

## **2005 PATENT ADVISORY COMMITTEE'S PREFACE**

Pursuant to 28 U.S.C. § 2077, the Court appointed an Advisory Committee to prepare a draft of the 2005 Amendments and to make recommendations to the Court with respect to local rules for patent cases in the District of Minnesota. The Advisory Committee consisted of the following members:

Mr. Jake M. Holdreith, Chair  
Mr. Jeffer Ali  
Ms. Alana T. Bergman  
The Honorable Arthur J. Boylan  
Ms. Sue Halverson  
Mr. Peter M. Lancaster  
Professor R. Carl Moy  
Mr. James T. Nikolai  
The Honorable James M. Rosenbaum  
Mr. Richard D. Sletten  
Ms. Becky R. Thorson

The Committee wishes to express its gratitude to all those who aided its efforts. Special thanks are due to a few individuals. Wendy S. Osterberg, the Chief Deputy Clerk, provided invaluable information and support, and she was ably assisted by Karen Mack and Mary McKay. Finally, we would like to recognize Rachel Clark Hughey and Annie Huang for their contributions to the formulation of these Rules.

These Rules are designed to ease, simplify, and reduce the cost of patent practice in the District of Minnesota. Patent cases are frequently complex. These Rules are designed to streamline the pre-trial and claim construction processes.

The bar bears the dual role as zealous advocates for its clients as well as its concomitant duties as officers of the Court. It is expected by the Court that counsel will emphasize and discuss both of these obligations with their clients.

The Court has the ability to use its traditional means of shifting costs or imposing sanctions for any practice which impedes the efforts under these amendments to further the goals established in Rule 1 of the Federal Rules of Civil Procedure.

The Committee prepared its draft and made its recommendations with the following objects in mind:

1. Reducing the cost and burden of patent litigation in Minnesota without sacrificing fairness.
2. Promoting consistency and certainty in how patent cases are handled in Minnesota.

3. Addressing issues that are recurring in most patent cases and that all litigants and the Courts have some common interests in managing by rule, in particular disclosure, discovery, and claim construction issues.
4. Promoting the greatest and most accessible understanding of patent issues and technical issues by litigants, Courts, and juries.
5. Minimizing the discovery procedural disputes that often lead to the same outcome and could be resolved at less cost and burden, at least presumptively, by rule rather than by motion.
6. Discouraging expensive and/or burdensome litigation procedures that do not substantially contribute to the resolution of patent cases.

With these objects and priorities in mind, the Committee considered a number of rules and procedures that have been used in the District of Minnesota and in other districts in patent cases, including in particular the case management orders for patent cases that have been entered in patent cases by individual judges in the District of Minnesota with patent-specific provisions, as well as the local rules in the District of Delaware and the Northern District of California. From a large number of proposals, the Committee focused its draft and recommendations on the areas that, in the opinion of the Committee, are likely to arise in a majority of patent cases and which lend themselves to management by rules that should not advantage or disadvantage any particular litigants or groups, but should reduce time, burden, and expense when governed by rule rather than motion practice or stipulation.

Each Local Rule is followed by an effective date. The Local Rules with an effective date of 2005 were adopted at the recommendation of the 2005 Patent Advisory Committee.

## **LR 16.2 PRETRIAL CONFERENCE**

(a) In every case, not exempted by LR 26.1(d), the Court shall schedule an initial pretrial conference, pursuant to Fed.R.Civ.P. 16, for the purpose of adopting a pretrial schedule. The initial pretrial conference shall be held within 90 days after the first responsive pleading is filed or, in the case of actions removed or transferred from another Court, within 90 days after the Notice of Removal is filed. No later than 14 days before the scheduled initial pretrial conference, the parties shall meet as required by Fed.R.Civ.P. 26(f) and LR 26.1(f). If the case is not settled at the Rule 26(f) meeting, the parties shall, within 10 days of the meeting, file with the Court the joint report of the meeting. The report shall be made in the form prescribed in Form 3, “Rule 26(f) Report”, or in the cases in which any party asserts any claim involving a patent, in the form prescribed in Form 4, “Rule 26(f) Report (Patent Cases)”.

### **2005 Advisory Committee’s Note to LR 16.2 and Form 4**

Form 4 addresses recurring issues in patent cases. Form 4 is intended to reduce motion practice and to encourage parties to narrow and focus issues for resolution by the Court, including claim construction issues. Although various provisions in Form 4 are phrased in terms of the “plaintiff” and the “defendant”, in cases of counterclaims of patent infringement or for declaratory judgment, each party asserting a patent is expected to provide the information required for “plaintiff”, and each party asserting a defense to patent infringement is expected to provide the information required for “defendant”.

Paragraph (c) allows discovery related to a charge of willful infringement and to defenses of invalidity and unenforceability, such as the defense of inequitable conduct, without pleading of those defenses, in order to encourage parties to explore whether there is a substantial basis for such pleading before pleading them. The Court of Appeals for the Federal Circuit has commented that “the habit of charging inequitable conduct in almost every major patent case has become an absolute plague.” *Burlington Indus. v. Dayco Corp.*, 849 F.2d 1418, 1422 (Fed. Cir. 1988). The Committee considered a proposal to require leave of the Court for pleading inequitable conduct or willfulness, similar to Minn. Stat. § 549.191 (2003), but concluded that the power of the Court to dismiss such allegations under Rules 12 and 56 of the Federal Rules of Civil Procedure provides an existing tool for management of insufficient charges of inequitable conduct or willfulness.

