UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS

LOCAL PATENT RULES

PREAMBLE

1. SCOPE OF RULES

LPR 1.1 Application and Construction
LPR 1.2 Initial Scheduling Conference
LPR 1.3 Fact Discovery
LPR 1.4 Confidentiality
LPR 1.5 Certification of Disclosures
LPR 1.6 Admissibility of Disclosures
LPR 1.7 Relationship to Federal Rules of Civil Procedure

2. PATENT INITIAL DISCLOSURES

LPR 2.1 Initial Disclosures
LPR 2.2 Initial Infringement Contentions
LPR 2.3 Initial Non-Infringement, Unenforceability and Invalidity Contentions
LPR 2.4 Document Production Accompanying Initial Invalidity Contentions
LPR 2.5 Initial Response to Invalidity Contentions
LPR 2.6 Disclosure Requirement in Patent Cases Initiated by Complaint for Declaratory Judgment

3. FINAL CONTENTIONS

LPR 3.1 Final Infringement, Unenforceability and Invalidity Contentions
LPR 3.2 Final Non-infringement, Enforceability and Validity Contentions
LPR 3.3 Document Production Accompanying Final Invalidity Contentions
LPR 3.4 Amendment of Final Contentions
LPR 3.5 Final Date to Seek Stay Pending Reexamination
LPR 3.6 Discovery Concerning Opinions of Counsel

4. CLAIM CONSTRUCTION PROCEEDINGS

LPR 4.1 Exchange of Proposed Claim Terms To Be Construed Along With Proposed Constructions
LPR 4.2 Claim Construction Briefs
LPR4.3 Claim Construction Hearing

5. EXPERT WITNESSES

LPR 5.1 Disclosure of Experts and Expert Reports
LPR 5.2 Depositions of Experts
LPR 5.3 Presumption Against Supplementation of Reports

6. DISPOSITIVE MOTIONS

LPR 6.1 Final Day for Filing Dispositive Motions

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS

LOCAL PATENT RULES

PREAMBLE

These Local Patent Rules provide a standard structure for patent cases that will permit greater predictability and planning for the Court and the litigants. These Rules also anticipate and address many of the procedural issues that commonly arise in patent cases. The Court's intention is to eliminate the need for litigants and judges to address separately in each case procedural issues that tend to recur in the vast majority of patent cases.

The Rules require, along with a party's disclosures under Federal Rule of Civil Procedure 26(a)(1), meaningful disclosure of each party's contentions and support for allegations in the pleadings. Complaints and counterclaims in patent cases often need discovery to flesh out the basis for each party's contentions. The Rules require the parties to provide the particulars behind allegations of infringement, non-infringement, and invalidity at an early date. Because Federal Rule of Civil Procedure 11 requires a party to have factual and legal support for allegations in its pleadings, early disclosure of the basis for each side's allegations will impose no unfair hardship and will benefit all parties by enabling a focus on the contested issues at an early stage of the case. The Rules' supplementation of the requirements of Rule 26(a)(1) and other Federal Rules is also appropriate due to the various ways in which patent litigation differs from most other civil litigation, including its factual complexity; the routine assertion of counterclaims; the need for the Court to construe, and thus for the parties to identify, disputed language in patent claims; and the variety of ways in which a patent may be infringed or invalid.

The initial disclosures required by the Rules are not intended to confine a party to the contentions it makes at the outset of the case. It is not unusual for a party in a patent case to learn additional grounds for claims of infringement, non-infringement, and invalidity as the case progresses. After a reasonable period for fact discovery, however, each party must provide a final statement of its contentions on relevant issues, which the party may thereafter amend only "upon a showing of good cause and absence of unfair prejudice, made in timely fashion following discovery of the basis for the amendment." LPR 3.4.

