UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of **CERTAIN DERMATOLOGICAL TREATMENT DEVICES AND COMPONENTS THEREOF**	**Inv. No. 337-TA-1356**

ORDER NO. 2: NOTICE OF GROUND RULES

(April 7, 2023)

The conduct of this Investigation shall be governed by the Commission Rules and the Ground Rules attached hereto as Attachment A.

SO ORDERED.

MaryJoan McNamara
Administrative Law Judge

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IPR2024-00383

ATTACHMENT A

ALJ MARYJOAN MCNAMARA'S GROUND RULES FOR THIS SECTION 337 INVESTIGATION 337-TA-1356 (4/7/2023)

These Ground Rules supplement the Commission's Rules of Practice and Procedure, 19 C.F.R. Parts 201 and 210 ("Commission Rules"), in order to aid the Administrative Law Judge in the orderly conduct of this Section 337 Investigation.

These Ground Rules govern a U.S. patent-based investigation. In the case of an investigation based upon a registered copyright, registered trademark, or registered mask work, additional Ground Rules may also govern. In addition, in a case involving a motion for temporary relief, Ground Rules in addition to Ground Rule 1.8 may also govern.

Chambers no longer accepts paper copies of documents, flash drives or CD Roms unless otherwise notified.

Courtesy copies of documents that are filed on EDIS should be submitted to Chambers through McNamara337@usitc.gov.

Applications for subpoenas must be submitted in Microsoft Word to McNamara337@usitc.gov. Subpoena applications submitted to McNamara337@usitc.gov must comply with the substantive requirements of Ground Rule 3.5.

Courtesy copies of Expert Reports and Expert Rebuttal Reports must be submitted to McNamara337@usitc.gov. There has been a problem with the manner in which parties have failed to ensure that appropriate sections or paragraphs of expert reports are admitted into evidence post-hearing. The same is true of deposition transcript passages. This may be an issue for discussion during one of the Management Conferences, most likely the first scheduled Management Conference.

Webex is the secure video platform that the Commission uses. Management conferences may be held by either Telephone Conference or by Webex. We anticipate that the evidentiary hearing ("Hearing") will be in person in one of the ITC's courtrooms. This will be discussed at a Management Conference.

Please note the Ground Rule with respect to the NEXT Advocates Program. We actively encourage andoffer incentivize the participation of less experienced attorneys in our proceedings.

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Appendix B.

JUDGE MCNAMARA'S GROUND RULES (04/7/2023)

1. General Procedures and Information.

1.1. Address of Administrative Law Judge.

The Administrative Law Judge's address is as follows:

The Honorable MaryJoan McNamara
U.S. International Trade Commission
500 E Street, S.W., Room 317
Washington, D.C. 20436

1.2. Filing Requirement.

All submissions shall be filed with the Office of the Secretary of the Commission in accordance with Commission Rule 210.4(f) unless otherwise specifically provided for in these Ground Rules or by order of the Administrative Law Judge. *See* the United States International Trade Commission Handbook on Filing Procedures www.usitc.gov/secretary/documents/handbook_on_filing_procedures.pdf[1] for further details. The parties should be aware that the close of business for the agency is 5:15 pm. *See* Commission Rule 201.3(c).

All documents filed on EDIS must contain in the footer of each page the name of the party that filed the document along with the title of the document.

1.3. Service Copy Requirement.

1.3.1. Paper Copies.

Copies of the papers filed with the Secretary shall be served concurrently on all other parties, including the Commission Investigative Staff (if named as a party). Also, two (2) double-sided courtesy paper copies shall be served on the Administrative Law Judge ("ALJ"), addressed to her, at her office the next business day[2] after the papers are electronically filed with the Secretary. *See* Ground Rule 7 regarding courtesy copies of pre-hearing statements, pre- and post-hearing briefs, and motions *in limine*.

1.3.1.1. Copies To ALJ.

A courtesy copy of each filing, excluding exhibits, should be sent to

[1] *See also* https://www.usitc.gov/secretary/documents/handbook_on_filing_procedures.pdf

[2] Parties need not serve courtesy paper copes of subscriptions to the protective order that have been filed on EDIS, although electronic courtesy copies are still required.

McNamara337@usitc.gov. *See* G.R. 1.3.2 below.

1.3.2. Electronic Copies.

In addition to that which is required in Ground Rule 1.3.1, while the Investigation is pending before the Administrative Law Judge, any party submitting a motion or any response to a motion, as well as any other paper submitted in this Investigation, shall on the same business day as the electronic filing, send one: (1) courtesy electronic copy of said document in Microsoft Word or PDF format (preferred), to McNamara337@usitc.gov. In particular, *submissions in chart form*, such as the Joint Claim Construction and Proposed Procedural Schedule, *must be provided in Microsoft Word*.

Copies sent via e-mail should include the number of this Investigation as the first item in the subject line and *must be followed by a very brief summary of the contents*. For example, the subject line may[3] read: "Inv. No. 337-TA-####, Motion for Summary Determination."

1.4. Submission by Fax Disfavored.

Submissions to the Administrative Law Judge by fax are not to be made without her prior approval. They cannot be made at all during the Pandemic.

1.5. Concurrent Service.

The parties are encouraged to confer and stipulate in writing to acceptable forms and terms of service. Service on opposing counsel may be made by hand, facsimile, e-mail, or overnight courier. Any foreign respondent who is not represented by counsel may be served by first class mail. A motion served by overnight courier must be received by the other parties no later than the close of business on the day after the day it was filed.

1.6. Confidential Submissions.

Any document containing confidential business information shall be prominently marked on at least its first page with the legend "confidential business information," or equivalent wording.[4] Documents filed with confidential attachments shall similarly contain a prominent marking on at least the first page of the document indicating that there are confidential attachments and at least the first page of each of the confidential attachments shall be marked pursuant to Commission Rules. A party who mistakenly files a document without a confidential designation thereon shall immediately contact the Office of the Secretary and the Administrative Law Judge's Attorney Advisor.

If a motion or related document (e.g., response, reply, stipulation or exhibit) is filed as confidential because it purportedly contains CBI as defined in 19 C.F.R. § 201.6(a), the private parties must file a non-confidential, public version of the motion and related document within five (5) business days from the date of the purportedly confidential filing. Each filed version of

[3] The investigation number followed by the word "service" is not adequate.

[4] *See* Commission Rules 210.6 and 210.34. It is recommended that every confidential page be so marked.

the motion or related document must be labeled appropriately as either public or confidential (with the latter labeled as containing CBI consistent with past practices).

When redacting CBI, a high level of care must be exercised in order to ensure that non-confidential business information is not redacted or indicated. The document labeled confidential should contain brackets and highlighting, in accordance with Ground Rule 1.10, of only that material/information that complies with 19 C.F.R. § 201.6(a). Other than in extremely rare circumstances, block-redaction and block-bracketing are prohibited. In most cases, redaction or bracketing of only discrete CBI words and phrases will be permitted. Titles of documents shall not contain CBI.

All confidential motions and confidential responses to motions must be accompanied by declarations, grounded in facts, explaining how each proposed redaction is CBI.

Exhibits attached to the confidential motions and confidential responses to motions generally need not be bracketed, although CBI contained in an exhibit must be bracketed when quoted in a motion or response thereto. If an exhibit is a brief for which the moving party seeks leave to file, e.g., a reply brief attached as an exhibit to a motion for leave to reply, then that exhibit shall be bracketed. If the main text of a confidential motion or response contains no redaction, the declaration shall explain why the filing is designated confidential (e.g., the motion contains no confidential text but has a confidential attachment).

The same day public version of confidential documents should have redacted the identical material/information bracketed and highlighted in the confidential version.

For those cases where the Office of Unfair Import Investigations ("OUII") is a party, OUII shall have ten (10) business days to submit a non-confidential version of the motion and/or related document.

1.7. Unreported Court Decisions.

Any submission that refers to an unreported court decision shall include as an exhibit the text of the decision.

1.8. Temporary Relief.

In any aspect of an Investigation which involves a pending motion for temporary relief, a party serving any paper, including any motion or discovery requests, must notify counsel for the other parties, including the Commission Investigative Staff Attorney ("Staff") if Staff is a party, by telephone on the day the paper is served about the substance of the paper, and must arrange for the other parties to receive the paper the next business day.

1.9. Deadlines and Extensions.

All due dates for any paper necessitate that the paper be received by the intended recipient no later than the close of business on the due date. For this reason, electronic service on the other parties is encouraged. *See* Commission Rule 201.16(f).

1.9.1. Extension of Time

To extend a deadline, the parties must file a motion seeking an extension of time and must set forth good cause for such an extension. Such motions must be filed on EDIS no later than **two (2) days** before the due date. The parties shall not file any joint stipulations extending a filing (unless an emergency), discovery or hearing deadline. Leave should be requested by motions practice.

1.9.2. Expedited Treatment

Urgent matters should be brought to the attention of the Administrative Law Judge as follows. First, motions, responses, or other filings that are urgent or that should receive expedited treatment should be **clearly noted** in the document's caption. Second, on the date of said filing, the Administrative Law Judge's Attorney Advisor must be notified by e-mail, with a copy to all parties that the matter is of pressing importance or urgency. The parties should note, however, that the Administrative Law Judge has many ongoing investigations. All pending matters will be addressed with as much dispatch as time and circumstances allow. *See also* Ground Rule 2.6.

1.9.3. Untimely Filings

It is the responsibility of the other parties to promptly notify the Administrative Law Judge in writing if a party has filed or served a document after the deadline set in the procedural schedule or Commission Rules.

A party may correct an untimely filing or submission by promptly moving to have the document accepted out of time by the Administrative Law Judge and explaining the good cause for late consideration. *See* Commission Rule 201.3(c). The two-day meet and confer requirement is waived for such motions, although movants should attempt to determine the other parties' position with respect to the motion. If no prompt[5] motion is brought, the Administrative Law Judge may in her discretion order that an untimely filed or served[6] document be disregarded.

1.10. Redaction Requirements for Public Versions of Orders and Teleconference Transcripts.

Orders issued by the Administrative Law Judge may contain the confidential business information of the parties (or in some cases nonparties), in which case the orders will be designated confidential. The Administrative Law Judge has the discretion, pursuant to Commission Rule 210.5(e), to determine whether the information designated confidential by the supplier is entitled to confidential treatment in orders, initial determinations, and other

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[5] The Administrative Law Judge suggests, but does not require, that this occur within two (2) business days of the late filing.

[6] The procedural schedule provides for certain documents to be submitted or served rather than filed on EDIS. This rule shall apply equally to all due dates set forth in the procedural schedule, regardless of whether service or filing is required.

documents issued by the Administrative Law Judge. The parties will receive instructions in said orders as to the submission of proposed redactions of confidential business information so that a public version of the order may be prepared. Parties who do not intend to submit proposed redactions must notify the Administrative Law Judge in writing. Due to changes to Commission Rule 210.5, the Administrative Law Judge has a limited time to make a confidential order or initial determination available to the public. Therefore, the parties are expected to use their best efforts to facilitate timely issuance of public versions.

One document containing joint redactions is preferred, and sometimes will be ordered. If not, two (2) copies of a proposed public version of an issued order or initial determination must be submitted to the Administrative Law Judge at the time specified in the issued confidential order or initial determination. Proposed redactions of information subject to the protective order should be bracketed and highlighted, for example, in yellow.

A party's proposed public version must be served on all parties at least one (1) business day before submission to the Administrative Law Judge. Any party with comments regarding another party's proposed public version must submit them to the Administrative Law Judge on the same date as specified for the submission of the proposed public version.

If no proposed public version is received by the date set in an order requiring such submission, the totality of the order will be made public. Parties should <u>not</u> file the proposed public version with the Secretary. The Administrative Law Judge will issue the final public version of the order once all appropriate redactions are made.

The parties should note that it is the Administrative Law Judge's <u>firm</u> policy that the public has a right to know the substantive outcome of the Investigation. Therefore, for any order resolving a matter of substance (such as a *Markman* order, grant of summary determination, or final initial determination), the parties must pay particular attention to their proposed redactions. Only confidential business information ("CBI") should be redacted, even if this means redacting only a portion of a sentence.

For transcripts of teleconferences, the parties shall file confidential, final versions on EDIS as soon as they receive them from court reporters and <u>jointly</u> submit proposed redactions as they would for Orders, i.e., bracketed and highlighted, for example, in yellow, within 10 days of the teleconference, unless requested otherwise by the Court. If the parties disagree about a redaction, the parties' joint submission should include a cover letter specifically identifying the page number(s) on which the disputed proposed redactions can be found and a legal justification for each such redaction. *See*, e.g., *Certain Light-Emitting Diode Products and Components Thereof*, 337-TA-947, Order No. 57 (April 29, 2016). After the proposed redactions have been reviewed, the parties will be informally notified as to which redactions have been approved. Within seven (7) days of such notice, one of the parties (to be decided between the parties) shall file a public version of the transcript on EDIS.

1.11. Electronic Filing (EDIS).

Commission Rule 210.4(f) governs the electronic filing of certain documents in Section 337 Investigations with the Office of the Secretary via the Commission's Electronic Document Information System (EDIS). Filing through EDIS, however, does not remove the requirement that parties also submit an electronic copy of such filing with the office of the Administrative Law Judges to McNamara337@usitc.gov.

For additional information regarding EDIS, the parties may contact the EDIS Helpdesk at (202) 205-3347, review the Docket Services webpage,[7] or access the EDIS 3 User Guide currently found at the following Internet address:

www.usitc.gov/sites/default/files/documents/edis3_10userguide-external_final_optimized.pdf

Electronic filing on EDIS is governed by the U.S.I.T.C. Handbook on Filing Procedures.

