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LPR 1: GENERAL PROVISIONS

LPR 1.1. TITLE.

These are the Local Rules of Practice for Patent Cases before the United States District Court for the Northern District of Georgia. They may be cited as “Patent L.R. ___.”

LPR 1.2. PURPOSE, SCOPE AND CONSTRUCTION.

(a) These rules are intended to supplement the Civil Local Rules of this District to facilitate the speedy, fair and efficient resolution of patent disputes.

(b) These rules apply to all civil actions filed in or transferred to this Court 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.

(c) The Court may modify the obligations or deadlines set forth in these Patent Local Rules based on the circumstances of any particular case, by stipulation of all parties, on motion of a party or on the Court’s own motion. The parties shall meet and confer prior to filing any motion seeking a modification of the obligations or deadlines set forth in these Patent Local Rules. Such meeting shall take place prior to the filing of the Joint Preliminary Report and Discovery Plan, and any such motion shall be filed no later than the filing of the Joint Preliminary Report and Discovery Plan.

LPR 1.3. EFFECTIVE DATE.

These Patent Local Rules shall take effect on July 15, 2004 and shall apply to any case filed or transferred to this Court thereafter. Relevant provisions of these rules may be applied to any pending case by the Court, on its own motion or on motion by any party.

LPR 2: CONFIDENTIALITY OF COMMERCIAL OR TECHNICAL INFORMATION

LPR 2.1. Confidentiality Prior to Entry of Case Specific Protective Order.

(a) If any document or information produced is deemed confidential by the producing party and if the Court has not entered a protective order, until a protective order is issued by the Court, the document shall be marked “Confidential – Subject to Protective Order” by the disclosing party and disclosure of the confidential document or information shall be limited to each party’s outside attorney(s) of record and the employees of such outside attorney(s).

(b) If a party is not represented by an outside attorney, disclosure of the confidential document or information shall be limited to one designated “in house” attorney, whose identity and job functions shall be disclosed to the producing party five (5) court days prior to any such disclosure, in order to permit any motion for protective order or other relief regarding such disclosure.

(c) Pending entry of a protective order (by stipulation or on motion), all persons to whom disclosure of a confidential document or information is made under this local rule shall not disclose any such protected information to any person not entitled to have access to it. After entry of such an order, the limits on disclosure provided by such order shall apply to the disclosure of documents otherwise produced pursuant to this rule.

(d) Documents filed with the clerk containing or disclosing information protected by this rule shall be filed under seal with a notation that the pleading is not to be made available to members of the public.

(e) Nothing in this rule shall affect the burden of proof or persuasion imposed by law on a party seeking to limit or prevent disclosure or use of a document deemed confidential by that party.

LPR 2.2. Stipulated Protective Orders

(a) No later than the time for filing of the Joint Preliminary Report and Discovery Plan pursuant to Local Rule 16.2, the parties shall meet and confer to prepare a stipulated protective order to govern the production of commercially or technologically sensitive information in the case.

(b) Notwithstanding any provision in a protective order limiting the use of a document for purposes of a single lawsuit, the fact that an attorney or law firm has had access to a document covered by a protective order in one case shall not furnish a basis for disqualifying such lawyer in another case.

LPR 3: RELATIONSHIP TO GENERAL DISCOVERY PROCEDURES

LPR 3.1. Discovery Requests

a) These Rules do not excuse any party from responding to any proper discovery request made under the Federal Rules of Civil Procedure within the time required by such rules, except as follows:

- (1) Requests seeking to elicit a party's claim construction position;
- (2) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused technology;
- (3) Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art; and
- (4) 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.

(b) Disclosure of such information shall instead be made pursuant to these rules, absent stipulation of the parties or other order of the Court.

LPR 4: DISCLOSURE OF CONTENTIONS

LPR 4.1. INFRINGEMENT CONTENTIONS

(a) A party claiming patent infringement shall serve on all parties a Disclosure of Infringement Contentions at the time specified in these Rules. A separate Disclosure shall be made for each party accused of infringing a patent-in-suit.

(b) The Disclosure of Infringement Contentions shall contain the following information:

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

(2) Separately for each asserted claim, each accused apparatus, method, composition or other instrumentality (“Accused Instrumentality”) of each accused party of which the claiming party is aware. This identification shall be as specific as possible, with each apparatus identified by name or model number, if known, and each method identified by name, if known;

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

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

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

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

(1) Documents sufficient to evidence each instance of providing the claimed invention to a third party, by sale, offer to sell, or other manner of transfer, prior to the date of application for the patent in suit;

(2) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant in the Disclosure, whichever is earlier;

(3) A copy of the file history for each patent in suit; and

(4) A copy of all non-U.S. patents claiming a common priority with any patent asserted in the case, together with a copy of all prior art cited in such non-U.S. patent proceedings.

(d) 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.

