summary for which the attorney-client and work-product protection has been waived;
 - (3) **Privilege Log.** Each party relying upon advice of counsel must also serve a privilege log identifying any other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the opinion(s) that the party is withholding on the grounds of attorney-client privilege or work-product protection; and

- (4) **Failure to Comply.** A party that does not comply with these requirements will not be permitted to rely on the advice of counsel for any purpose, absent a stipulation of all parties or an order of the court, which will be entered only upon showing of good cause.