One of the instructions concerns current size limits of files. The current size limit for each file submitted on EDIS is 25 MB, defined as follows:

The size of an electronic document as a whole is not limited by the capability of EDIS, but no single file attached to a document submission may exceed 25 megabytes in size. Documents which exceed the 25-megabyte size limit must be broken down into two or more individual files which are each less than the limit and attached as separate files to the document submission. EDIS allows for an unlimited number of PDF files to be attached to a document submission, which taken together comprise the full document; thus, there is no limit to the overall size of a filing. If a filing includes an attachment that exceeds the foregoing size limitation and cannot be broken down into multiple PDF files, the Secretary may authorize filing of the document in paper form or on electronic media approved by the Secretary, pursuant to section II(C) above. All page limits set forth in the rules and the Handbook shall remain in effect for purposes of electronic filing.

There are other EDIS filing requirements that should be consulted.

1.12. Computation of Time.

In addition to the requirements of Commission Rules 201.14, 201.16(d) and 210.6 for computation of time, if the last day of the period for making a submission falls on a day on which weather or other conditions have made EDIS and the Office of the Secretary of the Commission inaccessible, the cut off shall be extended to the end of the next business day.

The first day of the ten (10) calendar days for responding to a motion shall be the first business day following the date that said motion was filed on EDIS. In addition to the requirements of Commission Rules 201.16 and 210.15(c) governing the period for a nonmoving party's response to a written motion, the date of service of a motion on a nonmoving party by electronic mail, personal delivery, express-type mail or courier service is the date of delivery.

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[7] *See* https://www.usitc.gov/sites/default/files/documents/edis3_10userguide-external_final_optimized.pdf

The additional times provided under Commission Rules 201.16(d) and (e) after service by non-electronic means do not apply in such instances, unless service to a nonmoving party is effected in a foreign country.

1.13. Procedural Schedule.

The Administrative Law Judge will establish a procedural schedule for this Investigation. Modifications of the procedural schedule by any party shall ***be regulated by written motion showing good cause. However, the parties should not expect to be able to modify the hearing dates absent exigent circumstances***. The event and deadline dates in the procedural schedule will generally adhere (but may vary) to the following chronological order:

Deadline for proposed Procedural Schedule and Discovery Statement
Initial Case Management Conference (if needed)
Deadline for Propounding Interrogatories
File identification of expert witnesses, including their expertise and Curriculum Vitae
Complainant files notice of patent priority dates/dates of conception/reduction to practice
Respondent files notice of Prior Art
Complainant(s) and Respondent(s) provide Staff [8] with their proposed list of claim terms for construction
Exchange proposed Claim Constructions
File Joint Claim Construction Chart
Parties submit a joint list showing each party's proposed construction of the disputed claim terms with briefs by all parties with regard to their initial claim constructions
Parties meet and confer (including Staff, if applicable) in an attempt to reconcile or otherwise limit disputed claim terms
Deadline to file *Markman* hearing proposals
Deadline for Disclosure of Domestic Industry Products
Technology Stipulation deadline
Telephone Management Conference

[8] If Staff is not a party to the Investigation, the private parties should exchange their proposed constructions.

***Markman* Hearing (if ordered)**
Deadline for post-*Markman* Hearing claim construction
File tentative list of witnesses a party will call to testify at the hearing, with an identification of each witness' relationship to the party
Fact discovery cutoff and completion
Last day for filing motions to compel discovery
Attendance at one-day mediation session[9]
Submission of joint report on mediation
Exchange of initial expert reports (identify tests/surveys/data)
Exchange of rebuttal expert reports
File expert reports
File expert report rebuttals
Last day for filing summary determination motions
Expert discovery cutoff and completion
Submission of statements regarding the use of witness statements in lieu of live direct testimony, and statements regarding whether any party intends to offer expert reports into evidence
Exchange of exhibit lists among the parties
File Pre-hearing statements and briefs -- Complainant(s) and Respondent(s)
File Pre-hearing statement and brief -- Staff (if applicable)
File requests for receipt of evidence without a witness
Last day for filing motions *in limine*[10]
File statement of high priority objections
File responses to statement of high priority objections

[9] For any questions regarding the mediation program, the parties should refer to the Revised Users' Manual for Commission Mediation Program, available at http://www.usitc.gov.
[10] *See* Ground Rule 7 regarding format of courtesy copies.

Submission of declarations justifying confidentiality of exhibits
Last day for filing responses to motions *in limine*
Tutorial on technology
Pre-hearing conference
Evidentiary Hearing
File initial post-hearing briefs, proposed findings of fact and conclusions of law,[11] and final exhibit lists
Parties jointly submit electronic copy of combined exhibit lists
File reply post-hearing briefs, objections and rebuttals to proposed findings of fact and conclusions of law
Initial Determination on Violation Target Date
Target Date for completion of Investigation

Where the procedural schedule indicates the "last day to file," the parties should note that motions are expected on a rolling basis when issues are ripe for determination.

This Procedural Schedule may change greatly depending upon complexity and the types, numbers and complexity of claims involved in the Investigation.

1.14. Early Claim Construction

At the start of an Investigation involving patent litigation, the Administrative Law Judge may order early claim construction, or alternatively, may provide the parties with an opportunity to submit proposals requesting early claim construction. Regardless of whether an early claim construction hearing is ordered, the parties are expected to disclose and solidify their claim construction positions early in the Investigation. Thus, the procedural schedule includes dates for identifying patent claim terms that need construction, for exchanging initial proposed constructions, for meeting and conferring to attempt to resolve disputed claim language, and for identifying a final joint list of disputed claim terms and including each party's final proposed constructions.

At the time that the parties first exchange their initial proposed constructions, any party who fails to set forth a specific proposed construction or who relies on the plain and ordinary meaning of the patent language at issue (without elaboration) may not subsequently elaborate or rely on a different proposed construction absent advance approval from the Administrative Law

[11] In accordance with Commission Rule 210.40, a party may elect to file proposed findings of fact and conclusions of law; however, the other side is not required to respond to the proposed findings of fact and conclusions of law. The lack of a response does not mean that the proposed findings of fact and conclusions of law are admitted, unless specifically stated as such.

Judge.[12] In other words, the private parties are expected to make a near-simultaneous show of their "hands." Regardless of what claim construction a party proposed initially, during the meet and confer period, a party may shift position in order to "join" in proposing the claim construction position set forth by another party and also may shift position in order to reach agreement with all parties in order to resolve a disputed claim term in whole or in part. The parties will be bound by their claim construction positions set forth on the date they are required to submit a joint list showing each party's final proposed construction of the disputed claim terms and will not be permitted to alter these absent a timely showing of good cause.

On the date set in the procedural schedule, the parties are to file a list of claim terms that each party contends should be construed, including any term to be given its plain and ordinary meaning. The parties shall thereafter meet and confer for the purposes of limiting the terms in dispute by narrowing or resolving differences and facilitating the ultimate preparation of a Joint Claim Construction Chart. The parties shall also jointly identify the 10 terms likely to be most significant to resolving the parties' disputes, including those terms for which construction may be case or claim dispositive. Parties will not be permitted to submit more than 14 terms for construction without leave of court.

If a *Markman* hearing in advance of the evidentiary hearing is ordered, the parties are required to confer and set a logical order for briefing the disputed claim terms of the asserted patents, and then follow that pre-set order in all *Markman*-related submissions and filings. *See*, for example, the relevant portions of **Appendix B**. Expert reports related to early claim construction may be required to be filed on EDIS. The procedural schedule will state whether the reports should be filed or submitted.

The parties should also understand that, because of the tight schedule needed for expeditious proceedings, a *Markman* order may sometimes issue late in the Investigation, such as shortly before the hearing. The parties should not assume that a *Markman* order will issue before expert report deadlines or that there will be a seasonable opportunity to supplement expert reports after a claim construction ruling. *See* Ground Rule 5. Therefore, the parties are advised, but not required, to account for the proposed constructions of the other parties in their expert reports. When a *Markman* order issues, the Administrative Law Judge will explain whether expert report supplementation is permitted. This typically will only be an opportunity for limited expert report supplementation and only with respect to final claim constructions that substantively differ from those proposed by any party. These will only be permitted by Leave of Court.

The parties and Commission Investigative Staff shall meet and confer on disputed claim construction issues no later than ten (10) days before the *Markma*n hearing in order to reduce the number of disputed claim terms to a minimum. Before the *Markman* hearing, Complainant(s), Respondent(s) (if there is more than one Respondent, they are required to file a joint brief), and Staff shall file with the Administrative Law Judge, by the date set forth in the procedural

[12] The Administrative Law Judge takes no position here as to the merits of proposing the plain and ordinary meaning (as understood by one of skill in the art) of a disputed term, which may be quite reasonable under the circumstances. *See, e.g., Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). What is of concern is when a party makes a tactical decision to shift to a new, detailed disclosure after seeing what the other side has to offer.

schedule, a short written statement of its interpretation of each of the remaining disputed claim terms together with its support for each interpretation as a matter of ordinary meaning, or as derived from the claims, specification, or prosecution history of the patent(s) at issue, or from extrinsic evidence. After the *Markman* hearing, the parties shall submit a joint chart, by the date set forth in the procedural schedule, setting forth their post-hearing constructions.

Absent a showing of good cause made at or before the *Markman* hearing, a subsequent *Markman* order will provide constructions for only the parties' top 10 terms. After the Administrative Law Judge issues an order construing the disputed claim terms for the purposes of the Investigation, discovery and briefing in the Investigation shall be limited to that claim construction.

1.14.1. *Markman* Briefing.

Absent prior approval of the Administrative Law Judge, initial *Markman* briefs shall not exceed 150 pages. The parties should use their best efforts to attempt to resolve disputed claim language up to and throughout the *Markman* hearing and promptly notify the Administrative Law Judge in writing if any agreements are reached. The parties may be asked during a *Markman* hearing to make additional efforts to resolve their disputes. If so, the parties may be given a certain amount of time after the *Markman* hearing to report on their attempts to resolve disputes and to resubmit any resolved, previously disputed constructions. If the parties designate a large number of claim terms for construction, the Administrative Law Judge may set limits on the number of claim terms to be construed. If the parties designate a large number of claim terms for construction, this may delay the issuance of any *Markman* order.

If the parties have agreed to the construction of any claim terms, the Administrative Law Judge considers those terms to be "in controversy"[13] and expects the parties to include a section in their *Markman* briefs setting forth in detail their rationale and support for their agreed upon constructions so that the Administrative Law Judge may make an independent evaluation. *See Certain Reduced Ignition Proclivity Cigarette Wrappers and Products Containing Same,* Inv. No. 337-TA-756, Comm'n Op. at 43-44 (U.S.I.T.C., June 15, 2012).

Arguments that do not appear in the initial *Markman* briefs shall be deemed waived. As noted above, the parties will be bound by their final claim construction positions set forth on the date they are required to submit a joint list to the Administrative Law Judge, which may, in some circumstances, include post-*Markman* hearing constructions as described above.

If the parties have exhibits or attachments they wish to submit with their *Markman* briefing, these must correspond to the proposed exhibits that the parties intend to have entered into the record during the *Markman* hearing. Citations to these attachments in the briefing should correspond to the proposed exhibit numbers. This means the parties should meet and confer with respect to joint exhibits <u>prior to</u> the deadline for the initial *Markman* briefs. For example, if Complainants intend to attach a copy of a dictionary definition, Complainants should mark that attachment as a proposed (four-digit) exhibit (*e.g.*, CXM-0003) and refer to that attachment by the proposed exhibit designation in the briefing (*e.g.*, *see* proposed CXM-0003 at

[13] *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011); *Vanderlande Indus. Nederland BV v. Int'l Trade Comm.*, 366 F.3d 1311, 1323 (Fed. Cir. 2004); *Vivid Tech., Inc. v. American Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

14). The Administrative Law Judge may disregard any attachments to the *Markman* briefs that have not been admitted into the record during the *Markman* hearing.

The parties are expected to use extrinsic evidence only for the purposes set forth in *Phillips v. AWH Corp*., 415 F.3d 1303 (Fed. Cir. 2005) and *General Protecht Group, Inc. v. International Trade Comm'n*, 619 F.3d 1303, 1310-11 (Fed. Cir. 2010). "[A]n expert's subjective understanding of a patent term is irrelevant." *General Protecht*, 619 F.3d at 1310-11. The Administrative Law Judge may, in her discretion, strike or disregard improperly advanced extrinsic evidence.

Reply or responsive *Markman* briefs are generally disfavored. Such briefs are permitted only upon an order issued upon a showing of good cause. They are limited to 50 pages, and must not repeat arguments presented in initial *Markman* briefs.

1.14.2. *Markman* Pre-Hearing Statement.

This section applies to **all** Investigations, whether or not patents are involved. However, any party who intends to take part in the *Markman* hearing in this Investigation must file on or before the date set forth in the procedural schedule a brief statement containing the following information:

(a) The names of all known speakers or witnesses, including an identification of whether the speaker is counsel, a fact witness, or an expert witness. If a party intends to use witnesses, the pre-hearing statement should include a very brief outline of the testimony of each witness.

(b) A list, by title and number, of all exhibits which the parties will seek to introduce at the *Markman* hearing. The list shall include five columns. In the first four columns, the party shall include the number of the exhibit, a brief description and the title of the exhibit, the purpose for which it is being offered, and each sponsoring witness. The last column shall be labeled "Received" and need only include sufficient space for a date.

(c) A list of any stipulations to which the parties have agreed. All stipulations should be filed on EDIS.

(d) A proposed schedule/allocation of time for the *Markman* hearing, including the estimated length for the appearance of each speaker or witness. (The parties shall confer on estimated dates and approximate length prior to submission of their pre-hearing statements).

1.14.3. *Markman* Hearing Evidence.

1.14.3.1. Exchange of Proposed Exhibits.

As noted above, the parties should meet and confer in an effort to identify and number joint exhibits <u>prior to</u> submission of the *Markman* briefs. Copies of proposed exhibit lists shall be served on the opposing parties by no later than the date set forth in the procedural schedule. Once the parties have exchanged their proposed exhibit lists, they shall further eliminate any inadvertent duplicate exhibits or renumber such exhibits as joint exhibits and update their exhibit lists. Any exhibits that have been cited to in the *Markman* briefing that have been consolidated

or renumbered must remain on the exhibit lists with a clear indication of what the new proposed exhibit number is. For example, if Respondents, in Respondents' *Markman* brief, had cited to some dictionary definitions marked as RXM-0003 and this exhibit was later renumbered as JXM-0056 to remove duplication, the entry on Respondents' proposed exhibit list would reflect this change.

