

# THE HISTORY, CONTENT, APPLICATION AND INFLUENCE OF THE NORTHERN DISTRICT OF CALIFORNIA'S PATENT LOCAL RULES

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## *Abstract*

*On December 1, 2000, the United States District Court for the Northern District of California became the first district court to promulgate rules governing the content and timing of disclosures in patent-related cases. The Northern District's conception of Patent Local Rules finds its origins in the concerns during the 1980's and 1990's, when the increasing cost and expense of civil litigation came under increasing attack from commentators and all three branches of the federal government. Despite efforts to improve the efficiency of civil litigation generally, patent litigation proved particularly burdensome on litigants and the courts. The Supreme Court's decision in Markman v. Westview Instruments, Inc. only exacerbated this situation. The Northern District's Patent Local Rules are specifically tailored to address the unique challenges that arise during patent litigation, particularly during the pretrial discovery process. The Rules require the patentee and the accused infringer to set forth detailed infringement and invalidity theories early in the case. The Rules also govern the content and timing of disclosures related to the claim construction hearing, an event unique to patent litigation that is often case-dispositive. The Northern District's Patent Local Rules have been expressly endorsed by the United States Court of Appeals for the Federal Circuit. The Rules have also proven highly influential in other judicial districts, as evidenced by the adoption of substantially similar rules in a growing number of district courts. Substantive differences do exist, however, between the patent local rules of various district courts. Accordingly, the Judicial Council of the United States should consider the advisability of appointing an*

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*Advisory Committee to consider the adoption of Federal Rules of Patent Procedures (FRPP) for United States District Courts to promote the efficient resolution of patent-related cases, regardless of the forum in which the case is litigated.*

## I. INTRODUCTION

On December 1, 2000, the United States District Court for the Northern District of California adopted pioneering and innovative Patent Local Rules.<sup>1</sup> The idea of having separate Patent Local Rules first surfaced in 1994. Chief Judge Thelton Henderson appointed advisory committees to study and make recommendations on revisions to the existing local rules so that they would be aligned with amendments which had been made to the national rules.<sup>2</sup> Due in large part to the growth of the electronics industry in the Silicon Valley, a relatively large number of patent infringement cases were pending in the District.<sup>3</sup> Many of these cases involved complexities unique to patent cases.<sup>4</sup> Judge Henderson appointed District Judge Ronald Whyte to Chair an advisory committee to determine whether the District should adopt a set of local rules specifically addressing patent cases. The advisory committee determined that separate patent local rules would be extremely helpful and recommended a set of rules. The Court approved the rules and published them for public comment. With relatively few changes, the rules were adopted and became effective on January 1, 2001.<sup>5</sup>

In the years following their adoption, other districts have determined to adopt patent local rules, many of which utilized the original Northern District Patent Local Rules as a template.<sup>6</sup> The Northern District's Patent Local Rules, and others patterned after them, have been enforced in district court cases and have been cited approvingly by the Federal Circuit.<sup>7</sup>

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1. See Edward Brunet, Markman *Hearings, Summary Judgment, and Judicial Discretion*, 9 LEWIS & CLARK L. REV. 93, 109 (2005).

2. See N.D. CAL. GEN. ORDER 39 § I (1993).

3. See Yan Leychkis, *Of Fire Ants and Claim Construction: An Empirical Study of the Meteoric Rise of the Eastern District of Texas as the Preeminent Forum for Patent Litigation*, 9 YALE J.L. & TECH. 193, 201 (2007).

4. See James Ware, *Patent Rules of Evidence*, 23 SANTA CLARA COMPUTER & HIGH TECH. L.J. 749, 764 (2007).

5. N.D. CAL. PATENT L.R. 1-3 (2000).

6. See discussion *infra* Part IV.B.

7. See discussion *infra* Part IV.A.

Part II describes the civil justice reform environment which gave rise to the Patent Local Rules, including a United States Supreme Court decision on patent infringement proceedings, which was issued while the Rules were under development. Part III details the procedures required by the original patent local rules and how they are affected by a 2008 amendment. Part IV discusses the Federal Circuit's endorsement of the Northern District's patent local rules, as well as the influence the rules have had on other district courts. This part also describes the adoption of patent local rules in other jurisdictions that are substantially similar to those of the Northern District. As discussed in Part V, the Northern District's Patent Local Rules have taken on national significance. Part V discusses whether the wide-spread use and benefit of the Northern District's Patent Local Rules demonstrate the need for formal adoption of Federal Rules of Patent Procedures for United States District Courts. Tables are provided at the end of this article which compare key provisions of the Northern District's original rules with patent local rules from five other district courts.

## II. THE SOCIAL AND LEGAL MANDATES THAT TRIGGERED THE ADOPTION OF PATENT LOCAL RULES IN THE NORTHERN DISTRICT OF CALIFORNIA

### *A. Local Rules in the Northern District (1977 – 1990)*

As discussed in detail in Section III, the Northern District Patent Local Rules regulate the procedure to be followed in patent infringement cases from the time that a complaint is filed up to a claim construction hearing before the court. The Rules may be summarized as containing three elements: (1) cooperation—parties are required to confer to develop a case schedule and to make joint submissions; (2) disclosure—parties are required to make timely disclosures of their legal contentions and provide supporting documentation; and (3) judicial management—the assigned judge becomes involved in the case early and may actively supervise the process leading up to the claim construction hearing.<sup>8</sup> As the following discussion indicates, these three elements of the Patent Local Rules are a consequence of civil litigation reform developments within the Northern District itself, and nation-wide reform mandates which accompanied the development of the Patent Local Rules.

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8. See discussion *infra* Part III.A.

Prior to the adoption of its innovative Patent Local Rules, the Northern District of California had earned a reputation among practitioners and scholars for innovative programs and procedures which were built on these same three elements.<sup>9</sup> During the 1970's under the leadership of Chief Judge Robert Peckham, the Northern District received national recognition for its court-based Alternative Dispute Resolutions (ADR) programs.<sup>10</sup> The various forms of ADR included processes for binding and non-binding arbitration, and mediation and judicial settlement conferences, with consequent reduction in costs if the parties were able to reach an out-of-court settlement.<sup>11</sup> However, the court assisted parties in litigation through its Early Neutral Evaluation Program (ENE), improving the efficiency of litigation even if parties did not reach an immediate settlement.<sup>12</sup>

A key component of the Northern District's ADR programs is a *status conference* between the parties and the assigned District or Magistrate Judge, where attendance at the status conference was required by a local rule.<sup>13</sup> From their adoption in 1937 up to the

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9. See David I. Levine, *Northern District of California Adopts Early Neutral Evaluation to Expedite Dispute Resolution*, 72 JUDICATURE 235, 235 (1989); see also David I. Levine, *Early Neutral Evaluation: A Follow-Up Report*, 70 JUDICATURE 236 (1987); Wayne D. Brazil, *A Close Look at Three Court-Sponsored ADR Programs: Why They Exist, How They Operate, What They Deliver, and Whether They Threaten Important Values*, 1990 U. CHI. LEGAL F., 303, 331-363 (1990).

10. ADR programs available in the N.D. Cal. included: Early Neutral Evaluation (ENE), binding and non-binding arbitration, judicially-hosted settlement conferences, non-binding summary jury or bench trials, services of special masters, and jury trial conducted by Magistrate Judges with the consent of the parties. DISPUTE RESOLUTION PROCEDURES IN THE NORTHERN DISTRICT OF CALIFORNIA 6-16 (2005), available at <http://www.adr.cand.uscourts.gov> (in the Contents section in the middle of the page, follow the hyperlink for "Dispute Resolution Procedures in the Northern District of California").

11. See *id.* at 2.

12. See N.D. CAL. GEN. ORDER 26 (1986). Under the ENE Program, the Clerk of Court and a Magistrate Judge were given authority to select a case for inclusion in the program. The ENE program administrator would assign an evaluator to the case. The evaluators were volunteer neutral attorneys who had experience in the subject matter of the case. The parties would present their case to the neutral "evaluator." Under the program, among other things, the evaluator would "help the parties identify areas of agreement and, where appropriate, enter stipulations; assess strengths and weaknesses of parties' contentions and evidence; if the parties are interested, help them, through private caucusing or otherwise, explore the possibility of settling the case; estimate where feasible, the likelihood of liability and the dollar range of damages; and help the litigants devise a plan for sharing the important information and/or conducting the key discovery that will equip them as expeditiously as possible to enter meaningful settlement discussions or to posture the case for other form of disposition." *Id.* at pt. 6.

13. See N.D. CAL. L.R. 235-3 ("At any time after an action or proceeding has been filed, the assigned judge may, with or without the written request of any party, order the holding of a

1970s, the Federal Rules of Civil Procedure (FRCP) provided for a *pretrial conference* between the parties and the assigned trial judge.<sup>14</sup> During those four decades, the FRCP did not contain provisions on when the pretrial conference should take place. In practice and as suggested by its name, the pretrial conference focused on the trial itself and sometimes was scheduled late in the litigation. The Northern District local rule requiring the parties to attend status conferences provided the assigned judges with an opportunity to schedule the conference early in the life of the litigation, focus on ways to resolve the case short of trial, and to focus the litigation. Although the Northern District's Local Rules provided for a status conference, the Local Rules—like the FRCP—did not specify when or if a status conference would be held. Northern District Local Rule 235-3 provided that at *any time*, an assigned judge could call a “*status or scheduling conference*.”<sup>15</sup> The holding of a status conference was left to a party-filed motion for a conference or to the discretion of the assigned judge.<sup>16</sup>

In addition to being required to comply with deadlines which might be set in a scheduling conference order, local rule 235-2 provided: “All counsel shall proceed with diligence to take all steps necessary to bring an action to readiness for pretrial and trial.”<sup>17</sup> When one or more parties had completed pretrial discovery to a point that they believed sufficient for a state of “readiness” to try the case, the party could file a “motion to set case for trial and certificate of readiness.”<sup>18</sup> Under this procedure, in the absence of a scheduling conference order, parties would be left free to prosecute the case at a pace dictated by their mutual agreement or depending upon the pace at which they were able to complete formal discovery.

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status or scheduling conference. All parties receiving notice of the conference shall attend in person or by counsel and shall be prepared to discuss such subjects as may be specified in the order noticing the conference . . .”). The quoted language is from a publication of Rule 235-3 in 1987, but this is the language that was in effect during the 1970s. The Northern District's Local Rules were adopted effective August 1, 1977. The rules were revised effective May 1, 1983. The quoted language of Rule 235-3 was unaffected by the 1983 amendment.

14. See FED. R. CIV. P. 16 advisory committee's note on the 1937 adoption.

15. N.D. CAL. L.R. 235-3.

16. Many district judges issued “Standing Orders” which set a schedule for a status conference.

17. See N.D. CAL. L.R. 235-2.

18. *Jarva v. United States*, 280 F.2d 892, 894 (9th Cir. 1960).

Typically, the vast majority of time that a civil case is pending before the court is consumed with pretrial discovery.<sup>19</sup> In the mechanisms provided for formal discovery—such as oral depositions, requests for admission, and written interrogatories—the FRCP provided a time period for a responding party once the discovery mechanism had been initiated.<sup>20</sup> However, the FRCP contained no provisions controlling how much time was allowed for a party to initiate formal discovery.<sup>21</sup> Moreover, once initiated, unless it violated a scheduling order made by the assigned judge, the parties were free to stipulate to extending the deadlines for response.<sup>22</sup> Unless it was shortened by an order of the assigned judge, the life of the case was measured by how long the parties afforded one another. Parties could schedule and conduct discovery over whatever period they decided was appropriate for the case.<sup>23</sup> The assigned judge would, of course, become involved in the pace of the case if a motion to compel discovery were filed or on the hearing of a motion for summary judgment. Otherwise, however, the litigants could conduct the litigation as they saw fit. Under Northern District Local Rule 235-5, a party would file a “certificate of readiness,” advising the assigned judge that the party desired a pretrial conference to set the case for trial.<sup>24</sup>

Of course, in many civil cases, the parties reached an out-of-court settlement short of trial.<sup>25</sup> However, settlements often came after parties had spent considerable financial resources conducting discovery and after significant time had been spent in litigation.<sup>26</sup> In the late 1970s, the cost and expense of civil litigation came under

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19. See, e.g., Laurie Kratky Dore, *Secrecy by Consent: The Use and Limits of Confidentiality in the Pursuit of Settlement*, 74 NOTRE DAME L. REV. 283, 288-89 (1999) (noting that the “civil process in this country is increasingly diverting time and resources away from trial and adjudication toward pretrial activities and settlement.”).

20. FED. R. CIV. P. 33(b)(2), 34(b)(2), 36(a)(3).

21. See *id.*

22. FED. R. CIV. P. 29 advisory committee’s note on the 1970 amendment (“There is no provision for stipulations varying the procedures by which methods of discovery other than depositions are governed. It is common practice for parties to agree on such variations, and the amendment recognizes such agreements and provides a formal mechanism in the rules for giving them effect. Any stipulation varying the procedures may be superseded by court order, and stipulations extending the time for response to discovery under Rules 33, 34, and 36 require court approval.”).

23. See *id.*

24. *Jarva v. United States*, 280 F.2d 892, 894 (9th Cir. 1960).

25. CARL BAAR, *THE MYTH OF SETTLEMENT 2* (1999).

26. See, e.g., Dore, *supra* note 19, at 288-89.

scalding attack by citizens, “think tank” task forces, the courts themselves, Congress, and the Executive Branch.<sup>27</sup> In an effort to curtail wide ranging pretrial discovery, the American Bar Association Section on Litigation published proposals to change the FRCP to redefine “relevance” more narrowly in Rule 26 and to amend the Rules to impose specific limits on discovery.<sup>28</sup> In 1979, the United States Department of Justice Office for Improvement in the Administration of Justice published a report on “the effectiveness of sanctions in controlling discovery abuse.”<sup>29</sup> The report “recommended early judicial involvement in discovery combined with more frequent assessment” of sanctions against parties losing discovery motions.<sup>30</sup>

In 1980, the Judicial Conference Advisory Committee on the Federal Rules of Civil Procedure (Advisory Committee) noted the widespread criticism, particularly the abuses in the pretrial discovery process.<sup>31</sup> While it regarded the concerns as serious, the Advisory Committee did not regard the abuse so serious as to require basic changes in the rules that govern discovery.<sup>32</sup> However, the Advisory Committee saw the benefit in encouraging judges to become more actively involved in managing civil cases.<sup>33</sup> At the recommendation of the Advisory Committee, in 1980, Rule 26(f) was added specifically to provide for a “*scheduling conference*.”<sup>34</sup> Under FRCP 26(f), the scheduling conference could be ordered by the court on its own motion or upon motion of any party.<sup>35</sup> The Advisory Committee

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27. See Leonard S. Janofsky, *A.B.A. Attacks Delay and the High Cost of Litigation*, 65 A.B.A. J. 1323, 1323 (1979).

28. See FED. R. CIV. P. 26 advisory committee’s note on the 1980 amendment.

29. Kimba W. Lovejoy, *The Proposed Amendments to the Federal Rules of Civil Procedure*, in CIVIL PRACTICE AND LITIGATION IN FEDERAL AND STATE COURTS 197, 199 (Sol Schreiber ed., 1981).

30. *Id.*

31. *Id.* at 200 (“The Advisory Committee has accepted many of these recommendations and is now proposing sweeping changes to Rules 16 and 26, requiring increased judicial intervention and strictures on attorneys to circumscribe discovery and other pretrial activity. The Committee once again did not, however, accept proposals made by the American Bar Association Section of Litigation to narrow the standard of relevance or to impose specific limits on discovery in the Rules. The main thrust of the changes is to place on judges and attorneys the responsibility for keeping the level of pretrial activity in proportion to the values at stake in each case.”).

32. FED. R. CIV. P. 26 advisory committee’s note on the 1980 amendment.

33. See Lovejoy, *supra* note 29, at 200.

34. FED. R. CIV. P. 26 advisory committee’s note on the 1980 amendment.

35. FED. R. CIV. P. 26(f) (1980).

noted that the procedure was intended to provide a hearing before the court for an attorney who has unsuccessfully attempted to effect a reasonable program or plan for discovery with opposing counsel.<sup>36</sup> The Advisory Committee stated:

It is not contemplated that requests for discovery conferences will be made routinely. . . . A number of courts routinely consider discovery matter in preliminary pretrial conferences held shortly after the pleadings are closed. The subdivision does not interfere with such a practice. It authorizes the court to combine a discovery conference with a pretrial conference under Rule 16 if a pretrial conference is held sufficiently early to prevent or curb abuse.<sup>37</sup>

One year later, in 1981, Rule 26 was amended again to provide for increased judicial supervision of the pretrial discovery process.<sup>38</sup> In 1983, Rule 16(b) was added, which required district judges to follow the Rule 16(a) pretrial conference with a scheduling order with respect to the timing of pleadings, completion of discovery, and motions.<sup>39</sup>

Although its local rules already provided for a status or scheduling conference, in conjunction with the amendments to the FRCP, effective May 1, 1983, the Northern District amended Local Rule 235-3 to require that a status or scheduling conference be held within 120 days of the filing of a complaint.<sup>40</sup> Local Rule 235-3 was also amended to incorporate the topics Rule 16 mandated to be addressed at scheduling conferences.<sup>41</sup> As these and other amendments were being made by the Northern District to its local rules, the national demand for procedures to reduce cost and delay in civil litigation continued.

36. FED. R. CIV. P. 26 advisory committee's note on the 1980 amendment.

37. *Id.*

38. FED. R. CIV. P. 26 advisory committee's note on the 1983 amendment. Rule 26 was changed to spell out the circumstances in which the court may limit either the frequency or extent of use of discovery methods, and to impose upon attorneys and parties a requirement signed, with the signature constituting a certification that the signer had made reasonable inquiry and that to the best of his or her belief the request, response, or objection (1) was warranted by existing law or a good faith argument for the extension, modification, or reversal of existing law; (2) is interposed in good faith and not primarily for an improper purpose; and (3) in not unreasonable or unduly burdensome or expensive, given the nature and complexity of the case, the discovery already had in the case, the amount in controversy, and other values at stake in the litigation. FED. R. CIV. P. 26(g)(1).

39. *See* FED. R. CIV. P. 16 advisory committee's note on the 1983 amendment.

40. N.D. CAL. L.R. 235-3.

41. *Id.*



*B. Local Rules under the Civil Justice Reform Act of 1990*

In 1990, after Senator Joseph Biden urged for special legislation to deal with cost and expense in civil litigation,<sup>42</sup> Congress enacted the Civil Justice Reform Act of 1990 (CJRA).<sup>43</sup> The CJRA required each U.S. district court to implement a civil justice expense and delay reduction plan that would “facilitate deliberate adjudication of civil cases on the merits, monitor discovery, improve litigation management, and ensure just, speedy, and inexpensive resolution of civil disputes.”<sup>44</sup>

Each district court was mandated to develop its plan after considering the recommendations of an advisory group formed in accordance with 28 U.S.C. § 478.<sup>45</sup> Ten district courts were designated as pilot courts and were required to include six principles and guidelines set forth in § 473(a) in their plans.<sup>46</sup> The CJRA required the Judicial Conference of the United States to conduct demonstration programs in five courts, in which the district would experiment with various methods of reducing cost and delay, including alternative dispute resolution.<sup>47</sup> The Judicial Conference was required to “submit a report to Congress no later than December 31, 1995 on the experience of the demonstration courts.”<sup>48</sup> The Northern District of California was designated by the Judicial Conference as a demonstration district.<sup>49</sup>

The Advisory Group which was appointed for the Northern District of California focused its deliberations on three causes of expense and delay: (1) judicial “inattention to civil cases in their early stages,” (2) “excessive reliance on motion work and formal discovery to determine the essence of claims and defenses and to identify supporting evidence,” and (3) “insufficient involvement of clients in decision-making about the handling of their cases.”<sup>50</sup> In December, 1991, The Northern District Advisory Group issued its report and

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42. See Richard L. Marcus, *Of Babies and Bathwater: The Prospects for Procedural Progress*, 59 BROOK. L. REV. 761, 801 (1993).