The Rules also provide a standardized structure for claim construction proceedings, requiring the parties to identify and exchange position statements regarding disputed claim language before presenting disputes to the Court. The Rules contemplate that claim construction will be done, in most cases, toward the end of fact discovery. The committee of lawyers and judges that drafted and proposed the Rules considered placing claim construction at both earlier and later spots in the standard schedule. The decision to place claim construction near the end of fact discovery is premised on the determination that claim construction is more likely to be a meaningful process that deals with the truly significant disputed claim terms if the parties have had sufficient time, via the discovery process, to

ascertain what claim terms really matter and why and can identify (as the Rules require) which are outcome determinative. The Rules' placement of claim construction near the end of fact discovery does not preclude the parties from proposing or the Court from requiring an earlier claim construction in a particular case. This may be appropriate in, for example, a case in which it is apparent at an early stage that the outcome will turn on one claim term or a small number of terms that can be identified without a significant amount of fact discovery.

Finally, the Rules provide for a standardized protective order that is deemed to be in effect upon the initiation of the lawsuit. This is done for two reasons. First, confidentiality issues abound in patent litigation. Second, early entry of a protective order is critical to enable the early initial disclosures of patent-related contentions that the Rules require. Absent a "default" protective order, the making of initial disclosures, and thus the entire schedule, would be delayed while the parties negotiated a protective order. The parties may, either at the outset of the case or later, seek a revised protective order that is more tailored to their case. Because, however, the Rules provide for automatic entry of the default protective order, the desire to negotiate a more tailored version is not a basis to delay the disclosure and discovery schedule that the Rules contemplate.

1. SCOPE OF RULES

LPR 1.1 Application and Construction

These Rules ("LPR") apply to all cases filed in or transferred to this District after September 24, 2009, in which a party makes a claim of infringement, non-infringement, invalidity, or unenforceability of a utility patent. The Court may modify the obligations and deadlines of the LPR based on the circumstances of any particular case. If a party files, prior to the Claim Construction Proceedings provided for in LPR Section 5, a motion that raises claim construction issues, the Court may defer the motion until after the Claim Construction Proceedings.

LPR 1.2 Initial Scheduling Conference

In their conference pursuant to Fed. R. Civ. P. 26(f), the parties must discuss and address those matters found in the form scheduling order contained in LPR Appendix "A." A completed proposed version of the scheduling order is to be presented to the Court within seven (7) days after the Rule 26(f) conference or at such other time as the Court directs. Paragraphs 4(e), 7(c) and 7(d) of the form scheduling order shall be included, without alteration, in this proposed scheduling order.

LPR 1.3 Fact Discovery

Fact discovery shall commence upon the date for the Initial Disclosures under LPR 2.1 and shall be completed twenty-eight (28) days after the date for exchange of claim terms and

phrases under LPR 4.1. Fact discovery may resume upon entry of a claim construction ruling and shall end forty-two (42) days after entry of the claim construction ruling.

Comment

The Rule states that resumption of fact discovery upon entry of a claim construction ruling "may" occur. The Rule does not provide that discovery shall automatically resume as a matter of right. It is intended that parties seeking further discovery following the claim construction ruling shall submit a motion explaining why further discovery is necessitated by the claim construction ruling.

LPR 1.4 Confidentiality

The protective order found in LPR Appendix B shall be deemed to be in effect as of the date for each party's Initial Disclosures. Any party may move the Court to modify the Appendix B protective order for good cause. The filing of such a motion does not affect the requirement for or timing of any of the disclosures required by the LPR.

LPR 1.5 Certification of Disclosures

All disclosures made pursuant to LPR 2.2, 2.3, 2.4, 2.5, 3.1, and 3.2 must be dated and signed by counsel of record (or by the party if unrepresented by counsel) and are subject to the requirements of Federal Rules of Civil Procedure 11 and 26(g).

LPR 1.6 Admissibility of Disclosures

The disclosures provided for in LPR 2.2, 2.3, 2.4, and 2.5 are inadmissible as evidence on the merits.

Comment

The purpose of the initial disclosures pursuant to LPR *2.2* - 2.5 is to identify the likely issues in the case, to enable the parties to focus and narrow their discovery requests. Permitting use of the initial disclosures as evidence on the merits would defeat this purpose. A party may make reference to the initial disclosures for any other appropriate purpose.