RXM-0003	Excerpts from Oxford English Dictionary, 2nd Ed.	Extrinsic evidence as to common meaning of disputed terms "coextensive" and "adjacent"	Respondents' presentation	**Renumbered to JXM-0056**

Copies of proposed exhibits, if any, including all demonstratives, along with an updated proposed exhibit list, shall be served on the opposing parties by no later than the date set forth in the procedural schedule. Proposed exhibits shall not be filed with the Office of the Secretary of the Commission or served on the Administrative Law Judge in advance of the *Markman* hearing.

Final proposed exhibit lists should be filed as part of the *Markman* pre-hearing statement.

Final exhibits will be submitted to the ALJ's Box account. An e-mail link to Box will be provided before a *Markman* hearing or as otherwise directed at the *Markman* hearing (if there is one). If there is no Markman hearing, the exhibits with briefs should be filed directly on EDIS.

1.14.3.2. Service of Proposed Exhibits upon Administrative Law Judge.

Prior to the start of the *Markman* hearing, while Pandemic rules are in force, the parties should submit a copy of their *Markman* exhibits to the ALJ before the hearing through the Box link that will be provided. Those exhibits will be uploaded unto EDIS. If submission rules change, the parties will be notified.

1.14.3.3. Format and Submission of Admitted Exhibits.

The parties should refer to the procedures in Ground Rule 8 below with respect to the format and submission of admitted and rejected *Markman* hearing exhibits. *See* Ground Rule 8. Written exhibits shall be marked in order beginning with the four-digit number "0001" and preceded by the prefix "CXM" for Complainants' *Markman* exhibits, "RXM" for Respondents' exhibits, "SXM" for the Staff's *Markman* exhibits (if applicable), and "JXM" for any joint exhibits.

Additionally, all exhibits that are filed on EDIS with a motion, memorandum, or Markman brief should contain an explanation of content and not simply identified as an exhibit with an alpha character or number. For example, "Exhibit A: Declaration of ____;" "Exhibit 1: Declaration of ___."

Please note: the description of any Exhibit should not exceed 35 characters. File size may not exceed 25 MB consistent with the United States International Trade Commission Handbook on Filing Procedures at p. 11 and as described.

1.14.4. *Markman* Hearing.

The parties have the discretion to determine the order of presentation and allocation of time for the *Markman* proceedings. For example, the parties may have Complainants discuss all of the patents before moving on to Respondents and then Staff (if applicable), or the parties may each present their arguments with respect to one patent or claim term before moving on to the next patent. The parties may also determine what, if any, time will be allocated for rebuttal. The parties should keep in mind that the total time allocated for one *Markman* hearing day is 6.5 hours.

1.14.4.1. Opening Statement and Closing Argument.

Opening statements are required. Closing arguments are not necessary. They are however helpful. The Parties may choose whether to make a closing statement. Technology tutorials for each asserted patent are recommended, but not required.

1.14.4.2. *Markman* Hearing Hours.

Normal hearing hours are 9:30 a.m. to 5:30 p.m., with a one (1) hour luncheon recess and two (2) fifteen (15) minute breaks.

1.14.4.3. Admission of Exhibits.

The parties are responsible for moving their exhibits into the record and should initiate admission of exhibits on the record with the Administrative Law Judge in advance of the 5 p.m. (or other time) close of a *Markman* hearing. If the Administrative Law Judge approves admission of the requested exhibits, the parties should be prepared to submit a list of admitted exhibits to the hearing reporter for entry into the record.

The parties may seek to have demonstrative exhibits admitted into evidence for substantive or solely for demonstrative purposes. Such designation should be made clear on the record at the time of submission.

1.14.4.4. Transcript.

During the Pandemic, with the use of the Commission's Webex platform, the parties do not have the option of real time. That will likely change when we are back in the courtrooms. Transcripts provided in real time are preferred.

1.15. Stipulations.

1.15.1. Stipulations Generally.

All stipulations between/among the parties should be filed on EDIS. The parties should also notify the Administrative Law Judge via e-mail to McNamara337@usitc.gov of any such stipulations. Stipulations that vary these Ground Rules may not necessarily be approved without leave.

1.15.2. Technology Stipulations.

If the Administrative Law Judge has set a deadline for submission of a technology stipulation in the procedural schedule, the private parties are required to meet and confer in good faith and then, after consultation with Staff (if applicable), shall submit to the Administrative Law Judge two copies of a joint stipulation regarding the patent technology at issue in this Investigation. The parties shall further state the position of the Staff (if applicable) on the joint technology stipulation.

Said stipulation shall have one section for each asserted patent or family of patents, if it would be more appropriate, and, if applicable, a general technology section should be included that discusses technology common to all of the patents at issue. At a minimum, said stipulation should provide sufficient background information to understand the disputed claim constructions of each of the asserted claims in issue and should not include any facts upon which the parties are not in agreement.

It is expected that any facts listed in said stipulation may be used and relied upon throughout the remainder of the Investigation, including, *inter alia*, in the Administrative Law Judge's final initial determination on violation. Also, said stipulation should not be a vehicle for presenting legal arguments.

It is expected that the parties will use their best efforts to jointly create the technology stipulation. The joint technology stipulation to be submitted should have substance and should not be a list of quotations or paraphrases from the patents at issue (although discussion of the patents is expected to be a component part). *See Certain Electronic Devices, Including Mobile Phones, Portable Music Players, and Computers*, Inv. No. 337-TA-701, Order No. 26 at 1 (U.S.I.T.C., July 29, 2010).

1.16. Protective Orders and Patent Prosecution Bars.

In certain investigations, the private parties or nonparties have confidential materials that are relevant and discoverable and which may warrant heightened protections beyond those ordered[14] at the outset of the case. Parties in need of such heightened protections are promptly expected to begin negotiations for a protective order addendum, *i.e.*, within five (5) business days of the issuance of these Ground Rules. A party that has subpoenaed a nonparty for discovery is expected to immediately inquire, *i.e.,* within two (2) business days of subpoena

[14] This is usually Order No. 1, Protective Order.

service, whether nonparty intends to seek such protections and begin negotiations in good faith if source code or other highly confidential materials are identified in the subpoena. If a protective order addendum is sought by motion, rather than by private stipulation, such motion must be brought as soon as practicable to avoid discovery delays and should include evidence, such as a declaration, setting forth good cause for heightened protections under the circumstances. Parties and nonparties may not use the need for a protective order addendum as a basis to withhold other discovery that is non-confidential or that may be produced under the already governing protective order.

The parties should not include the Commission, Commission staff, the Administrative Law Judge or the Administrative Law Judge's staff in protective orders. They are already covered under Commission rules that protect CBI.

The Administrative Law Judge orders that any party bringing a motion for a protective order addendum containing provisions for a proposed patent prosecution bar should review *Certain Consumer Electronics, Including Mobile Phones and Tablets,* Inv. No. 337-TA-839, Order No. 28 (U.S.I.T.C., 2013). It is further recommended, but not required, that rather than seek a patent prosecution bar in advance, the parties instead incorporate a notification provision requiring any individual seeking to view highly confidential materials subject to a protective order addendum to certify in writing whether or not they have recently, are, or in the near future intend to be engaged in patent prosecution or competitive decision making. This would allow the supplier to promptly seek an individually tailored patent prosecution bar (by stipulation or motion) prior to access, and would improve the chances of meeting the criteria set forth in *In re Deutsche Bank Trust Co. Americas*, 605 F.3d 1373 (Fed. Cir. 2010).

2. Motions.

Parties with similar interests should coordinate and consolidate motion practice to the extent practicable.

2.1. Contents.

All written motions shall consist of (i) the motion; (ii) a separate memorandum of points and authorities in support of the motion;[15] (iii) an appendix of declarations, affidavits, exhibits, or other attachments in support of the memorandum of points and authorities; and (iv) a Certificate of Service as required by Commission Rule 201.16(c). It is recommended that a moving party clearly articulate what relief is requested in the motion, as well as the law and facts supporting said request(s). Without leave, the motions and supporting memoranda together shall not exceed thirty-five (35) pages, and all attachments to motions shall not exceed a total of one hundred (100) pages. Any motion exceeding either page limit may be denied without prejudice or stricken. An Order may issue for the party to re-submit its motion to comply with the Ground Rule.

[15] A separate memorandum of points and authority is not necessary for motions shorter than five (5) pages.

Offers of Proof fall under this category. An Offer of Proof is a type of Motion, in some sense a motion for reconsideration. A written offer of proof may not exceed the page limitations specified in this section. It should not even come close to the page limitation for motions. The ALJ may specify a different page limitation based upon the circumstances and type of evidence. Please do not misuse the Offer of Proof for a purpose that is inappropriate. For example, if a defense has been denied and eliminated, it is inappropriate to try to resurrect it through an Offer of Proof. Another example is an attempt to change inadequate or existing discovery testimony to enhance the record to the advantage of the proponent for the Offer of Proof. Moreover, a proper Offer of Proof is more often than not a proffer of a line of questions and answers that would have been given in testimony, and typically, based upon already existing evidence. Please review Fed. R. Evid. 103, commentary and precedent that pertains to the same before making an Offer of Proof.

All motion responses shall consist of: (i) a memorandum of points and authorities in response to the motion; (ii) an appendix of declarations, affidavits, exhibits, or other attachments in support of the memorandum of points and authorities; and (iii) a Certificate of Service as required by Commission Rule 201.16(c). All responses to motions shall also include the Motion Docket Number assigned to the motion by the Commission's Office of the Secretary in either the title or the first paragraph of any such responses. EDIS discloses what docket number has been assigned to a motion. Without leave, responses to motions and memoranda supporting such responses together shall not exceed twenty-five (25) pages, and all attachments to responses to motions shall not exceed a total of one hundred (100) pages.

Unopposed motions and joint motions shall contain a proposed order. On the same day the motion is filed, a version of the motion including the proposed order in MS Word for Windows shall be submitted to McNamara337@usitc.gov via e-mail.

All exhibits submitted with any motion/memorandum must contain exhibit descriptions of the content of the exhibits in addition to an alpha or numerical character. The exhibit descriptions should not exceed 35 characters. The size of any file should not exceed 25 MB (See United States International Trade Commission Handbook on Filing Procedures).

2.2. Certification.

All motions shall include a certification that the moving party has made a reasonable, good-faith effort to contact and resolve[16] the matter with the other parties at least two (2) business days before filing the motion, and shall state, if known, the position of the other parties regarding the motion. Non-moving parties shall try to timely and substantively respond in good faith to moving party's efforts to resolve a motion.

2.3. High Priority Objections, Motions *in Limine* and Motions to Strike.

The procedural schedule provides a date for filing a document listing and providing a narrative explanation of the objections to exhibits which the party believes to be of high priority for discussion or ruling at the hearing. Additionally, the procedural schedule also specifies the

[16] Emailing the other parties to inquire as to their position on the proposed motion does not constitute a good faith effort to resolve the matter.

number of motions *in limine* and high priority objections in combination for each Party and the last date that they can be filed.

All motions *in limine* and high priority objections must be numbered as 1, 2 or 3, etc. Similarly, the responses to motions *in limine* and high priority objections should use the same number of the motion or objection it addresses, i.e., MIL No. 1, 2, 3, etc.

Without leave, each motion *in limine* and high priority objection shall not exceed twenty-five (25) pages, and all attachments to such motions shall not exceed a total of fifty (50) pages. Responses to such motions shall not exceed the same. Any motion exceeding any of these page limits may be denied without prejudice or stricken.

In addition to the foregoing requirements, motions to strike must include by page and line number the text and/or testimony the movant seeks to have stricken, if applicable. The movant should include as attachments to the motion the document containing the page and line numbers of the text to be stricken.

Pre-hearing motions to strike should be few in number and filed rarely.

Each party is limited to one pre-hearing motion to strike without leave. However, if such a motion to strike is filed within two (2) months of the commencement of the evidentiary hearing, it will be treated as a motion *in limine* or high priority objection and it will count against that party's (or group's) permitted number of motions *in limine* and high priority objections.

This rule does not apply to objections to evidence/testimony or motions to strike raised/filed during the hearing or to motions to strike filed post-hearing. *See also* G.R. 9.8.

2.4. Summary Determination Motions.

No more than one (1) motion for summary determination on one (1) issue may be filed by complainants as a group and by respondents as a group (or individually by each party in a group if they do not share an identity of interests) without first filing a motion for leave. A motion for summary determination is limited to 10,000 words (which equates to approximately 40 pages), using 12-point font in text, 11-point font in footnotes and 1.0-inch side margins. Tables of contents, a page(s) containing abbreviations, the page(s) of citations to case precedent, and document headings will not be counted in the count for the number of pages. No more than 100 pages in exhibits may be attached without leave.

Motions for summary determination shall be accompanied by a separate statement of the material facts with which the moving party contends there is no genuine issue, and which entitles the moving party to a summary determination as a matter of law.

Additionally, the statement of material facts must include a chart that consists "of short, factual statements with specific references to supporting declarations, affidavits or other materials."

Whenever possible, the factual statement should be a direct quote from record evidence, using quotation marks. The format of the chart should be substantially as follows:

Item #	Factual Statement	Citation	Disputed	Factual Rebuttal	Citation

The moving party shall fill out the first three columns of the chart (item number, factual statement/quote, and citation), and any non-moving party shall fill out the remaining columns (indication of dispute, factual rebuttal, citation).

2.4.1. Response to a Motion for Summary Determination.

A response to a motion for summary determination is limited to 10,000 words (approximately 40 pages) as counted above in Ground Rule 2.4.

The response shall complete and append the chart of facts prepared by the movant. The response shall complete the last three columns of the chart (indication of dispute, factual rebuttal, citation) by reproducing specific record evidence that shows or other materials. Whenever possible, the factual rebuttal should be a direct quote from record evidence using quotation marks. The chart shall not be included in the word count.

