

JUDGE CAMPBELL'S PATENT RULES

1. Scope of Rules

These are my Rules of Practice for Patent Cases.

These Rules apply to all civil actions where I am the judge which allege infringement of a utility patent in a complaint, counterclaim, cross-claim or third party claim, or which seek a declaratory judgment that a utility patent is not infringed, is invalid or is unenforceable. Counsel for the party alleging infringement or seeking a declaration of noninfringement must ensure that counsel for all parties in the case receive a copy of these Rules. I may accelerate, extend, eliminate or modify the deadlines set forth in these Rules based on the circumstances of any particular case, including, without limitation, the complexity of the case or the number of patents, claims, products, or parties involved.

With my approval, the parties may accelerate, extend, eliminate, enlarge or modify the deadlines set forth in these Rules based on the particular circumstances of the case. When possible, the parties should stipulate to all proposed changes. For all proposed changes, there must be a brief explanation of the reason for the change in the Patent Case Management Statement. If a party opposes the change, that party must briefly explain the reason.

2. GENERAL PROVISIONS

2-1. Governing Procedure

(a) Initial Case Management Conference. When the parties confer with each other pursuant to FRCivP 26(f), in addition to the matters covered by FRCivP 26, the parties must discuss and address in the Case Management Statement filed pursuant to FRCivP 26(f) and Civil L.R. 16-9, the following topics:

- (1) Proposed modification of these Rules in your case;
- (2) Whether the court should hear live testimony at the Markman hearing;
- (3) The need for and any specific limits on discovery relating to claim construction, including depositions of witnesses, including expert witnesses;
- (4) The order of presentation at the Markman hearing; and
- (5) The scheduling of a Claim Construction Prehearing Conference to be held after the Joint Claim Construction and Prehearing Statement provided for in rule 4-3 has been filed.

2-3. Relationship to Federal Rules of Civil Procedure.

Except as provided in this paragraph or as otherwise ordered, it shall not be a legitimate ground for objecting to an opposing party's discovery request (e.g., interrogatory, document request, request for admission, deposition question) or declining to provide information otherwise required to be disclosed pursuant to FRCivP 26(a)(1) that the discovery request or disclosure requirement is premature in light of or otherwise conflicts with, these patent Rules. A party may object, however, to responding to the following categories of discovery requests (or decline to provide information in its initial disclosures under FRCivP 26(a)(1)) on the ground that they are premature in light of the timetable provided in these patent Rules:

(a) Requests seeking to elicit a party's claim construction position;

(b) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, or other instrumentality;

(c) Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art; and

(d) Requests seeking to elicit from an accused infringer the identification of any opinions of counsel, and related documents, that it intends to rely upon as a defense to an allegation of willful infringement.

Where a party properly objects to a discovery request (or declines to provide information in its initial disclosures under FRCivP 26(a)(1)) as set forth above, that party shall provide the requested information on the date on which it is required to provide the requested information to an opposing party under these patent Rules, unless there exists another legitimate ground for objection.

3. PATENT INITIAL DISCLOSURES

3-1. Disclosure of Asserted Claims and Preliminary Infringement Contentions.

Not later than the date of the Initial Case Management Conference, a party asserting patent infringement shall serve upon each party accused of infringement a preliminary list identifying each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentalities") of which that party is aware at the time. 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 that it believes infringes one or more of the claims of the asserted patents. At the time the list of Accused Instrumentalities is served, the party claiming patent infringement may also serve, if desired, document

requests and interrogatories requesting information about the identity of persons involved in the design, development, sale and manufacture of Accused Instrumentalities and similar products, as well as the design, development, manufacture, use, sale and functionality of Accused Instrumentalities.

Not later than 30 days after service of the preliminary list of Accused Instrumentalities, all parties accused of patent infringement shall produce all documents and things related to the design, development, manufacture, sale, offer for sale, use and functionality of Accused Instrumentalities, as well as responses to the interrogatories referenced herein and all documents not previously produced that are responsive to the document requests referenced herein. If the Accused Instrumentalities include software that is related to the allegation of infringement, the source code for such software shall be produced under this provision.