LPR 1.7 Relationship to Federal Rules of Civil Procedure

A party may not object to mandatory disclosures under Federal Rule of Civil Procedure 26(a) or to a discovery request on the ground that it conflicts with or is premature under the LPR, except to the following categories of requests and disclosures:

(a) requests for a party's claim construction position;

(b) requests to the patent claimant for a comparison of the asserted claims and the accused apparatus, device, process, method, act, or other instrumentality;

(c) requests to an accused infringer for a comparison of the asserted claims and the prior art;

(d) requests to an accused infringer for its non-infringement contentions; and

(e) requests to the patent claimant for its contentions regarding the presence of claim elements in the prior art.

Federal Rule of Civil Procedure 26's requirements concerning supplementation of disclosure and discovery responses apply to all disclosures required under the LPR.

2. PATENT INITIAL DISCLOSURES

Comment

LPR 2.2 - 2.5 supplements the initial disclosures required by Federal Rule of Civil Procedure 26(a)(1). As stated in the comment to LPR 1.6, the purpose of these provisions is to require the parties to identify the likely issues in the case, to enable them to focus and narrow their discovery requests. To accomplish this purpose, the parties' disclosures must be meaningful - as opposed to boilerplate - and non-evasive. These provisions should be construed accordingly when applied to particular cases.

LPR2.1 Initial Disclosures

The plaintiff and any defendant that files an answer or other response to the complaint shall exchange their Initial Disclosures under Federal Rule of Civil Procedure 26(a)(1) ("Initial Disclosures") within fourteen (14) days after the defendant files its answer or other response, provided, however, if defendant asserts a counterclaim for infringement of another patent, the Initial Disclosures shall be exchanged within fourteen (14) days after the plaintiff files its answer or other response to that counterclaim. As used in this Rule, the term "document" has the same meaning as in Federal Rule of Civil Procedure 34(a):

(a) A party asserting a claim of patent infringement shall produce or make the following available for inspection and copying along with its Initial Disclosures, to the extent they are in the party's possession, custody or control.

(1) all documents concerning any disclosure, sale or transfer, or offer to sell or transfer, of any item embodying, practicing or resulting from the practice of the claimed invention prior to the date of application for the patent in suit. Production of a document pursuant to this Rule is not an admission that the document evidences or is prior art under 35 U.S.C. § 102;

(2) with respect to patents that are not governed by the America Invents Act ("AIA") but instead are governed by the pre-AIA patent statute: all documents concerning 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 a priority date otherwise identified for the patent in suit, whichever is earlier;

(3) all communications to and from the U.S. Patent and Trademark Office for each patent in suit and for each patent or patent application on which a claim for priority is based; and

(4) all documents concerning ownership of the patent rights by the party asserting patent infringement.

(b) A party opposing a claim of patent infringement shall produce or make the following available for inspection and copying, along with its Initial Disclosures:

(1) documents sufficient to show the operation and construction of all aspects or elements of each accused apparatus, product, device, component, process, method or other instrumentality identified with specificity in the pleading of the party asserting patent infringement; and

(2) a copy of each item of prior art of which the party is aware that allegedly anticipates each asserted patent and its related claims or renders them obvious or, if a copy is unavailable, a description sufficient to identify the prior art and its relevant details; and

(3) a statement of the gross sales revenue from the accused product(s) (a) for the six (6) year period preceding the filing of the complaint or, if shorter, (b) from the date of issuance of the patent that will enable the parties to estimate potential damages and engage in meaningful settlement negotiations.

With respect to LPR 2.1 (a) and (b), each producing party shall separately identify by production number which documents correspond to each category of the corresponding LPR.

LPR 2.2 Initial Infringement Contentions

A party claiming patent infringement must serve on all parties "Initial Infringement Contentions" containing the following information within fourteen (14) days after the Initial Disclosures under LPR 2.1:

(a) an identification of no more than 25 claims of each patent in suit that are allegedly infringed by the opposing party, but no more than 50 claims total, including for each claim the applicable statutory subsection of 35 U.S.C. § 271;

(b) separately for each asserted claim, an identification of each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of the opposing party of which the party claiming infringement is aware. Each Accused Instrumentality 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)/112(f), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) identification of whether each element of each asserted claim is claimed to be present in the Accused Instrumentality literally or under the doctrine of equivalents. For any claim under the doctrine of equivalents, the Initial Infringement Contentions must include an initial explanation of each function, way, and result that is equivalent and why any differences are not substantial;

(e) for each claim that is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement. If alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described;

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

(g) identification of the basis for any allegation of willful infringement; and

(h) if a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own or its licensee's apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted patent, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim, including whether it is marked (actually or virtually) with the patent number.