Paragraph (e)(7) encourages the parties to agree in advance as to the discoverability of drafts of expert reports and provides that in the absence of agreement, such drafts are not discoverable. Under the Federal Rule of Civil Procedure 26, the Court has power to limit use of any discovery method by local rule if the Court determines that the burden or expense of proposed discovery outweighs its benefit. Discovery of drafts of expert reports rarely provides substantial benefits. This paragraph is intended to end motion practice as to the discoverability of drafts of expert reports.

Paragraphs (f) and (g) provide a sequence of exchanges intended to focus issues for claim construction by the Court. The parties are expected to determine the most appropriate intervals for the exchanges given the particular circumstances of a case. In general, the Court has ordered

intervals of 30 to 60 days between each step in the series of exchanges. In particular cases, a different schedule may be appropriate, for example if a party intends to bring an early motion that does not depend on claim construction, such as a motion to dismiss for lack of subject matter jurisdiction.

Paragraph (h) provides for a delay of the waiver of attorney-client privilege when an opinion of counsel is offered as part of a defense to a charge of willful infringement and a provision allowing the parties to make proposals addressing other phasing or sequencing issues in discovery. The Committee considered and rejected recommending any presumptions for phased discovery or establishing schedules for phased discovery because of the variety of circumstances presented in patent cases. For example, in certain cases, prejudice could result from discovery of willfulness issues relating to attorney-client materials. On the other hand, willfulness discovery could be relevant to issues of infringement and/or equitable defenses to infringement. Depending upon the case, phasing of discovery could save discovery expense or cause an expensive duplication of discovery efforts.

Paragraph (h)(1) is intended to address discovery controversies that frequently arise when there is a claim of willful infringement and a denial based upon reliance on advice of counsel. Motion practice often follows requests for discovery, including motions to compel discovery or motions to stay discovery and bifurcate trial. Paragraph (h)(1) encourages the parties to agree on the time table for discovery regarding the waiver of any applicable attorney-client privilege on topics relevant to willfulness or articulate proposals regarding such discovery in advance of the initial pretrial conference. The parties are not required to propose that the Court phase discovery regarding the waiver of any applicable attorney-client privilege on topics relevant to willfulness. This provision provides a format for the parties to meet and confer on this subject and either present joint or individual proposals to be considered by the Court.

The general provision set forth in paragraph (h)(2) is intended to encourage the parties to identify other areas of agreement or dispute regarding discovery phasing early so these matters can be addressed at the initial pretrial conference. Optional responses to paragraph (h)(2) include no proposals, joint proposals, or individual proposals regarding the phasing or sequencing of discovery. The inclusion of paragraph (h)(2) should not be interpreted to mean phased discovery is favored in patent cases. Whether discovery on topics that are the subject of discovery are phased depends upon the Court's discretion in adopting a pretrial schedule. Whether phased discovery is proposed or adopted also does not create a presumption regarding the bifurcation of any issues for trial.

Paragraph (n) provides for the use of a tutorial describing the technology and matters in issue for the benefit of the Court. A technology tutorial is not mandatory. Rather, the parties are free to decide whether a technology tutorial would be helpful to educate the Court regarding the technology at issue. A mandatory technology tutorial would unnecessarily increase the cost of and needlessly complicate patent suits involving relatively simple, easily understandable technologies.

If the parties believe that it would be helpful to the Court to have a tutorial, it is not required that the tutorial be in the form of a video tape. Should the parties determine that a format other than video tape be more appropriate, such as a DVD or a computerized

presentation, they may suggest the format at the initial pretrial conference. For any such format selected, the parties must confirm the Court's technical ability to access the information contained in the tutorial. The parties may further choose to present the tutorials in person.

The purpose of the technology tutorial is to educate the Court. As such, the scheduling of the tutorial should preferably be early in the litigation, and most preferably before the exchange of claim construction briefs. However, the scheduling of the tutorial may vary based on the complexity of the case and the amount at stake in the litigation. In some cases, the parties may suggest that the tutorial be due mid-discovery to allow its use in connection with any possible summary judgment motions or claim construction hearing. In cases that are likely to settle early on, the parties may suggest the deadline for the tutorial be set late in the litigation in hopes of avoiding its cost altogether.

Whether or not the parties agree to use a technology tutorial, the Court may request that the parties have their experts appear to explain the technology. However, expert legal testimony (as opposed to technical testimony) on such substantive issues as invalidity (by anticipation, obviousness, on-sale bar, etc.) and claim construction and infringement are not intended to be part of the tutorial.

Paragraph (o) provides for the use of the patent procedure tutorial. The purpose of the patent procedure tutorial is to educate the jury about the patent process. The Federal Judicial Center distributes this 18-minute video, entitled "An Introduction to the Patent System". This video provides jurors with an overview of patent rights in the United States, patent office procedure, and the contents of a patent.