43. DAVID RAUMA & DONNA STIENSTRA, THE CIVIL JUSTICE REFORM ACT EXPENSE AND DELAY REDUCTION PLANS: A SOURCEBOOK 2 (1995); 28 U.S.C. § 473(a) (2006).

44. 28 U.S.C. § 471 (2006).

45. RAUMA & STIENSTRA, *supra* note 43, at 2.

46. *Id.* at 3.

47. *Id.* at 3-4.

48. *Id.* at 4 n.10.

49. *Id.* at 3.

50. N. D. CAL. GEN. ORDER 34 § 1 (1992).

recommendations.<sup>51</sup> The recommendations fell into areas including alternative dispute resolution, motion practice, pretrial case management, and special scheduling of short cause trials.<sup>52</sup> Specifically with respect to pretrial case management, the Advisory Group recommended the adoption of a “Case Management and Discovery Pilot Program.”<sup>53</sup> Under the pilot program, a select group of judges would follow a set of procedures—all centered on conferences with the assigned judge, acting as an active case manager.<sup>54</sup> The parties would be required to attend these conferences.<sup>55</sup> The judge would develop a discovery plan for the case, and would impose and enforce a firm time line for accomplishing the case plan.<sup>56</sup>

### 1. General Orders 34 and 39

On July 1, 1992, the Northern District issued General Order 34 (GO 34) implementing a “Case Management Pilot Program.”<sup>57</sup> A group of judges was designated as “Participating Judges” in the pilot program.<sup>58</sup> With few exceptions, all civil cases filed on or after December 1, 1992 and assigned to those judges would follow the special procedures set forth in GO 34.<sup>59</sup> The events which would otherwise be the subject of an order following Local Rule 235-3 status and scheduling conferences and FRCP 16(a) pretrial conferences were consolidated under GO 34 for consideration at newly coined “Case Management Conferences.”<sup>60</sup> General Order 34 provided for an initial case management conference early in the life of

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51. See 1991 Report of the Advisory Group of the United States District Court for the Northern District of California, *reprinted in* CIVIL JUSTICE EXPENSE AND DELAY REDUCTION PLAN OF THE NORTHERN DISTRICT OF CALIFORNIA app. A (1991).

52. *Id.* at 4-7.

53. *Id.* at 33.

54. See CIVIL JUSTICE EXPENSE AND DELAY REDUCTION PLAN OF THE NORTHERN DISTRICT OF CALIFORNIA 3-4 (1991).

55. *Id.* at 36.

56. See *id.* at 37.

57. N.D. CAL. GEN. ORDER 34 § II (1992).

58. *Id.* at app. A. The participants were Judges Henderson, Peckham, Orrick, Patel, Lynch, Legge, Jensen, Smith, Walker, Ware, Armstrong, Caulfield, and Whyte. This included all of the active district judges. Non-participants were the senior and magistrate judges. *Id.* at app. A.

59. See *id.* at § II.

60. See *id.*

the case and additional or supplemental case management conferences as required for the management of the case.<sup>61</sup>

The procedures set forth in GO 34 deviated from the Northern District's Local Rules and, indeed, in some respects deviated from the procedures prescribed by the FRCP. Under GO 34, when a complaint was filed or was removed to the Northern District, the clerk of court set a date for the parties to appear before the court for a case management conference. The conference date would be set at approximately 120 days after the date the complaint was filed.<sup>62</sup> A principal feature of GO 34 was a requirement that the parties meet, confer, and adopt a plan about how to cooperate in the litigation of the case in advance of the case management conference.

Under GO 34, all formal discovery was suspended until after the initial case management conference.<sup>63</sup> Instead of resorting to discovery in the period leading up to the case management conference, GO 34 required the parties to voluntarily disclose basic information about the case without the necessity of a formal discovery request.<sup>64</sup> No later than 90 days after the complaint was filed, each party was required to disclose identifying information regarding all persons known to have discoverable information about factual matter relevant to the case; all unprivileged documents in the party's custody or control that tend to support the positions that the disclosing party has taken or is reasonably likely to take in the case; insurance agreements; and a computation of claims of any category of damages.<sup>65</sup> General Order 34 imposed a continuing duty on each party to supplement its disclosures on a timely basis.<sup>66</sup>

In preparation for the initial case management conference, no later than 100 days after the complaint was filed, lead counsel for the parties were required to meet and confer regarding the matters which would be addressed at the case management conference.<sup>67</sup> Ten days

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61. *See id.* at § X.

62. *Id.*

63. *Id.* at § VI.

64. *Id.* at § VII.

65. *Id.*

66. *Id.* at § VII(E).

67. *Id.* at § VIII. The issues were enumerated in GO 34 as: principal issues and evidence; alternative dispute resolution; jurisdiction by a magistrate judge; additional disclosure; motions; discovery; and scheduling.

before the conference, the parties were required to file a joint statement addressing those matters.<sup>68</sup>

Effective December 1, 1993, and in the midst of programs and procedures being conducted by the district courts under the congressionally initiated CJRA, the FRCP was amended.<sup>69</sup> Some of the amendments adopted as part of the national rules' procedures were identical to those which were being used by districts under their CJRA Plans. Rule 16 was amended to set a deadline for an initial scheduling conference.<sup>70</sup> In addition, FRCP Rule 26 was amended to provide for mandatory disclosure of basic information.<sup>71</sup>

Notwithstanding the amendments to the FRCP, the CJRA's mandate that district courts experiment with new procedures was still in effect.<sup>72</sup> Some of the deadlines and other procedures established in the 1993 amendments to the FRCP conflicted with those required by GO 34.<sup>73</sup> To clarify the procedure which should be followed in the Northern District, the District issued General Order 39 (GO 39) on December 1, 1993.<sup>74</sup> Acting under the authority provided by the CJRA—permitting districts to adopt procedures which deviated from the FRCP—GO 39 provided that in all cases governed by GO 34, its provisions shall supersede any conflicting or overlapping provisions of the FRCP.<sup>75</sup>

## 2. Revised Local Rules

In GO 39, the Northern District stated an intention to conduct a systematic review of all its local rules.<sup>76</sup> In 1994, Chief Judge Henderson tasked the Court's Rules Committee to develop a comprehensive set of civil local rules, which incorporate the GO 34

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68. *Id.* at § IX.

69. See Edward D. Cavanagh, *The Civil Justice Reform Act of 1990 and the 1993 Amendments to the Federal Rules of Civil Procedure: Can Systemic Ills Afflicting the Federal Courts Be Remedied By Local Rules?*, 67 ST. JOHN'S L. REV. 721, 722-23 (1993).

70. See FED. R. CIV. P. 16 advisory committee's note on the 1983 amendment.

71. FED. R. CIV. P. 26 advisory committee's note on the 1993 amendment.

72. See Cavanagh, *supra* note 69, at 722-23.

73. See N.D. CAL. GEN. ORDER 39 (1993) § I (“[T]his Court is experimenting with procedural rules . . . that differ in some respects from pertinent provisions in the Federal Rules of Civil Procedure.”).

74. *Id.*

75. *Id.* at § III(A) (“In cases governed by General Order No. 34, its provisions shall supersede any apparently conflicting or overlapping provisions of the Federal Rules of Civil Procedure, as amended.”).

76. *Id.* at § I.

case management pilot program and reconcile the local rules with the FRCP. Chief Judge Henderson directed that the revised local rules address the subject areas covered by the existing local rules (civil, criminal, habeas, admiralty, and bankruptcy). He also appointed advisory committees to propose local rules for ADR procedures in the District, securities litigation, and patent litigation.

On June 28, 1995, the District adopted Revised Local Rules, which became effective on September 1, 1995.<sup>77</sup> The Revised Local Rules were divided into six substantive areas: Admiralty and Maritime, Alternative Dispute Resolution, Bankruptcy, Civil, Criminal Proceedings, and Habeas Corpus Petitions.<sup>78</sup> Because the proposed Securities Litigation and Patent Local Rules were still under development, they were not included in the 1995 Revision.<sup>79</sup> As the following discussion indicates—with respect to the proposed Patent Local Rules—a major legal development pertaining to patent case procedure contributed to the delay.

### *C. The Effect of Markman v. Westview on the Patent Local Rules*

In 1994, when Chief Judge Henderson asked District Judge Whyte to chair an advisory committee to develop Patent Local Rules, the United States Court of Appeals for the Federal Circuit was reviewing *Markman v. Westview Instruments, Inc.*<sup>80</sup> The case was on appeal from a 1991 decision by the Eastern District of Pennsylvania.<sup>81</sup> The issue on appeal was whether the district judge erred in granting a renewed motion for judgment in favor of the defendants on the basis of the district judge's own construction of one of the patent claims.<sup>82</sup> Although the district judge had instructed the jury to decide the proper construction, in a post-verdict hearing, the district judge had ruled that claim construction was a question of law to be decided by

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77. N.D. CAL. L.R (1995).

78. *Id.*

79. *See id.*

80. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc).

81. *Id.* at 970.

82. *Id.* at 973-74. At trial, after the close of the plaintiffs' case, defendants moved for judgment as a matter of law. In the order the district judge referred to the motion as one for a directed verdict. The district judge deferred ruling on the motion. The district judge instructed the jury that they were to first construe the patent's claims and then decide if infringement had occurred. The jury found that defendants' device infringed plaintiffs' patent. After hearing additional argument following the verdict, the district judge granted the defendants' renewed motion for judgment as a matter of law. *Id.* at 973.

the court.<sup>83</sup> A panel of the Federal Circuit heard oral argument in the appeal.<sup>84</sup> However, on November 5, 1993, the Federal Circuit had ordered sua sponte that the matter be reheard en banc.<sup>85</sup> On April 5, 1995, the Federal Circuit affirmed the decision of the district court holding that in a patent infringement case, any dispute over the scope of the patent, including specifically the meaning of the words and phrases of the patent claim, was a question of law which was to be decided by the judge.<sup>86</sup> Later that year, the United States Supreme Court accepted the case for review.<sup>87</sup> On April 23, 1996, the Supreme Court unanimously affirmed the Federal Circuit's decision that it was an obligation of the district judge to construe, as a matter of law, the scope of a patent, including the meaning of its claims.<sup>88</sup>

The *Markman* requirement for judicial pretrial claim construction was the subject of considerable discussion among members of the patent bar and, of course, it became a major factor in the deliberations of the Northern District Patent Local Rules Advisory Committee. Neither the Federal Circuit nor the Supreme Court commented on what procedure should be used. Among the issues which emerged was the role of the assigned judge in the prehearing process, the timing of the claim construction hearing, the scope of prehearing discovery, and the effect of evidentiary restrictions imposed by substantive patent law on what evidence the parties should be permitted to submit prior to or at the hearing.<sup>89</sup>

Procedures for judicial management, case scheduling, and disclosure were contained in the Northern District's Civil Local Rules.<sup>90</sup> These procedures had proven to be an effective case management tool for civil cases in general. Thus, in 2000, during the tenure of Chief Judge Marilyn Hall Patel, the Patent Local Rules Advisory Committee proposed Rules which incorporated these procedures, modified to accommodate the unique nature of the claim construction process. The next Part discusses the content and application of the Northern District's Patent Local Rules.

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83. *Id.* at 973.

84. *Id.* at 970 n.1.

85. *Id.*

86. *Id.* at 970-71.

87. *Markman v. Westview Instruments, Inc.*, 515 U.S. 1192, 1192 (1995).

88. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

89. Deliberation of these issues is evidenced by the Northern District's Patent Local Rules governing claim construction. *See* discussion *infra* Part III.A.4.

90. *See* N.D. CAL. L.R. § 1 (1995).

### III. THE CONTENT AND APPLICATION OF THE NORTHERN DISTRICT'S PATENT LOCAL RULES

#### *A. The Patent Local Rules as Adopted in 2000*

Recognizing that enhanced judicial management of patent-related cases was appropriate to address the issues discussed in Part II of this article, the Northern District of California, in 2000, became the first federal judicial district to adopt Patent Local Rules (PLRs).<sup>91</sup> The authority for promulgating such rules derives from FRCP 83,<sup>92</sup> and the Northern District's adoption and application of PLRs has been expressly endorsed by the Court of Appeals for the Federal Circuit.<sup>93</sup> The following discussion provides an overview of the Northern District's PLRs, as adopted in 2000, which comprise four sections: (1) Scope of the Rules; (2) General Provisions; (3) Patent Initial Disclosures; and (4) Claim Construction Proceedings.

#### 1. Scope of the Rules

Section 1 (Scope of the Rules) defines the types of actions to which the PLRs apply as "all civil actions . . . which allege infringement of a utility patent in a complaint, cross-claim or third party claim, or which seek a declaratory judgment that a utility patent is not infringed, is invalid or is unenforceable."<sup>94</sup> Rule 1-3 provides that the PLRs apply to any such cases filed after January 1, 2001.<sup>95</sup> Of the 297 patent cases currently active in the Northern District, over 150 cases remain subject to the 2000 PLRs,<sup>96</sup> indicating the continuing

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91. See Brunet, *supra* note 1, at 109. The Patent Local Rules for the Northern District of California, as adopted in 2000, available at <http://www.cand.uscourts.gov> (follow the "Rules" hyperlink; then follow the "Patent Local Rules" hyperlink; then download the file named "Patent rules for cases filed before March 1, 2008") (last visited April 19, 2009).

92. FED. R. CIV. P. 83(a) ("After giving public notice and an opportunity for comment, a district court, acting by a majority of its district judges, may adopt and amend rules governing its practice."); FED. R. CIV. P. 83(b) ("A judge may regulate practice in any manner consistent with federal law, rules adopted under 28 U.S.C. §§ 2072 and 2075, and the district's local rules. No sanction or other disadvantage will be imposed for noncompliance . . . unless the alleged violator has been furnished in the particular case with actual notice of the requirement.").

93. See, e.g., *O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366 (Fed. Cir. 2006) ("[W]e see nothing in the Federal Rules that is inconsistent with [the Northern District of California's] local rules requiring the early disclosure of infringement and invalidity contentions . . .").

94. N.D. CAL. PATENT L.R. 1-2 (2000).

95. N.D. CAL. PATENT L.R. 1-3 (2000).

96. This figure was obtained by determining the number of open cases filed between January 1, 2001 and March 1, 2008 in the Northern District of California, as the Northern

vitality of this version of the PLRs to those litigating patent-related cases in the Northern District.

Section 1 also provides that the court retains discretion to “accelerate, extend, eliminate, or modify the obligations or deadlines” set forth in the PLRs based upon particular circumstances of the case at bar.<sup>97</sup> This provision, while affording the court a substantial degree of flexibility in its application of the PLRs, appears to be overlooked by some commentators who assert that the deadlines for filing disclosures under the PLRs are unduly rigid.<sup>98</sup> According to Rule 1-2, characteristics of a cause of action that may necessitate a flexible application of the PLRs include, but are not limited to, “the complexity of the case or the number of patents, claims, products, or parties” at issue in the litigation.<sup>99</sup> Indeed, the court has employed its discretion to relax the PLRs’ standards under certain circumstances to avoid substantial prejudice to a litigant.<sup>100</sup>

## 2. General Provisions

Rules 2-1 through 2-5 (General Provisions) cover a range of topics including the initial case management conference (Rule 2-1), confidentiality (Rule 2-2), certification and admissibility of disclosures (Rules 2-3 and 2-4), and the relationship between the PLRs and the FRCP with respect to the timing of discovery requests (Rule 2-5).<sup>101</sup> Under FRCP 26(f), litigants are required to confer and discuss the claims and defenses in the case, the possibility of a prompt

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District’s revised PLRs apply to patent cases filed after March 1, 2008. See Stanford IP Litigation Clearinghouse, [http://lexmachina.stanford.edu/cases/court/72?sort=Date+Filed+\(Ascending\)&perPage=20&link\\_var](http://lexmachina.stanford.edu/cases/court/72?sort=Date+Filed+(Ascending)&perPage=20&link_var) (last visited April 19, 2009).

97. N.D. CAL. PATENT L.R. 1-2 (2000).

98. See, e.g., Ellisen S. Turner, *Swallowing the Apple Whole: Improper Patent Use by Local Rule*, 100 MICH. L. REV. 640, 647 (2001) (“[T]he mandatory disclosure procedure set out by the [Northern District Patent] Local Rules grants discovery of the accused instrumentality too early in the claim construction process.”); Markman Subcommittee of the Patent Litigation Committee of the American Intellectual Property Law Association, *The Interpretation of Patent Claims*, 32 AIPLA Q.J. 1, 68 (2004) (“[T]he Northern District of California rules could be criticized as imposing overly strict timelines and an inappropriately early claim construction . . .”).

99. N.D. CAL. PATENT L.R. 1-2 (2000).

100. See, e.g., *Biogenex Labs., Inc. v. Ventana Med. Sys., Inc.*, No. C 05-860 JF (PVT), 2006 WL 2228940, at \*3-4 (N.D. Cal. Aug. 3, 2006) (showing that to not “dispose of substantive infringement claims based upon procedural defects,” the court permitted a patentee to amend its infringement contentions despite non-compliance with Rule 3-7.).

101. N.D. CAL. PAT. L.R. 2-1 to 2-5 (2000).



settlement or resolution of the case, disclosures to be made, and a discovery plan.<sup>102</sup> Patent Local Rule 2-1(a) additionally requires litigants in patent-related cases to discuss and address in a case management statement any proposals to modify the deadlines set forth in the PLRs.<sup>103</sup> Further, the parties must discuss and address various issues related to claim construction, including the order of presentation at the claim construction hearing, whether the hearing will include live testimony, any limits on discovery specific to claim construction, and the scheduling of a claim construction prehearing conference.<sup>104</sup> The requirement to discuss and address these topics is in furtherance of the court's stated purpose of the PLRs to "place the parties on an orderly pretrial track which will produce a ruling on claim construction approximately a year after the complaint is filed."<sup>105</sup>

Rule 2-5 clarifies the relationship between the PLRs and the FRCP with respect to discovery requests.<sup>106</sup> The Rule makes clear that a party may decline to respond to a discovery request, even where disclosure of the requested information would otherwise be required pursuant to FRCP 26(a)(1),<sup>107</sup> when the request is premature according to the timetable set forth in the PLRs.<sup>108</sup> Types of information for which discovery requests may be objected to as premature include: (1) a party's position on claim construction;<sup>109</sup> (2) the accused infringer's request to elicit the patentee's asserted claims and the accused instrumentality or conduct;<sup>110</sup> (3) the patentee's request to elicit from the accused infringer any prior art that is intended to form the basis of an invalidity defense,<sup>111</sup> and (4) the patentee's request to elicit from an accused infringer information

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102. FED. R. CIV. P. 26(f)(2).