Parties asserting patent infringement shall be presumptively entitled to take a 30(b)(6) deposition on the subjects of the design, development, manufacture, use, sale, offer for sale and functionality of the items on the preliminary list of Accused Instrumentalities and the depositions of two persons substantively involved in the design and development of the Accused Instrumentalities during the period from the date of service of the preliminary list of Accused Instrumentalities and the date on which that party's Disclosure of Asserted Claims and Preliminary Infringement Contentions is due.

Not later than 90 days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Preliminary Infringement Contentions." Separately, for each opposing party, the "Disclosure of Asserted Claims and Preliminary Infringement Contentions" shall contain the following information:

(a) Each claim of each patent in suit that is allegedly infringed by each opposing Party and identification of each Accused Instrumentality alleged to infringe any claim of the patents in suit;

(b) Separately for each asserted claim, each 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 Device, 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 Device 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 Device;

(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.

3-2. Document Production Accompanying Disclosure.

With the “Disclosure of Asserted Claims and Preliminary 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) 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.

3-3. Preliminary Invalidity Contentions.

Not later than 10 days after service of the Disclosure of Asserted Claims and Preliminary Infringement Contentions, any party asserting the invalidity of any claim based on prior art shall inform the adverse party(ies) of its intention to assert invalidity. If there is an assertion of invalidity, within 15 days after the service of the Disclosure of Asserted Claims and Preliminary Infringement Contentions, the party or parties asserting patent infringement shall produce all documents evidencing the conception, reduction to practice, design and development of each claimed invention, which were created on or before the date of the application for the patent in suit or the priority date identified in Patent L.R. 3-2(b), whichever is earlier. Simultaneously, any party asserting the invalidity of any claim of any patent in suit shall produce all documents evidencing the conception, reduction to practice, design and development of each piece of prior art alleged to invalidate any asserted claim, either by itself or in combination with other art.

Not later than 45 days after service upon it of the “Disclosure of Asserted Claims and Preliminary Infringement Contentions,” each party opposing a claim of patent infringement shall serve on all parties its “Preliminary Invalidity Contentions” which must contain the following information:

(a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. 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, author and publisher. Prior art under 35 U.S.C. §102(b) 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. 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. Prior art under 35 U.S.C. §102(g) 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), including any evidence related to whether such invention was abandoned, suppressed or concealed;

(b) Whether each item of prior art anticipates each asserted claim or renders it obvious. If a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, must be identified;

(c) 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), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and

(d) Any grounds of invalidity based on indefiniteness under 35 U.S.C. §112(2) or enablement or written description under 35 U.S.C. §112(1) of any of the asserted claims.

3-4. Document Production Accompanying Preliminary Invalidity Contentions.

With the “Preliminary Invalidity Contentions,” the party opposing a claim of patent infringement must produce or make available for inspection and copying:

(a) Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant as required in 3-1(c) above; and

(b) A copy of each item of prior art identified as required by 3-3(a) above which does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon must be produced.

3-5. Final Contentions.

Each party's "Preliminary Infringement Contentions" and "Preliminary Invalidity Contentions" shall be deemed to be that party's final contentions, except as set forth below:

(a) If a party claiming patent infringement believes in good faith that (1) the court's Markman order or (2) information uncovered during discovery so requires, not later than 30 days after service by the court of its Markman order, that party may serve "Final Infringement Contentions" without leave of court that amend its "Preliminary Infringement Contentions."

(b) Not later than 30 days after service by the court of its Markman order, each party opposing a claim of patent infringement may serve "Final Invalidity Contentions" without leave of court that amend its "Preliminary Invalidity Contentions" if:

(1) a party claiming patent infringement has served "Final Infringement Contentions" pursuant to Rule 3-6(a), or

(2) the party opposing a claim of patent infringement believes in good faith that the court's Markman order or information uncovered during discovery so requires.

3-6. Amendment to Contentions.

Amendment or modification of the Preliminary or Final Infringement Contentions or the Preliminary or Final Invalidity Contentions, other than as expressly permitted as described above, may be made only by order of the court, which shall be entered only upon a showing of good cause.