A decision by one or all the parties not to show a patent procedure tutorial as set forth in Paragraph (o) does not preclude a Court from showing the patent procedure tutorial on its own initiative.

## **LR 16.6 FINAL PRETRIAL CONFERENCE**

(a) In every case not specified by LR 26.1(b)(1), the Court shall hold a final pretrial conference. The final pretrial conference required by this Rule may be combined with the settlement conference required by LR 16.5(a). In any event the conference must be held no earlier than 45 days before trial.

(b) At the final pretrial conference, the parties and the Court shall discuss:

- (1) Stipulated and uncontested facts;
- (2) List of issues to be tried;
- (3) Disclosure of all witnesses;
- (4) Listing and exchange of copies of all exhibits;
- (5) Motions in limine, pretrial rulings, and, where possible, objections to evidence;
- (6) Disposition of all outstanding motions;
- (7) Elimination of unnecessary or redundant proof, including limitations on expert witnesses;
- (8) Itemized statement of all damages by all parties;
- (9) Bifurcation of the trial;
- (10) Limits on the length of trial;
- (11) Jury selection issues; and
- (12) Any issue that in the Judge's opinion may facilitate and expedite the trial; for example, the feasibility of presenting trial testimony by way of deposition or by a summary written statement; **and**

(c) If the case involves one or more claims relating to patents, and is to be tried to a jury, the parties shall confer with the objective of agreeing to a particular set of model jury instructions to be used as a template for each party's proposed jury instructions; and

(d) Following the final pretrial conference, the Court shall issue a final pretrial order, which shall set forth dates by which motions in limine shall be filed, date by which the disclosures of Fed. R. Civ. P. 26(a)(3) shall be made and dates by which the documents identified in LR 39.1 shall be filed and exchanged between counsel.

### **2005 Advisory Committee's Note to LR 16.6(c)**

The Committee recognizes that there are several model jury instructions that could be used as a template for proposed jury instructions. Specifically, model jury instructions issued by the United States Courts of Appeals for Fifth, Ninth, and Eleventh Circuits, the United States District Courts for the District of Delaware and the Northern District of California, the American Intellectual Property Law Association, and the Federal Circuit Bar Association might be appropriate.

## LR 26.1 DISCOVERY

**(c) Protective Orders in Patent Cases.** In cases involving one or more claims relating to patents, no claim that discoverable material otherwise subject to production includes confidential or trade secret information shall constitute grounds for refusing to produce such material. Distribution of any material identified as confidential by a producing party, however, shall be limited to outside attorneys of record in the case who will not be involved in reviewing or drafting claims or arguments on behalf of the receiving party in any patent prosecution before the United States Patent and Trademark Office or foreign patent agency. All attorneys shall maintain the confidentiality of such material and shall use the material only for purposes of the case in which the material is produced. If a protective order is entered in the case, its terms shall supersede the terms of this paragraph. Such subsequent protective order shall, subject to the differing agreement of the parties or Court order, take the form of the Protective Order set out as Form 5.

### **2005 Advisory Committee's Note to LR 26.1(c)**

Patent litigation ordinarily includes requests for protective orders. The Committee concluded that repeated negotiation of such orders wastes the parties' resources and delays the beginning of discovery. Protective orders, while nearly universal in patent litigation, are not unique to such litigation; nor, so far as the Committee could determine, do the issues present in patent litigation lead to types of protective orders that are different from those used in other kinds of litigation involving trade secret or confidential information.

LR 26.1(c) seeks to expedite discovery in two ways: first, by providing for the exchange of confidential information between outside trial counsel prior to entry of a protective order, and second, by providing a form protective order for parties to consider.

The Rule prohibits outside trial counsel from being involved in certain facets of patent prosecution after reviewing confidential information prior to the entry of a protective order. This Rule does not create a presumption that the protective order will exclude outside trial counsel from being involved in patent prosecution after they have had access to confidential information. The Committee recognizes that the Rule may, in certain limited cases, give a party an unfair advantage by requiring the other party to choose between having an attorney serve as litigation counsel or patent prosecution counsel. This is not the intent of the Rule. In such cases, the parties are encouraged to identify and resolve such issues expeditiously and, if they are unable to do so, present such issues for prompt resolution by the Court.

The Form is meant to focus attention on the issues that are typically contested in negotiating protective orders rather than resolve those issues. This Form is thus presented as one that might serve as a starting point or template for protective orders in any kind of case calling for such an order. In any individual case, parties may by agreement or by motion seek changes to the template.

## **LR 39.1 PREPARATION FOR TRIAL IN CIVIL CASES**

(a) Setting the Trial Date. The Judge to whom the case is assigned shall notify counsel in cases set on the Judge's calendar at least 21 days in advance of the date the first case on the civil calendar is to be called. Cases on such calendar may be called on a peremptory basis. The case may be heard by any judge. For information on calendar matters, counsel shall contact the calendar clerk of the Judge who is to try the case.