LPR 4.2. RESPONSE TO INFRINGEMENT CONTENTIONS

(a) A party opposing a claim of infringement shall make the following **Response to Infringement Contentions** within the time period provided by these rules:

(1) The **Response to Infringement Contentions** shall include a chart responsive to the claims chart contained within the Disclosure of **Infringement Contentions**, and shall either acknowledge or deny whether each element of each asserted claim is found within each **Accused Instrumentality**;

(2) The **Response to Infringement Contentions** shall include a copy of source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation or composition of an **Accused Instrumentality** identified in the **Disclosure of Infringement Contentions** within the time period specified by these Rules.

LPR 4.3. INVALIDITY CONTENTIONS.

(a) Each party opposing a claim of patent infringement, and each party seeking a declaratory judgment of patent invalidity, shall serve on all parties its **Disclosure of Invalidity Contentions** at the time specified in these rules, which shall contain the following information:

(1) The **identity of each item of prior art** that allegedly anticipates each asserted claim or renders it obvious.

(i) **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.**

(ii) **Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) or entity(ies) from whom**

and the circumstances under which the invention or any part of it was derived.

(iii) Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entity(ies) involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

(2) For each item of prior art disclosed, whether each item of prior art anticipates each asserted claim or renders it obvious. If the disclosing party contends that a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, shall be identified.

(3) A chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found;

(4) Any grounds of invalidity based on any applicable provision of 35 U.S.C. § 112.

(b) The Disclosure shall include a copy of each item of prior art identified in the Disclosure comprising a printed publication if such item of prior art 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 shall be produced.

LPR 4.4. TIME FOR DISCLOSURES

(a) A plaintiff pleading infringement of a patent shall first make its Disclosure of Infringement Contentions within thirty (30) days after filing of the Joint Preliminary Report and Discovery Plan. A plaintiff seeking a declaratory judgment of patent invalidity or non-infringement shall likewise first make its Disclosure of Invalidity Contentions within thirty (30) days after filing of the Joint Preliminary Report and Discovery Plan.

(b) A defendant responding to a declaratory judgment action and pleading infringement of a patent in a counterclaim shall first make its Disclosure of Infringement Contentions within thirty (30) days after service of the plaintiff's Disclosure of Invalidity Contentions. A defendant opposing a claim of patent infringement shall first make its Disclosure of Invalidity Contentions and its Response to Infringement within thirty (30)

days after the plaintiff's Disclosure of Infringement Contentions.

(c) A plaintiff seeking a declaratory judgment of patent invalidity or non-infringement, and responding to a counter-claim of patent infringement, shall produce its Response to Infringement Contentions within twenty (20) days after the defendant's Disclosure of Infringement Contentions.

LPR 4.5. SUPPLEMENTING OR AMENDING CONTENTIONS.

(a) Disclosures and Responses shall have such binding effect on a party as a response to an interrogatory under Rule 33 of the Federal Rules of Civil Procedure.

(b) Each party's Disclosures or Response shall be supplemented or amended pursuant to the rules for supplementation and amendment of discovery responses generally provided for under the Federal Rules of Civil Procedure.

(c) In addition, any amendment or modification of the Disclosures or Responses which a party believes are required in light of a either a claim construction ruling by the Court or a modification of an opposing party's Disclosure or Response shall be made within thirty (30) days of service of such ruling, Disclosure or Response.

LPR 5: BIFURCATION AND WILLFUL INFRINGEMENT ISSUES

LPR 5.1. PRESUMPTION AGAINST BIFURCATION

There shall be a rebuttable presumption against the bifurcation of damages from liability issues in patent cases for purposes of either discovery or trial.

LPR 5.2. DISCOVERY OF THE SUBSTANCE OF OPINIONS OF COUNSEL

(a) The substance of any advice of counsel tendered in defense to a charge of willful infringement, and any other information which might be deemed to be within the scope of a waiver attendant to disclosure of such advice, shall not be discoverable until the earlier of:

(1) five (5) days after a ruling on summary judgment indicating a

triable issue of fact to which willfulness would be relevant; or

(2) thirty (30) days prior to the close of fact discovery under the discovery track to which the case is assigned.

(b) On the day such willfulness information becomes discoverable, the party relying on such advice shall produce the following:

(1) a copy of all written opinions to be relied on by the party opposing the claim of infringement;

(2) a copy of all materials or information provided to the attorney in connection with the advice;

(3) a copy of all written attorney-work product developed in the course of preparation of the opinion and which work product was disclosed to the client;

(4) identification of the date, sender and recipient (but not necessarily the substance) of all written or oral communications between the attorney or law firm rendering any opinions to be relied on, which communications discuss the same subject matter as such opinion.

(c) After such willfulness information becomes discoverable, a party claiming willful infringement shall be entitled to take the deposition of any attorneys rendering the advice relied on and any persons who received such advice, including but not limited to any person who claims to have relied on such advice.

(d) These rules contain no presumption as to whether any materials other than those specifically required to be produced by this rule are, in fact, discoverable or subject to the scope of the waiver of any attorney client privilege. Resolution of any dispute over disclosure of further material shall be left to the Court.