Parties should avoid boilerplate rebuttals, and particularly should avoid rebuttals or objections that are not directly relevant to the material fact at issue. <u>If a material fact, or a portion of a material fact, is undisputed, the responding party should so state.</u>

All material facts set forth in the moving party's chart may be deemed admitted by a non-moving party unless the non-moving party specifically controverts the statement.

2.5. Discovery and Discovery-Related Motions.

The Administrative Law Judge will try to convene two (2) telephone conferences with the parties at least one of which will be during the discovery period. Dates for these telephone conferences will be included in the procedural schedule governing this Investigation. The parties shall alternate responsibility for securing a dial-in number and a court reporter to transcribe these conferences, beginning with the complainant. The transcript for all conferences shall be filed on EDIS after the parties have jointly submitted a telephone hearing transcript containing their proposed redactions because of CBI no more than seven (7) days from the parties' receipt of the transcript.

Prior to filing **any motion related to a discovery dispute**, the party that seeks to file such a motion must discharge its obligation to meet and confer under Ground Rule 2.2. If, after discharging its obligation under that rule, the discovery dispute persists, that party shall submit a letter explaining the nature of the discovery dispute to <u>McNamara337@usitc.gov</u>. The letter shall be submitted by e-mail to McNamara337@usitc.gov and shall consist of no more than two (2) pages. Any party that seeks to submit a responsive letter must do so no later than (2) business days following submission of the initial letter by the intended movant. Any responsive letter should be submitted by e-mail to the address above and shall be no more than two (2) pages. The underlying discovery dispute will then be placed on the agenda for the next scheduled

teleconference with the Administrative Law Judge. There may be interim telephone conferences as may be necessary.

One business day before each scheduled telephone conference, the parties shall jointly submit to McNamara337@usitc.gov a proposed agenda for the telephone conference, which shall include all disputes raised according to the procedure above.

If no disputes are pending, and there is no need for the scheduled telephone conference on the procedural schedule from the parties' perspective, the parties shall notify the Administrative Law Judge by e-mail to McNamara337@usitc.gov at least two (2) business days before the scheduled telephone conference may not be necessary

Leave to file a discovery-related motion will be granted, if at all, only after the intended movant has complied with the procedure provided herein.

2.5.1. Contents

Any discovery-related motion must have appended to it the pertinent parts of the discovery request and all objections and answers thereto. Additionally, if the party subject to the motion to compel serves supplemental discovery responses while the motion is pending, then the response to the motion must include copies of the supplemental responses, or, where documents are produced, a detailed accounting of what additional documents were produced.

2.6. Request for Shortened Time to Respond to Motion.

If a party seeks expedited treatment pursuant to Ground Rule 1.9.2., such motion shall include any request to shorten the time for which other parties may respond to the motion. The fact that a shortened response time is requested shall be noted in the title of the motion and the motion shall include an explanation of the grounds for such a request. A request for a shortened response time shall not be made through a separate motion.

2.7. No Motion Stops Discovery Except Motion to Quash Subpoena.

The submission of a motion does not stop discovery except in the case of a timely motion to quash a subpoena, and only with respect to the party or witness who may be a non-party who is served with a subpoena.

2.8. Motion Deadlines in the Procedural Schedule.

Although the procedural schedule contains several cut-off points for bringing motions (motions to compel discovery, summary determination motions, and motions *in limine*), parties are expected to bring their motions on a rolling basis. Parties who fail to diligently bring issues to the attention of the Administrative Law Judge as close to the time of the dispute as practicable may find that their arguments have lost persuasive value. *See e.g.*, *Certain Electronic Devices, Including Wireless Communication Devices, Portable Music and Data Processing Devices, and Tablet Computers*, Inv. No. 337-TA-794, Order No. 52 at 2 (U.S.I.T.C., 2012).

Motions to compel discovery must comply with Ground Rule 2.5.

2.9. Mootness.

The parties should file a notice on EDIS within seven (7) business days when any issue, such as an invalidity argument, a substantive factual or expert theory (often called a "contention"), or any other allegation or defense becomes moot, or is being dropped.

If a change in circumstances renders all or any portion of a motion moot, the moving party is expected to promptly file notice (with the pertinent motion number in the document title) as to whether all or a specific portion of said motion is being withdrawn. In addition, movant is expected to notify my Attorney Advisor via email within 24 hours.

3. Discovery.

The parties should make intensive good faith efforts promptly commence and respond to discovery. Lack of diligence may affect a party's showing of good cause for motions to enforce discovery, particularly if such motions are adjacent to the close of fact discovery. In the same vein, failure to promptly seek a protective order in the face of highly objectionable or inappropriate discovery requests may undermine the opposition of a party responding to a motion to compel. The parties should also note that the deadlines in the procedural schedule are considered to be the last day to complete a task. Because these are fast-paced proceedings, parties are expected to exert diligence and file motions earlier than the stated deadline, such as motions to compel discovery or to enforce subpoenas. Parties should not tactically seek to withhold or delay motions or discovery, as every party is expected to proceed expeditiously. Commission Rule 210.2.

The Commission has affirmed that the notice of investigation, not a complaint, defines the scope of an investigation. 78 F.R. 23476 (April 19, 2013). "The scope of discovery is necessarily commensurate with the scope of the investigation." *Certain Rechargeable Lithium-Ion Batteries, Components Thereof, and Prods. Containing Same*, 337-TA-600, Order No. 8 (July 25, 2007). Thus, it is unacceptable for a party to unilaterally limit the scope of discovery to solely those products specifically accused in the complaint, and a party refusing to respond to discovery requests on this ground may be subject to sanctions in light of the Commission's clear guidance on this issue. Should a party have serious concerns about the scope of the notice of investigation or about the scope of requested discovery, it has a responsibility to promptly take appropriate action.

3.1. Resolution of Disputes; Coordinated Discovery.

The parties shall make reasonable efforts to resolve between or among themselves disputes that arise during discovery. Parties with similar interests must coordinate and consolidate depositions and all other discovery.

3.1.1. Discovery Committee.

Starting the first full week after these Ground Rules are issued, a discovery conference committee (the "Discovery Committee") consisting of the lead counsel for each party and Staff,

if Staff is a party, shall confer at least once every two (2) weeks during the discovery phase of this Investigation, either in person or by telephone, to resolve discovery disputes. The Discovery Committee shall confer in good faith to resolve every outstanding discovery dispute in a timely manner within the deadlines set forth in the procedural schedule.

Within ten (10) calendar days after the end of each month during the discovery phase, the Discovery Committee shall report in writing to the Administrative Law Judge all disputes that were resolved during the preceding month and all disputes about which there is an impasse as of the end of that month. No motion to compel discovery may be filed unless the subject matter of the motion has first been brought to the Discovery Committee and the Committee has reached an impasse in trying to resolve it. It is recommended, but not required, that within twenty-four (24) hours of each meeting the Discovery Committee members exchange[17] written confirmation of what disputes have reached an impasse.

3.2. Stipulations Regarding Discovery Procedure.

Unless otherwise directed by the Administrative Law Judge, the parties may, by written stipulation, modify procedures for, or limitations placed upon, discovery. The parties may not stipulate to change any Commission Rule with respect to discovery, unless the Rule expressly permits it. *See, e.g.*, Commission Rules 210.28(a), 210.29(a). Furthermore, stipulations extending the time provided in Ground Rule 3.4.2 and Commission Rules 210.30(b)(2) and 210.31(b) for responses to discovery, if they would interfere with (i) the target date of this Investigation, (ii) any time set in the procedural schedule or other order related to completion of discovery,[18] or (iii) the evidentiary hearing or hearing of a motion, may only be made with the advance approval of the Administrative Law Judge upon a timely written motion showing good cause.

3.3. Service of Discovery Requests and Responses.

Discovery requests and responses must be served on all parties, including Staff (if applicable), but are not to be served on the Administrative Law Judge, or her Attorney Advisor, or filed on EDIS unless they are appended to a motion.

3.4. Timing of Discovery Requests, Responses and Objections.

3.4.1. Depositions.

In addition to the requirements of Commission Rule 210.28(c), unless otherwise ordered or stipulated pursuant to Ground Rule 3.2, any party desiring to take a deposition shall give **at least ten (10) days'** written notice to every other party if the deposition is to be taken of a person located in the United States, or at least **fifteen (15) business days'** written notice if the deposition is to be taken of a person located outside the United States. No party shall notice the

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[17] Such exchange should not be served on the Administrative Law Judge or filed on EDIS, unless it is appended as a necessary component to a discovery motion or response thereto.

[18] *See, e.g., Certain Dynamic Random Access Memory and NAND Flash Memory Devices and Products Containing Same*, Inv. No. 337-TA-803, Order No. 42 at 3, n.1 (U.S.I.T.C., 2012).

deposition of a party witness without first consulting with the opposing party and Staff, if Staff is a party, regarding the availability of witnesses and counsel for the deposition. Opposing party (and Staff) shall make a good faith effort to timely consult with the party requesting said deposition.

3.4.1.1.Depositions in Japan.

If an application for a recommendation to the U.S. District Court requiring depositions of a party in Japan is necessary, it should be titled as an "application" but filed on EDIS as a "motion." The application should include a statement as to the other parties' positions regarding the application as well as any relevant supportive material.

If the Administrative Law Judge determines that the application should be granted, an order and recommendation will issue. A copy will then be served on all parties. It is the responsibility of the applicant to determine whether the U.S. District Court requires a certified original. If so, the applicant should include in a cover letter, or include in the application itself, clear instructions explaining the requirement, and if the applicant prefers to pick up the certified original, the manner of pick up and the individual to be contacted. Absent these instructions, only the service copy will be sent to the applicant.

3.4.2. Interrogatories.

In addition to the requirements of Commission Rule 210.29(b), unless otherwise ordered, the party on whom interrogatories have been served shall serve a copy of the answers, and any objections, within **ten (10) days** after the service of the interrogatories.

3.4.3. Requests for Production of Documents or Things or for Entry upon Land.

See Commission Rule 210.30. Additionally, the parties should start providing documents to one another within fifteen (15) days of receiving a Request for Production.

3.4.4. Request for Admission.

In addition to the requirements of Commission Rule 210.31(a) and (b), a request for admission may be served at any time **twenty (20) days** after the date of service of the Complaint and Notice of Investigation.

3.4.5. Discovery Cutoff and Completion.

All discovery requests, including requests for admissions, must be initiated long enough before the fact discovery cutoff and completion date to allow responses by that date without curtailing the response times prescribed in the Commission Rules and Ground Rules. Discovery requests by any party that would require responses after the fact discovery cutoff and completion date must be approved in advance by the Administrative Law Judge upon a showing of compelling circumstances.

3.5. Subpoenas.

Subpoenas may be requested to compel third parties to testify or produce documents. The Administrative Law Judge expects the parties to diligently seek third-party subpoenas as early as practicable in the Investigation, and to take quick action to enforce said subpoenas if third parties delay. *See* Ground Rule 3.5.2. Hearing subpoenas will be issued only if the subpoenaed party refuses to testify.

3.5.1. Issuance and Service.

Pursuant to Commission Rule 210.32, applications for subpoenas may be made *ex parte* to the Administrative Law Judge. An application shall be in writing with the proposed subpoena attached. One (1) original and one (1) copy thereof shall be submitted to the office of the Administrative Law Judges.

The subpoena application shall set forth: (i) the relevancy of the information sought and the reasonableness of the scope of the inquiry; and (ii) shall state that the subpoena will be served (on the individual or entity subject to subpoena) by overnight delivery, if not sooner. The subpoena should: (i) set forth a time limit for a motion to quash; and (ii) should refer to and also have a copy of the Protective Order in this Investigation as an attachment. At a minimum, the subpoenaed party shall be given ten (10) days after receipt of the subpoena to file a motion to quash.

Any dates in a subpoena for appearance of a deponent or production of documents shall accommodate the time allowed for the filing of any motions to quash and shall accommodate for the time needed for the Office of Administrative Law Judges to process the subpoena application.[19] *See* Commission Rule 201.14(a); Ground Rule 1.12. A copy of the issued subpoena and the application shall be served by the applicant on the subpoenaed party by overnight delivery, if not sooner, and on all other parties to this Investigation on the next business day, at the latest, after the subpoena is issued.

A sample of a subpoena application is attached as **Appendix A**. In addition, two forms of subpoenas, which the parties must follow precisely, are attached as **Appendix A**. The parties must seek advance leave if they wish to make substantive changes to the subpoena forms. The application and subpoena shall not be filed on EDIS or served on the Office of the Secretary of the Commission unless they are appended to a motion.

3.5.2. Extensions and Enforcement.

Any stipulated extensions to the time set forth for discovery in a subpoena must be made in writing and signed by the requesting party and the nonparty. A stipulation to extend the deadline to respond to a subpoena may be filed once as a matter of course. A motion for leave demonstrating good cause must be filed for any additional extensions. The same applies to third-party subpoenas.

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[19] This is typically 24-48 hours, depending in part on whether the application is delivered by mail or by courier. Parties with urgent subpoena requests should contact the Administrative Law Judge's Attorney Advisor.

There is always an expectation that good faith efforts to rapidly negotiate with a nonparty to gain subpoena compliance should be made and documented. *See also* Ground Rule 1.16. However, these are expeditious proceedings and a nonparty's failure to cooperate or respond to a subpoena should be brought promptly to the attention of the Administrative Law Judge by way of a supported motion for judicial enforcement. Lack of diligence may affect a party's showing of good cause for motions to enforce (or defend against) discovery, particularly if such motions are adjacent to the close of fact discovery.

If a motion to enforce or quash a subpoena, or a response to such a motion, contains confidential business information, a public version with confidential materials redacted must accompany the confidential filing. *See* Commission Rule 210.32(g).[20] If movant, nonparty, or other responding parties fail to timely file non-confidential versions of their pertinent papers on EDIS, then the Administrative Law Judge will exercise discretion as to what portions of a final order may be treated as confidential. Commission Rule 210.5(e)(1). In addition, in the event of a failure to timely file non-confidential version when another party or a nonparty is not permitted to view the confidential business information contained therein, the Administrative Law Judge may consider whether such failure was effected for an improper purpose.