(b) Documents to be Submitted for Trial . Unless otherwise ordered, counsel shall file and serve the following documents at least 10 days before the first case on the civil calendar is to be called for trial:

(1) Documents Required for All Trials

(A) Trial Brief.

(B) Exhibit List. A list of exhibits shall be prepared on a form to be obtained from the Clerk of Court. All exhibits shall be marked for identification with Arabic numbers and shall include the case number.

Example: Pltf. or Deft. #1

Civ. 3-84-2

(Multiple parties list name, e.g. Pltf. Smith #1)

These exhibits shall be made available for examination and copying at least 14 days prior to the date the first case on the civil calendar may be called for trial.

(C) Witness List. The list shall include a short statement of the substance of the expected testimony of each witness.

(D) List of Deposition Testimony. The list shall designate those specific parts of deposition to be offered at trial. Any party who wishes to object to deposition testimony shall **submit file and serve** a list of objections at least 5 days before the first case on the civil calendar is to be called for trial.

(E) Motions in Limine.

(2) Additional Documents for Jury Trials. In all jury trials, counsel shall file and serve the following documents in addition to the documents listed in LR 39.1(b)(1):

(A) Proposed Voir Dire Questions

(B) Proposed Jury Instructions.

**(i) In general.** Each proposed instruction shall be numbered and on a separate page and shall contain citation to legal authority.

**(ii) Patent cases.** In trials that involve one or more claims relating to patents, in which the parties have agreed to a particular set of model jury instructions as set out in LR 16.6(c), the parties shall additionally file and serve those of their instructions that pertain to the claims relating to patents in the form of specific additions to and/or deletions from those model jury instructions.

(C) Proposed Special Verdict Forms

(3) Additional Documents for Non-Jury Trials. In all non-jury trials, counsel shall file and serve proposed findings of fact and conclusions of law in addition to the documents listed in LR 39.1(b)(1).

(c) Failure to Comply. See LR 1.3 for sanctions for failure to comply with this rule.

**2005 Advisory Committee's Note to LR 39.1(b)(2)(B)(ii)**

*In general.* Paragraph (b)(2)(B)(ii) sets out a suggested practice in which the jury instructions of both parties relating to the scope, validity, enforcement, or unenforceability of patents is based on a single, common set of standard jury instructions. The handling of jury instructions has proven to require significant resources from both the parties and the Court. The instructions can be lengthy and detailed. In addition, the traditional process, by which the parties construct their proposed instructions in isolation from each other, presents inherent inefficiencies. It tends to cause the parties to suggest differing instructions even where they do not disagree over substance. In addition, it makes it difficult to identify the substantive points that the parties actually dispute. The problems are especially acute in cases relating to patents.

The suggestion in paragraph (b)(2)(B)(ii) addresses these problems by encouraging the parties to present their proposed suggestions as additions to or deletions from a common set of standard instructions. Under this practice, the instructions proposed by the parties will agree unless at least one party takes the affirmative step of proposing a modification of the standard language. Presumably this will occur only where the party considers the matter to be worth addressing. As a result, aspects of the instructions over which the parties do not disagree, and which the parties consider routine, will be proposed in unmodified form in such a manner as to make the lack of dispute clear. Accordingly, the areas of true disagreement will be plainly visible. In this way, the paragraph should reduce the time and cost, for both the parties and the Court, of attending to jury instructions.

Various other districts have promulgated local rules that require or encourage the parties' proposed instructions to be related to a common set of standard instructions. The suggestion in paragraph (b)(2)(B)(ii) is similar to the more lenient of these rules.

*Two-stage procedure; default standard instructions.* Paragraph (b)(2)(B)(ii) operates in connection with paragraph (c) of Local Rule 16.6. Under the two paragraphs, the parties are to consult regarding the selection of a particular set of pattern jury instructions as part of the final pretrial conference. The Rule contemplates that the parties will, in most cases, be able to agree on a particular set of pattern jury instructions. In the event that they are unable to agree, however, the parties should expect that the Court may, on its own initiative, impose a set of common instructions on them.

*Scope of requirement; included cases vs. included instructions.* The suggestion in paragraph (b)(2)(B)(ii), and the related requirement to confer under paragraph (c) of Local Rule 16.6, are intended to apply to cases relatively broadly. Cases that are included under the Rule are any that involve a claim or defense relating to patents. This includes, but is not limited to, cases that include claims for patent infringement and/or declarations for patent non-infringement or invalidity. It also includes cases in which the claims may not "arise under" the law of patents strictly, but in which the claim or defense draws upon or involves a patent more tangentially. Examples of this latter type of case include, for example, claims for breach of contract, where the contract terms at issue refer to patents or patentable subject matter, or claims for violation of antitrust law where the accused conduct involves the use of a patent or patent rights.

At the same time, the suggestion in paragraph (b)(2)(B)(ii) actually to submit instructions in terms of additions and/or deletions from a standard text is narrower. It applies only to those instructions, in an included case, that relate to the scope, validity, enforcement, or unenforceability of a patent. This is less than all the issues that may exist in an included case, and it is contemplated that, under the usual circumstances, only some of the instructions in an included case will be of the type that the Rule suggests be presented as additions and/or deletions. Instructions not included in the suggestion can be presented in any acceptable manner.