103. N.D. CAL. PATENT L.R. 2-1(a)(1) (2000).

104. N.D. CAL. PATENT L.R. 2-1(a)(2) to 2-2(a)(5) (2000).

105. *Integrated Circuit Sys., Inc. v. Realtek Semiconductor Co.*, 308 F. Supp. 2d 1106, 1107 (N.D. Cal. 2004).

106. N.D. CAL. PATENT L.R. 2-5 (2000).

107. FED. R. CIV. P. 26(a)(1) (providing that a party has a duty to disclose certain information and "tangible things" which may be used to support that party's case).

108. N.D. CAL. PATENT L.R. 2-5 (2000).

109. N.D. CAL. PATENT L.R. 2-5(a) (2000).

110. N.D. CAL. PATENT L.R. 2-5(b) (2000).

111. N.D. CAL. PATENT L.R. 2-5(c) (2000).

relevant to defending against an allegation of willful infringement,<sup>112</sup> including opinions of counsel and related documents.<sup>113</sup>

The scope of Rule 2-5 was recently clarified in *Townshend Intellectual Property, L.L.C. v. Broadcom Corp.*<sup>114</sup> Prior to serving its infringement contentions, Townshend, the patent claimant, moved to compel responses to interrogatories and document requests relating to Broadcom's contentions and supporting evidence of non-infringement, invalidity, prosecution history estoppel, defenses to willful infringement, and unenforceability of the patents on the grounds of estoppel.<sup>115</sup> With regard to Broadcom's non-infringement contentions, the court noted that the PLRs do not provide a timeframe for an alleged infringer to serve non-infringement contentions, but concluded that "the overall structure of the Rules, as well as common sense, supports Broadcom's argument that it would be fundamentally unfair to require a patent defendant to set out and support its non-infringement case before the plaintiff has complied with its obligation to serve Preliminary Infringement Contentions."<sup>116</sup>

As for Broadcom's objection to discovery requests relating to invalidity and prosecution history estoppel, Townshend argued that *document* requests may not be objected to as premature unless such documents pertain to willfulness under Rule 2-5(d).<sup>117</sup> Townshend noted that only subparagraph (d) expressly refers to "documents" and argued that established principles of statutory interpretation warrant a conclusion that requests for documents falling within the scope of

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112. A patent claimant may be awarded enhanced damages upon successfully asserting that the defendant's infringement was willful. 35 U.S.C. § 284 (2006) (providing for enhanced damages up to three times the amount of actual damages incurred). Until recently, advice of counsel was a strong defense against willful infringement. *See Underwater Devices Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983) (holding that a potential infringer, after being provided notice that it is infringing another's patent, has an affirmative duty to obtain competent advice of counsel as to whether infringement is occurring). *But see In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (overruling *Underwater Devices* and raising the level of proof required to prove willful infringement, and accordingly, diminishing the importance of advice of counsel as a defense against allegations of willful infringement).

113. N.D. CAL. PATENT L.R. 2-5(d) (2000). Rule 2-5(d) of the 2008 revised PLRs omits the qualification that advice of counsel and related documents must pertain to a defense to an allegation of willful infringement. N.D. CAL. PATENT L.R. 2-5(d) (2008).

114. *Townshend Intellectual Prop., L.L.C. v. Broadcom Corp.*, No. C 06-05118 JF (RS), 2007 WL 2462152 (N.D. Cal. Aug. 29, 2007).

115. *Id.* at \*1, 3.

116. *Id.* at \*3.

117. *Id.* at \*1-2.

Rules 2-5(a) to 2-5(c) may not be objected to as premature.<sup>118</sup> The court rejected this argument, noting that the definition of “discovery requests” in the preamble to Rule 2-5 includes “document requests,” and therefore *any* discovery request falling within Rule 2-5 are objectionable as premature if requested prior to the PLRs’ prescribed timeframe.<sup>119</sup>

Finally, the court in *Townshend* addressed whether Broadcom can object to Townshend’s interrogatories and document requests relating to Broadcom’s estoppel-based contentions of unenforceability.<sup>120</sup> The court found that contentions relating to unenforceability, as opposed to validity, did not fall within the scope of Rule 2-5.<sup>121</sup> Accordingly, Broadcom was required to produce any documents in its possession relating to its theory of patent unenforceability on the basis of estoppel.<sup>122</sup>

### 3. Patent Initial Disclosures

The liberal notice pleading standard of FRCP 8(a) merely requires a claimant to make “a short and plain statement of the claim showing that the pleader is entitled to relief, . . . [and] a demand for the relief the pleader seeks.”<sup>123</sup> Under this pleading standard, a patent claimant asserting infringement need not provide detailed information about the basis of its claim. One commentator has summarized the practical effect of FRCP 8(a)-type pleading on patent litigation as follows:

The plaintiff has not traditionally been required to specify which claims are infringed. Nor has the plaintiff needed to plead its theory of the meaning of the claim terms and the features of the defendant’s products (or even the products themselves) that are alleged to infringe. Because a plaintiff may assert multiple claims in multiple patents, a defendant reading a notice pleading

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118. *Id.* at \*2. Townshend referred to the principle of statutory interpretation that “if a term has been employed in a section, but excluded from another, the term should not be read to be included in the section in which it does not appear.” *Id.* (citing *FTC v. Sun Oil Co.*, 371 U.S. 505, 514-15 (1963)).

119. *Id.*

120. *Id.*

121. *Id.* (“It does not appear that Broadcom would be obliged to provide substantially equivalent information in either its invalidity contentions or its *Markman* briefing. Accordingly, those requests are not premature under Rule 2-5.”).

122. *Id.*

123. FED. R. CIV. P. 8(a).

complaint is typically left to guess as to the boundaries of a plaintiff's case and the available defenses.

A patent plaintiff reading a notice pleading answer and counterclaim is equally in the dark about the substance of the defendant's case. The defendant, for example, need not identify the prior art on which its invalidity defense relies. Nor does the defendant have to plead its theories of claim construction or which combinations of prior art references might invalidate each of the claims.<sup>124</sup>

Section 3 (Patent Initial Disclosures) of the PLRs dramatically heightens the level of specificity required of a patent claimant asserting infringement (and an accused infringer asserting invalidity), and it does so early in the case. Rule 3-1 requires the plaintiff—no later than 10 days following the initial case management conference—to serve a “Disclosure of Asserted Claims and Preliminary Infringement Contentions” on all parties to the suit.<sup>125</sup> This disclosure must recite each asserted claim of each patent allegedly infringed<sup>126</sup> and identify the “accused instrumentality”<sup>127</sup> that allegedly infringes each asserted claim.<sup>128</sup>

Rule 3-1(c) further requires the infringement contentions to include “a chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality.”<sup>129</sup> Caselaw from the Northern District indicates that compliance with Rule 3-1(c) “requires that a plaintiff explain how each allegedly infringing product meets each element of the plaintiff's asserted patent claim,”<sup>130</sup> which in turn requires that “a plaintiff compare an accused product to its patents on a claim by claim, element by

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124. Peter S. Menell et al., *Patent Case Management Judicial Guide* at ch. 2 p. 6 (U.C. Berkeley Pub. Law Research, Working Paper No. 1328659, 2009), available at <http://ssrn.com/abstract=1328659>.

125. N.D. CAL. PATENT L.R. 3-1 (2000).

126. N.D. CAL. PATENT L.R. 3-1(a) (2000).

127. The PLRs employ the term “Accused Instrumentality” to describe the “accused apparatus, product, device, process, method, act, or other instrumentality.” See N.D. CAL. PATENT L.R. 3-1(b) (2000).

128. N.D. CAL. PATENT L.R. 3-1(b) (2000).

129. N.D. CAL. PATENT L.R. 3-1(c) (2000). For each element that the patentee contends is governed by 35 U.S.C. §112 ¶ 6 (i.e., a means- or step-plus-function limitation), the chart must include the structure, act, or material in the accused instrumentality that performs the claimed function. N.D. CAL. PATENT L.R. 3-1(c) (2000).

130. *InterTrust Techs. Corp. v. Microsoft Corp.*, No. C 01-1640 SBA, 2003 WL 23120174, at \*2 (N.D. Cal. Dec. 1, 2003).

element basis” for at least one of the accused instrumentalities.<sup>131</sup> Thus, the claim chart must provide the accused infringer with more than a mere “laundry list” of claim elements and accused instrumentalities. Rather, the patentee must provide the accused infringer with a meaningful explanation as to *how its claims read on the accused instrumentality* to fully comply with Rule 3-1(c).<sup>132</sup>

Certain limits have been placed on the level of specificity required under Rule 3-1(c). First, the plaintiff is under no obligation to provide *evidence* in the claim chart to support its infringement contentions.<sup>133</sup> Second, as indicated in *Renesas Technology Corp. v. Nanya Technology Corp.*,<sup>134</sup> when accused instrumentalities fall into product families, and the instrumentalities within each family are indistinguishable with respect to the alleged infringement, the patent claimant need not disclose each instrumentality separately.<sup>135</sup> Rather, providing instrumentalities in the claim chart that are representative of each product family is sufficient to comply with the specificity requirement of Rule 3-1(c) and is deemed to provide adequate notice to the accused infringer of the patent claimant’s infringement theories.<sup>136</sup>

Rule 3-1(d) requires the patentee to indicate whether each element of each asserted claim is alleged to be present literally or under the Doctrine of Equivalents (DoE) in the accused instrumentality.<sup>137</sup> At issue in *Rambus Inc. v. Hynix Semiconductor Inc.*<sup>138</sup> was the particularity with which the patentee must indicate whether an asserted claim is infringed literally or under the DoE.<sup>139</sup> Rambus—the patent claimant—stated in its infringement contentions<sup>140</sup>

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131. *Network Caching Tech., LLC v. Novell, Inc.*, No. C-01-2079-VRW, 2002 WL 32126128, at \*5 (N.D. Cal. Aug. 13, 2002).

132. *See InterTrust Techs.*, 2003 WL 23120174, at \*3.

133. *See Network Caching Tech., LLC v. Novell, Inc.*, No. C-01-2079 VRW, 2003 WL 21699799, at \*4 (N.D. Cal. March 21, 2003).

134. *Renesas Tech. Corp. v. Nanya Tech. Corp.*, No. C03-05709JF(HRL), 2005 WL 2000926 (N.D. Cal. Aug 18, 2005).

135. *Id.* at \*4.

136. *See id.*

137. *See* N.D. CAL. PATENT L.R. 3-1(d) (2000).

138. *Rambus Inc. v. Hynix Semiconductor Inc.*, No. C-05-00334 RMW, C-05-02298 RMW, C-06-00244 RMW, 2008 WL 5411564, slip op. (N.D. Cal. Dec 29, 2008).

139. *Id.* at \*3.

140. The infringement contentions at issue in *Rambus Inc.* were technically Rambus’ *final* infringement contentions. *See id.* However, the particularity standard for preliminary and final contentions is identical. *See* N.D. CAL. PATENT L.R. 3-6 (2000).

that “[t]o the extent that any limitation is found to be not literally present, Rambus asserts that such limitation is present under the doctrine of equivalents.”<sup>141</sup> The court found that Rambus’s contentions failed to comply with Rule 3-1(d):

The Patent Local Rules require a limitation-by-limitation analysis, not a boilerplate reservation. The doctrine of equivalents exists to prevent ‘a fraud on the patent.’ It is not designed to give a patentee a second shot at proving infringement ‘[t]o the extent that any limitation is found to be not literally present.’ Rambus’s failure to comply with the Patent Local Rules . . . provides ample . . . justification for dismissing Rambus’s claims of infringement under the doctrine of equivalents.<sup>142</sup>

*Rambus* demonstrates that a patentee must specify with particularity, on an element by element basis, its position regarding literal infringement versus infringement under the DoE, and generally illustrates the principle that failure to comply with the Northern District’s PLRs can be fatal to a party’s case.

*Genentech, Inc. v. Amgen, Inc.*<sup>143</sup> further illustrates the serious consequences of a patent claimant inadequately disclosing its theories of infringement as literal or under the DoE.<sup>144</sup> *Genentech* originated prior to the Northern District’s adoption of the 2000 PLRs.<sup>145</sup> In effect during that time, however, was the Northern District’s Civil Local Rule 16-9, which required a patent claimant to submit a claim chart indicating, inter alia, whether each asserted claim was alleged to be infringed literally or under the DoE.<sup>146</sup> *Genentech*’s infringement contentions, as indicated in its claim chart, proceeded on the theory that its asserted claims were literally infringed by Amgen.<sup>147</sup> After a claim construction ruling that was adverse to *Genentech*’s position of literal infringement, *Genentech* sought to amend its claim chart to include theories of infringement under the DoE.<sup>148</sup> Because Rule 16-9 required the claim chart to indicate whether the alleged infringement was literal “or” under the doctrine of equivalents, *Genentech* argued

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141. *Rambus Inc.*, 2008 WL 5411564, at \*3.

142. *Id.* (citations omitted).

143. *Genentech, Inc. v. Amgen, Inc.*, 289 F.3d 761 (Fed. Cir. 2002).

144. *See id.* at 773-74.

145. *See id.* at 765.

146. *Id.* at 773.

147. *Id.* at 773-74.

148. *Id.*

that the “or” required one theory or the other, but not both.<sup>149</sup> After Genentech’s motion to amend its infringement theory was denied by the Northern District, it appealed to the Federal Circuit, which held that the district court did not abuse its discretion in denying Genentech’s motion to amend its infringement theories.<sup>150</sup> The alternative (“or”) language was retained in both the 2000 and 2008 PLRs with respect to theories of literal infringement and infringement under the DoE,<sup>151</sup> and a claimant should be aware, in light of *Genentech*, that both theories should be asserted if a party intends to preserve the right to contend either theory later in the case. Further, *Genentech* represents an early endorsement by the Federal Circuit of the Northern District’s efforts to adopt special rules governing patent litigation: “this court defers to the district court when interpreting and enforcing local rules so as not to frustrate local attempts to manage patent cases according to prescribed guidelines.”<sup>152</sup>

Rule 3-1 also provides that the patentee must indicate the priority date of any asserted claims belonging to a patent that claims priority to an earlier patent application.<sup>153</sup> The final subparagraph of Rule 3-1, subparagraph (f), requires a patentee, who intends to rely on his own instrumentality as practicing the claimed invention, to identify, for each asserted claim, the instrumentality that incorporates or reflects that particular claim.<sup>154</sup> The scope of Rule 3-1(f) was clarified in *Baxter Healthcare Corp. v. Fresenius Medical Care Holding, Inc.*<sup>155</sup> At issue in *Baxter* was whether the patent claimant is required to include unfinished projects and prototypes—as opposed to final commercial products only—in a Rule 3-1(f)-type<sup>156</sup> disclosure.<sup>157</sup> Fresenius, the accused infringer, brought a motion to compel Baxter to do what Baxter described as the “impossible” task of “assess[ing]

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149. *Id.*

150. *Id.* at 774.

151. See N.D. CAL. PATENT L.R. 3-1(d) (2000); N.D. CAL. PATENT L.R. 3-1(e) (2008).

152. *Genentech*, 289 F.3d at 774.

153. N.D. CAL. PATENT L.R. 3-1(e) (2000).

154. N.D. CAL. PATENT L.R. 3-1(f) (2000).

155. See *Baxter Healthcare Corp. v. Fresenius Med. Care Holding, Inc.*, No. C 07-1359 PJH (JL), 2008 WL 5271990, slip op. at \*2-3 (N.D. Cal. Dec. 15, 2008).

156. Technically, Fresenius was not objecting to Baxter’s infringement contentions. Fresenius served Baxter with an interrogatory requesting a list of unfinished prototypes which Baxter did *not* intend to rely upon in its case. Nonetheless, the court analyzed the adequateness of Baxter’s response to the interrogatory in terms of what is required under Rule 3-1(g) (2008), which is the equivalent of Rule 3-1(f) (2000). See *Baxter*, 2008 WL 5271990, at \*2.

157. *Baxter*, 2008 WL 5271990, at \*2.

whether claim chart comparisons are needed for every iteration of every prototype ever created.”<sup>158</sup> Analyzing Fresenius’s motion within the framework of Rule 3-1(f), the court found that the scope of the rule is limited to “final commercial products and not a multiplicity of prototypes,” unless the plaintiff intends to rely on such prototypes in the case.<sup>159</sup>

Patent Local Rule 3-2 sets forth the types of documents that a patent claimant must provide to the opposing party along with its infringement contentions.<sup>160</sup> Rule 3-2(a) requires the patentee to provide documents relating to any invention disclosures the patentee made to third parties prior to filing the application for the patent being asserted.<sup>161</sup> Essentially, the claimant must provide the accused infringer with documents that are relevant to the novelty of the invention under 35 U.S.C. § 102,<sup>162</sup> including any sales (or offers to sell) the invention prior to filing the patent application.<sup>163</sup> Under Rule 3-2(b), the claimant must produce documents evidencing the conception, reduction to practice, and any other activities occurring prior to the filing date of the application that are relevant to the priority date of the asserted claims.<sup>164</sup> Rule 3-2(c) requires the claimant to produce a copy of the file history of each patent allegedly infringed.<sup>165</sup> In *Renesas Technology Corp. v. Nanya Technology Corp.*,<sup>166</sup> Nanya objected to Renesas’ file history disclosure because Renesas omitted the file histories of *related* patent applications (i.e., divisional, continuation, and continuation-in-part applications).<sup>167</sup> Whether a Rule 3-2(c) disclosure must comprise the file histories of

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158. *Id.* at \*3.

159. *Id.*

160. N.D. CAL. PATENT L.R. 3-2 (2000).

161. N.D. CAL. PATENT L.R. 3-2(a) (2000).

162. 35 U.S.C. § 102 (2006). Certain activities will render an invention unpatentable for lack of novelty under § 102, including public disclosures, offers for sale, and public use. The timing of the activity, the location where the activity occurred, and whether the activity was by the patent applicant or someone other than the applicant, determine whether a particular provision of 35 U.S.C. §102 renders an invention invalid for lack of novelty. *See, e.g.*, §§ 102(a) and (b).

163. N.D. CAL. PATENT L.R. 3-2(a) (2000).

164. N.D. CAL. PATENT L.R. 3-2(b) (2000).

165. N.D. CAL. PATENT L.R. 3-2(c) (2000).

166. *Renesas Tech. Corp. v. Nanya Tech. Corp.*, No. C03-05709 JF (HRL), 2005 WL 2072121 (N.D. Cal. Aug. 26, 2005).