LPR 5.3. NO DISQUALIFICATION

(a) An individual lawyer who rendered an opinion tendered in defense of a charge of willful infringement should not, absent express permission from the Court, examine witnesses or otherwise appear as an advocate in

front of a jury where the jury will be determining the question of willful infringement.

(b) An individual lawyer involved in the prosecution of a patent-in-suit and whose conduct in connection with such prosecution is to be determined by the trier of fact should not, absent express permission from the Court, examine witnesses or otherwise appear as an advocate in front of the trier of fact where the trier of fact will make any determination of the question of inequitable conduct with respect to that patent-in-suit.

(c) No other disqualification or limitation on the participation of an individual lawyer should be required solely based on the fact that the lawyer rendered an opinion tendered in defense of a charge of willful infringement or the fact that there is a claim of inequitable conduct with regard to a patent in which the lawyer was involved in the prosecution of the particular patent-in-suit *unless* the party moving for disqualification or limitation of participation shall demonstrate a basis for such under the Georgia Rules of Professional Conduct or applicable case authority, or shall otherwise show good cause for such disqualification or limitation of participation.

(d) With regard to motions made pursuant to (c), counsel shall not be disqualified or limited from participation in the case, pursuant to these rules, prior to a ruling on such a motion.

LPR 6: CLAIM CONSTRUCTION PROCEEDINGS

LPR 6.1. EXCHANGE OF PROPOSED TERMS

(a) Not later than ninety (90) days after filing of the Joint Preliminary Report and Discovery Plan, 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.

LPR 6.2. EXCHANGE OF PRELIMINARY CONSTRUCTIONS

(a) Not later than twenty (20) days after the exchange of Proposed Terms, for Construction, the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which any party has 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) in the specification 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 percipient and expert witnesses intended to support the 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. 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.

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

LPR 6.3. JOINT CLAIM CONSTRUCTION STATEMENT

(a) Not later than one hundred and thirty (130) days after the filing of the Joint Preliminary Report and Discovery Plan, the parties shall complete and file a Joint Claim Construction Statement,

(b) The Joint Claim Construction Statement shall contain the following information:

- (1) The construction of those claim terms, phrases, or clauses on which the parties agree;
- (2) 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;
- (3) The anticipated length of time necessary for the Claim Construction Hearing;
- (4) 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. No other Rule 26 report or disclosure shall be required for testimony directed solely towards claim construction.

**LPR 6.4. COMPLETION OF CLAIM CONSTRUCTION
DISCOVERY**

(a) No later than fifteen (15) days after service and filing of the Joint Claim Construction Statement, the parties shall complete all discovery relating to claim construction, including any depositions with respect to claim construction of any witnesses, including experts, identified in the Joint Claim Construction Statement.

(b) Discovery from an individual on claim construction issues shall not prevent a prior or subsequent deposition of the same individual on other issues.

LPR 6.5. CLAIM CONSTRUCTION BRIEFS

(a) Not later than thirty (30) days after serving and filing the Joint Claim Construction Statement, each party shall serve and file an opening brief and any evidence supporting its claim construction.

(b) Not later than twenty (20) days after service upon it of an opening brief, each party shall serve and file its responsive brief and supporting evidence.

LPR 6.6. CLAIM CONSTRUCTION HEARING

Subject to the convenience of the Court's calendar, the Court shall conduct a Claim Construction Hearing to the extent the Court believe a hearing is necessary for construction of the claims at issue.

LPR 6.7. DISCOVERY AFTER CLAIM CONSTRUCTION

If at the time the Court issues its claim construction ruling, there are fewer than thirty (30) days left for discovery pursuant to the discovery track to which the case was assigned pursuant to the Local Rules, the parties shall have an additional forty-five (45) days in which to take discovery after the Court files and serves its claim construction ruling.

LPR 7: EXPERT WITNESSES

LPR 7.1. DISCLOSURE OF EXPERTS AND EXPERT REPORTS

(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) No later than thirty (30) days after (1) the normal close of discovery pursuant to the discovery track to which the case was assigned, or (2) the close of discovery after claim construction, which ever is later, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which each bears the burden of proof;

(c) No later than thirty (30) days after the first round of disclosures, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which the opposing party bears the burden of proof;

(d) No later than ten (10) days after the second round of disclosures, each party shall make any rebuttal expert witness disclosures permitted by Rule 26.

LPR 7.2. DEPOSITIONS OF EXPERTS

Depositions of expert witnesses disclosed under this Rule shall commence within seven (7) days of the deadline service of rebuttal reports and shall be completed within thirty (30) days after commencement of the deposition period. If the party taking the deposition agrees to pay the reasonable travel expenses of the expert, and absent good cause otherwise shown, the party designating the expert shall make its expert witness available for deposition in this District.

LPR 7.3. PRESUMPTION AGAINST SUPPLEMENTATION OR AMENDMENT

Because of the complexity of the issues often present in patent cases, amendments or supplementation to expert reports after the deadlines provided here are presumptively prejudicial and shall not be allowed unless (a) the tendering party shows cause that the amendment or supplementation could not reasonably have been made earlier and (b) all reasonable steps are made to ameliorate the prejudice to the responding party.