3.6. Bates Numbering.

Documents produced in response to a document request which are copies of original documents, shall be numbered sequentially by a unique number (commonly known as a "Bates number"). The Bates number shall appear stamped on the lower right-hand corner of the page. The parties are encouraged to use Bates numbers without long prefixes. For example, the short Bates number XYZ-00001 is preferable over LONGPARTYNAME-ITCNUMBER-00001.

3.7. Translations.

A document produced in response to a document request shall be either the original or a legible and complete copy. If an English translation of any document produced exists, the English translation must also be produced. If any of the parties dispute the translation provided by the producing party, then the translation must be certified by a qualified and neutral translator upon whom counsel can agree.

3.8. Privileged Matter.

In addition to the requirements set forth in Commission Rule 210.27(e) with respect to privilege logs, each privilege log shall contain a certification that all elements of the claimed privilege are met and have not been waived with respect to each document. The parties should not provide a "key" at the end of a privilege log with the position and entity of each sender and recipient, or otherwise require cross-referencing.

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[20] This is necessary because a certification to the Commission requires simultaneous public and confidential orders to issue. *Id.* Therefore, proposed redactions submitted after an order issues are not feasible.

4. Notice of Patent Priority Dates and Notice of Prior Art.

Patent Priority Dates.

Complainant(s) must file on or before the date set in the procedural schedule, a notice setting forth the alleged priority date[21] for each asserted patent, and if applicable because of differences in priority dates, for each asserted patent claim. Such notice will be binding on Complainant(s) and may not be amended absent a timely written motion showing good cause.

Prior Art.

The purpose of the prior art identification is to notify all parties (early in the Investigation) of the prior art likely to be raised during the hearing on the question of violation of section 337, and thus to allow the parties to formulate their facts and factual predicates, theories of the case, and to allow the experts to provide meaningful reports and deposition testimony.

Parties must file on or before the date set in the procedural schedule, notices of any prior art containing of the following information: issuing country, number, date, and name of the patentee of any patent; the title, date and page numbers of any publication to be relied upon as evidence of invalidity of the patent in suit; and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit. Such notices should include the information set out in 35 U.S.C. § 282.

If a trademark is involved, the parties must file on or before the date set in the procedural schedule, notices of any art on which a party will rely at the hearing regarding the functionality or non-functionality of any trademarks at issue.

Prior art, as well as related evidence, that is not disclosed in the Notice of Prior Art on or before the date set forth in the procedural schedule will not be admitted at the hearing absent a timely written motion showing good cause. Notices of prior art with excessive disclosures have been stricken in the past on the basis that they thwart the purpose of this Ground Rule 4. *See, e.g., Certain Wireless Communications System Server Software, Wireless Handheld Devices and Battery Packs*, Inv. No. 337-TA-706, Order No. 10 (U.S.I.T.C., 2010); *Certain Electronic Devices, Including Wireless Communication Devices, Portable Music and Data Processing Devices, and Tablet Computers*, Inv. No. 337-TA-794, Order Nos. 40, 56 (U.S.I.T.C., 2012).

5. Expert Witnesses and Reports.

On or before the dates set forth in the procedural schedule, a party shall disclose to all other parties the identity of any person who is retained or employed to provide expert testimony

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[21] This disclosure should make clear what date(s) Complainant(s) intend to rely on for asserting priority of invention, if at all, as Complainant(s) are presumed to be in possession of dates of conception and reduction to practice for the asserted patent claim(s). Likewise, if Complainant(s) intend to rely on an earlier related or foreign application to the asserted patent claim(s), the priority disclosure should also make this clear. The purpose of this notice in light of the expeditious nature of these proceedings is to help delineate the boundaries of the search for prior art.

at the hearing and shall provide the other parties a written report prepared and signed by that witness. Experts who are not disclosed on or before the date set forth in the procedural schedule must be approved in advance by the Administrative Law Judge upon a showing of compelling circumstances.

An electronic courtesy copy of the expert report shall be served on the Administrative Law Judge through McNamara337@usitc.gov, excluding exhibits, as noted in Ground Rule 1.3.2.

The report shall contain a complete statement of all opinions to be expressed and the basis and reasons therefor; the data or other information considered by the witness in forming the opinions; any exhibits to be used as a summary of or support for the opinions; the qualifications of the witness, including a list of all publications authored by the witness within the preceding ten years; the compensation to be paid for the study and testimony; and a listing of any other cases in which the witness has testified as an expert at hearing or by deposition within the preceding four (4) years. The parties shall supplement these disclosures as needed in the manner provided in Commission Rule 210.27(c).

The parties should note, however, that unseasonable,[22] substantive supplementation of an expert report requires agreement prior approval from the Administrative Law Judge.

6. Settlement; Settlement Reports.

All parties, throughout the proceedings, shall explore reasonable possibilities for settlement of all or any of the contested issues. All parties shall certify in their pre-hearing statements that good faith efforts were undertaken to settle the remaining issues.

Additionally, for each of the required settlement conferences provided for in the procedural schedule, the parties shall provide the Administrative Law Judge with two (2) double-sided copies of a joint report signed by all the parties setting forth any stipulations on which the parties have agreed. The report must also disclose what meeting(s) took place, who attended, and what result, if any, was obtained in each meeting. *See e.g., Certain Dynamic Random Access Memory and NAND Flash Memory Devices and Products Containing Same*, Inv. No. 337-TA-803, Order No. 16 (U.S.I.T.C., 2011). These reports are due by the time designated in the procedural schedule or within such other time as the Administrative Law Judge may allow. The reports shall not be filed with the Office of the Secretary of the Commission.

7. Pre-Hearing Submissions.

Courtesy copies of all pre-hearing submissions shall be 3-hole punched in addition to being double-sided. **All filings exceeding 100 pages in length must be placed in binders, preferably not exceeding 3" in width.** Courtesy copies of all motions *in limine* should also meet this format requirement. Ground Rule 2.9 regarding mootness applies to all motions *in limine* and high priority objections.

[22] For example, if a party wishes to supplement an initial expert report after the deadline for rebuttal reports has passed.

7.1. Pre-Hearing Statement.

Pre-hearing statements are limited to 100 pages, including attachments, without leave from the ALJ. Each party who intends to take part in the hearing in this Investigation must file on or before the date set forth in the procedural schedule a pre-hearing statement containing the following information:

(a) The names of all known witnesses, their addresses, whether they are fact or expert witnesses (and their fields of expertise), and a brief outline of the testimony of each witness. In the case of expert witnesses, a copy of the expert's curriculum vitae shall accompany this submission. The identification of witnesses should be contained in the text of the pre-hearing statement and not attached as an exhibit.

(b) A preliminary list, by title and number, of all exhibits that the parties will seek to introduce at the trial. The list shall include five columns. In the first four columns, the party shall include the four-digit number of the exhibit, a brief description and the title of the exhibit, the purpose for which it is being offered, and each sponsoring witness. The last column shall be labeled "Received" and need only include sufficient space for a date.

(c) A list of any stipulations on which the parties have agreed. It is expected that all stipulations other than discovery stipulations will be marked as joint exhibits. For example, the technology stipulation (*see* Ground Rule 1.15) should be marked as a joint exhibit.

(d) A proposed agenda for the pre-trial conference.

(e) Estimated date and approximate length for appearance of each witness. (The parties must confer on this prior to submission of the pre-hearing statements).

(f) Certification regarding good faith efforts to settle. *See* Ground Rule 6 *infra*.

Additional Submission, Complainant(s).

In addition to the above, in patent Investigations, Complainant(s) shall attach a chart or table to the pre-hearing statement specifically matching all asserted patent claims to each accused article. If there are nuances, *e.g.*, with respect to model number or particular components, these should be identified. Furthermore, Complainant(s) should identify representative accused articles, if any. The chart should further identify the asserted type(s) of infringement. For example, if there are three asserted claims and five accused articles, a sample chart might appear as follows.

'##1 Patent, claim 5	'##1 Patent, claim 7	'##2 Patent, claim 12
P Product family: Accused Product AA (7MA config. only) Accused Product BB	P Product family: Accused Product BB	P Product family: n/a
Q Product family: Accused Product CC Accused Product EE	Q Product family: Accused Product DD Accused Product EE	Q Product family: Accused Product CC (T6 config. only) Accused Product DD

		Accused Product EE
Representative Products: Accused Product BB Accused Product CC	Representative Products: Accused Product BB Accused Product EE	Representative Products: Accused Product CC (T6 config. only) Accused Product EE
Infringement: Literal Direct, induced, contributory	Infringement: Literal Direct, induced, contributory	Infringement: Literal, Doctrine of Equivalents (Accused Product CC, T6 config. only) Direct

Complainant(s) shall be bound by the identification of asserted claims as matched to the accused products in this submission.

Additional Submission, Respondent(s).

In addition to the above, in patent Investigations, Respondent(s) asserting any Section 102 or 103 invalidity defenses shall attach a chart or table to the pre-hearing statement listing all asserted prior art references, or combinations of references, and specifically matching these to each asserted patent claim. For example, if there are four prior art references and five asserted patent claims, a sample chart might appear as follows.

Cheng (§102)	**Davis (§103)**	**Davis, Scott, Maxwell (§103)**	**Davis, Maxwell, Aguilar (§103)**
'##1 Patent, claim 5	'##1 Patent, claim 12	'##1 Patent, claim 12	'##1 Patent, claim 12
'##2 Patent, n/a	'##2 Patent, claims 12, 16, 17	'##2 Patent, claim 17	'##2 Patent, claim 12, 16

If Respondent(s) use a single chart, each entry must clearly state whether Section 102 or 103 is applicable. (*See* above sample.) Respondent(s) may alternatively separate the Section 102 and 103 invalidity defenses into two charts in the same submission.

Respondent(s) shall be bound by the identification of asserted prior art as matched to the asserted patent claims in this submission.

7.2. Pre-Hearing Brief.

The parties must meet and confer prior to filing the pre-hearing briefs in order to determine appropriate common locations for each issue. *See, e.g.*, **Appendix B**. For example, in an Investigation involving patent litigation, this conference should, *inter alia*, determine the order of patents to be set forth in the pre-hearing briefing.

On or before the date set in the procedural schedule, each party shall file a pre-hearing brief. Absent prior approval of the Administrative Law Judge, said brief shall consist of no more than one hundred fifty (150) pages and may have no more than fifty (50) pages of relevant

attachments. The parties should not use attachments to bypass the page limits of the pre-hearing brief, but may use them to attach critical charts, figures, or other pertinent material.

The pre-hearing brief shall be prefaced with a table of contents and a table of authorities, which do not count toward the page limits. The brief shall set forth with particularity the authoring party's theories of the case and contentions on each of the proposed issues, including citations to legal authorities in support thereof, and shall conform to the sample outline set forth in **Appendix B** hereto. All issues, including issues not specifically named in the general outline set forth in said appendix that any party seeks to address, shall be added where appropriate. The parties need not use precious space on lengthy introductory arguments.

If claim construction issues have not been resolved in a *Markman* order prior to the hearing, the parties need only cite to the last claim construction the party argued in its claim construction brief, or in its post-*Markman* hearing brief.

Any contentions and theories of the case not set forth in detail as required herein shall be deemed abandoned or withdrawn,[23] except for contentions of which a party is not aware and could not be aware in the exercise of reasonable diligence at the time of filing the pre-hearing brief. However, the parties are advised to select their best, well-reasoned and persuasive arguments, and abandon extraneous or far-fetched contentions at this time.

7.2.1. Content of Pre-Hearing Brief

There seems to be confusion about the content of pre-hearing briefs. A pre-hearing brief should never be is a diatribe against the other parties or claims made for which the party knows there is virtually no support. Choose issues carefully. Limit. Focus on the strongest issues for which there is evidence. Additionally, a pre-hearing brief should *not* consist of primarily attorney argument, conclusory statements, or a mere re-recitation of language contained in patent claims or specifications. If you argue a proposition or issue which you know you will not win and there truly is little or no dispute or evidence, concede it and focus where there is at least a colorable argument.

Any factual or theoretical contention made, whether for infringement or for validity, and any other issues, must be supported by citations to likely exhibits, deposition testimony, expert reports, and be supported by case law. The reasoning and explanations of expert testimony or likely expert testimony should be clear and cite to supporting evidence. A pre-hearing brief without citation to evidence is not an appropriate pre-hearing brief.

Validity arguments, where there are multiple sources, should be clearly explained. At a minimum, *why* the piece of prior art was chosen should be explained. The technology from which it comes or relates to should be explained. If there are aspects of the prior art that do not apply, be clear about that. Too often parties attempt to hide or obfuscate. It cannot be emphasized enough that conclusory statements, including about anticipation or motivation to combine needs to be explained, with reasoning, or to put it another way, a structured argument is

[23] *Certain Automated Media Library Devices*, Inv. No. 337-TA-746, Comm'n Op. at 14-16 (U.S.I.T.C., 2013).

a requirement. If the other party's critique is wrong, explain *why*, with reasoning and evidentiary support.

Block string cites are not appropriate. Similarly, merely attaching Appendices to a pre-hearing brief with block string cites is never appropriate. String cites that have meaning or contain necessary, corroborative evidence from different sources may be appropriate, especially if there are multiple evidentiary sources for a theory, proposition, illustrative point or argument. Charts are fine if, in fact, the individual elements are supported, again, by *evidence.* Include the citations to evidence.

All of the above applies to expert reports.

7.3. Joint Outline of Issues in Chart Form.

The parties must jointly create and maintain a single chart of substantive legal issues being litigated in the Investigation. The chart shall be jointly filed as a separate docket entry simultaneously with the pre-hearing and the post-hearing briefs. The parties' pre-hearing and initial post-hearing briefs will follow the order of the issues set forth in the chart. The leftmost column of the chart will list the issues being litigated, including all infringement and invalidity theories and defenses. The parties will create subsequent columns for each of their briefs, grouped by party (i.e., the chart accompanying the post-hearing reply briefs will include columns for Complainant(s)'s pre-hearing brief, initial post-hearing brief, and post-hearing reply brief, followed by columns for Respondent(s)'s pre-hearing brief, initial post-hearing brief, and post-hearing reply brief). The cells of the columns will contain page numbers of the particular sections of the briefs where those issues are addressed.