LPR 2.3 Initial Non-Infringement, Unenforceability and Invalidity Contentions

Each party opposing a claim of patent infringement or asserting invalidity or unenforceability shall serve upon all parties its "Initial Non-Infringement, Unenforceability and Invalidity Contentions" , within fourteen (14) days after service of the Initial Infringement Contentions. Such Initial Contentions shall be as follows:

(a) Non-Infringement Contentions shall contain a chart, responsive to the chart required by LPR 2.2(c), that separately indicates, for each identified element in each asserted claim, to the extent then known by the party opposing infringement, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality and, if not, each reason for such denial and the relevant distinctions. Conclusory denials are not permitted.

(b) Invalidity Contentions must contain the following information to the extent then known to the party asserting invalidity:

(1) an identification, with particularity, of up to twenty five (25) items of prior art per asserted patent that allegedly invalidates each asserted claim . Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, autl10r and publisher. Prior art in the form of sales, offers for sale, or uses shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. For a patent governed by the pre-AIA amendments to the patent statute, any prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived, and prior art under 35 U.S.C. § 102(g) (pre-AIA) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

(2) for each item of prior art, a detailed statement of whether it allegedly anticipates or renders obvious each asserted claim. If a combination of items of prior art allegedly makes a claim obvious, the Invalidity Contentions must identify each such combination and the reasons to combine such items;

(3) a chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element that such party contends is governed by 35 U.S.C. § 112(6)/112(f), a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function;

(4) a detailed statement of any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2)/112(b), enablement or written description under 35 U.S.C. § 112(1)/112(a), or any other basis; and

(5) a detailed statement of any grounds for contentions that a claim is invalid as non-statutory/patent ineligible under 35 U.S.C. §101.

(c) Unenforceability contentions shall identify the acts allegedly supporting and all bases for the assertion of unenforceability.

LPR 2.4 Document Production Accompanying Initial Non-Infringement and Invalidity Contentions

With the Initial Non-Infringement and Invalidity Contentions under LPR 2.3, the party opposing a claim of patent infringement shall supplement its Initial Disclosures and, in particular, must produce or make available for inspection and copying:

(a) any additional documentation showing the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its LPR 2.2 chart; and

(b) a copy of any additional items of prior art identified pursuant to LPR 2.3 that does not appear in the file history of the patent(s) at issue.

LPR 2.5 Initial Response to Non-Infringement and Invalidity Contentions

Within fourteen (14) days after service of the Initial Non-Infringement and Invalidity Contentions under LPR 2.3, each party claiming patent infringement shall serve upon all parties its "Initial Response to Non-Infringement and Invalidity Contentions."

(a) With respect to invalidity issues, the initial response shall contain a chart, responsive to the chart required by LPR 2.3(a)-(d), that states as to each identified element in each asserted claim, to the extent then known, whether the party admits to the identity of elements in the prior art and, if not, the reason for such denial.

(b) In response to denials of infringement, if the party asserting infringement intends to rely upon Doctrine of Equivalents, such party must include an initial explanation of each function, way, and result that is equivalent and why any differences are not substantial, to the extent not previously provided in response to LPR 2.2(d).

LPR 2.6 Disclosure Requirement in Patent Cases Initiated by Complaint for Declaratory Judgment

In a case initiated by a complaint for declaratory judgment in which a party files a pleading seeking a judgment that a patent is not infringed, is invalid, or is unenforceable, LPR 2.2 and 2.3 shall not apply unless a party makes a claim for patent infringement. If no claim of infringement is made, the party seeking a declaratory judgment must comply with LPR 2.3 and 2.4 within twenty-eight (28) days after the Initial Disclosures.