167. *Id.* at \*1.



related applications remains an open question, as the court declined to decide the issue.<sup>168</sup>

Patent Local Rule 3-3 (Preliminary Invalidity Contentions) is to the accused infringer what Rule 3-1 is to the patent claimant. It requires the accused infringer—within 45 days of receiving the infringement contentions—to reveal its theories of patent invalidity, if any, with a high degree of particularity to the patent claimant.<sup>169</sup> First, the preliminary invalidity contentions must include “each item of prior art that allegedly anticipates each asserted claim or renders it obvious,” and such items must be identified with great specificity so as to avoid any confusion on the part of the patent claimant regarding how the prior art relates to the asserted claims.<sup>170</sup>

Pursuant to Rule 3-3(b), the accused infringer must also disclose its invalidity theory as to whether each item of prior art anticipates the asserted claims or renders the claims obvious.<sup>171</sup> At issue in *Keithley v. The Homestore.com*<sup>172</sup> was the degree of particularity required of the accused infringer in providing its theory of invalidity with respect to anticipation or obviousness.<sup>173</sup> The defendant provided information pursuant to Rule 3-3(b) in the form of a chart that comprised each element of each claim asserted by the plaintiff.<sup>174</sup> Next to each element, the defendant indicated which prior art reference was relevant to that element, but failed to explicitly indicate whether the reference anticipated the claim or rendered the claim obvious.<sup>175</sup> The defendant argued that when a reference is cited next to *every element of each asserted claim*, the reference is relied upon as anticipating the claim.<sup>176</sup> Accordingly, the defendant argued that when a reference is provided next to some, but not all of the elements of an asserted

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168. *Id.* at \*4.

169. *See* N.D. CAL. PATENT L.R. 3-3 (2000).

170. *See* N.D. CAL. PATENT L.R. 3-3(a) (2000).

171. *See* N.D. CAL. PATENT L.R. 3-3(b) (2000). When prior art meets one or more of the criteria set forth in 35 U.S.C. §102 (relating to novelty), *see infra* note 162, it is said to “anticipate” the claimed invention. Anticipation requires that each element of the claimed invention is found within a single prior art reference. A prior art reference, or combination thereof, renders a claimed invention obvious if it meets the test set forth in 35 U.S.C. § 103. *See* 35 U.S.C. § 103(a) (2006). For the current authoritative interpretation of obviousness under 35 U.S.C. § 103, *see* *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

172. *Keithley v. The Homestore.com, Inc.*, 553 F. Supp. 2d 1148 (N.D. Cal. 2008).

173. *Id.* at 1149.

174. *Id.*

175. *Id.*

176. *Id.* at 1150.

claim, the reference is relied upon for obviousness.<sup>177</sup> The court, in *Keithley*, found the defendant's argument persuasive and concluded that the chart complied with the Rule 3-3(b).<sup>178</sup>

Rule 3-3(c) requires the accused infringer to produce "[a] chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found."<sup>179</sup> This chart, in large part, mirrors the chart required of the patent claimant's infringement contentions under Rule 3-1(c). The specificity requirement for complying with Rule 3-3(c) also appears to track that of Rule 3-1(c), as indicated by the court in *MEMC Electronic Materials, Inc. v. Mitsubishi Materials Silicon Corp.*,<sup>180</sup> stating that claim charts pursuant to Rule 3-1(c) must be "detailed, claim-by-claim, element-by-element charts."<sup>181</sup>

If the accused infringer's invalidity defense is based upon lack of enablement<sup>182</sup> or failure to meet the written description requirement<sup>183</sup> or indefiniteness,<sup>184</sup> such information must be provided pursuant to Rule 3-3(d).<sup>185</sup> As *Funai Electric Co. v. Daewoo Electronics Corp.*<sup>186</sup> illustrates, failure to indicate a defense of invalidity based on 35 U.S.C. § 112 can result in forfeiture of the accused infringer's right to raise the defense later in the case: "[T]o the extent that Daewoo now presents an entirely new ground for arguing that claims 1, 3 and 4 are indefinite, based on the doctrine of claim differentiation, that argument is waived by Daewoo's failure to include this theory in its invalidity contentions."<sup>187</sup> A careful reading of *Funai* reveals that not only must the accused infringer raise its § 112 defense in its invalidity contentions, but it must state the basis (e.g., claim differentiation or otherwise) for which the asserted claim violates § 112.<sup>188</sup> *Funai* indicates that abandoning an initial theory of how the asserted claim

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177. *Id.*

178. *Id.*

179. N.D. CAL. PATENT L.R. 3-3(c) (2000).

180. *MEMC Elect. Materials, Inc. v. Mitsubishi Materials Silicon Corp.*, No. C 01-4925 SBA, 2006 WL 463525, at \*4 (N.D. Cal. Feb. 24, 2006), *aff'd in part, rev'd in part, and appeal dismissed in part*, 2007 WL 2728376 (Fed. Cir. Sept. 20, 2007).

181. *Id.* at \*4.

182. 35 U.S.C. § 112 ¶ 1 (2006).

183. *Id.*

184. *Id.* § 112 ¶ 2.

185. *See* N.D. CAL. PATENT L.R. 3-3(d) (2000).

186. *Funai Elec. Co. v. Daewoo Electronics Corp.*, 593 F. Supp. 2d 1088 (N.D. Cal. 2009).

187. *Id.* at 1102.

188. *See id.*

violates § 112 for a different theory later in the case can have the practical effect of never having raised a § 112 defense at all.

Noticeably absent from Rule 3-3(d) is a requirement that the accused infringer raise a “best mode”<sup>189</sup> defense, if any, in its invalidity contentions.<sup>190</sup> This apparent ambiguity was resolved in *Fresenius Medical Care Holdings, Inc. v. Baxter International, Inc.*<sup>191</sup> In *Fresenius*, Baxter moved to strike a best mode defense raised by Fresenius on the grounds that the defense was not included in Fresenius’s invalidity contentions.<sup>192</sup> Baxter argued that, because two of the three requirements for patentability under 35 U.S.C. § 112 ¶1, enablement and written description, appear in Rule 3-3(d), disclosure of an invalidity defense based upon the failure to disclose the best mode is implicitly required under the Rule.<sup>193</sup> The court in *Fresenius* readily dispensed with this argument:

Baxter’s argument is based on the flawed premise that the Patent Local Rules require a party to disclose its best mode defense in its . . . Invalidity Contentions. In fact, there is no such requirement. . . . The rationale for this is clear; an accused infringer typically does not have the evidence necessary to establish its best mode defense until much later in the discovery process.<sup>194</sup>

The Northern District has stood firm in its position that an accused infringer need not raise a best mode defense in its invalidity contentions, as indicated by the omission of such a requirement in Rule 3-3(d) of the 2008 revision to its PLRs.<sup>195</sup> Interestingly, at least three district courts that have adopted rules modeled after those of the

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189. In addition to the enablement and written description requirements, 35 U.S.C. § 112 ¶ 1, requires a patent applicant to disclose the “best mode” in the specification of its application, where best mode refers to the best embodiment of the invention known to the inventor at the time the patent application was filed.

190. See N.D. CAL. PATENT L.R. 3-3(d) (2000).

191. *Fresenius Med. Care Holdings, Inc. v. Baxter Int’l, Inc.*, No. C 03-1431 SBA, 2006 WL 1329997 (N.D. Cal. May 15, 2006).

192. *Id.* at \*5.

193. See *id.*

194. *Id.*

195. See N.D. CAL. PATENT L.R. 3-3(d) (2008).

Northern District<sup>196</sup> require the defendant to raise a best mode defense in its invalidity contentions.<sup>197</sup>

Rule 3-4 of the PLRs sets forth the types of documents that must accompany the accused infringer's invalidity contentions.<sup>198</sup> In addition to producing a copy of each prior art reference relied upon in its invalidity contentions (unless such a copy appears in the file history of the patents allegedly infringed),<sup>199</sup> the accused infringer must produce documentation evidencing the operation of the accused instrumentality identified in the patent claimant's Rule 3-1(c) claim chart.<sup>200</sup> If the documents in question are electronic, courts of the Northern District have required that they be produced in their native file format, with original metadata, and be searchable.<sup>201</sup> This requirement has been enforced even where *hundreds of thousands* of documents would require conversion to their native file format.<sup>202</sup>

Rule 3-5 governs a party's disclosure requirements when filing a complaint seeking a declaratory judgment that the party does not infringe a particular patent, or a particular patent is invalid or unenforceable.<sup>203</sup> If a party files such a complaint, and the patentee does not file a counterclaim for infringement, Rules 3-1 and 3-2 (governing a patentee's infringement contentions) do not apply to the case.<sup>204</sup> Under these circumstances, the plaintiff seeking the declaratory judgment must file infringement contentions—conforming to Rule 3-3—no later than ten days after the case management conference or service of the defendant's answer, whichever is later.<sup>205</sup>

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196. For a discussion of other districts' adoption of PLRs modeled after those of the Northern District, *see infra* Part III.A.

197. The Northern District of Georgia: N.D. GA. PATENT L.R. 4.3(a)(4) (2004), *available at* <http://www.gand.uscourts.gov/localrules>; The Eastern District of North Carolina: E.D. N.C. LOCAL PATENT RULE 303.3(b)(4), EDNC (2007), *available at* [http://www.nced.uscourts.gov/flashhtml/LocalRules/NCED-Local\\_Rules.htm](http://www.nced.uscourts.gov/flashhtml/LocalRules/NCED-Local_Rules.htm); The Southern District of California: S.D. CAL. PATENT L.R. 3.3(e) (2006), *available at* <http://www.casd.uscourts.gov/index.php?page=local-rules>.

198. N.D. CAL. PATENT L.R. 3-4 (2000).

199. N.D. CAL. PATENT L.R. 3-4(b) (2000).

200. N.D. CAL. PATENT L.R. 3-4(a) (2000).

201. *See In re Verisign*, No. C 02-02270 JW, 2004 WL 2445243, at \*1-2 (N.D. Cal. Mar. 10, 2004).

202. *Id.*

203. N.D. CAL. PATENT L.R. 3-5(a) (2000).

204. *Id.*

205. *Id.*

As will be discussed in more detail in Part III.B. below, the provisions of Rule 3-6 have been removed from the most recent version of the Northern District's PLRs. Nonetheless, Rule 3-6 (Final Contentions) of the original PLRs will remain relevant for quite some time, as it applies to all cases filed between January 1, 2001 and March 1, 2008.<sup>206</sup> The essential feature of Rule 3-6 is that it enables each party to amend its preliminary contentions, *without leave of court*, in response to particular developments occurring subsequent to service of the preliminary contentions, so long as such amendments are made in "good faith."<sup>207</sup> Specifically, Rule 3-6(a) permits a patent claimant to file "Final Infringement Contentions" within 30 days of the claim construction hearing in response to: (1) the claim construction ruling; and/or (2) documents accompanying the accused infringer's invalidity contentions.<sup>208</sup> The patentee is only permitted to amend its claim chart and theories regarding literal infringement or infringement under the DoE.<sup>209</sup> Conversely, the accused infringer may amend its preliminary contentions in response to receiving final infringement contentions from the patent claimant, or if it believes in good faith that the amendments are necessary in light of the claim construction ruling.<sup>210</sup>

Rule 3-7<sup>211</sup> allows a party, with the court's permission, to amend its preliminary or final infringement/invalidity contentions only upon a showing of "good cause."<sup>212</sup> What constitutes good cause has proven to be the most frequently litigated issue raised by the PLRs.<sup>213</sup> The Federal Circuit addressed Rule 3-7's good cause requirement in *O2 Micro International Ltd. v. Monolithic Power Systems, Inc.*<sup>214</sup> O2 Micro maintained a single theory of infringement in both its preliminary and final infringement contentions.<sup>215</sup> Subsequent to

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206. See *supra* note 96 and accompanying text.

207. N.D. CAL. PATENT L.R. 3-6(a) (2000).

208. *Id.*

209. See *id.*

210. N.D. CAL. PATENT L.R. 3-6(b) (2000).

211. In an effort to avoid confusion, it is worth noting that the provisions of Rule 3-7 in the 2000 PLRs now appear in Rule 3-6 of the 2008 PLRs.

212. N.D. CAL. PATENT L.R. 3-7 (2000).

213. See Matthew L. Ahart, *Litigating Patents: What Every Patent Litigator Needs to Know About Infringement and Invalidity Contentions*, INTELLECTUAL PROPERTY TODAY, <http://www.iptoday.com/articles/2008-6-ahart.asp> (last visited April 21, 2009).

214. See *O2 Micro Int'l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355 (Fed. Cir. 2006).

215. *Id.* at 1360.

servicing its final infringement contentions, O2 Micro deposed an MPS engineer and, from the information obtained at the deposition, decided to pursue a second theory of infringement.<sup>216</sup> Importantly, O2 Micro waited nearly three months after the deposition to file its proposed amended contentions.<sup>217</sup> The district court found that the three month delay constituted a lack of diligence and denied O2 Micro's motion to amend.<sup>218</sup> The court subsequently denied O2 Micro's motion for reconsideration, stating that the O2 Micro had "unreasonably delayed" in filing its motion to amend.<sup>219</sup>

On appeal, the Federal Circuit favorably characterized the Northern District's PLRs as follows:

The local patent rules in the Northern District of California are designed to address [the problem of shifting theories of infringement/invalidity throughout discovery] by requiring both the plaintiff and the defendant in patent cases to provide early notice of their infringement and invalidity contentions, and to proceed with diligence in amending those contentions when new information comes to light in the course of discovery. The rules thus seek to balance the right to develop new information in discovery with the need for certainty as to the legal theories.<sup>220</sup>

The court next turned to the issue of good cause under Rule 3-7. It first noted that judges in the Northern District have interpreted good cause as requiring that a party seeking to amend its preliminary or final contentions—based on new evidence revealed in discovery—act with *diligence* in filing its motion to amend once such evidence is obtained.<sup>221</sup> O2 Micro argued that good cause for amending contentions is met, regardless of a party's diligence in moving to amend, simply because new evidence is obtained during discovery.<sup>222</sup> The court rejected this argument, finding that diligence is the central inquiry for determining good cause under Rule 3-7 and that the burden of proving diligence rests squarely on the party seeking to amend its contentions.<sup>223</sup> Ultimately the court held that, "[g]iven O2 Micro's delay in moving to amend its infringement contentions and

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216. *Id.*

217. *Id.* at 1361.

218. *Id.*

219. *Id.* at 1362.

220. *Id.* at 1365-66.

221. *Id.* at 1363.

222. *Id.* at 1366.

223. *Id.*

its lack of adequate explanation for this delay,” the district court did not abuse its discretion in denying O2 Micro’s motion to amend for lack of good cause.<sup>224</sup>

It was clear after *O2 Micro* that once the period for filing “final” contentions expires, a party seeking to amend its contentions must do so promptly once it receives the information that forms the basis of the proposed amendment. Thus, the diligence discussed in *O2 Micro* relates to how quickly the party moves to amend its contentions once a new theory of infringement (or with respect to an accused infringer, a prior art reference) comes to light. Subsequent to *O2 Micro*, the “boundaries of the diligence requirement” were further examined by the Northern District in *West v. Jewelry Innovations, Inc.*<sup>225</sup> At issue in *West* was whether—in addition to proceeding with diligence in *amending* infringement or invalidity contentions—a party must proceed with diligence in *discovering the information* that forms the basis of the amendment.<sup>226</sup> The court in *West* found that diligence in *both* of these contexts is necessary to establish good cause under Rule 3-7.<sup>227</sup>

In light of *O2* and *West*, the take-home message for meeting the good cause requirement under Rule 3-7 (Rule 3-6 of the 2008 PLRs) is to exhibit diligence in discovering information and diligence in filing the proposed amendment once such information is obtained. However, judges in the Northern District consider additional factors in determining whether to allow a party to amend their contentions, including: (1) whether the amendment will be prejudicial to the non-moving party,<sup>228</sup> (2) whether the opposing party had sufficient notice such that the amendment was foreseeable,<sup>229</sup> and (3) the amendment’s impact, or lack thereof, on other case deadlines.<sup>230</sup>

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224. *Id.* at 1367-68.

225. *West v. Jewelry Innovations, Inc.*, No. C 07-1812 JF (HRL), 2008 WL 4532558, slip op. at \*2 (N.D. Cal. Oct. 8, 2008).

226. *Id.*

227. *Id.*

228. *Fresenius Med. Care Holdings, Inc. v. Baxter Int’l, Inc.*, No. C 03-1431 SBA, 2006 WL 1329997, at \*6 (N.D. Cal. May 15, 2006) (finding sufficient notice and lack of prejudice to the non-moving party as grounds for permitting the addition of a new invalidity defense to the moving party’s invalidity contentions, where the defense was “fully briefed by both parties” at an earlier stage of discovery).

229. *See id.* at \*6-7.

230. *Tessera, Inc. v. Advanced Micro Devices, Inc.*, No. C 05-4063 CW, 2007 WL 1288199, at \*2 (N.D. Cal. April 30, 2007) (“Here, Defendants seek to amend their invalidity

#### 4. Claim Construction Proceedings

Claim construction is a critical first step in determining whether an accused instrumentality infringes a patentee's asserted claims, where "construction" refers to assigning "the meaning and scope of any disputed terms and limiting expressions in the claims."<sup>231</sup> In *Markman v. Westview Instruments, Inc.*,<sup>232</sup> the Supreme Court held that claim construction is a matter of law to be determined by the court, rather than by a jury.<sup>233</sup> The already heavy burden that patent litigation imposed on judicial resources was thus exacerbated by the Court's decision in *Markman*.<sup>234</sup> In the wake of *Markman*, patent cases frequently require a separate hearing to construe the patentee's asserted claims.<sup>235</sup> While the Federal Circuit has granted considerable discretion to the district courts regarding claim construction proceedings, the Court in *Markman* provided little guidance to the district courts "regarding the appropriate procedures and timing for claim construction."<sup>236</sup>

Section 4 of the PLRs governs "Claim Construction Proceedings" that culminate in a claim construction hearing, if necessary. Under Rule 4-1, the parties must—no later than ten days after the accused infringer serves its invalidity contentions—exchange a list of claim terms that each party believes requires construction by the court.<sup>237</sup> After the terms have been exchanged, Rule 4-1 also requires the parties to "meet and confer" in order to resolve any differences and narrow the number of disputed claim terms, but a maximum number of disputed claim terms is not provided in the 2000 version of Rule 4-1.<sup>238</sup> Rule 4-2 requires each party to exchange its proposed *construction* of the terms identified under Rule 4-1.<sup>239</sup> The

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contentions well in advance [sic] of the deadline for any expert reports that may be effected [sic] and briefing on claim construction.").

231. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

232. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

233. *See Id.* at 384.

234. *See* Elizabeth D. Laporte, *Managing the Runaway Patent Case*, ASS'N BUS. TRIAL LAW. REP. FOR N. CAL., Summer 2003, at 6, available at <http://www.abtl.org/report/nc/abtlncorcalvol12no3.pdf>.

235. Julie A. Petruzzelli, *Claim Construction Strategy and Tactics in Litigation*, in *MARKMAN HEARINGS AND CLAIM CONSTRUCTION IN PATENT LITIGATION 2008*, PRACTICING LAW INSTITUTE INTELLECTUAL PROPERTY COURSE HANDBOOK, at 37, 45 (2008).