If issues, facts, claims, patents, arguments, or defenses have dropped out from the pre-hearing briefs, that should be noted explicitly in the chart accompanying the initial post-hearing briefs. That same principle should carry through to the outline accompanying the post-hearing reply briefs.

8. Hearing Exhibits.

8.1. Material to Be Received Into Evidence.

Only factual material and expert opinion shall be received into evidence. Legal argument shall be presented in the briefs.

8.2. Legal Experts.

Legal experts may only testify as to procedures of the U.S. Patent and Trademark Office. In the event that legal experts are called to testify on foreign law, Federal Circuit Court and Commission precedent will apply to interpretation.

8.3. Witness Sequestration.

Fact witnesses may be in the courtroom during opening statements. However, fact

witnesses must then remain outside the courtroom until they have completed all testimony. Otherwise, Fed. R. Evid. 615 is referenced.

8.4. Witness Testimony.

Unless ordered otherwise, all witness testimony will be live testimony. To minimize the risk of biased testimony, after the parties provide opening statements, live fact witnesses shall not observe in the courtroom during the hearing until after they have completed their live testimony.

In the event witness statements are permitted in lieu of live witness testimony, witness statements (which will be rare) leave must be requested through motions practice at least one (1) month before the evidentiary hearing unless there is an illness or injury involved. If there is an illness or injury, leave by motions practice must occur as soon as practicable. It is not sufficient or acceptable in replacement of this rule that the parties agree between/among themselves to a witness statement. It should be noted that leave will rarely be granted for non, in-person, expert testimony. Additionally, the following rules would apply if leave by motion for other than in-person testimony is granted.

8.4.1. Witness Statements in Lieu of Direct Testimony (RARE).

Witness statements are disfavored and except as described, will not be allowed in place of direct testimony during the evidentiary hearing. Witnesses will not be permitted to read prepared testimony into the record. Staff may ask a witness supplemental direct testimony on the witness stand. Witnesses shall be available for cross-examination on the witness stand unless waived by the parties entitled to conduct cross-examination. While generally not a substitute for live testimony, witness statements containing background statements, such as CV type information, may be marked with exhibit numbers and offered into evidence as exhibits. Short witness statements, or preferably declarations, may be used to sponsor the admission of exhibits, only upon a showing of good cause set forth in a motion and only if: (1) a list of all such exhibits is attached to the witness statement; and (2) each such exhibit is explicitly cross-referenced to the corresponding portion of the witness statement in which the witness laid a foundation for the exhibit.

8.4.2. Format of Witness Statements (RARE).

In the exceedingly rare event that a witness statement of the type used by other Administrative Law Judges for direct testimony is allowed, the witness statement shall be in the form of consecutively numbered questions from counsel, with each question followed by the witness's own answer to that question. The final question from counsel should ask the witness whether or not the witness statement contains the witness's independent answers to the questions from counsel and should be followed by the witness's answer to this question and the witness's signature. The questions shall be in the form of a direct examination and the answers shall be in the form of verbal testimony, although the witness statement may be organized (e.g. headings, table of contents, and bulleted or numbered lists) to facilitate an understanding of the issues and may include illustrative excerpts from admissible exhibits. For evidentiary support, witness statements shall cite to exhibit numbers and brief descriptions of the exhibits (e.g., JX-0002

('123 Patent File History)) that will be introduced at the hearing. A witness statement must contain the entirety of the witness's direct testimony; attachments or incorporation of other documents by reference is not allowed.

A witness statement shall be in the language of the witness, and a foreign language witness statement shall be accompanied by a certified English translation thereof.

Except upon a timely written motion and for good cause shown, fact witnesses shall not review the witness statements of other witnesses and shall be excluded from the hearing prior to their testimony. Subject to restrictions imposed by any protective order entered in an investigation, this rule does not apply to exclude a party who is a natural person or an officer or employee of a party designated as the party's representative by its attorney.

If allowed in the first instance, witness statements may not be withdrawn, in whole or in part, without leave. Witness statements may not be amended. If witnesses desire to correct typographical or clerical errors in their testimony, they should prepare errata sheets. Counsel should mark the errata sheets as exhibits and should give them as quickly as possible to the other parties and to the Administrative Law Judge. During the hearing, a motion may be made to have the errata sheets accepted into the record.

Absent leave granted by the Administrative Law Judge, the total number of witness statement pages offered by the complainants (collectively) may not exceed one hundred (100) pages. Similarly, absent leave granted by the Administrative Law Judge, the respondents (collectively) may not offer more than one hundred (100) pages of witness statements. Tables of contents and certified translations are not counted toward the page limits. The text of the questions and answers in the witness statements may be single spaced, provided that at least double spacing is used between questions and answers, and at least a 12-point font is used. Illustrations may be included in the witness statements, but they will be counted among the aggregate number of pages that may be offered.

8.5. Expert Reports.

Pursuant to the procedural schedule, after conferring, each party, including the Staff (if Staff is a party), shall file on EDIS and submit to the Administrative Law Judge at McNamara337@usitc.gov, one copy of a statement stating its position on whether or not it intends to offer into evidence[24] any parts of their expert reports as part of a motion, or for any other purpose permitted under the rules. The expert report expected to be used as described should be identified. The statement shall not be filed with the Office of the Secretary of the Commission.

A courtesy copy of all expert reports must be submitted to McNamara337@usitc.gov. when they are submitted to other parties.

If a party files a motion to preclude parts of an expert report or makes any type of motion to strike any part of an expert report or expert deposition testimony, that party should take care

[24] Relevant parts of expert reports may be admitted into evidence.

not to withdraw or exclude any part of that same expert report and expert deposition testimony in exhibit lists. The opposing party may always rebut such a motion with other parts of the expert record. If the submissions are inadequate or distortive of testimony, the ALJ may, *sua sponte*, use other parts of the expert report or expert testimony to ensure that what is being presented is accurate in context.

8.6. Foreign Language Exhibits.

No foreign language exhibit will be received in evidence for substantive purposes unless a complete English translation of it is provided at the time set for exchange of exhibits. ***Translations of only a part or a section of a document will not be permitted.*** The entirety of any document must be translated. If any of the parties dispute the translation, then the translation must be certified by a qualified and neutral translator upon whom counsel can agree.

8.7. Exhibits.

8.7.1. Exchange of Proposed Exhibits.

The Ground Rules no longer specify an exact date by which copies of proposed documentary exhibits, along with a proposed exhibit list, shall be served on the opposing parties (including the Staff, if applicable). That gives the parties some flexibility. However, exhibit lists should be exchanged at least seven (7) days before the evidentiary hearing. After the proposed exhibit list exchange, the parties shall eliminate any duplicate exhibits or renumber such exhibits as joint exhibits and update their exhibit lists before they are submitted to the Administrative Law Judge.

Proposed physical and demonstrative exhibits need not be served but shall be identified in the proposed exhibit list. Proposed physical and demonstrative exhibits, however, must be made available for inspection by the other parties on the date established for the submission and service of proposed exhibits.

Proposed exhibits shall not be filed with the Office of the Secretary of the Commission.

8.7.2. Service of Proposed Exhibits upon Administrative Law Judge.

Just before, or during the evidentiary hearing, the parties shall provide the Administrative Law Judge with copies of the exhibits they plan to introduce, including an electronic PDF version of a list of proposed exhibits, along with a proposed exhibit list through a Box link that will be provided both before, during and after a hearing.

8.7.3. Maintenance and Filing of Final Exhibits and Final Exhibit List.

Before and after the evidentiary hearing, each party will be sent a Box link into which their preliminary and final exhibit lists and exhibits should be uploaded. Each party must submit a final exhibit list in conformity with Ground Rule 8.7.5, and the Procedural Schedule that reflects the status of all exhibits, including those admitted and rejected during the hearing. Any withdrawn exhibit shall be identified on the final exhibit list only, by exhibit number, and shall

indicate that it has been withdrawn. Withdrawn exhibits are not to be submitted; however, the rejected exhibits will be retained with the official record.

The parties are responsible throughout the course of the hearing for updating the exhibit lists and exhibits as well as for confirming that all admitted and rejected exhibits are included in the final exhibit list at the conclusion of the hearing.

A semi-final exhibit list should be submitted to Box through the link provided no later than 5 p.m. on the seventh day after the last day of the hearing. The exhibits should be organized as: (i) Admitted Confidential; (ii) Admitted Public; (iii) Rejected Confidential; and (iv) Rejected Public. The exhibits should be submitted to the Administrative Law Judge's assistant by appointment. The Administrative Law Judge's assistant will review the exhibits with the parties and notify them of any necessary corrections. It is advisable to leave time between the appointment with the Administrative Law Judge's assistant and the final submission deadline in order to make any needed corrections. Please be timely and courteous when working with the Administrative Law Judge's assistant on the submission of these exhibit sets.

All documents submitted as exhibits should be dated. If there are multiple iterations of the same documents, those multiple iterations should be dated. If, for example, screen shots of web sites are used, then the dates the screen shots were taken along with the https://address should be provided.

The parties are responsible for confirming that all admitted and rejected exhibits are included in the final filed exhibits. Any exhibits that are not included on the final exhibit list will not be considered as part of the record to be certified to the Commission when the final initial determination issues.

The Commission set of exhibits shall be uploaded using the Box platform with separate folders for each type of exhibit, e.g., CX (Public), CX (Confidential), etc. The exhibits must be PDF files and any file larger than 25MB shall be broken up into separate files. A Table of Contents file in PDF format which lists the names of all files in each folder should be created and included in each folder. Rejected exhibits should be provided in separate folders.
Any exhibits that are not included with the Commission exhibits and on the final exhibit list at the conclusion of the hearing will not be considered as part of the record to be certified to the Commission when the final initial determination issues. "Each type of exhibit (i.e., CX, CDX, CPX, RX, RDX, RPX, JX, JDX, JPX, SX, SDX, SPX, CX-{four digit number}C, CDX-{four digit number}C, RX-{four digit number}C, RDX-{four digit number}C, JX-{four digit number}C, JDX-{four digit number}C, SX-{four digit number}C, and SDX-{four digit number}C) must be submitted on a different [disc] or set of [disc]s so they may be uploaded and labeled more reliably by Docket[]" Services. Each disc "must have a label with the investigation name and number, and the range of exhibits contained thereon."

If the appropriate permission is received pursuant to Commission Rule 19 C.F.R. § 210.4(f)(8) and The Handbook of Filing Procedures § II.C(3)(a) to submit the Commission Set on paper, the following shall apply. In order to facilitate the optical scanning of the exhibits, the exhibits in the Commission Set shall consist of loose sheets (which may be clipped but not stapled) in folders (file folders, accordion folders, etc.) that are provided in sequentially-

numbered boxes. Each folder must be labeled to reflect the number of the exhibit contained therein, e.g., RX-0014C. In each box of the Commission Set, the folders containing the exhibits shall be placed in numerical order. Confidential exhibits and public exhibits shall be placed in separate boxes which are clearly marked as containing either confidential or public exhibits. *See* Ground Rule 8.6.5. Because public and confidential exhibits are to be placed in separate boxes, numerical gaps may appear in each box, e.g., the public box may contain exhibits CX-0001, CX-0002 and CX-0004, while the confidential box may contain CX-0003C and CX-0005C.

Finally, every exhibit that has been identified in the Pre-Hearing Briefs must use the same exhibit numbers in Post-Hearing Briefs and in the final submitted exhibit lists. The parties should take care not to withdraw exhibits they have used or are using in motions to strike or for offers of proof.

The final Exhibit List and Exhibits will be due two (2) days before each Party files its post-hearing brief.

8.7.4. Numbering and Labeling of Exhibits; Confidential Exhibits.

All exhibits or copies of exhibits shall be clear and legible. Each exhibit shall be identified by placing a label bearing the exhibit's **four-digit**[25] number (*e.g.*, CX-0003C or RX-0005) in the upper right portion of the exhibit's first page. Each exhibit may be assigned no more than one number. Further, the pages of each exhibit must be sequentially numbered in a consistent location on the pages and in a manner that will not permanently conceal information that is included in the exhibit. Except for good cause shown, each exhibit shall consist of no more than one (1) document and every page of every document shall be Bates numbered in accordance with Ground Rule 3.6. Exceptions to this "one document per exhibit" rule include instances when it would be appropriate to group certain documents together as a single exhibit, such as a group of invoices or related e-mails.

Respondent(s) shall coordinate their numbering to avoid duplication. Additionally, all parties shall coordinate exhibits to avoid unnecessary duplication (*e.g.*, patents; file wrappers).

If any portion of an exhibit contains confidential business information, the entire exhibit shall be treated as confidential. For certain lengthy exhibits of which only portions are confidential, the parties may be asked to submit a public version of the exhibit.

If an exhibit (including physical or demonstrative exhibits) contains confidential business information, a "C" shall be placed after the exhibit number. Furthermore, exhibits containing confidential business information shall also be marked according to the Protective Order requirements, preferably on every page. Exhibit lists must also reflect whether exhibits contain confidential business information by placing a "C" after the exhibit number in the listing. No exhibit list shall contain confidential information; all exhibit lists shall be public documents.

[25] All exhibits submitted to the Commission are now required to have "a four-digit exhibit number, with leading zeros as necessary."

For exhibits submitted electronically, in accordance with Ground Rule 8.7, public and confidential exhibits should be submitted separately. Each submission should have an accurate table of contents.

8.7.4.1. Documentary Exhibits.

Written exhibits shall be marked in order beginning with the number "0001" and preceded by the prefix "CX" for Complainant's exhibits, "RX" for Respondent(s)' exhibits, "SX" for the Commission Investigative Staff's exhibits (if applicable), and "JX" for any joint exhibits. The parties shall not "reserve" numbers, but instead must assign all numbers to the exhibits in their proper order.