*Freedom to propose particular instructions; consistency with Fed. R. Civ. P. 51.* Under the practice suggested in paragraph (b)(2)(B)(ii), all parties retain the freedom to propose whatever instructions they choose. The practice does not restrict the substance of what the parties must propose; rather, it addresses only the form. The paragraph contemplates that parties who disagree with a particular standard instruction have the freedom to alter it if necessary to lay out the text of the instruction that they wish to propose. In this way, paragraph (b)(2)(B)(ii) is fully consistent with the parties' general freedom to present jury instructions, as set out for example in Fed. R. Civ. P. 51.

# Form 4

**FORM 4. RULE 26(f) REPORT (PATENT CASES)**

UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA

Name of Plaintiff )  
 )  
 )  
 )  
 ) CIVIL FILE NO. \_\_\_\_\_  
Plaintiff, )  
 )  
 )  
v. ) RULE 26(f) REPORT  
 ) (PATENT CASES)  
Name of Defendant )  
 )  
 )  
Defendant. )  
 )  
\_\_\_\_\_ )

The parties/counsel identified below participated in the meeting required by Fed. R. Civ. P. 26(f) and the Local Rules, on \_\_\_\_\_, and prepared the following recommended pretrial scheduling order.

The pretrial conference in this matter is scheduled for \_\_\_\_\_, before the United States Magistrate Judge \_\_\_\_\_ in Room \_\_\_\_\_, Federal Courts Building, \_\_\_\_\_, Minnesota. The parties [request/do not request] that the pretrial be held by telephone.

(a) Description of Case

- (1) Concise factual summary of Plaintiff's claims, including the patent number(s), date(s) of patent(s), and patentee(s);
- (2) Concise factual summary of Defendant's claims/defenses;
- (3) Statement of jurisdiction (including statutory citations);
- (4) Summary of factual stipulations or agreements;
- (5) Statement of whether jury trial has been timely demanded by any party.

(b) Pleadings

- (1) Statement of whether all process has been served, all pleadings filed and any plan for any party to amend pleadings or add additional parties to the action;
- (2) Proposed date by which all hearings on motions to amend and/or add parties to the action shall be heard;

Date: \_\_\_\_\_

(c) Discovery and Pleading of Additional Claims and Defenses

- (1) Discovery is permitted with respect to claims of willful infringement and defenses of patent invalidity or unenforceability not pleaded by a party, where the evidence needed to support these claims or defenses is in whole or in part in the hands of another party.
- (2) Once a party has given the necessary discovery, the opposing party may seek leave of Court to add claims or defenses for which it alleges, consistent with Fed. R. Civ. P. 11, that it has support, and such support shall be explained in the motion seeking leave. Leave shall be liberally given where prima facie support is present, provided that the party seeks leave as soon as reasonably possible following the opposing party providing the necessary discovery.

(d) Fact Discovery

The parties recommend that the Court establish the following fact discovery deadlines and limitations:

- (1) All pre-discovery disclosures required by Fed. R. Civ. P. 26(a)(1) shall be completed on or before \_\_\_\_\_.
- (2) Fact discovery shall be commenced in time to be completed by \_\_\_\_\_.
- (3) The parties agree and recommend that the Court limit the use and numbers of discovery procedures as follows:
  - (A) \_\_\_\_\_ interrogatories;
  - (B) \_\_\_\_\_ document requests;
  - (C) \_\_\_\_\_ factual depositions;
  - (D) \_\_\_\_\_ requests for admissions;
  - (E) \_\_\_\_\_ other.

(e) Expert Discovery

The parties anticipate that they will/will not require expert witnesses at time of trial.

- (1) The plaintiff anticipates calling \_\_\_\_\_ experts in the fields of:
- (2) The defendant anticipates calling \_\_\_\_\_ experts in the fields of:
- (3) By the close of fact discovery, the parties shall identify to the opposing party the experts who will provide a report that deals with the issues on which that party has the burden of persuasion.

Alternate recommended date: \_\_\_\_\_

- (4) Within 30 days after the close of fact discovery the parties shall exchange initial expert reports, which reports shall be in accordance with Fed. R. Civ. P. 26(a)(2)(B) ("Initial Expert Reports"). The Initial Expert Reports from each party shall deal with the issues on which that party has the burden of persuasion.

Alternate recommended date: \_\_\_\_\_

- (5) Within 30 days after the Initial Expert Reports are exchanged Rebuttal Expert Reports shall be exchanged. Rebuttal Expert Reports shall also be in accordance with Fed. R. Civ. P. 26(a)(2)(B).

Alternate recommended date: \_\_\_\_\_

- (6) Anything shown or told to a testifying expert relating to the issues on which he/she opines, or to the basis or grounds in support of or countering the opinion, is subject to discovery by the opposing party.

- (7) The parties shall agree that: (A) drafts of expert reports [will/will not] be retained and produced; and (B) inquiry [is/is not] permitted into whom, if anyone, other than the expert participated in the drafting of his/her report. As part of this agreement, the parties will not further address these questions to the Court. In the absence of such an agreement, drafts of expert reports need not be produced, but inquiry into who participated in the drafting and what their respective contributions were is permitted.