236. *Id.*

237. N.D. CAL. PATENT L.R. 4-1(a) (2000).

238. N.D. CAL. PATENT L.R. 4-1(b) (2000).

239. *See* N.D. CAL. PATENT L.R. 4-2(a) (2000).



proposed constructions must be accompanied by any extrinsic evidence<sup>240</sup> that the parties intend to rely upon to support their proposed constructions.<sup>241</sup>

Within 60 days of the accused infringer serving its invalidity contentions, the parties must file a “Joint Claim Construction and Prehearing Statement.”<sup>242</sup> The parties must identify in the statement the “claim terms, phrases, or clauses on which the parties agree.”<sup>243</sup> In addition, the statement must include each party’s proposed construction for each disputed term, phrase or clause, with particular references to the patent application, prosecution history, or extrinsic evidence in support of its construction (or in opposition to the opponent’s proposed construction).<sup>244</sup> The statement must also include the “anticipated length of time necessary for the Claim Construction Hearing,”<sup>245</sup> the identification of witnesses, if any, the parties intend to call at the hearing,<sup>246</sup> and any additional issues a party believes merits consideration at the hearing.<sup>247</sup>

*Nordic Naturals, Inc. v. J.R. Carlson Laboratories, Inc.*<sup>248</sup> illustrates the application of, and potentially harsh results from non-compliance with, Rules 4-2 and 4-3.<sup>249</sup> In *Nordic Naturals*, the defendant submitted a declaration *after* the Joint Claim Construction and Prehearing Statement had been filed, but failed to identify the declarant in either its proposed constructions or the statement.<sup>250</sup> The plaintiff’s motion to strike the declaration was granted on grounds that the declaration violated Rules 4-2 and 4-3.<sup>251</sup> Rule 4-3(d) indicates the policy for identifying such witnesses—and the information they intend to provide—well in advance of the claim construction hearing: “to permit a meaningful deposition” of the

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240. See N.D. CAL. PATENT L.R. 4-2(b) (2000). Extrinsic evidence refers to anything that is not intrinsic evidence, including dictionary definitions, text books, technical articles and witness testimony. See *id.*

241. *Id.*

242. N.D. CAL. PATENT L.R. 4-3 (2000).

243. N.D. CAL. PATENT L.R. 4-3(a) (2000).

244. See N.D. CAL. PATENT L.R. 4-3(b) (2000).

245. N.D. CAL. PATENT L.R. 4-3(c) (2000).

246. See N.D. CAL. PATENT L.R. 4-3(d) (2000).

247. See N.D. CAL. PATENT L.R. 4-3(e) (2000).

248. *Nordic Naturals, Inc. v. J.R. Carlson Labs., Inc.*, No. C 07-2385 PJH, 2008 WL 2357312 (N.D. Cal. June 6, 2008).

249. See *id.* at \*10.

250. *Id.*

251. *Id.*

witness by the opposing party in preparation for the claim construction hearing.<sup>252</sup>

All discovery relating to claim construction must be completed no later than 30 days after the joint claim construction and prehearing statement has been filed.<sup>253</sup> Within 45 days of filing the prehearing statement, the claimant must file an opening claim construction brief, to which the opposing party has 14 days to respond with its own brief.<sup>254</sup> If such a responsive brief is filed, the claimant may file a reply brief rebutting the opposing party's arguments.<sup>255</sup> As illustrated in *Competitive Technologies v. Fujitsu Ltd.*,<sup>256</sup> the evidence presented by the claimant in its reply brief is not necessarily restricted to evidence presented by the claimant in the prehearing statement.<sup>257</sup> In *Competitive Technologies*, Fujitsu objected to the claimant's reply brief because the brief included the declaration of an expert who was not identified in the prehearing statement.<sup>258</sup> The court characterized the declaration as "rebuttal" and concluded that Rule 4-5(c) permits the inclusion in the reply brief of evidence not presented in the prehearing statement when such evidence is used to rebut arguments in the accused infringer's responsive brief.<sup>259</sup> After all briefs relating to claim construction have been filed, the court will schedule the claim construction hearing two weeks from the filing of the claimant's reply brief.<sup>260</sup>

### *B. The Patent Local Rules as Adopted in 2008*

In 2006, the Northern District's Patent Local Rules Advisory Subcommittee (the Committee) began deliberations as to whether modification of the PLRs was warranted.<sup>261</sup> In addition to receiving input from—and reviewing the standing orders of—members of its own

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252. N.D. CAL. PATENT L.R. 4-3(d) (2000).

253. N.D. CAL. PATENT L.R. 4-4 (2000).

254. N.D. CAL. PATENT L.R. 4-5(a)-(b) (2000).

255. N.D. CAL. PATENT L.R. 4-5(c) (2000) (stating that the rebutting brief must be filed within 7 days of service of the responsive brief).

256. *Competitive Techs. v. Fujitsu Ltd.*, 286 F. Supp. 2d 1161 (N.D. Cal. 2003).

257. *See id.* at 1169.

258. *Id.*

259. *Id.*

260. *See* N.D. CAL. PATENT L.R. 4-6 (2000).

261. *See* N.D. CAL. PATENT LOCAL RULES ADVISORY SUBCOMMITTEE REPORT 1 (2008) [hereinafter PLRS ADVISORY SUBCOMMITTEE REPORT], available at <http://www.cand.uscourts.gov> (follow "Rules" hyperlink; then follow "Patent Local Rules" hyperlink; then download file "Committee Report") (last visited April 20, 2009).

court, the Committee solicited comments from the community at large regarding perceived strengths and weaknesses of the PLRs.<sup>262</sup> After reviewing the information it gathered from this diverse range of resources, the Committee made the following determinations: (1) the Northern District's unprecedented adoption of PLRs was a sound decision that has been "broadly applauded"; (2) the decision by other district courts to adopt their own PLRs, using the Northern District's PLRs as a model,<sup>263</sup> validated the efficacy of the 2000 PLRs; (3) the input received by the Committee from those familiar with the Northern District's PLRs suggested "meaningful areas for potential improvement"; (4) the development of substantive patent law in the Federal Circuit and Supreme Court warranted an update to the PLRs; and (5) the experience of the Northern District's judges with the PLRs "should inform the proposed revisions to the rules."<sup>264</sup>

#### 1. "Major Conceptual Changes" in the 2008 PLRs

The revised PLRs adopted in 2008 contain "two major conceptual changes."<sup>265</sup> First, with respect to infringement and invalidity contentions, the 2008 PLRs eliminate "the concept of 'preliminary' contentions in favor of a single round of contentions which can be modified only for good cause."<sup>266</sup> Accordingly, the term "preliminary" is absent in Rules 3-1 and 3-3 from the 2008 PLRs, and Rule 3-6 of the 2000 PLRs (Final Contentions) was removed altogether.<sup>267</sup> The Committee explains the rationale for this change as follows:

Under the [2000 PLRs], the litigants disclose preliminary contentions before claim construction and then, as a matter of right, may have an opportunity to reformulate those disclosures as final contentions after claim construction. This is viewed by many as not tying litigants sufficiently to their positions. At the same time, many have critiqued the current amendment process as allowing changes "as of right" in circumstances where such

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262. *See id.* The Northern District publicized its requests for feedback via traditional media, as well as non-traditional media including its own website and patent-related blogs. Further, practitioners from law firms and corporate legal departments were asked to relate their experience with the PLRs to the Committee. *Id.*

263. For a discussion of the influence the Northern District's PLRs have had on other district courts, *see infra* Part IV.B.

264. *See* PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 1-2.

265. *Id.* at 2.

266. *Id.*

267. *See* N.D. Cal. Patent L.R. 3-1, 3-3 (2008).

changes are not in fact warranted, while also creating undue barriers to their amendment when the circumstances do warrant modification.<sup>268</sup>

Thus, the revised PLRs substantially limit the ability of patent claimants and accused infringers to modify their contentions without leave of court as discovery unfolds and further promotes a principal objective of the Northern District's original PLRs to "require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed."<sup>269</sup>

Under the 2008 PLRs, a party may amend its contentions only by order of the court upon a "timely showing of good cause,"<sup>270</sup> the test for which developed during the years subsequent to the enactment of the 2000 PLRs (i.e., the party moving to amend its contentions bears the burden of proving that it was diligent, both in obtaining the information that purportedly warrants the amendment and in moving to amend).<sup>271</sup> Rule 3-6 of the 2008 PLRs expressly provides three examples of circumstances under which good cause may arise:

(a) a claim construction [ruling] different from that proposed by the party seeking amendment; (b) recent discovery of material, prior art despite earlier diligent search; and (c) recent discovery of nonpublic information about the Accused Instrumentality which was not discovered, despite diligent efforts, before the service of the Infringement Contentions.<sup>272</sup>

Rule 3-6 indicates that this list is non-exhaustive and that the court should—even when the three circumstances expressly provided exist—consider prejudice to the non-moving party when issuing its order regarding the motion to amend.<sup>273</sup> From the express references to diligence as a central component of the good cause inquiry and prejudice to the non-moving party as a relevant consideration in deciding whether to permit a proposed amendment, Rule 3-6 clearly incorporates the Federal Circuit's holding in *O2 Micro* and subsequent case law from the Northern District.<sup>274</sup>

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268. PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 2.

269. *Integrated Circuit Sys., Inc. v. Realtek Semiconductor Co.* 308 F. Supp. 2d 1106, 1107 (N.D. Cal. 2004).

270. N.D. CAL. PATENT L.R. 3-6 (2008).

271. *See supra* Part III.A.3.

272. N.D. CAL. PATENT L.R. 3-6 (2008).

273. *Id.*

274. *See supra* Part III.A.3.

The second major change in the 2008 PLRs involves a substantial limitation on the number of disputed claim terms at the claim construction hearing. Specifically, the modified PLRs require the parties to “jointly identify the 10 terms likely to be most significant to resolving the parties’ dispute, including those terms for which construction may be case or claim dispositive”<sup>275</sup> and provide those terms in the joint claim construction and prehearing statement.<sup>276</sup> The rationale for restricting the number of claim terms was articulated by the Committee as follows:

Under the current rules, there is no system for the litigants to identify the most significant claim construction disputes. Such an identification is, in our view, warranted. This is particularly true because litigants tend to identify as many terms as they can for construction to avoid a waiver of rights—even if the construction of all such terms is not necessarily consequential to the disposition of the case. While it is understandable that the litigants do not want to waive their rights, this potential glut of terms for construction can impede the claim construction process. By requiring the 10 most significant terms to be identified, priorities can be identified and resources can most efficiently be deployed to particular claim terms . . . .<sup>277</sup>

This rationale and the Northern District’s solution of limiting the number of disputed claim terms appears to be gaining traction in other district courts. In June 2008, Judge Ron Clark of the Eastern District of Texas required the litigants in *Hearing Components, Inc. v. Shure, Inc.*<sup>278</sup> narrow the number of disputed claim terms to ten, citing the Northern District’s recently adopted Rule 4-1(b) in support of the order.<sup>279</sup>

Rule 4-3(c) provides the procedure to be followed in the probable event that the parties disagree with respect to the ten most significant claim terms.<sup>280</sup> In the joint claim construction statement, the parties must identify their agreed upon “most significant” terms, and then “evenly divide the remainder with each party identifying

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275. N.D. CAL. PATENT L.R. 4-1(b) (2008).

276. N.D. CAL. PATENT L.R. 4-3(c) (2008).

277. PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 2.

278. *Hearing Components, Inc. v. Shure, Inc.*, No. 9:07CV104, 2008 WL 2485426 (E.D. Tex. June 13, 2008).

279. *See id.* at \*1.

280. *See* N.D. CAL. PATENT L.R. 4-3(c) (2008).

what it believes are the remaining most significant terms.”<sup>281</sup> Thus, if the parties agree on six terms, each party is permitted to unilaterally identify two additional terms as most significant in the joint claim construction statement. However, this procedure can result in fewer than ten “most significant” terms appearing in the statement. For example, if the parties reach agreement on only seven claim terms, each party is limited to identifying only one additional term as most significant (for a total of nine).<sup>282</sup>

One can imagine that imposing a strict cap on the number of most significant claim terms would be unreasonable under certain circumstances. For instance, if the litigation involves a multiplicity of patents, ten terms may not suffice for resolving all of the issues in the case. In its report accompanying the 2008 PLRs, the Committee emphasized that limiting the number of claim terms to ten is “a default rule,” and upward (or downward) adjustments to that number “may be warranted by the circumstances of a particular case.”<sup>283</sup> While this flexibility is not expressly provided for in the rules governing claim construction proceedings, the Committee makes special reference to Rule 1-3<sup>284</sup> as authorizing the court to adjust the number of most significant terms when the nature of the litigation warrants doing so.<sup>285</sup> However, the appearance of Rule 4-7 (Good Faith Participation) in the 2008 PLRs emphasizes the litigants’ duty to minimize the number of disputed terms to be construed at the claim construction hearing: “A failure to make a good faith effort to narrow the instances of disputed terms or otherwise participate in the meet and confer process of any of the provisions [governing claim construction proceedings] may expose counsel to sanctions, including under 28 U.S.C. § 1927.”<sup>286</sup>

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281. *Id.*

282. *Id.*

283. PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 2.

284. See N.D. CAL. PATENT L.R. 1-3 (2008) (permitting the court to “modify the obligations or deadlines set forth in [the PLRs] 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.”).

285. PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 2.

286. N.D. CAL. PATENT L.R. 4-7 (2008); 28 U.S.C. § 1927 (2006) (A litigant who “multiplies the proceedings in any case unreasonably and vexatiously may be required by the court to satisfy personally the excess costs, expenses, and attorneys’ fees reasonably incurred because of such conduct.”).

## 2. Other Noteworthy Modifications to the PLRs

In addition to removing the concept of “preliminary” infringement/invalidity contentions and requiring the parties to identify the ten most significant claim terms, the 2008 PLRs include additional modifications of which litigants should be aware. For example, Rule 3-1 requires a patent claimant to provide additional information in its infringement contentions that was not required in the 2000 PLRs. Under Rule 3-1(a), the claimant is now required to identify—for each asserted claim—the applicable subsection of 35 U.S.C. § 271<sup>287</sup> under which the asserted claim is allegedly infringed.<sup>288</sup> Rule 3-1(d) not only requires the plaintiff to notify the accused infringer of the general type of infringement asserted (e.g., direct, induced, contributory, etc.) pursuant to Rule 3-1(a), but also requires identification with a high degree of particularity the activities giving rise to any theories of indirect and joint infringement.<sup>289</sup> With respect to indirect infringement,<sup>290</sup> the claimant must identify the underlying direct infringement and the activities of the alleged indirect infringer that induce or contribute to the direct infringement.<sup>291</sup> Similarly, infringement contentions that allege joint infringement<sup>292</sup> must include the role that each party plays in the direct infringement of an asserted claim.<sup>293</sup> Moreover, infringement contentions in which the claimant intends to assert *willful* infringement must provide the basis for willfulness under Rule 3-1(h).<sup>294</sup> Requiring a more detailed disclosure of the underlying facts supporting an allegation of willful infringement is likely in response to the heightened standard (objective recklessness) for finding willful

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287. See 35 U.S.C. § 271 (2006) (providing the various types of patent infringement, including direct infringement, induced infringement, contributory infringement, and infringement arising from certain activities occurring outside the United States).

288. See N.D. CAL. PATENT L.R. 3-1(a) (2008).

289. See N.D. CAL. PATENT L.R. 3-1(d) (2008).

290. Indirect infringement arises when a party either induces or contributes to an underlying direct infringement of the patent. See 35 U.S.C. § 271(b)-(c) (2006).

291. See N.D. CAL. PATENT L.R. 3-1(d) (2008).

292. Direct infringement that arises from the concerted (joint) acts of multiple parties constitutes joint infringement. For the Federal Circuit’s recent articulation of the test for liability under a theory of joint infringement, see *BMC Res., Inc. v. Paymentech, L.P.*, 498 F.3d 1373, 1380-81 (Fed. Cir. 2007) (stating that a claimant may prevail on a theory of joint infringement upon showing that the accused party “control[s] or direct[s] each step of the patented process.”).

293. See N.D. CAL. PATENT L.R. 3-1(d) (2008) (“Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described.”).

294. See N.D. CAL. PATENT L.R. 3-1(h) (2008).

infringement enunciated by the Federal Circuit in *In re Seagate Technology, LLC*.<sup>295</sup>

The 2008 PLRs also require the patentee to accompany its infringement contentions with additional information relevant to the validity of its own patent set forth in 35 U.S.C. §102.<sup>296</sup> In addition to disclosing *offers to sell* the claimed invention, which appears in Rule 3-2(a) of the 2000 PLRs,<sup>297</sup> the 2008 PLRs require production of documents evidencing any *public use* of the claimed invention prior to the patent application's filing date.<sup>298</sup> Moreover, infringement contentions in cases governed by the 2008 PLRs must be accompanied by documents evidencing ownership of the asserted patents.<sup>299</sup> According to the Committee, this addition to Rule 3-2 "is designed to ensure that issues of subject matter jurisdiction are resolved early" in the case.<sup>300</sup> In light of the above-noted additions to Rules 3-1 and 3-2, putative patent claimants would be well-advised—now more than ever—to "do their homework" before filing claims for infringement in the Northern District. As one commentator notes, the changes appearing in the 2008 PLRs "require plaintiffs to invest more time and energy in a case before filing suit . . . ."<sup>301</sup>

The 2008 PLRs also modify the information required of the accused infringer's invalidity contentions. For example, in response to the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*,<sup>302</sup> Rule 3-3(b) no longer requires an accused infringer to disclose the "motivation to combine" prior art references to support an assertion that the patent is invalid on the basis of obviousness.<sup>303</sup> Rather, invalidity contentions under the 2008 PLRs merely require

295. *In re Seagate Tech., LLC*, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en banc).

296. *See* 35 U.S.C. § 102 (2006).

297. N.D. CAL. PATENT L.R. 3-2(a) (2000).

298. N.D. CAL. PATENT L.R. 3-2(a) (2008).

299. N.D. CAL. PATENT L.R. 3-2(d) (2008).

300. PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 3.

301. Northern District of California Rule Changes 2008, FISH & RICHARDSON NEWS, <http://www.fr.com/news/articledetail.cfm?articleid=860> (last visited April 20, 2009).

302. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418-22 (2007) (holding that the teaching, suggestion, or motivation (TSM) test developed in the Federal Circuit is not mandatory, and a "rigid" application of the TSM test is inappropriate for determining whether a patented claim is invalid as obvious). The Northern District's Patent Local Rules Advisory Subcommittee noted that the previous version of Rule 3-3(b) is "outdated" and the 2008 version conforms "with recent Supreme Court authority on the subject." PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 3.

303. *Compare* N.D. CAL. PATENT L.R. 3-3(b) (2008), with N.D. CAL. PATENT L.R. 3-3(b) (2000).



“an identification of any combinations of prior art showing obviousness,” without any disclosure of the underlying rationale for combining such references.<sup>304</sup> Moreover, if the accused infringer intends to challenge the validity of the asserted claims as non-statutory subject matter under 35 U.S.C. § 101,<sup>305</sup> Rule 3-3(d) requires the basis of the assertion to be disclosed in the invalidity contentions.<sup>306</sup> This additional disclosure requirement is likely in response to the recent resurgence of § 101 as a viable basis for invalidating patents.<sup>307</sup>

### 3. Criticism of the Revised PLRs

Under the 2008 PLRs, the heightened disclosure requirements with respect to infringement and invalidity contentions—combined with the elimination of the “preliminary” contentions concept—has led some commentators to criticize the rules for not affording the parties adequate time to formulate their theories of the case.<sup>308</sup> The increased burden placed upon accused infringers is characterized by one commentator as follows:

For defendants, there will be increased pressure to “scour the earth” for prior art in the first 90 days of the litigation. Defendants can no longer assume that they will be able to add hard-to-find prior art later in the case, thus increasing the pressure to conduct expensive international searches right from the outset of the litigation. Defendants in certain technologies will also be pressured to fully track down long-retired and difficult-to-document prior art products and services—a process that often requires a team of searchers to contact dozens or potentially hundreds of potential leads. To put it simply, the new rules will require plaintiffs to invest more time and energy in a case before filing suit, while

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304. N.D. CAL. PATENT L.R. 3-3(b) (2008).