8.7.4.2. Physical Exhibits.

Physical exhibits shall be numbered in a separate series commencing with "0001" preceded by the prefixes "CPX", "RPX", "SPX" and "JPX", for Complainant, Respondent, the Staff (if applicable), and joint exhibits, respectively. For the Commission Set, physical exhibits should be boxed and provided to the Administrative Law Judge's assistant no later than the second day after the close of the evidentiary hearing, by appointment. *See* Ground Rule 8.6.4 above. Physical exhibits that have been admitted into evidence are retained by the Commission. A party may request permission from the Administrative Law Judge to substitute a photograph for an admitted physical exhibit prior to the deadline for submission of exhibits.

All Exhibits must be labeled with their content as well as according to the numbering scheme identified above.

Unless otherwise instructed, the Commission has not been accepting physical exhibits during the Pandemic.

8.7.4.3. Demonstrative Exhibits.

Demonstrative exhibits shall be numbered in a separate series commencing with "0001" preceded by the prefixes "CDX", "RDX", and "SDX", for Complainant, Respondent(s), and the Staff (if applicable), respectively. Additionally, the parties shall provide the Administrative Law Judge with two (2) double-sided copies of key demonstrative exhibits (*e.g.*, charts, drawings, etc.) reduced to 8 ½ inches x 11 inches for use during the hearing. If applicable, demonstrative exhibits shall indicate what documentary or physical exhibit was the source for its creation.

The parties may seek to have demonstrative exhibits admitted into evidence, for substantive or solely for demonstrative purposes. Such designation must be made clear on the record at the time of admission. Admitted demonstrative exhibits must be submitted with the ALJ and Commission Sets pursuant to Ground Rules 8.6.4 and 8.7.

8.7.4.4. Joint Exhibits.

If agreed to by parties, they may submit joint documentary exhibits, including for example, a patent in issue, prosecution history, etc.

The joint documentary exhibits shall include an index which identifies the parties that have submitted each joint exhibit and should be arranged based on the various groups offering such exhibits. For example, if complainant and respondent A have offered a series of joint documentary exhibits, those exhibits would appear as the first group of joint documentary exhibits in the joint documentary exhibit index. The index would then include all joint documentary exhibits offered by complainant and respondent B, then joint documentary exhibits offered by complainant and respondent C, etc.

8.7.5. Exhibit Lists.

Every exhibit list shall include a table enumerating all exhibits consecutively by exhibit number and identify each exhibit by a descriptive title, a brief statement of the purpose for which the exhibit is being offered in evidence, the name of the sponsoring witness, and the status of receipt of the exhibit into evidence.

Every joint exhibit list shall identify each exhibit, and the parties shall meet and confer before submitting the lists for the purpose of seeking an agreement on a common descriptive title, statement of purpose, and sponsoring witnesses that shall appear on every list for each joint exhibit.

In any exhibit list submitted before the offer of an included exhibit into evidence, the entry in the column for the status of receipt shall be left blank. In any exhibit list submitted after the exhibit is offered into evidence or withdrawn, the entry in that column shall show the date of admission into evidence or rejection of the exhibit or shall indicate its withdrawal.

Exhibit lists shall include public and confidential exhibits, and shall list all exhibits together in (four-digit) numerical order, *e.g.*, CX-0001, CX-0002, CX-0003C, CX-0004, CX-0005C, etc. Exhibit lists are public documents and should not contain confidential business information.

Again, all exhibit lists should explain the content of the exhibit as well as contain the alpha character or number, and whether it has been withdrawn. A description of each exhibit should not exceed 35 characters. A file may not exceed 25MB. See infra.

8.7.6. Witness Exhibits.

In questioning a witness on direct examination, cross-examination, or examination of an adverse witness during the hearing, counsel shall provide the witness, and other counsel, before the commencement of the examination, with a binder (or binders) (or if done electronically by e-mail or FTP, or for the ALJ, electronically) containing all the exhibits that the examining attorney intends to use with that witness. If a binder is used (as the parties choose), it should contain double-sided exhibits, in numerical order and individually tabbed. Each witness binder must be labeled on its spine with the name and number of this Investigation and the nature of the contents of the binder, *e.g.*, Cross-Examination of Witness - Volume 1 of 1. In addition, the front of the witness binder must include a table of contents.

If there are certain exhibits (*i.e.* patent, prosecution histories) that will be used frequently with more than one witness, a separate exhibit binder (unless service is made electronically) containing those exhibits may be used with those witnesses and those exhibits may be omitted from the individual witness binders, or as the parties agree.

8.7.7. Authenticity.

All documents that appear to be regular on their face shall be deemed authentic, unless it is shown by other evidence that the document is not genuine.

8.7.8. Sponsoring Witness.

Each exhibit that is offered into evidence shall have a "sponsoring witness." One of the purposes for a sponsoring witness is to establish a foundation for the exhibit and to prevent exhibits from entering the record that have not been adequately explained. Sponsoring witness testimony does not have to be in the form of oral testimony if all parties agree to allow otherwise. For example, if the parties are willing to stipulate and agree to designate portions of deposition testimony, along with certain exhibits that were discussed during the deposition, such request will generally be permitted upon the filing of a motion demonstrating good cause, as long as the exhibit was clearly identified and discussed during the deposition and the deposition pages discussing the exhibit are included in the designation.

Except for investigations without a participating respondent, if a party believes evidence to be non-controversial and appropriate for admission into evidence without a sponsoring witness, that party may present with each such exhibit on or before the due date set forth in the procedural schedule (i) an affidavit or declaration that the declarant prepared or someone under the declarant's direction prepared the exhibit; (ii) a request that the exhibit be received in evidence without a witness at the hearing; and (iii) a statement of grounds for receiving the exhibit in evidence without a witness at the hearing. Any party who wishes to cross-examine the declarant may object in writing within three (3) days of service of the affidavit or declaration and request, specifying whom the party intends to examine. In the absence of objections, and upon good cause being shown, the Administrative Law Judge may in her discretion admit the exhibit in evidence without a witness.

8.8. Filing of Exhibits.

The procedure for submitting exhibits on electronic media is set forth in the Docket Services section of the U.S. International Trade Commission's website. Please contact Dockets directly from the website.

Directions for uploading to the ALJ's Box account before and after the evidentiary hearing will be provided before the evidentiary hearing. An e-mail link will be provided to one individual (and preferably a back-up person) from each party, and if there are joint exhibits, to the individual designated to upload joint exhibits, who will be responsible for uploading documents to the ALJ's Box account. Please note that only the ALJ and her staff will have access to those documents once submitted.

9. Hearing Procedure.

9.1. Order of Examination.

Unless altered during the pre-hearing conference, or as necessitated by exigent circumstances such as the unavailability of witnesses on certain days, the order of examination at the hearing is as follows:

(1) Complainant's Case-in-Chief.

(2) Respondent's Case-in-Chief. In the event there is more than one respondent, the order of presentation will be determined at the pre-hearing conference. Respondents should avoid unnecessary repetition of testimony or other evidence.

(3) Staff's Case-in-Chief (if applicable).

(4) Complainant's Rebuttal. Complainant's rebuttal, absent prior approval, shall be limited to the scope of Respondent's defense case.

(5) Respondent's Rebuttal. Respondent's rebuttal, absent prior approval, shall be limited to the issues for which Respondent carries ultimate burden of proof.

9.2. Opening Statement and Closing Argument.

The Administrative Law Judge does not require opening statements and closing arguments. The parties may present opening statements. Opening statements are limited to one (1) hour for the complainant, one (1) hour for respondent(s), and thirty (30) minutes for Staff (if applicable). The parties may make a request to present closing arguments.

9.3. Hearing Hours.

Normal hearing hours are 9:30 a.m. to 5:30 p.m., with a one (1) hour luncheon recess beginning each day at approximately 12:15-12:30 p.m. Also, there will be a morning and an afternoon break of approximately fifteen (15) minutes each.

9.4. Hearing Decorum.

9.4.1. Conversations at Hearing.

No audible discourse between opposing counsel will be permitted while the hearing is in session. If an attorney has anything to address to opposing counsel, it must be done through the Administrative Law Judge.

9.4.2. Cell Phones and Beepers; Food and Beverages.

Audible cell phone and beeper signals shall be turned off in the courtroom during hearing, and all cell phone conversations must occur outside the courtroom. No food or drink other than water is permitted in the courtroom during hearing.

9.4.3. Swearing of Witnesses.

Each witness shall stand while being administered the oath of affirmation. All others in the hearing room should remain seated and quiet.

9.4.4. Arguments on Objection.

Arguments or objections may only be made by counsel prior to a ruling. Once a ruling is made, no further discussion of the matter will be permitted. The basis for the objection must be stated; general objections are not acceptable.

9.5. Examination of Witnesses.

9.5.1. Scope of Examination.

Except in extraordinary circumstances, examination of witnesses for Complainant(s)' case-in-chief and Respondent(s)' case-in-chief shall be limited to direct, cross, redirect, and re-cross.

9.5.2. Scope of Cross-Examination.

Cross-examination is typically limited to the scope of the direct examination. For witnesses called for the purpose of giving testimony in support of a position on an issue that is the same as the position on that issue of a party desiring cross-examination of that witness, that party is precluded from asking that witness leading questions, *i.e.* "no friendly cross-examination."

When counsel is presenting a witness with a question that refers back to the witness's previous testimony, counsel shall refrain from summarizing the witness's previous testimony because this can lead to a time-consuming objection that counsel's summary was not an accurate recitation of the witness's previous testimony. If counsel wishes to refer back to a witness's previous testimony, counsel must use direct quotations.

9.5.3. Scope of Redirect and Re-Cross Examination.

Redirect examination is limited to matters brought out on cross-examination. Re-cross examination is limited to matters brought out on redirect examination.

9.5.4. Coordination of Witnesses.

The parties are expected to conduct their witness examination in a matter that will adhere to the total time allotted for the hearing.

9.5.5. Documents Presented to Witnesses.

Any document that an attorney wishes to show a witness must first be shown to opposing counsel.

9.5.6. Scope of Expert Witness Testimony.

Expert witness testimony at the hearing shall be confined to the scope of the expert's report(s), and deposition testimony. The proponent of the witness is expected to be prepared to demonstrate promptly where in that witness's reports or deposition may be found each element of testimony sought to be elicited at the hearing.

9.5.7. Coordination of Respondents' Cross-Examination.

Respondents are expected to coordinate cross-examination through one attorney as far as practicable to avoid duplication. If that is not possible, counsel who intend to cross-examine must be present in the hearing room during the entire preceding cross-examination of the witness so as not to engage in repetitive questioning.

9.5.8. Requests for Clarification of a Question.

Requests for clarification of a question may only be made by the witness or the Administrative Law Judge.

9.5.9. Use of Translators.

If a translator will be used at the hearing, the parties are responsible for obtaining a qualified, neutral translator on whom they can agree. It is suggested that the translator be chosen from a list of approved translators, such as the ones maintained by various federal courts and federal agencies. Translators will be administered an oath or affirmation.

9.5.10. Conferring with a Witness during a Break in Testimony.

Counsel or intermediaries shall not confer with a witness during a break in the witness's testimony on the witness's substantive testimony.

9.6. Transcript.

The parties have the option of arranging for the hearing transcript in real time. The Administrative Law Judge prefers to have hearing transcripts in real time. The parties should monitor the admission of exhibits on the transcript as it comes out, and promptly bring any errors or omissions to the Administrative Law Judge's attention at the hearing.

If a transcript needs to be corrected after the conclusion of the hearing, the party requesting the change shall do so through a motion. Once an order issues adopting the proposed correction, it is incumbent upon the party requesting the change to send a copy of the order to Ace-Federal Reporters, Inc. so that the corrections can be made.

9.7. Bench Briefs.

Bench briefs, if they are permitted by the Administrative Law Judge during the hearing, must be filed on EDIS as motions and must comport with the Commission Rules and Ground Rules relating to motions.

9.8. Objections to Evidence/Testimony and Motions to Strike.

During the hearing, any evidentiary objections or motions to strike that cannot be resolved on the spot will be subject to a written motion not to exceed five (5) pages with no more than 10 pages of attachments, unless leave is requested from the Administrative Law Judge and given. Any such motion must be filed on EDIS the same day as raised during the hearing unless otherwise changed by the Administrative Law Judge. The response must be filed the next day, unless granted leave for a different deadline, and will be subject to the same page limits as the motion to strike. References to exact pages and lines of testimony or documents to be stricken must be included. Testimony citations and sections/paragraphs from an expert report (with cover page and date thereof) should be attached, with the surrounding testimony, or relevant portions of the expert report(s). No more than two (2) motions to strike will be allowed during the hearing by complainants as a group or respondents as a group (or by each party in a group if they do not share an identity of interests).

If a party who files a motion loses the motion on a ruling that is made during the hearing, that party will be penalized by a time deduction that it took for argument and the ruling.

Post-hearing motions to strike brought separately from MILs or motions to strike made during an evidentiary hearing are discouraged. No more than one (1) motion to strike will be allowed post-hearing without leave by complainants as a group and respondents as a group (or by each party in a group if they do not share an identity of interests).

10. Post-Hearing Submissions.

10.1. Initial Post-Hearing Briefs.

On or before the date set forth in the procedural schedule, the parties shall file a post-hearing brief on the issues for which they have the burden of proof. Absent approval by the Administrative Law Judge said brief shall consist of no more than one hundred (100) pages and have no more than fifty (50) pages of relevant attachments. In addition, each party shall file a copy of its final exhibit list. Courtesy copies of all post-hearing briefs and final exhibit lists shall be submitted in binders, preferably not exceeding 3" in width.

The post-hearing brief for each party shall discuss the issues and evidence tried (through, *e.g.*, citations to specific supporting evidence) within the framework of the general issues determined by the Commission's Notice of Investigation, identified in the joint issue chart <u>for which that party bears the burden (except Staff)</u>, and any permitted amendments thereto. <u>All other issues shall be deemed waived</u>.[26]

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[26] *Certain Automated Media Library Devices*, Inv. No. 337-TA-746, Comm'n Op. at 14-16 (U.S.I.T.C., 2013).

The parties' initial post-hearing briefs must follow the order set forth in the joint issue chart.

