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Patent Rules

You are here

[Home](#) » [Attorneys](#) » Patent Resources[To Local Rules](#)

- SCOPE OF RULES 1-1. Title.
- SCOPE OF RULES 1-2. Scope and Construction.
- SCOPE OF RULES 1-3. Effective Date.
- GENERAL PROVISIONS 2-1. Governing Procedure
- GENERAL PROVISIONS 2-2. Confidentiality.
- GENERAL PROVISIONS 2-3. Certification of Initial Disclosures.
- GENERAL PROVISIONS 2-4. Admissibility of Disclosures.
- GENERAL PROVISIONS 2-5. Relationship to Federal Rules of Civil Procedure.
- GENERAL PROVISIONS 2-6. Assignment of Related Cases.
- PATENT INITIAL DISCLOSURES 3-1. Disclosure of Asserted Claims and Infringement Contentions.

Not later than 10 days before the Initial Case Management Conference with the Court, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Infringement Contentions." Separately for each opposing party, the "Disclosure of Asserted Claims and Infringement Contentions" shall contain the following information:

(a) Each claim of each patent in suit that is allegedly infringed by each opposing party;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(c) A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112 (¶ 6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;

(e) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

(f) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

- **PATENT INITIAL DISCLOSURES 3-2. Document Production Accompanying Disclosure.**

With the "Disclosure of Asserted Claims and Infringement Contentions," the party claiming patent infringement must produce to each opposing party or make available for inspection and copying:

(a) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. §102;

(b) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P. R. 3-1(e), whichever is earlier; and

(c) A copy of the file history for each patent in suit.

The producing party shall separately identify by production number which documents correspond to each category.

- **PATENT INITIAL DISCLOSURES 3-3. Invalidity Contentions.**
- **PATENT INITIAL DISCLOSURES 3-4. Document Production Accompanying Invalidity Contentions.**
- **PATENT INITIAL DISCLOSURES 3-5. Disclosure Requirement in Patent Cases for Declaratory Judgment.**
- **PATENT INITIAL DISCLOSURES 3-6. Amending Contentions.**
- **PATENT INITIAL DISCLOSURES 3-7 Opinion of Counsel Defenses.**
- **PATENT INITIAL DISCLOSURES 3-8. Disclosure Requirements for Patent Cases Arising Under 21 U.S.C. . § 355 (Hatch-Waxman Act).**
- **CLAIM CONSTRUCTION PROCEEDINGS 4-1. Exchange of Proposed Terms and Claim Elements for Construction.**
- **CLAIM CONSTRUCTION PROCEEDINGS 4-2. Exchange of Preliminary Claim Constructions and Extrinsic Evidence.**
- **CLAIM CONSTRUCTION PROCEEDINGS 4-3. Joint Claim Construction and Prehearing Statement.**
- **CLAIM CONSTRUCTION PROCEEDINGS 4-4. Completion of Claim Construction Discovery.**
- **CLAIM CONSTRUCTION PROCEEDINGS 4-5. Claim Construction Briefs.**
- **CLAIM CONSTRUCTION PROCEEDINGS 4-6. Claim Construction Hearing.**

[Court Information](#)

[United States Court Sites](#)

[Judges](#)

[Rules & Orders](#)

[Filing](#)

[Resources](#)

[FAQs](#)

[Attorneys](#)

[Jurors](#)

[Pro Se](#)

[Forms](#)