3. FINAL CONTENTIONS

LPR 3.1 Final Infringement, Unenforceability and Invalidity Contentions

(a) Final Infringement Contentions. Final infringement contentions shall be served in two stages:

(1) Within nineteen (19) weeks after the due date for service of Initial Infringement Contentions, each party claiming patent infringement must serve on all other parties a list identifying no more than 10 claims per patent and no more than 20 claims overall that the party is asserting, each of which must be selected from claims identified in the Initial Infringement Contentions.

(2) Within twenty-one (21) weeks after the due date for service of Initial Infringement Contentions, each party claiming patent infringement must serve on all other parties "Final Infringement Contentions" containing the information required by LPR 2.2 (a)-(h). In the Final Infringement Contentions, no Accused Instrumentality may be accused of infringing more than ten (10) claims per patent and twenty (20) claims overall, selected from the claims identified in the Initial Infringement Contentions. If the Doctrine of Equivalents is being asserted, the Final Infringement Contentions must include an explanation of each function, way, and result that is equivalent and why any differences are not substantial.

(b) Final Unenforceability and Invalidity Contentions. Each party asserting invalidity or unenforceability of a patent claim shall serve on all other parties, at the same time that the Final Infringement Contentions required by LPR 3.1(a)(2) are served, "Final Unenforceability and Invalidity Contentions" containing the information required by LPR 2.3 (b) and (c). Final Invalidity Contentions may rely on more than twenty-five (25) prior art references only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties. For each claim alleged to be invalid, the Final Unenforceability and Invalidity Contentions are limited to four (4) prior art grounds per claim and four (4) non-prior art grounds. No claim asserted to be infringed shall be subject to more than eight (8) total grounds per claim. Each of the following shall constitute separate grounds: indefiniteness, lack of written description, lack of enablement, unenforceability, and non-statutory subject matter under 35 U.S.C. § 101. Each assertion of anticipation and each combination of references shall constitute separate grounds.

LPR 3.2 Final Non-infringement, Enforceability and Validity Contentions

Not later than 28 days after the due date for Final Infringement Contentions under LPR 3.1:

(a) Each party asserting non-infringement of a patent claim shall serve on all other parties "Final Non-infringement Contentions" containing the information called for in LPR 2.3(a).

(b) Each party asserting patent infringement shall serve "Final Enforceability and Validity Contentions" in response to any "Final Unenforceability and Invalidity Contentions."

LPR 3.3 Document Production Accompanying Final Invalidity Contentions

With the Final Invalidity Contentions, the party asserting invalidity of any patent claim shall produce or make available for inspection and copying: a copy or sample of all prior art identified pursuant to LPR 3.1(b), to the extent not previously produced, that does not appear in the file history of the patent(s) at issue. If any such item is not in English, an English translation of the portion(s) relied upon shall be produced. The translated portion of the non-English prior art shall be sufficient to place in context the particular matter upon which the party relies.

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

LPR3.4. Amendment of Final Contentions

A party may amend its Final Infringement Contentions or Final Non-infringement and Invalidity Contentions only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery of tl1e basis for tl1e amendment.

An example of a circumstance that may support a finding of good cause, absent undue prejudice to the non-moving party, includes a claim construction by the Court different from that proposed by the party seeking amendment.

The duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.

LPR 3.5 Relationship to USPTO Proceedings and Prior Litigation

(a) In the parties' Rule 26(f) Report, the parties shall advise the court with respect to each patent in suit (1) whether the patent is eligible to be challenged at the USPTO by each defendant, (2) what form such a challenge may take (inter parties review, post grant review, covered business method review, ex parte reexamination, etc.), (3) the earliest and latest date such a challenge is permitted to be made for each defendant, (4) whether the patent has been the subject of prior USPTO reviews and, if so, the status of the same, and (5) any other prior litigation history of the patent and the status of the same.

(b) Absent exceptional circumstances, no party may file a motion to stay the lawsuit pending any proceeding in the U.S. Patent and Trademark Office after the due date for service of that party's Final Contentions pursuant to LPR 3.2.

LPR3.6 Discovery Concerning Opinions of Counsel

(a) The substance of a claim of reliance on advice of counsel offered in defense to a charge of willful infringement, and other information within the scope of a waiver of the attorney-client privilege based upon disclosure of such advice, is not subject to discovery until seven (7) days after the court's claim construction ruling.