305. 35 U.S.C. § 101 (2006) (requiring that, in order to be eligible for patent protection, the claimed invention must constitute a “process, machine, manufacture, or composition of matter”).

306. N.D. CAL. PATENT L.R. 3-3(d) (2008).

307. See, e.g., *In re Comiskey*, 499 F.3d 1365, 1378 (Fed. Cir. 2007) (holding that a claim directed to a process for mandatory arbitration did not fall within the enumerated categories of patentable subject matter under § 101 because the claim “depend[ed] entirely on the use of mental processes”); *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007) (holding that a digital signal, standing alone, is not patentable subject matter under § 101).

308. See, e.g., Michael Barclay, *Playing by the Rules*, DAILY JOURNAL, Apr. 11, 2008, available at <http://www.wsgr.com/publications/PDFSearch/Barclay0408.pdf>.

defendants will bear a similar burden during the first four to six months of litigation.<sup>309</sup>

In addition to its effect on accused infringers, the removal of the preliminary contentions concept has been criticized as unduly burdensome on patent claimants: “[U]nder the 2008 scheme, the initial contentions effectively *are* ‘final.’ In a complex patent case, this is a serious problem—the patent owner often needs discovery about the confidential details of the accused infringing device to prepare its final infringement contentions . . . .”<sup>310</sup>

It should be noted that the concept of making initial contentions “final” did not originate in the Northern District. For instance, the Eastern District of Texas preceded the Northern District in eliminating the concept of “preliminary” contentions from its PLRs.<sup>311</sup> The Eastern District of Texas still allows amendments to contentions without leave of court, but only in response to a claim construction ruling adverse to the party seeking amendment.<sup>312</sup> Similarly, the Northern District’s 2008 PLRs expressly mention adverse claim construction rulings as an event that may support a finding of good cause for the purpose of amending contentions.<sup>313</sup> However, because the 2008 PLRs provide that particular developments “may” be sufficient for finding good cause,<sup>314</sup> a degree of uncertainty exists as to whether good cause will actually be found by a particular judge. Some have argued that the good cause standard set forth in *O2 Micro*, by the Federal Circuit, has been applied inconsistently by judges in the Northern District: “[T]here is no ‘well-established ‘good cause’ test’ under the case law interpreting [Rule 3-6 (2008)], so the parties are effectively left at the mercy of their assigned judge’s view on what constitutes ‘good cause.’”<sup>315</sup> The future application of Rule 3-6 (2008) by judges in the Northern District will determine whether concerns regarding the purported uncertainty of the good cause requirement are indeed justified. Interestingly, the two judicial districts to most recently adopt PLRs

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309. Northern District of California Rule Changes 2008, *supra* note 301.

310. Barclay, *supra* note 308.

311. *See* E.D. TEX. P. R. 3-1 (2005) (amended 2007).

312. *See* E.D. TEX. P. R. 3-6(a) (2005) (amended 2007).

313. N.D. CAL. PATENT L.R. 3-6 (2008).

314. *Id.*

315. Barclay, *supra* note 308.

have incorporated the Northern District's framework of making initial contentions "final" and allowing amendments only for good cause.<sup>316</sup>

There are indications that judges in the Northern District will take a common sense approach to applying the revised PLRs, taking into consideration the circumstances of a particular case. In an interview conducted shortly before the effective date of the revised PLRs, Northern District Judge Jeremy Fogel reinforced the notion that the PLRs are guidelines to which exceptions may be granted when warranted.<sup>317</sup> With respect to identification of the ten most significant claim terms, Fogel stated: "If somebody comes in and says there are 15 patents at issue and says, 'We can't do it with 10 claims,' then I'll say, 'Let's talk about it.'"<sup>318</sup> This notion of applying the PLRs in a flexible manner depending on the particularities of a given case is in accordance with the PLRs themselves,<sup>319</sup> and judges in the Northern District appear willing to apply the rules so as to avoid undue burdens on the parties.

#### IV. ENDORSEMENT OF THE NORTHERN DISTRICT'S PATENT LOCAL RULES AND ADOPTION OF SUBSTANTIALLY SIMILAR PLRS IN OTHER JURISDICTIONS

The Northern District's Patent Local Rules Advisory Subcommittee noted in its report accompanying the 2008 PLRs that the District's decision to promulgate local rules governing the disclosures (and timing of such disclosures) in patent-related cases has been "broadly applauded."<sup>320</sup> First, an overwhelming majority of commentators have endorsed the Northern District's PLRs.<sup>321</sup> Second,

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316. See *infra* notes 366-367 and accompanying text.

317. Zusha Elinson, *Courts New Rules to Streamline IP Cases*, THE RECORDER, Feb. 29, 2008, available at <http://www.law.com/jsp/article.jsp?id=900005560477>.

318. *Id.*

319. See N.D. CAL. PATENT L.R. 1-3 (2008) ("The Court may modify the obligations or deadlines set forth in these Patent Local 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.").

320. PLRS ADVISORY SUBCOMMITTEE REPORT, *supra* note 261, at 1.

321. See MICHAEL C. SMITH, EASTERN DISTRICT OF TEXAS PATENT RULES, AIPLA SPRING MEETING 1, 4 (2004) ("Courts and commentators have noted that the Northern District's patent rules improve the litigation process . . ."), available at [http://mcsmith.blogs.com/eastern\\_district\\_of\\_texas/2004\\_patent\\_rules\\_ed\\_texas.pdf](http://mcsmith.blogs.com/eastern_district_of_texas/2004_patent_rules_ed_texas.pdf); see also William F. Lee & Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J.L. & TECH. 55, 79 (1999) ("Because, under these rules, the parties must adhere to a variety of mandatory initial disclosures, the discovery process is more productive.").

the Committee's assertion is supported by a number of developments in other judicial districts following the Northern District's adoption of PLRs in 2000. The following discussion highlights these developments, which include the express endorsement of the Northern District's PLRs by the Federal Circuit, the decision of individual judges in other districts to apply the Northern District's PLRs to their own patent cases, voluntary requests by patent litigants in other district courts that the Northern District's PLRs be applied to their cases, and—perhaps most importantly—the adoption of substantially similar patent local rules in other judicial districts on a district-wide basis. This Part also provides a comparison of the Northern District's PLRs with those of other districts.

#### *A. Favorable Review of the PLRs by the Federal Circuit*

The Federal Circuit has reviewed four cases in which the PLRs of the Northern District were at issue.<sup>322</sup> As the following discussion indicates, the court decided in favor of the Northern District's application of the PLRs in each case. In *Genentech, Inc. v. Amgen, Inc.*, the Federal Circuit reviewed the Northern District's application of Civil Local Rule 16-9,<sup>323</sup> the predecessor rule to PLRs 3-1(d) (2000) and 3-1(e) (2008) requiring the patent claimant to disclose in a claim chart whether the alleged infringement is literal or under the doctrine of equivalents.<sup>324</sup> The court held that the Northern District did not abuse its discretion in denying Genentech's motion to amend its claim chart to include infringement theories under the doctrine of equivalents.<sup>325</sup> The court in *Genentech* articulated the factors for determining whether a district court's application of patent local rules constitutes an abuse of discretion: "[T]his court determines 'whether (1) the decision was clearly unreasonable, arbitrary, or fanciful; (2) the decision was based on an erroneous conclusion of law; (3) the court's findings were clearly erroneous; or (4) the record contains no evidence upon which the court rationally could have based its decision.'"<sup>326</sup> Importantly, *Genentech* provided the first indication by

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322. See *Genentech, Inc. v. Amgen, Inc.*, 289 F.3d 761 (Fed. Cir. 2002); *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278 (Fed. Cir. 2005); *Safeclick, LLC v. Visa Int'l Serv. Ass'n*, 208 Fed. Appx. 829 (Fed. Cir. 2006); *O2 Micro Int'l, Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355 (Fed. Cir. 2006).

323. See *Genentech*, 289 F.3d at 773-74.

324. See N.D. CAL. PATENT L.R. 3-1(d) (2000); N.D. CAL. PATENT L.R. 3-1(e) (2008).

325. See *Genentech*, 289 F.3d at 774.

326. *Id.* (citing *In re Cambridge Biotech Corp.*, 186 F.3d 1356, 1369 (Fed. Cir. 1999)).

the Federal Circuit of its willingness to defer to “local attempts to manage patent cases according to prescribed guidelines,”<sup>327</sup> signaling its approval of the Northern District’s PLRs to reign in patent litigation.

The next Federal Circuit case to review the Northern District’s PLRs was *SanDisk Corp. v. Memorex Products, Inc.*<sup>328</sup> The central issue in *SanDisk* was the Northern District’s claim construction ruling—which was adverse to SanDisk—that necessitated the grant of summary judgment of non-infringement.<sup>329</sup> SanDisk appealed the district court’s grant of summary judgment in favor of the accused infringers to the Federal Circuit.<sup>330</sup> The Federal Circuit vacated and remanded the district court’s claim construction ruling.<sup>331</sup> Nonetheless, Pretec (an accused infringer) urged the court to affirm the district court’s judgment of non-infringement based upon a claim construction argument that Pretec presented at the trial court level.<sup>332</sup> The Northern District earlier refused to enter Pretec’s argument because it was untimely under the PLRs.<sup>333</sup> The Federal Circuit held that the Northern District did not abuse its discretion in refusing to enter Pretec’s untimely argument.<sup>334</sup> Accordingly, the Federal Circuit also refused to consider Pretec’s argument when it was reintroduced on appeal, stating that “this court gives broad deference to the trial court’s application of local procedural rules in view of the trial court’s need to control the parties and flow of litigation before it.”<sup>335</sup>

In 2006, the Federal Circuit again reviewed the application of the Northern District’s PLRs in *Safeclick, LLC v. Visa International Service Ass’n*.<sup>336</sup> In *Safeclick*, Visa moved for summary judgment of non-infringement in response to Safeclick’s timely filing of final infringement contentions.<sup>337</sup> Safeclick answered Visa’s motion with an explanation of its infringement theory, which Visa alleged was

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327. *Id.*

328. *See* *Sandisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278 (Fed. Cir. 2005).

329. *Id.* at 1283 (“In this case there are no disputed material facts at issue. The judgment turns solely on claim construction, which the court reviews *de novo*.”).

330. *Id.* at 1280.

331. *Id.* at 1292.

332. *Id.*

333. *Id.*

334. *Id.* (“Pretec shows no abuse of discretion in the district court’s ruling, and indeed we discern none.”).

335. *Id.*

336. *See* *Safeclick, LLC v. Visa Int’l Serv. Ass’n*, 208 Fed. Appx. 829 (Fed. Cir. 2006).

337. *Id.* at 832.

“materially different” from the theory set forth in Safeclick’s final infringement contentions.<sup>338</sup> The Northern District agreed with Visa that Safeclick violated the PLRs by “deviating from its Final Infringement Contentions.”<sup>339</sup> The court granted summary judgment in favor of Visa and Safeclick appealed to the Federal Circuit, alleging that the Northern District’s refusal to consider Safeclick’s most recent infringement theory constituted an abuse of discretion.<sup>340</sup> After characterizing its review of the Northern District’s application of PLRs as “very deferential,”<sup>341</sup> the Federal Circuit held that the district court did not abuse its discretion in refusing to consider Safeclick’s “new” theory of infringement.<sup>342</sup>

The most recent Federal Circuit review of the Northern District’s application of the PLRs is found in *O2 Micro International Ltd. v. Monolithic Power Systems, Inc.*<sup>343</sup> As discussed in Part III.A.3 above, the Federal Circuit, in *O2*, interpreted the “good cause” requirement for amending infringement or invalidity contentions under Rule 3-7 of the 2000 PLRs, corresponding to Rule 3-6 of the 2008 PLRs.<sup>344</sup> *O2* held that *diligence* in amending contentions is a prerequisite for satisfying the good cause requirement.<sup>345</sup> The language found in *O2* arguably provides the strongest endorsement of the Northern District’s PLRs by the Federal Circuit. The court described the underlying rationale of the PLRs’ good cause requirement as “seek[ing] to balance the right to develop new information in discovery with the need for certainty as to the legal theories.”<sup>346</sup> Further, in assessing the efficacy of the requirements for amending contentions under the PLRs, the court noted: “If the parties were not required to amend their contentions promptly after discovering new information, the contentions requirement would be virtually meaningless as a mechanism for shaping the conduct of discovery and trial preparation.”<sup>347</sup> Thus, it is readily apparent from the language in

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338. *Id.* at 832-33.

339. *Id.* at 833.

340. *Id.*

341. *Id.* at 834.

342. *Id.* at 836.

343. *O2 Micro Int’l, Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355 (Fed. Cir. 2006).

344. *See id.* at 1366; N.D. CAL. PATENT L.R. 3-7 (2000); N.D. CAL. PATENT L.R. 3-6 (2008).

345. *O2 Micro Int’l.*, 467 F.3d at 1366.

346. *Id.*

347. *Id.*

O2 that the Federal Circuit finds the Northern District's PLRs to be a rational solution for effectively managing patent-related cases.

*B. Adoption of Patent Local Rules in Other Jurisdictions*

Shortly after the Northern District adopted its PLRs in 2000, judges and litigants in other districts took notice of the potential benefits of applying the Northern District's PLRs to their own cases. Less than six months after the Northern District's original PLRs took effect, Judge T. John Ward from the Eastern District of Texas began to apply "Rules for Practice for Patent Cases" to his own cases that "track[ed] closely the 2001 version of the Northern District of California patent rules."<sup>348</sup> Further, *litigators* on both sides of patent cases in districts without PLRs requested that courts apply the Northern District's PLRs to their cases.<sup>349</sup> In 2003, for example, the litigants in *Watson Industries, Inc. v. Murata Electronics North America, Inc.* requested that the Northern District's PLRs be applied to their case.<sup>350</sup> The court, which admittedly took "a *laissez faire* approach to discovery," granted the request.<sup>351</sup> In districts where PLRs were not formally adopted, the phenomenon of judges applying to their own patent cases rules identical or substantially similar to the PLRs of the Northern District became prevalent.<sup>352</sup>

About three and a half years after the Northern District's PLRs took effect, other judicial districts began to formally adopt district-wide PLRs.<sup>353</sup> Even a cursory examination of these other districts' PLRs reveals that—rather than drafting their own patent rules *de novo*—

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348. SMITH, *supra* note 321, at 4.

349. See J. Christopher Carraway, *Discovery Issues in Patent Cases*, in 1 PATENT LITIGATION 2008, PRACTICING LAW INSTITUTE INTELLECTUAL PROPERTY COURSE HANDBOOK, at 465, 471 (2008) ("attorneys in cases pending in other districts often propose to the court as part of their Rule 16 or 26 report a schedule modeled after [the Northern District's PLRs].").

350. See *Watson Indus., Inc. v. Murata Elecs. N. Am., Inc.*, No. 02-C-524-C, 2003 WL 23315779, at \*1 (W.D. Wis. Aug. 7, 2003). ("At the outset of this lawsuit, the parties agreed between themselves to be governed by the patent local rules of the Northern District of California. . . . Because this court takes a *laissez faire* approach to discovery, it allowed the parties to self-govern their pretrial conduct as they wished.").

351. *Id.*

352. Dennis Crouch, *Revising the Northern District's Local Patent Rules*, Patently-O, [http://www.patentlyo.com/patent/2006/11/revising\\_the\\_no.html](http://www.patentlyo.com/patent/2006/11/revising_the_no.html) (Nov. 27, 2006) ("The Northern District of California patent rules have served as a set of model for a number of districts contemplating their own patent specific local rules. In addition, many district judges across the country require litigants to follow some form of the rules.").

353. For instance, the Patent local rules adopted by the Northern District of Georgia became effective on July 15, 2004. See N.D. Ga. Patent L.R. 1.3 (2004).

these districts began “adopting the Northern District’s patent local rules, or extremely close variations.”<sup>354</sup>

The first district to join the Northern District in promulgating patent local rules was the Northern District of Georgia (effective July 15, 2004),<sup>355</sup> followed by the Eastern District of Texas (effective February 22, 2005),<sup>356</sup> the Western District of Pennsylvania (effective April 1, 2005),<sup>357</sup> the District of Minnesota (effective February 9, 2006),<sup>358</sup> the Southern District of California (effective April 3, 2006),<sup>359</sup> the Northern District of Texas (effective May 1, 2007),<sup>360</sup> the Eastern District of North Carolina (effective September 17, 2007),<sup>361</sup> and the Southern District of Texas (effective January 1, 2008).<sup>362</sup>

Most recently, the District of New Jersey<sup>363</sup> and the Western District of Washington<sup>364</sup> adopted PLRs effective January 1, 2009. It is readily apparent that the PLRs from these two districts were heavily influenced by the Northern District’s 2008 PLRs. Indeed, the District of New Jersey’s Local Patent Rules Committee explained:

As a starting point, the Committee surveyed all districts where local patent rules were then in effect. Based on that review, the Committee concluded that it would use the Patent Local Rules of the Northern District of California as a template, with variants as

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354. See Carraway, *supra* note 349, at 471; see also Douglas R. Nemecek & Emily J. Zelenock, *Rethinking the Role of the Written Description Requirement in Claim Construction: Whatever Happened to “Possession is Nine-Tenths of the Law?”*, 8 MINN. J. L. SCI. & TECH. 357, 397 n.157 (2007) (“The Northern District of California was the first district to implement patent local rules. All districts to subsequently adopt patent local rules have modeled their rules closely on the Northern District of California rules.”).

355. See N.D. GA. PATENT L.R. 1.3 (2004).

356. See E.D. TEX. P. R. 1-3 (2005).

357. See W.D. PA. LPR 1.4 (2005).

358. See Petruzzelli, *supra* note 235, at 57 (Amended Local Rule 16.2, effective February 9, 2006, “requires that the parties in a patent case use a special form for the Rule 26(f) Report which requires that the parties provide a detailed discovery plan, including the exchange of claim charts, a meet and confer regarding proposed claim constructions, identification of extrinsic evidence, and requests for a claim construction hearing.”); D. MINN. LR 16.2, Form 4 (2006).

359. See S.D. CAL. PATENT L.R. 1.2 (2006)

360. See Petruzzelli, *supra* note 235, at 58.

361. See LOCAL PATENT RULE 301.3, EDNC (2007).

362. See S.D. TEX. P. R. 1-3 (2008).

363. See D. N.J. L. PAT. R. 1.4 (2009).

364. See W.D. WASH. LOCAL PATENT RULE 102 (2009); W.D. Wash. General Order No. 08-04 (2008).



may be appropriate in light of the practices, procedures, and Local Civil Rules that have been followed in this District.<sup>365</sup>

Like the Northern District's 2008 PLRs, the PLRs of the District of New Jersey and Western District of Washington lack the concept of preliminary contentions.<sup>366</sup> Further, these PLRs do *not* provide for amendments to contentions without leave of court, but rather require a showing of good cause by the party moving to amend.<sup>367</sup> Moreover, the rules from the districts analogous to the Northern District's Rule 3-6 (2008) expressly set forth the same types of circumstances that may support a finding of good cause.<sup>368</sup> The analogous rule from the District of New Jersey additionally includes service of invalidity contentions arising under the "Hatch-Waxman Act"<sup>369</sup> as a circumstance upon which good cause may be found.<sup>370</sup> The fact that the most recent districts to adopt PLRs modeled their rules after those of the Northern District is indicative that the Northern District's PLRs remain at the cutting edge of patent case management.