3-7. Willfulness.

Not later than 30 days after service by the court of its Markman order, each party opposing a claim of patent infringement that will rely on an opinion of counsel as part of a defense to a claim of willful infringement shall:

(a) Produce or make available for inspection and copying the opinion(s) and any other documents relating to the opinion(s) as to which that party agrees the attorney-client or work product protection has been waived; and

(b) If any oral opinion of counsel is relied upon, the party relying upon that opinion shall serve a statement upon the party asserting infringement a statement setting forth the date of the opinion, the identities of all persons giving and receiving the opinion(s), the content of the opinion, and produce all documents related to such opinion(s)

(b) Serve a privilege log identifying any other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the opinion(s) which the party is withholding on the grounds of attorney-client privilege or work product protection.

A party opposing a claim of patent infringement who does not comply with the requirements of this provision shall not be permitted to rely on an opinion of counsel as part of a defense to willful infringement absent a stipulation of all parties or by order of the court, which shall be entered only upon a showing of good cause.

4. CLAIM CONSTRUCTION PROCEEDINGS

4-1. Exchange of Proposed Terms and Claim Elements for Construction.

(a) Not later than 10 days after service of the “Preliminary Invalidity Contentions,” each party shall simultaneously exchange a list of claim terms, phrases, or clauses which that party contends should be construed by the court, and identify any claim element which that party contends should be governed by 35 U.S.C. §112(6).

(b) The parties shall thereafter meet and confer for the purposes of finalizing this list, narrowing or resolving differences, and facilitating the ultimate preparation of a Joint Claim Construction and Prehearing Statement.

(c) The list submitted by the parties shall not include more than ten (10) claim terms for interpretation.

4-2. Exchange of Preliminary Claim Construction and Extrinsic Evidence.

(a) Not later than 20 days after the exchange of “Proposed Terms and Claim Elements for Construction,” the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which the parties collectively have identified for claim construction purposes. Each such “Preliminary Claim Construction” shall also, for each element which any party contends is governed by 35 U.S.C. § 112(6), identify the structure(s), act(s), or material(s) corresponding to that element.

(b) At the same time the parties exchange their respective “Preliminary Claim Constructions,” they shall each also provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of fact and expert witnesses they contend support their respective claim constructions. The parties shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. For each witness, the parties shall also provide a brief description of the substance of that witness’ proposed testimony.

(c) The parties shall thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a Joint Claim Construction and Prehearing Statement.

4-3. Joint Claim Construction and Prehearing Statement.

Not later than 60 days after service of the “Preliminary Invalidity Contentions,” the parties shall complete and file a Joint Claim Construction and Prehearing Statement, which shall contain the following information:

(a) The construction of those claim terms, phrases, or clauses on which the parties agree;

(b) Each party’s proposed construction of each disputed claim term, phrase, or clause, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction of the claim or to oppose any other party’s proposed construction of the claim, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses;

(c) The anticipated length of time necessary for the Markman hearing;

(d) Whether any party proposes to call one or more witnesses, including experts, at the Markman hearing, the identity of each such witness, and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert (I generally do not allow such testimony); and

(e) A list of any other issues which might appropriately be taken up at a prehearing conference prior to the Markman hearing, and proposed dates, if not previously set, for any such prehearing conference.

4-4. Claim Construction Briefs.

(a) Not later than 45 days after serving and filing the Joint Claim Construction and Prehearing Statement, the party claiming patent infringement shall serve and file an opening brief and any evidence supporting its claim construction.

(b) Not later than 14 days after service upon it of an opening brief, each opposing party shall serve and file its responsive brief and supporting evidence.

(c) Not later than 7 days after service upon it of a responsive brief, the party claiming patent infringement shall serve and file any reply brief and any evidence directly rebutting the supporting evidence contained in an opposing party’s response.

4-5. Markman Hearing.

As soon as the court's calendar permits following submission of the reply brief specified in Rule 4-4(c), the court shall conduct a Markman hearing, to the extent the parties or the court believe a hearing is necessary for construction of the claims at issue.