(b) On the day advice of counsel information becomes discoverable under LPR 3.6(a), a party claiming reliance on advice of counsel shall disclose to all other parties the following:

(l) All written opinions of counsel upon which the party will rely;

(2) All information provided to the attorney in connection with the advice;

(3) All written attorney work product developed in preparing the opinion that the attorney disclosed to the client; and

(4) Identification of the date, sender and recipient of all written and oral communications with the attorney or law firm concerning the subject matter of the advice by counsel.

(c) After advice of counsel information becomes discoverable under LPR 3.6(a), a party claiming willful infringement may take the deposition of any attorneys preparing or rendering the advice relied upon and any persons who received or claims to have relied upon such advice.

(d) This Rule does not address whether materials other than those listed in LPR 3.6(b)(1-4) are subject to discovery or within the scope of any waiver of the attorney-client privilege.

(e) In a case where advice of counsel is considered relevant to a patent-related claim or defense, fact discovery relating to advice of counsel shall not commence until seven (7) days after entry of a claim construction ruling, notwithstanding LPR 1.3, and shall end forty-two (42) days after entry of the claim construction ruling.

4. CLAIM CONSTRUCTION PROCEEDINGS

LPR4.1 Exchange of Proposed Claim Terms To Be Construed Along With Proposed Constructions

(a) Within fourteen (14) days after service of the Final Invalidity Contentions pursuant to LPR 3.2, each party shall serve a list of (i) the claim terms and phrases the party contends the Court should construe; (ii) the party's proposed constructions; (iii) identification of any claim element that the party contends is governed by 35 U.S.C. § 112(6); and (iv) the party's description of the function of that element, and the structure(s), act(s), or material(s)

corresponding to that element, identified by column and line number with respect to the asserted patent(s).

(b) Within seven (7) days after the exchange of claim terms and phrases, the parties must meet and confer and agree upon no more than ten (10) terms or phrases to submit for construction by the court. No more than ten (10) terms or phrases may be presented to the Court for construction absent prior leave of court upon a showing of good cause. The assertion of multiple non-related patents shall, in an appropriate case, constitute good cause. If the parties are unable to agree upon ten terms, then five shall be allocated to all plaintiffs and five to all defendants. For each term to be presented to the Court, the parties must certify whether it is outcome-determinative.

Comment

In some cases, the parties may dispute the construction of more than ten terms. But because construction of outcome-determinative or otherwise significant claim terms may lead to settlement or entry of summary judgment, in the majority of cases tl1e need to construe other claim terms of lesser importance may be obviated. The limitation to ten claim terms to be presented for construction is intended to require the parties to focus upon outcome-determinative or otherwise significant disputes.

LPR 4.2 Claim Construction Briefs

(a) Opening Claim Construction Brief. Within thirty-five (35) days after the exchange of terms set forth in LPR 4.1(a), the parties opposing infringement shall file their Opening Claim Construction Brief, which may not exceed twenty-five (25) pages absent prior leave of court. The brief shall identify any intrinsic evidence with citation to the Joint Appendix under LPR 4.2(b) and shall separately identify any extrinsic evidence the party contends supports its proposed claim construction. If a party offers the testimony of a witness to support its claim construction, it must include with its brief a sworn declaration by the witness setting forth the substance of the witness' proposed testimony, and promptly make the witness available for deposition (if the witness is under the control of the party) concerning tl1e proposed testimony.

(b) Joint Appendix. On the date for filing the Opening Claim Construction Brief, the parties shall file a Joint Appendix containing the patent(s) in dispute and the prosecution history for each patent. The prosecution history must be paginated, and all parties must cite to the Joint Appendix when referencing the materials it contains. Any party may file a separate appendix to its claim construction brief containing other supporting materials.