- (8) All expert discovery shall be completed by \_\_\_\_\_.

(f) Discovery Relating to Claim Construction Hearing

- (1) Deadline For Plaintiff's Claim Chart: \_\_\_\_\_.

Plaintiff's Claim Chart shall identify: (1) which claim(s) of its patent(s) it alleges are being infringed; (2) which specific products or methods of defendant's it

alleges literally infringe each claim; and (3) where each element of each claim listed in (1) is found in each product or method listed in (2), including the basis for each contention that the element is present. If there is a contention by Plaintiff that there is infringement of any claims under the doctrine of equivalents, Plaintiff shall separately indicate this on its Claim Chart and, in addition to the information required for literal infringement, Plaintiff shall also explain each function, way, and result that it contends are equivalent, and why it contends that any differences are not substantial.

- (2) Deadline For Defendant's Claim Chart: \_\_\_\_\_.

Defendant's Claim Chart shall indicate with specificity which elements on Plaintiff's Claim Chart it admits are present in its accused device or process, and which it contends are absent. In the latter regard, Defendant will set forth in detail the basis for its contention that the element is absent. As to the doctrine of equivalents, Defendant shall indicate on its chart its contentions concerning any differences in function, way, and result, and why any differences are substantial.

- (3) On or before \_\_\_\_\_, the parties shall simultaneously exchange a list of claim terms, phrases, or clause that each party contends should be construed by the Court. On or before \_\_\_\_\_, the parties shall meet and confer for the purpose of finalizing a list, narrowing or resolving differences, and facilitating the ultimate preparation of a joint claim construction statement. During the meet and confer process, the parties shall exchange their preliminary proposed construction of each claim term, phrase or clause which the parties collectively have identified for claim construction purposes.

At the same time the parties exchange their respective "preliminary claim construction" they shall also provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses that they contend support their respective claim constructions. The parties shall identify each such items of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, percipient or expert, the parties shall also provide a brief description of the substance of that witness' proposed testimony.

- (4) Following the parties' meet and confer described above, and no later than \_\_\_\_\_, the parties shall notify the Court as to whether they request that the Court schedule a Claim Construction hearing to determine claim interpretation. If any party believes there is no reason for a Claim Construction hearing, the party shall provide the reason to the Court.

At the same time, the parties shall also complete and file with the Court a joint claim construction statement that shall contain the following information:

- (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 of prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either in support of its proposed construction of the claim or to oppose any other party's proposed construction of the claim, including, but not limited, as permitted by law, dictionary definitions, citation to learned treatises and prior art, and testimony of percipient and expert witnesses;
  - (C) Whether any party proposes to call one or more witnesses, including experts at the Claim Construction hearing, the identity of each such witness and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert.
- (5) If the Court schedules a Claim Construction hearing, prior to the date of the Claim Construction hearing, the Court shall issue an Order discussing:
- (A) Whether it will receive extrinsic evidence, and if so, the particular evidence it will receive;
  - (B) Whether the extrinsic evidence in the form of testimony shall be the affidavits already filed, or in the form of live testimony from the affiants; and
  - (C) A briefing schedule.
- (g) Discovery Relating to Validity/Prior Art
- (1) Within \_\_\_\_\_ days of its receipt of Plaintiff's Claim Chart pursuant to Discovery Plan paragraph (1) Defendant shall serve on Plaintiff a list of all of the prior art on which it relies, and a complete and detailed explanation of what it alleges the prior art shows and how that prior art invalidates the claim(s) asserted by Plaintiff ("Defendant's Prior Art Statement").
  - (2) Within \_\_\_\_\_ days of its receipt of Defendant's Prior Art Statement Plaintiff shall serve on Defendant "Plaintiff's Prior Art Statement", in which it will state in detail its position on what the prior art relied upon by Defendant shows, if its interpretation differs from Defendant's, and its position on why the prior art does not invalidate the asserted patent claims.
  - (3) Plaintiff's and Defendant's "Prior Art Statements" can be, but need not be, in the form of expert reports.

(4) Defendant can add prior art to its original Statement only by leave of the Court.

(h) Other Discovery

- (1) Defendant may postpone the waiver of any applicable attorney-client privilege on topics relevant to claims of willful infringement, if any, until \_\_\_\_\_, provided that all relevant privileged documents are produced no later than \_\_\_\_\_. All additional discovery regarding the waiver will take place after \_\_\_\_\_ and shall be completed by \_\_\_\_\_.
- (2) The parties have met and discussed whether any discovery should be conducted in phases to reduce expenses or make discovery more effective and present the following joint or individual proposals:

(i) Discovery Definitions

In responding to discovery requests, each party shall construe broadly terms of art used in the patent field (e.g., “prior art”, “best mode”, “on sale”), and read them as requesting discovery relating to the issue as opposed to a particular definition of the term used. Compliance with this provision is not satisfied by the respondent including a specific definition of the term of art in its response, and limiting its response to that definition.