Additionally, if a claim, argument or issue was briefed in a pre-hearing brief, but the party who raised the issue or made the argument did not adduce evidence on the same during the evidentiary hearing, then any such issue should be identified in the joint issue chart with the page numbers to each party's brief where such an unsupported issue or argument appears in a party's pre-hearing brief, and it shall be deemed waived.

The parties should not attempt to bypass the page limits by attaching[27] dense appendices, incorporating other documents by reference, such as a pre-hearing brief, or cross-referencing other sections of the post-hearing brief.

Neither should they change fonts to enhance words or use footnotes in lieu of text. Case citations should be in the text body, not in footnotes. In the same vein, the parties should set forth a clear, concise analysis of fact and law for each issue, and should not substitute their discussion of supporting facts with long string cites to the evidence. For example, a heading with a single sentence beneath it, followed by cites to thirty-five evidentiary citations is not likely to be a sufficient analysis of fact and law, particularly if an issue is disputed. Furthermore, arguments should not be hidden in footnotes, but should instead be presented in a straightforward and visible manner. The initial post-hearing brief is the most critical brief in the Investigation, and parties that do not set forth an articulate analysis may find they have failed to carry their burden on a particular issue.

The parties should make sure they understand the law for each issue and touch upon all the elements for an issue. For example, an analysis relating to a 35 U.S.C. § 103 obviousness defense should encompass a discussion of the scope and content of the prior art, the level of ordinary skill in the art, a comparison of the claimed invention and the prior art, and any secondary considerations of non-obviousness—not just a comparison of the claimed invention and the prior art. A discussion of whether a domestic industry product, accused product, or prior art reference does *or does not* meet an asserted patent claim should prominently identify what elements are disputed. If an element is not in dispute, each party must identify it with equal clarity or risk waiver of any opposition.

The parties are further advised to carefully select their best arguments, and set them forth in a logical, reasoned, persuasive manner. The method of spilling out every possible permutation of evidence in an unordered series of one sentence arguments until the allotted space is exhausted is not likely to be effective. The Administrative Law Judge may in her discretion treat only a few of the strongest arguments in such a case and ignore the remainder.

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[27] The parties are likewise barred from attaching evidence that is not in the record and that should have been offered during the hearing. For example, if an exhibit containing an expert report was not admitted at the hearing, then it should not be attached to a post-hearing brief. To the extent such an exhibit might be necessary to argue that another party's argument was waived or should be stricken, this must be introduced by way of separate motion papers and must not be submitted with any post-hearing briefing.

Staff will be permitted to change its pre-hearing position(s) on invalidity and infringement after the evidentiary hearing ("Hearing") where the evidence that came in during a Hearing appears to Staff to warrant such a change in its previous position. Staff will have seven (7) days after the last day of the evidentiary hearing to file a "Notice" on EDIS that it has changed its position. Staff should identify its filing on EDIS as a "Post-Hearing Notice." Staff should identify each issue on which it has changed its position, and explain why, citing to evidence from the hearing. The filing should be limited to 15 pages unless Staff requests leave to file a longer notice and explains why. The other parties will have seven (7) business days to respond to Staff's Notice. They may respond but need not and it will not be held against the parties. However, the parties will be expected to address Staff's change in position in post-hearing briefs.

10.2. Post-Hearing Reply Briefs.

On or before the date set in the procedural schedule, the parties shall file a post-hearing reply brief. Absent prior approval of the Administrative Law Judge said brief shall consist of no more than fifty pages (50) pages and shall have no more than twenty (20) pages of relevant attachments. The post-hearing reply brief shall discuss and rebut only the issues and evidence raised in the initial post-hearing brief of an opposing party and follow the joint issue chart accompanying the pre-hearing and initial post-hearing briefs as set forth in Ground Rule 7.3.

Ground Rules 10.1 and 10.2 allow parties to devote a maximum of 150 pages to post-hearing briefing, excluding attachments, absent prior leave from the Administrative Law Judge. Although these rules contemplate a party devoting no more than 100 pages to an initial post-hearing brief and no more than 50 pages to a post-hearing reply brief, any party may allocate its 150 pages of post-hearing briefing, as it sees fit, between an initial post-hearing brief and a post-hearing reply brief. For example, without leave, a party can devote 75 pages to each brief.

10.3. Proposed Findings of Fact

In accordance with Commission Rule 210.40, a party may elect to file proposed findings of fact and conclusions of law; however, the other side is not required to respond to the proposed findings of fact and conclusions of law. The lack of a response does not mean that the proposed findings of fact and conclusions of law are admitted, unless specifically stated as such. If a party chooses to file proposed findings of fact and conclusions of law, they must be filed on the same date as the initial post-trial brief.

The proposed findings of fact shall be in the form of numbered paragraphs. The findings shall reflect all section 337 elements, all issues outlined in the Notice of Investigation, and any other issues that arose during the course of the Investigation. Section headings consistent with the outline of the post-hearing brief may be used to set off paragraphs that relate to particular section 337 elements or issues. To be accepted without alteration, a proposed finding of fact must be an assertion of fact only (i.e., without argument more appropriately placed in the post-hearing brief). Each proposed finding of fact must be followed with citations to supporting authority in the evidence.

11. NEXT Advocates Program

In accordance with the NEXT Advocates Program initiated by the Commission's Office of Administrative Law Judges,[28] the parties are encouraged to provide opportunities for less experienced attorneys (i.e., those that have given three or fewer substantive oral arguments or witness examinations in any federal tribunal) to participate in substantive oral presentations during the investigation and/or to examine witnesses during the evidentiary hearing.

A party should submit a proposal to Chambers requesting accommodations that would support participation in the NEXT Advocates program. For example, a proposal could request additional trial time to permit a less-experienced attorney to examine a witness during the evidentiary hearing. Or, a proposal might request a hearing on a summary determination motion or on another issue dispositive to the issue, where at least one party commits to permitting a less-experienced attorney to argue a substantive portion of the motion.

As set forth in the NEXT Advocates program announcement on the Commission website, more-experienced attorneys will be permitted to assist less-experienced attorneys, if necessary, and to clarify any statements on the record before conclusion of the hearing if necessary.

The proposal should include a certification by lead counsel that explains the expected participation of one or more less-experienced attorneys. The certification need not identify the name of the less-experienced attorneys or the witnesses who will be examined, just the law firm. Submissions should be sent to McNamara337@usitc.gov and need not be filed on EDIS.

12. Citations.

12.1. Citations Generally.

The parties should not substitute their discussion of supporting facts with long string cites to the evidence. No combination charts of citations of any kind will suffice by themselves. Such arguments may be stricken.

Any party that cites to foreign language documents or provisions contained in foreign language documents in claim charts and discovery documents is required without exception to provide translations of the documents or provisions. Any document or portion of a document that circumvents this Ground Rule, or that mis-translates or mis-characterizes the foreign language, may be stricken.

All citations to case law and evidence must be included in the text of the motion/response /brief/document, i.e., not in footnotes.

12.2. Citation to Cases.

Every party must cite to the specific page(s) of the cited decision or order that includes the holding for which the authority is cited. The official case reporter citation must be included

[28] *See* NEXT Advocates Program Announcement, https://www.usitc.gov/next_advocates_nurturing_excellence_in_trial_advocates.htm.

for any published decision or order that is cited in a party's briefs or pleadings. Additionally, the docket number and the full date of the disposition must be included in the citation of any unreported decision or order that is referenced by the parties. Citations to unreported cases or those without precedential authority should be clearly marked with a parenthetical in the brief or pleading. For example, such a citation might read:

Case Name, ### F.3d ###, at ## (Fed. Cir. ####) (nonprecedential).

A copy of any cited decision or order that is not available on EDIS, LEXIS, or WESTLAW shall be provided in an appendix to the brief or pleading.

13. Cooperation among Parties.

Because of the time limitations imposed by Section 337, all counsel shall attempt to resolve, by stipulation or negotiated agreement, any procedural disputes encountered, including those relating to discovery and submission of evidence. To assure the proper cooperative spirit in this Investigation, continuing good faith communications between counsel for the parties is essential and is expected.

14. *Ex Parte* Contacts.

There shall be no *ex parte* communication with the Administrative Law Judge. Any questions of a technical or procedural nature shall be directed to the Administrative Law Judge's Attorney Advisor. Except for service of electronic copies pursuant to Ground Rule 1.3.2, the parties should take care not to copy the Attorney Advisor on email communications not specifically directed to them.

Informal communications with the Administrative Law Judge's Attorney Advisor or Chambers via email or telephone shall not be referenced in briefs, documents, or papers filed on EDIS. Otherwise, formal communications on EDIS only will be entertained.

The parties should note that the Docket Manager for this Investigation, as well as other staff in Docket Services and the Administrative Law Judge's Secretary, should not be contacted relating to such issues as whether an order has been signed, when an order posted on EDIS will be processed, whether an order posted on EDIS will go out by overnight courier or U.S. Mail (as opposed to an issue of non-receipt several days later). This is not to say that Docket Services may never be contacted with respect to this Investigation. If the parties have generic questions relating, e.g., to a party filing, such an inquiry would be appropriate. However, Docket Services' staff members are not allowed to give out information relating to the status of the Administrative Law Judge's orders. The Docket Manager for this Investigation and the Administrative Law Judge's Secretary may log any inappropriate calls made in this Investigation and bring them to the attention of the Administrative Law Judge if necessary.

15. Mediation.

The Commission has approved the initiation of a voluntary mediation program for investigations under Section 337 of the Tariff Act of 1930 as amended, to facilitate the

settlement of disputes. Parties who wish to participate in the mediation program should notify the Administrative Law Judge's Attorney Advisor.

APPENDIX A

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

Before the Honorable MaryJoan McNamara
Administrative Law Judge

In the Matter of **Certain . . .**	**Investigation No. 337-TA-___**

[SAMPLE] APPLICATION FOR ISSUANCE OF SUBPOENA AD TESTIFICANDUM

[Party name], pursuant to 19 C.F.R. § 210.32(a)(1), hereby applies to the Administrative Law Judge for the issuance of the attached subpoena *ad testificandum* to:

[Name]
[Address]

The subpoena *ad testificandum* requires [Name] to appear and testify at the taking of a deposition on [date], at [location], or at such other date and location as is mutually agreed upon.

[Party name] believes that [Name] may be in possession of substantial information relevant to this Investigation. [Insert explanation re relevance, *see* Ground Rule 3.5.1.] Furthermore, the topics identified in Attachment A of the subpoena are narrowly tailored to address only the aforementioned subjects. [Insert explanation re reasonableness of the scope of inquiry, *see* Ground Rule 3.5.1.]

[Name] will receive the application and subpoena by overnight delivery, if not sooner, and all other parties to this Investigation will receive them on the next business day, at the latest, after the subpoena has issued. For the reasons set forth above, [Party name] respectfully requests that its application for issuance of a subpoena *ad testificandum* be granted and the attached

subpoena be issued.

Dated: _____, 20__

Respectfully submitted,

_____
[Counsel]
[Address]

Counsel for [Party Name]

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of **Certain . . .**	**Investigation No. 337-TA-___**

[SAMPLE] SUBPOENA DUCES TECUM

TO: NAME
ADDRESS

TAKE NOTICE: By authority of Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application for subpoena made by ["Complainant(s)" / "Respondent(s)"/ etc., followed by name of company] _____,

YOU ARE HEREBY ORDERED to produce at _____, on _____, or at such other time and place agreed upon, all of the documents and things in your possession, custody or control which are listed and described in Attachment A hereto. Such production will be for the purpose of inspection and copying, as desired.

If production of any document listed and described in Attachment A hereto is withheld on the basis of a claim of privilege, each withheld document shall be separately identified in a privileged document list. The privileged document list must identify each document separately, specifying for each document at least: (i) the date the information was created or communicated; (ii) author(s)/sender(s); (iii) all recipient(s); and (iv) the general subject matter contained in the document. The sender(s) and recipient(s) shall be identified by position and entity (corporation or firm, etc.) with which they are employed or associated. If the sender or the recipient is an attorney or a foreign patent agent, he or she shall be so identified. The type of privilege claimed must also be stated, together with a certification that all elements of the claimed privilege have been met and have not been waived with respect to each document.

If any of the documents or things listed and described in Attachment A hereto are considered "confidential business information," as that term is defined in the Protective Order attached hereto, such documents or things shall be produced subject to the terms and provisions of the Protective Order.

Any motion to limit or quash this subpoena shall be filed within ten (10) days after the receipt hereof. At the time of filing of any motion concerning this subpoena, two (2) double-sided courtesy copies shall be served concurrently on the Administrative Law Judge at her office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set her hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this ___ day of _____, 20__.

_____
MaryJoan McNamara
Administrative Law Judge
United States International Trade Commission

APPENDIX B

EXAMPLE OF OUTLINE FOR ALL BRIEFS

I. INTRODUCTION
- A. Procedural History
- B. The Parties
- C. Overview of the Technology
- D. The Patents at Issue
- E. The Products at Issue

II. JURISDICTION AND IMPORTATION

III. PATENT "A"[29]
- A. Claim Construction
  - 1. Define Level of Skill of a Person of Ordinary Skill in the Art
  - 2. First Disputed Claim Term (Claims 1, 2, 3 , . . .)
  - 3. Second Disputed Claim Term (Claims 1,*2,*3 , . . .)
- B. Infringement
  - 1. Claim 1
  - 2. Claim 2
- C. Technical Domestic Industry
- D. Validity
  - 1. Anticipation Under 35 U.S.C. § 102
  - 2. Obviousness Under 35 U.S.C. § 103
    - a. The scope and content of the prior art
    - b. The level of ordinary skill in the art
    - c. Comparison of the claimed invention and the prior art
    - d. Secondary considerations of non-obviousness
- E. Unenforceability
- F. Other Defenses

IV. PATENT "B" ...

V. ECONOMIC DOMESTIC INDUSTRY (all patents)
- A. Significant Investment in Plant and Equipment
- B. Significant Employment of Labor or Capital
- C. …

VI. REMEDY AND BONDING

[29] The parties are required to confer and follow the same order of patents for all briefing.