(c) Responsive Claim Construction Brief. Within twenty-eight (28) days after filing of the Opening Claim Construction brief, the parties claiming infringement shall file their Responsive Claim Construction Brief, which may not exceed twenty-five (25) pages absent prior leave of Court. The brief shall identify any intrinsic evidence with citation to the Joint Appendix under

LPR 4.2(b) and shall separately identify any extrinsic evidence the party contends supports its proposed claim construction. If a party offers the testimony of a witness to support its claim construction, it must include with its brief a sworn declaration by the witness setting forth the substance of the witness's proposed testimony and promptly make the witness available for deposition (if the witness is under the control of the party) concerning the proposed testimony. If such a deposition occurs, the date for the filing of a Reply Claim Construction brief shall be extended by seven (7) calendar days. The brief shall also describe all objections to any extrinsic evidence identified in the Opening Claim Construction Brief.

(d) Reply Claim Construction Brief Within fourteen (14) days after filing of the Responsive Claim Construction Brief, the parties opposing infringement shall file their Reply Claim Construction Brief, which may not exceed fifteen (15) pages absent prior leave of Court. The brief shall describe all objections to any extrinsic evidence identified in the Opening Claim Construction Brief.

(e) The presence of multiple alleged infringers with different products or processes shall, in an appropriate case, constitute good cause for allowing additional pages in the Opening, Responsive, or Reply Claim Construction Briefs or for allowing separate briefing as to different alleged infringers.

(f) Joint Claim Construction Chart. Within seven (7) days after the date for filing of the Reply Claim Construction Brief, the parties shall file (1) a joint claim construction chart that sets forth each claim term and phrase addressed in the claim construction briefs; each party's proposed construction, and (2) a joint status report containing the parties' proposals for the nature and form of the claim construction hearing pursuant to LPR 4.3.

Comment

The committee opted for consecutive claim construction briefs rather than simultaneous briefs, concluding that consecutive briefing is more likely to promote a meaningful exchange regarding the contested points. For the same reason, the committee opted to have the alleged infringer file the opening claim construction brief. Patent holders are more likely to argue for a "plain meaning" construction or for non-construction of disputed terms; alleged infringers tend to be less likely to do so.

The Rules provide for three briefs (opening, response, and reply), not four, due to the likelihood of a claim construction hearing or argument. The Court's determination not to hold a hearing or argument may constitute a basis to permit a surreply brief by the patent holder. A judge may choose not to require or permit a reply brief.

LPR 4.3 Claim Construction Hearing

Brain Corporation EX2005
IPR2025-01602

Unless the Court orders otherwise, a claim construction oral argument or hearing may be held within twenty-eight (28) days after filing of the Reply Claim Construction Brief. Either before or after the filing of claim construction briefs, the Court shall issue an order describing the schedule and procedures for a claim construction hearing. Any exhibits, including demonstrative exhibits, to be used at a claim construction hearing must be exchanged no later than three (3) days before the hearing.

5. EXPERT WITNESSES

LPR 5.1 Disclosure of Experts and Expert Reports

Unless the Court orders otherwise,

(a) for issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule;

(b) within twenty-eight (28) days after the claim construction ruling or the close of discovery after the claim construction ruling, whichever is later, each party shall make its initial expert witness disclosures required by Federal Rule of Civil Procedure 26 on issues for which it bears the burden of proof;

(c) within twenty eight (28) days after the date for initial expert reports, each party shall make its rebuttal expert witness disclosures required by Federal Rule of Civil Procedure 26 on the issues for which the opposing party bears the burden of proof.

LPR 5.2 Depositions of Experts

Depositions of expert witnesses shall be completed within twenty-eight (28) days after exchange of expert rebuttal disclosures.

LPR 5.3 Presumption Against Supplementation of Reports

Amendments or supplementation to expert reports after the deadlines provided herein are presumptively prejudicial and shall not be allowed absent prior leave of court upon a showing of good cause that the amendment or supplementation could not reasonably have been made earlier and that the opposing party is not unfairly prejudiced.

6. DISPOSITIVE MOTIONS

LPR 6.1 Final Day for Filing Dispositive Motions

All dispositive motions shall be filed within twenty-eight (28) days after the scheduled date for the end of expert discovery.

Comment

This Rule does not preclude a party from moving for summary judgment at an earlier stage of the case if circumstances warrant. It is up to the trial judge to determine whether to consider an "early" summary judgment motion. *See also* LPR 1.1 (judge may defer a motion raising claim construction issues until after claim construction hearing is held).