(j) Motion Schedule

- (1) The parties recommend that all non-dispositive motions be filed and served on or before the following dates:
  - (A) All motions that seek to amend the pleadings or add parties must be served by \_\_\_\_\_.
  - (B) All other non-dispositive motions and supporting documents, including those which relate to discovery, shall be served and filed by the discovery deadline date \_\_\_\_\_.
  - (C) All non-dispositive motions shall be scheduled, filed and served in compliance with the Local Rules.
- (2) The parties recommend that all dispositive motions be filed and served so they can be heard by the following dates:
  - (A) All dispositive motions shall be served and filed by the parties by \_\_\_\_\_.
  - (B) All dispositive motions shall be scheduled, filed and served in compliance with the Local Rules.

- (k) Trial-Ready Date
- (1) The parties agree that the case will be ready for trial on or after \_\_\_\_\_.
  - (2) A final pretrial conference should be held on or before \_\_\_\_\_.

- (l) Settlement
- (1) The parties will discuss settlement before \_\_\_\_\_, the date of the initial pretrial conference, by Plaintiff making a written demand for settlement and each Defendant making a written response/offer to Plaintiff's demand.
  - (2) The parties believe that a settlement conference is appropriate and should be scheduled by the Court before \_\_\_\_\_.
  - (3) The parties have discussed whether alternative dispute resolution will be helpful to the resolution of this case and recommend the following to the Court:

(m) Trial by Magistrate Judge

The parties have/have not agreed to consent to jurisdiction by the Magistrate Judge pursuant to Title 28, United States Code, Section 636(c). (If the parties agree, the consent should be filed with the Fed. R. Civ. P. 26(f) Report.)

(n) Tutorial Describing the Technology and Matters in Issue

If the parties believe that a tutorial for the Court would be helpful for the Court, the parties shall simultaneously submit a letter to the Court, asking whether the Court wishes to schedule a tutorial and proposing the timing and format of the tutorial.

(o) Patent Procedure Tutorial

The parties [agree/do not agree] the video "An Introduction to the Patent System", distributed by the Federal Judicial Center, should be shown to the jurors in connection with its preliminary jury instructions.

DATE: \_\_\_\_\_

Plaintiff's Counsel  
License #  
Address  
Phone #  
Email

DATE: \_\_\_\_\_

Defendant's Counsel

License #

Address

Phone #

Email

# Form 5

## **FORM 5. PROTECTIVE ORDER (PATENT CASES)**

### IN THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF MINNESOTA

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[NAME OF PARTY], ) Case No. \_\_\_\_\_  
                        )  
Plaintiff,           ) **PROTECTIVE ORDER**  
v.                     ) **(PATENT CASES)**  
[NAME OF PARTY],      )  
                        )  
Defendant.           ) \_\_\_\_\_  

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Upon request by the parties for an order pursuant to Fed. R. Civ. P. 26(c) that trade secret or other confidential information be disclosed only in designated ways,

**IT IS HEREBY ORDERED:**

1. As used in this Protective Order, these terms have the following meanings:

“Attorneys” means counsel of record;

“Confidential” documents are documents designated pursuant to paragraph 2;

“Confidential – Attorneys’ Eyes Only” documents are Confidential documents designated pursuant to paragraph 5;

“Documents” are all materials within the scope of Fed. R. Civ. P. 34;

“Written Assurance” means an executed document in the form attached as Exhibit A.

2. By identifying a document “Confidential”, a party may designate any document, including interrogatory responses, other discovery responses, or transcripts, that it in good faith contends to constitute or contain trade secret or other confidential information.

3. All Confidential documents, along with the information contained in the documents, shall be used solely for the purpose of this action, and no person receiving such

documents shall, directly or indirectly, transfer, disclose, or communicate in any way the contents of the documents to any person other than those specified in paragraph 4. Prohibited purposes include, but are not limited to, use for competitive or patent prosecution purposes.

4. Access to any Confidential document shall be limited to:

- (a) the Court and its officers;
- (b) attorneys and their office associates, legal assistants, and stenographic and clerical employees;
- (c) persons shown on the face of the document to have authored or received it;
- (d) court reporters retained to transcribe testimony;
- (e) these inside counsel: [names];
- (f) these employees of the parties: [names];
- (g) outside independent persons (i.e., persons not currently or formerly employed by, consulting with, or otherwise associated with any party) who are retained by a party or its attorneys to furnish technical or expert services and/or to give testimony in this action.

5. The parties shall have the right to further designate Confidential documents or portions of documents in the areas of [xxxxx] as “Confidential – Attorneys’ Eyes Only”. Disclosure of such information shall be limited to the persons designated in paragraphs 4(a), (b), (c), (d), (e), and (g).

6. Third parties producing documents in the course of this action may also designate documents as “Confidential” or “Confidential – Attorneys’ Eyes Only”, subject to the same protections and constraints as the parties to the action. A copy of this Protective Order shall be served along with any subpoena served in connection with this action.