Tables in the Appendix of this article contain key provisions of the Northern District Patent Local Rules and those of six other districts: the Southern District of California, The Northern District of Texas, The Eastern District of Texas, the District of Minnesota, the Western district of Pennsylvania, and the Northern District of Georgia. The side-by-side comparison allows one to see how these districts have addressed the same subject matter. These charts illustrate the variety of procedures which the enumerated districts have taken in promulgating local rules for patent cases. In each of the enumerated districts, resolution of claim construction issues comes

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365. D. N.J. LOCAL PATENT RULES COMMITTEE, EXPLANATORY NOTES TO PROPOSED LOCAL PATENT RULES 32 (2008), available at <http://www.njd.uscourts.gov/rules/LocalRules-1-1-09.pdf>.

366. See D. N.J. L. PAT. R. 3.1 (2009); see also W.D. WASH. LOCAL PATENT RULE 120 (2009).

367. See D. N.J. L. PAT. R. 3.7 (2009); see also W.D. WASH. LOCAL PATENT RULE 124 (2009).

368. See *supra* note 272 and accompanying text.

369. See Matthew Avery, *Continuing Abuse of the Hatch-Waxman Act by Pharmaceutical Patent Holders and the Failure of the 2003 Amendments*, 60 HASTINGS L.J. 171, 173 n.12 (2008). The Hatch-Waxman Act is shorthand for the Drug Price Competition and Patent Term Restoration Act of 1984, (codified as amended at 21 U.S.C. § 355(j) (2006), 35 U.S.C. §§ 156, 271(e) (2006)). *Id.* An ANDA (abbreviated new drug application) applicant is required to make one of four certifications regarding a pharmaceutical it seeks to copy. One such certification is that the pharmaceutical patent at issue "is invalid or will not be infringed by the manufacture, use, or sale of the generic drug for which the [ANDA] is submitted." *Id.* at 176.

370. See D. N.J. L. PAT. R. 3.7 (2009).

relatively early in the litigation, but not before the parties have been required to disclose to the opponent information, far beyond the narrow issue of what meaning the party asks the court to adopt.

#### V. FEDERAL RULES OF PATENT PROCEDURE

Since the *Markman* decision, the claim construction order has become the focal point of patent infringement cases.<sup>371</sup> Except for rare cases, the ultimate determination of infringement or invalidity depends upon the interpretation which the trial judge gives to the words and phrases in the patent claim.<sup>372</sup> Naturally, this determinative effect which claim construction has on the other issues in the litigation heightens concerns by the parties about the fairness of the procedures. This Part invites consideration of whether these procedures should continue to be left in the domain of standing orders of individual judges or of local rules of individual districts or whether the procedures should be considered an appropriate area for national rules. The question for consideration is whether there should be Federal Rules of Patent Procedures (FRPP).

Recognizing that having specialized rules of procedure raises myriad issues, this Section does not attempt to identify or address all of those issues. The concept is discussed to suggest that this area of the law would benefit from appointment of an advisory committee which would host a healthy conversation about the benefit of national procedures.

The Federal Rules of Civil Procedure proceed from an inherent premise that civil litigation should be regulated by national rules which are neutral with respect to the substantive subject matter involved in the case. An obvious benefit of this neutrality is the efficiency which is achieved from reaching the substantive decision point by following a single well-established procedure.<sup>373</sup> Similarly, where the matter is purely substantive, one can recognize the benefit from having no defined procedure but instead leaving the decision-maker free to make the substantive decision under a variety of

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371. See Christopher A. Cotropia, *Patent Claim Interpretation and Information Costs*, 9 LEWIS & CLARK L. REV. 57, 74-75 (2005).

372. *Id.* at 75.

373. See Glenn S. Koppel, *Toward a New Federalism in State Civil Justice: Developing a Uniform Code of State Civil Procedure Through a Collaborative Rule-Making Process*, 58 VAND. L. REV. 1167, 1193 n.131, 1194-95 (2005).

procedures.<sup>374</sup> Most civil litigation is an amalgamation of mandated procedures which do not dictate the substantive outcome, and mandated substance rules with no required procedure. The FRCP effectively mandates that all district courts and parties follow an established procedure for all civil cases.<sup>375</sup> The Markman decision effectively mandated that all district courts make certain decisions unique to patent litigation.<sup>376</sup> The district courts were left on their own to figure out what procedures should be imposed on themselves and the parties in making those unique decisions.<sup>377</sup> In the absence of national standards, district courts filled the procedural void between the mandates of the FRCP and those of *Markman* with local rules.<sup>378</sup> Federal Rules of Patent Procedure would fill this void with national procedures.

Patent litigation is a well-recognized area of national practice.<sup>379</sup> There are already national rules which govern litigation and other procedures unique to patent cases when they are the subject of proceedings before the Patent and Trademark Office (PTO).<sup>380</sup> There are also national rules which govern practice in patent cases before the Federal Circuit.<sup>381</sup> An appropriate question is whether there should be national rules governing the unique aspects of patent cases in proceedings before the district courts.

An argument can be made that there are already national rules of patent procedure which govern district courts, albeit derivable only by combining a variety of sources. Federal Rules of Patent Procedures would involve encapsulating those rules in one comprehensive set. For example, a major part of the claim construction process is the rules of evidence which must be followed in the interpretation of the

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374. See Erwin Chermerinsky & Barry Friedman, *The Fragmentation of Federal Rules*, 46 MERCER L. REV. 757, 779 (1995).

375. FED. R. CIV. P. 1.

376. See Michael A. O'Shea, *A Changing Role for the Markman Hearing: In Light of Festo IX, Markman Hearings Could Become M-F-G Hearings Which Are Longer, More Complex and Ripe for Appeal*, 37 CREIGHTON L. REV. 843, 843 (2004).

377. *Id.* at 844-45; Edward Brunet, *Markman Hearings, Summary Judgment, and Judicial Discretion*, 9 LEWIS & CLARK L. REV. 93, 94-95 (2005).

378. Brunet, *supra* note 377, at 105-06; see also *supra* Part IV.B for a discussion of other districts, besides the Northern District of California, that have promulgated their own local rules.

379. Fla. Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank, 527 U.S. 627, 651 nn.2-3 (1999) (Stevens, J. dissenting).

380. See, e.g., 35 U.S.C. §§ 2, 146, 311 (2006).

381. See, e.g., 35 U.S.C. §§ 141-43 (2006).

meaning of words and phrases used in the patent claim.<sup>382</sup> Through a series of cases, the Federal Circuit and the Supreme Court have articulated these rules of evidence.<sup>383</sup> As a further example, an important issue in patent litigation often before the district court is the processes and procedures which were conducted before the PTO.<sup>384</sup> There are rules which govern what deference should be given to the PTO process by the district courts.<sup>385</sup>

In addition to encapsulating these and other areas, having Federal Rules of Patent Procedure could address a number of jurisprudential concerns:

**Neutrality.** An aspiration of a national advisory committee would be to create prehearing disclosure rules which are neutral, i.e., not structurally slanted toward any one side of the litigation. Balanced procedures should provide an alleged patent owner on one side of the case and an alleged patent infringer on the other side with a process that fairly supports the ultimate goal of a judicial decision which is accurate and which is reached after every participant has been fully heard.

**Uniformity.** Because of the number of districts that have patterned local rules after the Northern District Patent Local Rules, a de facto set of national rules for practice before the district courts is quickly developing.<sup>386</sup> However, as discussed above, there are significant variations among the procedures in the districts resulting in a less-than-ideal situation. Practitioners are confronted with learning new rules of procedure for every district and sometimes for various judges within the district. There are still districts where individual judges enforce personal rules of procedure.<sup>387</sup> A motivation

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382. See Ware, *supra* note 4, at 751-52, 755.

383. *Id.* at 751-52, 769.

384. See Mathew Eggerding, *Dependent Patent Claims and Prosecution History Estoppel: Weakening the Doctrine of Equivalents*, 50 ST. LOUIS U. L.J. 257, 274-75 (2005).

385. See Stuart Minor Benjamin & Arti K. Rai, *Who's Afraid of the APA? What the Patent System Can Learn from Administrative Law*, 95 GEO. L.J. 269, 326-27 (2007).

386. See Ellisen S. Turner, *Swallowing the Apple Whole: Improper Patent Use by Local Rule*, 100 MICH. L. REV. 640, 640 (2002).

387. See, e.g., Dabney Carr, *Does the Eastern District of Virginia Need Local Patent Rules?*, VA. IP LAW, Feb. 24, 2009, <http://www.virginiaiplaw.com/2009/02/articles/patent-litigation/does-the-eastern-district-of-virginia-need-local-patent-rules> ("The E.D.Va. . . . has no local rules for patent cases. Rather, the three divisions of the court, and even judges in the same division, follow different procedures for dealing with their cases and different ways of handling patent cases.").

for adopting national rules would be to reduce the number of personal procedures required by individual judges.<sup>388</sup>

**Authority.** The authoritative power of any rule is directly related to its source. While local rules derive their authority from the power given to districts by the FRCP,<sup>389</sup> they must be construed in a manner consistent with the national rules. When there is uncertainty, deference must be given to the national rules. Federal Rules of Patent Procedure promulgated by the Judicial Conference of the United States and codified by Congress would remove any uncertainty or hesitation inherent in enforcing local versus national rules.

**Efficiency.** One of the main reasons for cost and delay in civil litigation is the expense and time required when parties must resort to a motion to resolve a dispute.<sup>390</sup> Patent cases often involve high-stakes litigation, with parties willing to devote substantial resources to proving their respective positions and being extremely cautious about disclosing information to an opposing party.<sup>391</sup> National rules with presumptive time limits, disclosure obligations, automatic protective orders, and other orderly procedures would alleviate these matters from those subjects for which the parties would need to resort to motions in order to receive guidance from the court.

## VI. CONCLUSION

In order to address the unique challenges that arise during patent-related litigation, the Northern District of California adopted Patent Local Rules on December 1, 2000. The PLRs represent a significant departure from the default notice pleading standard for civil litigation in federal district courts.<sup>392</sup> Rather than permitting litigants to “hide the ball” with respect to their infringement or invalidity theories, the PLRs require patent claimants and accused infringers to serve detailed contentions early in the case. Patentees must reveal each claim allegedly infringed, identify the accused instrumentality, and provide a chart that indicates where each element of each asserted claim is found within the accused instrumentality. Conversely, accused

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388. “Personal procedures” are distinguished from specific orders made in a particular case which deviates from the local rules due to the needs of the case.

389. FED. R. CIV. P. 83.

390. See RAUMA & STIENSTRA, *supra* note 43, at 2.

391. See Christopher A. Harkins, *Tesla, Marconi, and the Great Radio Controversy: Awarding Patent Damages Without Chilling a Defendant’s Incentive to Innovate*, 73 Mo. L. Rev. 745, 766-67 (2008).

392. See *supra* Part III.A.3.

infringers who intend to invalidate the claimant's patent must reveal their theories of invalidity with great particularity. The PLRs also require litigants to disclose detailed information relevant to the claim construction hearing, including the identification of claim terms that each party believes merits construction and proposed constructions of those terms. In 2008, the Northern District adopted a revised set of PLRs that makes it more difficult for litigants to amend their original contentions, and also forces litigants to minimize the number of claim terms to be construed by the court at the claim construction hearing.

The Northern District's PLRs have been well-received by courts, litigators, and commentators alike. The Federal Circuit has expressly endorsed the Northern District's PLRs as a rational solution for managing patent litigation. Shortly after the implementation of PLRs in the Northern District, judges and litigators in other district courts recognized the benefits of applying identical or similar PLRs to their cases. This trend has culminated in the district-wide adoption of substantially similar local rules in a growing number of district courts across the country. However, substantive differences exist between patent local rules among jurisdictions, and the majority of district courts have yet to adopt uniform rules governing patent cases. Accordingly, the potential benefits of implementing national rules for patent case management—namely Federal Rules of Patent Procedures—merit consideration.

## APPENDIX

**Table 1.** Infringement Contentions

N.D. CAL. (2008)	<p>Not later than 10 days after the initial case management conference, a party claiming patent infringement shall serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions” that shall contain the following information:</p> <p>(a) each claim of each patent in suit that is allegedly infringed;</p> <p>(b) for each claim, each accused device of each opposing party of which the party is aware (this identification shall be as specific as possible);</p> <p>(c) a chart identifying specifically where each limitation of each asserted claim is found within each accused device (including recited structure for means-plus-function claims);</p> <p>(d) for each claim which is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged direct infringer that contribute to or are inducing that direct infringement (the role of each party must be described for multiple parties);</p> <p>(e) whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the accused device;</p> <p>(f) for any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;</p> <p>(g) if a party wishes to preserve the right to rely on its own device for any reason, the party shall identify, separately for each asserted claim, each device that incorporates or reflects that claim; and</p> <p>(h) the basis for any willful infringement allegation.<sup>393</sup></p>
S.D. CAL.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R. except that it excludes items (d) and (h). <sup>394</sup>
N.D. TEX.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except that it excludes items (d) and (h) and further provides: Failure to comply with the requirements of this paragraph, including the requirement of specificity and detail in contending infringement, may result in appropriate sanctions, including dismissal. <sup>395</sup>

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393. N.D. CAL. PATENT L.R. 3-1 (2008).

394. S.D. CAL. PATENT L.R. 3.1 (2006).

395. N.D. Tex. Miscellaneous Order No. 62 3-1 (2007).

**Table 1.** (continued)

E.D. TEX.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except that it excludes items (d) and (h). <sup>396</sup>
D. MINN.	Parties can recommend deadline for submitting plaintiff's infringement contentions and claim chart in Rule 26(f) report. Plaintiff's claim chart shall identify: (1) which claim(s) of its patent(s) it alleges are being infringed; (2) which specific products or methods of defendant's it alleges literally infringe each claim; and (3) where each element of each claim listed in (1) is found in each product or method listed in (2), including the basis for each contention that the element is present. If there is a contention by Plaintiff that there is infringement of any claims under the doctrine of equivalents, Plaintiff shall separately indicate this on its claim chart and, in addition to the information required for literal infringement, Plaintiff shall also explain each function, way, and result that it contends are equivalent, and why it contends that any differences are not substantial. <sup>397</sup>
W.D. PENN.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except that it excludes items (d) and (h) and provides for a 30 day period for service of the disclosure. <sup>398</sup>
N.D. GA.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except that it excludes items (d), (g) and (h), <sup>399</sup> and has a 30-day period for service of the disclosure. <sup>400</sup> The Rules further provide: A defendant responding to a declaratory judgment action and pleading infringement of a patent in counterclaim shall first make its disclosure within 30 days after service of the plaintiff's Disclosure of Invalidity Contentions. A defendant opposing a claim of patent infringement shall first make its Disclosure of Invalidity Contentions and its Response to Infringement within 30 days after the plaintiff's Disclosure of Infringement Contentions. <sup>401</sup>

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396. E.D. TEX. P. R. 3-1 (2005) (amended 2007).

397. D. MINN. LR 16.2, Form 4 ¶ (f)(1) (2006).

398. W.D. PA. LPR 3.2 (2008).

399. N.D. GA. PATENT L.R. 4.1 (2004).

400. N.D. GA. PATENT L.R. 4.4(a) (2004).

401. N.D. GA. PATENT L.R. 4.4(b) (2004).



**Table 2.** Invalidity Contentions

N.D. CAL. (2008)	<p>Not later than 45 days after the service upon it of the Disclosure of Asserted Claims and Infringement Contentions, each party opposing a claim of patent infringement shall serve on all parties its Invalidity Contentions, which shall contain the following:</p> <p>(a) the identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious (with each prior art patent identified by number, country of origin and date of issue, each prior art publication by author and publisher; prior art under 102(b) shall be identified by specifying the item offered for sale or publicly used along with details regarding the offer of use, prior art under 102(f) shall be identified by providing the name of the persons from whom the invention or any part of it was derived, prior art under 102(g) shall be identified by providing the identities of the persons or entities involved in and the circumstances surrounding the making of the invention before the patent applicant);</p> <p>(b) whether each item of prior art anticipates each asserted claim or renders it obvious (along with an explanation if obviousness is alleged);</p> <p>(c) a chart identifying where in each alleged item of prior art each limitation of each asserted claim is found (including structure for means-plus-function cases); and</p> <p>(d) any grounds of invalidity based on 101, 112(2) or enablement or written description under 112(1).<sup>402</sup></p>
S.D. CAL.	<p>Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except that it provides for a 60 day period for service. With respect to subparagraph (d), the rule provides: <i>any</i> grounds of invalidity based on indefiniteness under § 112(1) of any of the asserted claims.<sup>403</sup></p>
N.D. TEX.	<p>Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R. It further provides: Failure to comply with the requirements of this paragraph, including the requirement of specificity and detail, may result in appropriate sanctions.<sup>404</sup></p>

402. N.D. CAL. PATENT L.R. 3-3 (2008).

403. S.D. CAL. PATENT L.R. 3.3 (2006).

404. N.D. Tex. Miscellaneous Order No. 62 3-3 (2007).

**Table 2.** *(continued)*

E.D. TEX.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R. <sup>405</sup>
D. MINN.	Parties can recommend deadline for submitting defendant's claim chart in Rule 26(f) report. Defendant's Claim Chart shall indicate with specificity which elements on Plaintiff's Claim Chart it admits are present in its accused device or process, and which it contends are absent. In the latter regard, Defendant will set forth in detail the basis for its contention that the element is absent. As to the doctrine of equivalents, Defendant shall indicate on its chart its contentions concerning any differences in function, way, and result, and why any differences are substantial. <sup>406</sup>
W.D. PENN.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except that it provides for a 15 day period for service. The rule also requires the defendant to serve non-infringement contentions in addition to invalidity contentions. <sup>407</sup>
N.D. GA.	Rule addressing this subject matter is worded substantially the same as N.D. Cal. Patent L.R., except: (1) any applicable provision of § 112 may be included; and (2) the rule does not provide for invalidity contentions based upon § 101. <sup>408</sup> In addition to invalidity contentions, a party opposing a claim of infringement must serve "Response to Infringement Contentions." <sup>409</sup>

**Table 3.** Finality and Amendment of Contentions

N.D. CAL. (2008)	Amendment to Infringement Contentions or Invalidity Contentions may only be made by order of the Court upon a timely showing of good cause. <sup>410</sup>
S.D. CAL.	Each party's Infringement and Invalidity Contentions will be deemed that party's final contentions except: If a party claiming patent infringement believes in good faith that (1) the court's Claim Construction Ruling so requires, or (2) the documents produced pursuant to Rule 3.4 so require, then not later than 30 days after service by the court of its Claim Construction Ruling, that party may serve