7. Each person appropriately designated pursuant to paragraph 4(g) to receive Confidential information shall execute a “Written Assurance” in the form attached as Exhibit A. Opposing counsel shall be notified at least 10 days prior to disclosure to any such person of documents designated as “Confidential”. Such notice shall provide a reasonable description of the outside independent person to whom disclosure is sought sufficient to permit objection to be made. If a party objects in writing to such disclosure within 10 days after receipt of notice, no disclosure shall be made until the party seeking disclosure obtains the prior approval of the Court or the objecting party.

8. All depositions or portions of depositions taken in this action that contain trade secret or other confidential information may be designated “Confidential” or “Confidential – Attorneys’ Eyes Only” and thereby obtain the protections accorded other “Confidential” or “Confidential – Attorneys’ Eyes Only” documents. Confidentiality designations for depositions shall be made either on the record or by written notice to the other party within 10 days of receipt of the transcript. If not earlier designated, depositions shall be treated as “Confidential – Attorneys’ Eyes Only” during the 10-day period following receipt of the transcript. The deposition of any witness (or any portion of such deposition) that encompasses confidential information shall be taken only in the presence of persons who are qualified to have access to such information.

9. Any party who inadvertently fails to identify documents as “Confidential” or “Confidential – Attorneys’ Eyes Only” shall have 10 days from the discovery of its oversight to correct its failure. Such failure shall be corrected by providing written notice of the error and substituted copies of the inadvertently produced documents. Any party receiving such

inadvertently unmarked documents shall make reasonable efforts to retrieve documents distributed to persons not entitled to receive documents with the corrected designation.

10. If a party files a document containing Confidential information with the Court, it shall do so in compliance with the Electronic Case Filing Procedures for the District of Minnesota. Prior to disclosure at trial or a hearing of materials or information designated "Confidential" or "Confidential – Attorneys' Eyes Only", the parties may seek further protections against public disclosure from the Court.

11. Any party may request a change in the designation of any information designated "Confidential" and/or "Confidential – Attorneys' Eyes Only". Any such document shall be treated as designated until the change is completed. If the requested change in designation is not agreed to, the party seeking the change may move the Court for appropriate relief. The party asserting that the material is Confidential shall have the burden of proving that the information in question is within the scope of protection afforded by Fed. R. Civ. P. 26(c).

12. Within 60 days of the termination of this action, including any appeals, each party shall return to the opposing party all documents designated by the opposing party as "Confidential" or "Confidential – Attorneys' Eyes Only", and all copies of such documents, and shall destroy all extracts and/or data taken from such documents. A certification shall be forwarded as to such return and destruction as contemplated herein within the 30-day period. The parties' attorneys shall be entitled to retain, however, a set of all documents filed with the Court and all correspondence generated in connection with the action.

13. Any party may apply to the Court for a modification of this Protective Order, and nothing in this Protective Order shall be construed to prevent a party from seeking such further provisions enhancing or limiting confidentiality as may be appropriate.

14. No action taken in accordance with this Protective Order shall be construed as a waiver of any claim or defense in the action or of any position as to discoverability or admissibility of evidence.

15. The obligations imposed by this Protective Order shall survive the termination of this action. Within 60 days following the expiration of the last period for appeal from any order issued in connection with this action, the parties shall remove any materials designated "Confidential" or "Confidential – Attorneys' Eyes Only" from the office of the Clerk of Court. Following that 60-day period, the Clerk of Court shall destroy all "Confidential" and "Confidential – Attorneys' Eyes Only" materials.

Stipulated to:

Date: \_\_\_\_\_ By \_\_\_\_\_

Date: \_\_\_\_\_ By \_\_\_\_\_

IT IS SO ORDERED:

Date: \_\_\_\_\_  
United States Magistrate Judge

**EXHIBIT A**  
**WRITTEN ASSURANCE**

\_\_\_\_ declares that:

I reside at \_\_\_\_\_ in the city of \_\_\_\_\_,  
county \_\_\_\_\_, state of \_\_\_\_\_;

I am currently employed by \_\_\_\_\_ located at  
\_\_\_\_\_ and my current job title  
is \_\_\_\_\_.

I have read and believe I understand the terms of the Protective Order dated  
\_\_\_\_\_, filed in Civil Action No. xxxxxxxx, pending in the United  
States District Court for the District of Minnesota. I agree to comply with and be bound by the  
provisions of the Protective Order. I understand that any violation of the Protective Order may  
subject me to sanctions by the Court.

I shall not divulge any documents, or copies of documents, designated "Confidential" or  
"Confidential – Attorneys' Eyes Only" obtained pursuant to such Protective Order, or the  
contents of such documents, to any person other than those specifically authorized by the  
Protective Order. I shall not copy or use such documents except for the purposes of this action  
and pursuant to the terms of the Protective Order.

As soon as practical, but no later than 30 days after final termination of this action, I shall  
return to the attorney from whom I have received any documents in my possession designated  
"Confidential" or "Confidential – Attorneys' Eyes Only", and all copies, excerpts, summaries,  
notes, digests, abstracts, and indices relating to such documents.

I submit myself to the jurisdiction of the United States District Court for the District of Minnesota for the purpose of enforcing or otherwise providing relief relating to the Protective Order.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on \_\_\_\_\_

(Date)

\_\_\_\_\_ (Signature)