405. E.D. TEX. P. R. 3-3 (2005) (amended 2007).

406. D. MINN. LR 16.2, Form 4 ¶ (f)(2) (2006).

407. W.D. Pa. LPR 3.4 (2008).

408. N.D. GA. PATENT L.R. 4.3 (2004).

409. N.D. GA. PATENT L.R. 4.2 (2004).

410. N.D. CAL. PATENT L.R. 3-6 (2008).

**Table 3.** *(continued)*

	<p>“Final Infringement Contentions” without leave of court to amend its “Preliminary Infringement Contentions.” Not later than 50 days after service by the court of its Claim Construction Ruling, each party opposing a claim of patent infringement may serve “Final Infringement Contentions” without leave of court that amend its “Preliminary Infringement Contentions” with respect to the information required by Rule 3.3 if: (1) a party claiming patent infringement has served “Final Infringement Contentions,” or (2) the party opposing a claim of patent infringement believes in good faith that the court’s Claim Construction Ruling so requires.<sup>411</sup></p>
N.D. TEX.	<p>Rule addressing this subject matter is worded substantially the same as S.D. Cal. Patent L.R. Good cause may include newly discovered instrumentalities, bases for claiming infringement, or newly discovered prior art references. A party seeking to amend its invalidity contentions must include in its motion a statement that the newly discovered instrumentalities, bases for claiming infringement, or newly discovered prior art references were not known to that party prior to the motion despite diligence in seeking out same.<sup>412</sup></p>
E.D. TEX.	<p>Rule addressing this subject matter is worded substantially the same as S.D. Cal. Patent L.R.<sup>413</sup></p>
D. MINN.	<p>Once a party has given the necessary discovery, the opposing party may seek leave of Court to add claims or defenses for which it alleges, consistent with Fed. R. Civ. P. 11, that it has support, and such support shall be explained in the motion seeking leave. Leave shall be liberally given where prima facie support is present, provided that the party seeks leave as soon as reasonably possible following the opposing party providing the necessary discovery.<sup>414</sup></p>
W.D. PENN.	<p>Amendment to Infringement Contentions or Non-Infringement/Invalidity Contentions are allowed if made in a timely fashion and asserted in good faith and without purpose of delay. The Court’s ruling on a claim construction may support a timely amendment or modification of the Infringement Contentions or the Invalidity Contentions.<sup>415</sup></p>

411. S.D. CAL. PATENT L.R. 3.6 (2006).

412. N.D. Tex. Miscellaneous Order No. 62 3-6. 3-7 (2007).

413. E.D. TEX. P. R. 3-6 (2005) (amended 2007).

414. D. MINN. LR 16.2, Form 4 ¶ (c)(2) (2006).

415. W.D. PA. LPR 3.7 (2008).

**Table 3.** *(continued)*


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N.D. GA.	Disclosures and Responses are binding to the same extent as interrogatories are binding under Rule 33 of the Federal Rules of Civil Procedure. These can be amended according to the rules for supplementing and amending discovery responses under the FRCP. Any disclosure a party believes is required in light of a claim construction ruling to a modification of an opposing party's Disclosure or Response shall be made within 30 days of service of such ruling, Disclosure, or Response. <sup>416</sup>
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**Table 4.** Exchange of Proposed Terms for Construction

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N.D. CAL. (2008)	No later than 10 days after service of Invalidity Contentions and no later than 45 days after service of Infringement Contentions in cases where validity is not at issue, or in declaratory judgment actions not based on validity, not later than 10 days after an answer not asserting an infringement claim, each party shall serve on the other a list of claim terms that it contends should be construed by the Court. Parties shall also identify claim terms that are means-plus-function terms. The parties must jointly identify the 10 terms likely to be most significant in resolving the dispute, including terms that may be case or claim dispositive. <sup>417</sup>
S.D. CAL.	No corresponding local rule. <sup>418</sup>
N.D. TEX.	No substantial difference from the original N.D. Cal. Patent L.R. <sup>419</sup>
E.D. TEX.	No substantial difference from the original N.D. Cal. Patent L.R. <sup>420</sup>
D. MINN.	Parties can recommend deadline in Rule 26(f) report for when to simultaneously exchange a list of claim terms, phrases, or clauses that each party contends should be construed by the Court. <sup>421</sup>
W.D. PENN.	Not later than 10 calendar days after: i) service of the Non-Infringement and Invalidity Contentions; or ii) an agreement by the parties to expedite claim construction after the Initial Scheduling Conference, each party shall simultaneously exchange a list of claim

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416. N.D. GA. PATENT L.R. 4.5 (2004).

417. N.D. CAL. PATENT L.R. 4-1 (2008).

418. S.D. CAL. PATENT L.R. 4 (2006).

419. N.D. TEX. Miscellaneous Order No. 62 4-1 (2007).

420. E.D. TEX. P. R. 4-1 (2005) (amended 2007).

421. D. MINN. LR 16.2, Form 4 ¶ (f)(3) (2006).

**Table 4.** *(continued)*


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	terms that it contends the Court should construe and identify claim terms it contends should be governed by USC 112(6). <sup>422</sup>
N.D. GA.	Not later than 90 days after the filing of the Joint Preliminary Report and Discovery Plan, each party shall simultaneously exchange a list of claim terms, phrases, or clauses that it contends the Court should construe or that it contends should be governed by U.S.C. 112(6). The parties should then meet and confer to finalize the list, narrowing or resolving differences. <sup>423</sup>

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**Table 5.** Exchange of Preliminary Claim Constructions and Extrinsic Evidence

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N.D. CAL. (2008)	No later than 20 days after the exchange of claim terms, the parties shall simultaneously exchange proposed constructions. They shall also identify all references from the specification or file history that support their proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses. The parties shall thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a joint claim construction and prehearing statement. <sup>424</sup>
S.D. CAL.	Not later than 14 days after the service of the “Preliminary Invalidation Contentions,” the parties will simultaneously exchange a preliminary proposed construction of each claim term, phrase or clause which the parties have identified for claim construction purposes. Each such preliminary claim construction will also, for each element which any party contends is governed by § 112(6), identify the structure, act or material corresponding to that element. Simultaneously with the exchange of the “Preliminary Claim Constructions,” the parties must also provide a preliminary identification of extrinsic evidence and must produce any such extrinsic evidence not previously produced. The parties must provide a brief description of the substance of any proposed witness testimony. Not later than 14 days after the service of the “Preliminary Claim Construction,” parties will exchange “Responsive Claim Constructions” identifying whether the responding party agrees with the other party’s proposed construction, or identifying an alternate construction in the responding party’s

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422. W.D. PA. LPR 4.1 (2008).

423. N.D. GA. PATENT L.R. 6.1 (2004).

424. N.D. CAL. PATENT L.R. 4-2 (2008).

**Table 5.** *(continued)*

	preliminary construction, or setting forth the responding party's alternate construction. Simultaneous with the exchange of the Responsive Claim Constructions, the parties must also provide a preliminary identification of extrinsic evidence and produce any such evidence not previously produced. The parties must also provide a brief description of proposed witness testimony. The parties must thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a Joint Claim Construction Chart, Worksheet and Hearing Statement. <sup>425</sup>
N.D. TEX.	No substantial difference from S.D. Cal., except that there are no "Responsive Claim Constructions." <sup>426</sup>
E.D. TEX.	No substantial difference from S.D. Cal., except that there is a 20 day period and there are no "Responsive Claim Constructions." <sup>427</sup>
D. MINN.	Parties can recommend deadlines in Rule 26(f) report for exchanging proposed claim constructions and conferring to finalize a list that will be submitted to the court. At the same time the parties exchange their respective "preliminary claim construction" they shall also provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses that they contend support their respective claim constructions. The parties shall identify each such items of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, percipient or expert, the parties shall also provide a brief description of the substance of that witness' proposed testimony. <sup>428</sup>
W.D. PENN.	No substantial difference from S.D. Cal., except that there is a 10 day period for service. <sup>429</sup>
N.D. GA.	No substantial difference from S.D. Cal., except that there is a 20 day period and there are no "Responsive Claim Constructions." <sup>430</sup>

**Table 6.** Joint Claim Construction and Prehearing Statement

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| 425. | S.D. CAL. PATENT L.R. 4.1 (2006).                |
| 426. | N.D. Tex. Miscellaneous Order No. 62 4-2 (2007). |
| 427. | E.D. TEX. P. R. 4-2 (2005) (amended 2007).       |
| 428. | D. MINN. LR 16.2, Form 4 ¶ (f)(3) (2006).        |
| 429. | W.D. PA. LPR 4.1 (2008).                         |
| 430. | N.D. GA. PATENT L.R. 6.2 (2004).                 |

**Table 6.** *(continued)*

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N.D. CAL. (2008)	60 days after service of invalidity contentions, the parties shall file a Joint Claim Construction and Prehearing Statement, which shall contain the following information: (a) the construction of claim terms on which the parties agree; (b) each party’s proposed construction of each disputed term, together with identification of all references from the specification or file history that support that construction and identification of any extrinsic evidence known to the party on which it intends to rely; (c) an identification of claim terms whose construction will be most significant to the resolution of the case (up to 10, with identification of all dispositive terms); (d) anticipated length of time necessary for claim construction hearing; and (e) whether any party proposes to call one or more witnesses at the claim construction hearing, the identity of such witnesses and a summary of their testimony (including opinions to be offered). <sup>431</sup>
S.D. CAL.	Not later than 14 days after service of “Responsive Claim Construction,” the parties must complete and file a Joint Claim Construction Chart, Joint Claim Construction Worksheet and Joint Hearing Statement. (a) The Joint Claim Construction Chart must have a column listing complete language of disputed claims with the disputed terms in bold type and separate columns for each party’s proposed construction of each disputed term. Each party’s proposed construction of each disputed claim term, phrase, or clause, must identify all references from the specification or prosecution history that support that construction, and identify any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction of the claim or to oppose any party’s proposed construction of the claim, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses. (b) The parties’ Joint Claim Construction Worksheet must be in the format set forth in Appendix B and include any proposed constructions to which the parties agree, as well as those in dispute. The parties must jointly submit the Joint Claim Construction Worksheet on computer disk in both Word and WordPerfect format or in such other format as

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431. N.D. CAL. PATENT L.R. 4-3 (2008).

**Table 6.** *(continued)*


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	<p>the court may direct.</p> <p>(c) The Joint Hearing Statement must include: (1) the anticipated length of time necessary for the Claim Construction Hearing; and (2) whether any party proposes to call one or more witnesses, including experts, at the Claim Construction Hearing, the identity of each such witness, and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert.</p> <p>(d) At the court's discretion, within 5 calendar days of the joint submission of the Joint Claim Construction Chart, Joint Claim Construction Hearing and Joint Hearing Statement, the court will hold a status conference with the parties, in person or by telephone, to discuss scheduling, witnesses and any other matters regarding the Claim Construction Hearing.<sup>432</sup></p>
N.D. TEX.	<p>No substantial difference from the N.D. Cal. Patent L.R. except does not include subsection (c), and further provides: A list of any 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.<sup>433</sup></p>
E.D. TEX.	<p>No substantial difference from the original N.D. Cal. Patent L.R. does not include subsection (c), and further provides: A list of any 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.<sup>434</sup></p>
D. MINN.	<p>According to parties' recommended deadline, the parties shall notify the Court as to whether they request that the Court schedule a Claim Construction hearing to determine claim interpretation. If any party believes there is no reason for a Claim Construction hearing, the party shall provide the reason to the Court. At the same time, the parties shall also complete and file with the Court a joint claim construction statement that shall contain the following information:</p> <p>(A) The construction of those claim terms, phrases, or clauses on which the parties agree;</p> <p>(B) Each party's proposed construction of each disputed claim term, phrase, or clause together with an identification of all references from the specification of prosecution history that support that construction,</p>

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432. S.D. CAL. PATENT L.R. 4.2 (2006).

433. N.D. Tex. Miscellaneous Order No. 62 4-3 (2007).

434. E.D. TEX. P. R. 4-3 (2005) (amended 2007).



**Table 6.** *(continued)*

	and an identification of any extrinsic evidence known to the party on which it intends to rely either in support of its proposed construction of the claim or to oppose any other party's proposed construction of the claim, including, but not limited, as permitted by law, dictionary definitions, citation to learned treatises and prior art, and testimony of percipient and expert witnesses; (C) Whether any party proposes to call one or more witnesses, including experts at the Claim Construction hearing, the identity of each such witness and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert. <sup>435</sup>
W.D. PENN.	No corresponding local rule.
N.D. GA.	No substantial difference from N.D. Cal. Patent L.R. except there is a 130 day period and there is no requirement corresponding to item (c). <sup>436</sup>

**Table 7.** Claim Construction Briefs

N.D. CAL. (2008)	No later than 45 days after service and filing Joint Claim Construction and Prehearing Statement, the party claiming patent infringement, or the party asserting invalidity if there is no infringement issue in the case, shall serve and file an opening brief and any evidence supporting its claim construction. No later than 14 days after service of opening brief, responsive briefs and supporting evidence are due. No later than 7 days after responsive briefs, reply briefs and rebuttal evidence are due. <sup>437</sup>
S.D. CAL.	14 days after the close of claim construction discovery, the parties will simultaneously file and serve opening briefs and any evidence supporting their claim construction. 14 days after service of the opening briefs, the parties will simultaneously file and serve briefs responsive to the opposing party's opening brief and any evidence directly rebutting the supporting evidence contained in the opposing party's opening brief. <sup>438</sup>
N.D. TEX.	No substantial difference from N.D. Cal., except for the following

435. D. MINN. LR 16.2, Form 4 ¶ (f)(4) (2006).

436. N.D. GA. PATENT L.R. 6.3 (2004).

437. N.D. CAL. PATENT L.R. 4-5 (2008).

438. S.D. CAL. PATENT L.R. 4.4 (2006).

**Table 7.** *(continued)*


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	additions:
	The requirements of LR 7.2 apply to such briefs, except that, excluding the table of contents and the table of authorities, the length of the brief must not exceed 30 pages. By order or other appropriate notice, the presiding judge may restrict the length of the brief to fewer than 30 pages, or, for good cause, may enlarge the length of the brief.
	Within 10 days of the claim construction hearing, the parties must jointly submit a claim construction chart: (1) The claim construction chart must have a column listing the complete language of disputed claim with disputed terms in bold type and separate columns for each party's proposed construction of each disputed term. The chart must also include a fourth column entitled "Judge's Construction" that is otherwise left blank. Additionally, the chart must direct the presiding judge's attention to each patent and claim number where a disputed term appears; (2) The parties may also include constructions for claim terms to which they have agreed. If the parties choose to include agreed constructions, each party's proposed construction columns must state "[AGREED]", and the agreed construction must be inserted in the "Judge's Construction" column; (3) The purpose of this claim construction chart is to assist the presiding judge and the parties in tracking and resolving disputed claim terms. Accordingly, aside from the requirements set forth in this Order, the parties are afforded substantial latitude in the chart's format so that they may fashion a chart that most clearly and efficiently outlines the disputed terms and proposed constructions. Appendices to the presiding judge's prior published and unpublished claim construction opinions may provide helpful guidelines for parties fashioning claim construction charts. <sup>439</sup>
E.D. TEX.	No substantial difference from Northern District of Texas. <sup>440</sup>
D. MINN.	No corresponding local rule. <sup>441</sup>
W.D. PENN.	(a) Not later than 30 days after filing of the Joint Disputed Claim Terms Chart, the Plaintiff (unless otherwise stipulated by the parties) shall serve and file an Opening Claim Construction Brief along with a proposed construction of each disputed term. For each element which the party contends is governed by 112(6), the brief shall describe the claimed function of that element and identify the structure(s), act(s), or

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439. N.D. Tex. Miscellaneous Order No. 62 4-5 (2007).

440. E.D. TEX. P. R. 4-5 (2005) (amended 2007).

441. D. MINN. LR 16.2, Form 4 (2006).

**Table 7.** *(continued)*


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material(s) corresponding to that element. The Brief shall further include a statement of anticipated length of time necessary for the party to present its case at the claim construction hearing. If there is no claim on patent infringement in the complaint, the party first alleging infringement of the subject patent shall serve and file the Opening Claim Construction Brief.
(b) With the Opening Claim Construction Brief the party shall identify extrinsic evidence (see above in “Exchange of Preliminary Claim Construction and Extrinsic Evidence” table).
(c) 20 days after service of Opening Brief, a Response with the opposing party’s proposed construction of each claim term in dispute is due. For any element which the opposing party contends is governed by 112(6), the Response shall describe the claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element. This Response shall further contain a statement of the anticipated length of time necessary for the party to present its case and a concise statement as to whether the party objects to the opening party’s offer of extrinsic evidence.
(d) This Response shall also be filed with an identification of extrinsic evidence. (as described above in “Exchange of Preliminary Claim Construction and Extrinsic Evidence” table).
(e) A Reply by the opening party, rebutting the opposing party’s Response, may be filed not later than 15 days after service of the Response. This Reply shall include a statement as to whether the party objects to the opposing party’s offer of extrinsic evidence. <sup>442</sup>

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N.D. GA.	30 days after service and filing of the Joint Claim Construction Statement, each party shall serve and file an opening brief and any evidence supporting its claim construction. 20 days after service of opening brief, responsive briefs and supporting evidence are due. <sup>443</sup>
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**Table 8.** Claim Construction Hearing

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N.D. CAL. (2008)	2 weeks following submission of reply brief, the Court shall conduct a claim construction hearing—subject to the Court’s calendar and to the extent the parties believe such a hearing is necessary. <sup>444</sup>
S.D. CAL.	No substantial difference from N.D. Cal. except the period is not later

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442. W.D. PA. LPR 4.3 (2008).

443. N.D. GA. PATENT L.R. 6.5 (2004).

444. N.D. CAL. PATENT L.R. 4-6 (2008).

**Table 8.** *(continued)*

	than 28 days after service of responsive briefs. <sup>445</sup>
N.D. TEX.	No substantial difference from N.D. Cal. <sup>446</sup>
E.D. TEX.	No substantial difference from N.D. Cal. <sup>447</sup>
D. MINN.	Following the parties' meeting and conferring, at a time recommended by the parties in Rule 26(f) report, the parties shall notify the Court as to whether they request that the Court schedule a Claim Construction hearing to determine claim interpretation. If any party believes there is no reason for a Claim Construction hearing, the party shall provide the reason to the Court. If the Court schedules a Claim Construction hearing, prior to the date of the Claim Construction hearing, the Court shall issue an Order discussing: (A) Whether it will receive extrinsic evidence, and if so, the particular evidence it will receive; (B) Whether the extrinsic evidence in the form of testimony shall be the affidavits already filed, or in the form of live testimony from the affiants; and (C) A briefing schedule. <sup>448</sup>
W.D. PENN.	No substantial difference from the N.D. Cal. Patent L.R., except the period is 15 days. <sup>449</sup>
N.D. GA.	No substantial difference from the N.D. Cal. Patent L.R. except that there is no fixed time period. <sup>450</sup>

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445. S.D. Cal. PATENT L.R. 4.5 (2006).

446. N.D. Tex. Miscellaneous Order No. 62 4-6 (2007).

447. E.D. TEX. P. R. 4-6 (2005) (amended 2007).

448. D. MINN. LR 16.2, Form 4 ¶ (f)(5) (2006).

449. W.D. PA. LPR 4.4 (2008).

450. N.D. GA. PATENT L.R. 6.6 (2004).