

IP Litigation News

New Patent Rules Effective for Northern District of Illinois

Effective immediately, the U.S. District Court for the Northern District of Illinois, with one of the busiest patent dockets in the country, enacted Local Patent Rules (LPR) for all patent cases pending or brought in the district. The court, in its rules, notes that each judge has discretion to apply all or part of the LPR to any such case pending prior to October 1, 2009. The intent of the rules is to provide greater predictability and planning for the court and the litigants. A copy of the Local Patent Rules is available at www.ilnd.uscourts.gov.

While the rules have similarities to other jurisdictions' local patent rules, there are some portions of the LPR that are worth highlighting:

Standardized Protective Order

A standardized protective order is deemed to be in effect upon the initiation of the lawsuit. The standardized protective order is included in the new rules as Appendix B.

The standardized protective order includes two layers of confidentiality: (a) confidential and (b) highly confidential. Confidential information may be provided to a receiving party's (i) outside counsel, (ii) in house counsel, (iii) officers and employees involved in a case whose access is reasonably required to supervise, manage or participate in the litigation and (iv) stenographers. Highly confidential information may be disclosed only to (i) outside counsel, (ii) stenographers and, after time for objections and pursuant to a signed undertaking, (iii) retained experts.

It is important to note that the standardized protective order may be modified by the parties; however, any negotiations entered into to modify will not form a basis to delay the disclosure and discovery schedule.

Initial Disclosures

Parties must exchange their initial disclosures within 14 days after the last responsive pleading to claims or counterclaims by the parties have been served.

A party asserting a claim of infringement, in addition to the requirements under F.R.C.P. 26(a)(1), shall produce or make available for inspection and copying the following in its initial disclosures:

- (a) all documents concerning any disclosure, sale or transfer, or offer to sell or transfer, of any item practicing or resulting from the practice of the claimed invention prior to the date of the application for the patent in suit.

- (b) all documents concerning conception, reduction to practice, design and development of each claimed invention created before the patent application filing or other priority date.
- (c) all documents concerning communication to and from the PTO for each patent in suit and for each patent to which a claim of priority is made.
- (d) all documents regarding ownership of the patent.

A defending party's obligation with respect to initial disclosure includes producing or making available for inspection and copying:

- (a) documents sufficient to show the operation and construction of all aspects or elements of each accused product that has been identified with specificity in the pleading of the party asserting patent infringement.
- (b) A copy of each piece of prior art of which the party is aware that allegedly anticipates or renders obvious each asserted patent claim.

Important note:

- (1) Producing party *must* identify by production number which documents correspond to each category.

Initial Infringement Contentions

Due 14 days after the date for initial disclosures and must include:

- (a) identification of each claim infringed and the statutory bases for infringement under 35 U.S.C. § 271.
- (b) for each asserted claim, identification of each accused apparatus/product/method ("accused instrumentality") of which party is aware.
- (c) a chart identifying specifically where each element of each asserted claim is found within each accused instrumentality, including elements covered under 35 U.S.C. § 112(6), a description of the claimed function and the identity of the structure in the accused instrumentality that performs the claimed function.
- (d) identification of whether each element is found in each accused instrumentality whether literally or under the doctrine of equivalents. For doctrine of equivalents, party must include explanation of each function, way and result that is equivalent and why any differences are not substantial.
- (e) for each alleged indirect infringement, party is required to identify any act of direct infringement and a description of indirect infringement acts that contribute or direct infringement.
- (f) priority date to which each asserted claim allegedly is entitled.

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- (g) basis for any allegation of willful infringement.
 - (h) if intended to be relied on in any manner, an identification of each apparatus/product/method that patent owner alleges practices the claimed invention, and whether the product is marked with the patent number.

Initial Non-infringement, Unenforceability and Invalidity Contentions

Non-infringement, unenforceability and invalidity contentions are due 14 days after service of Initial Infringement Contentions and must include:

- (a) A chart responsive to the chart provided in the Initial Infringement Contentions (Rule 2.2(c)), including the reason for any denial and any relevant distinctions.
- (b) With respect to invalidity:
 - (1) identification of each item of prior art that anticipates each asserted claim or renders it obvious. The rule requires a specific and detailed identification for each prior art item under 35 U.S.C. § 102 that is being relied upon.
 - (2) a statement whether each prior art item anticipates or renders obvious the asserted claim, including an identification of each combination of prior art and the reasons to combine.
 - (3) a chart identifying in each prior art item where each element of an asserted claim is found and for 35 U.S.C. § 112(6), a description of the claimed functions and the structure that performs the function.
 - (4) a detailed statement of the basis for indefiniteness, non-enablement, or a defect in the written description under 35 U.S.C. § 112(1), (2).
- (c) Identification of all acts supporting bases for unenforceability.

The party claiming infringement must respond within 14 days after service of the initial non infringement and invalidity contention by providing a chart responsive to the chart produced in LPR 2.3(b)(3), demonstrating whether the party admits to the identity of elements in the prior art and, if not, the reason for such denial.

Final Contentions

Within 21 weeks after service of Initial Infringement Contentions, the party asserting infringement must serve its Final Infringement Contentions containing the information required in Rule 2.2(a)–(h). Similarly, the party asserting invalidity or unenforceability must also serve its final unenforceability and invalidity contentions containing the information required in 2.3(b), (c).

Within 28 days after service of the Final Infringement Contentions, the party asserting non-infringement must serve its final non-infringement contentions. Similarly, and at the same time, the party asserting

infringement shall serve its final contentions in response to the final unenforceability and invalidity contentions.

Important Note: Final Contentions, once served, may be amended only by order of the court upon a showing of good cause and absence of unfair prejudice to opposing party. The rules provide as an example of good cause the fact that the court may construe the claims at issue differently from that proposed by the party seeking amendment.

No party may file a stay pending reexamination after service of the Final Contentions.

Opinion of Counsel

Reliance on advice of counsel in response to charge of willful infringement is not subject to discovery until 35 days prior to the close of fact discovery.

Claim Construction Timing

- (a) Within 14 days after Final Invalidity Contentions, each party shall serve on the other a detailed list of claim terms, proposed construction, identification of any § 112(6) claim terms and the function and structure thereof.
- (b) Seven days after the exchange of claim terms, the parties must meet and confer and agree upon no more than 10 claim terms to be construed by the court. For each claim term to be presented for construction, the parties must certify whether it is outcome-determinative.
- (c) *Briefs: Party opposing infringement* must file its opening brief 35 days after the exchange of claim terms. Citations to intrinsic evidence, including the patents at issue and the prosecution history, must be to a joint appendix containing the patents and file histories. 25-page limit.

The brief of the party asserting infringement is due 28 days later. 25 pages.

Party opposing infringement shall file a reply brief 14 days after the party asserting infringement files its responsive brief. 15 pages.

Hearing within 28 days after reply brief is served.

United States District Court for the Northern District of Illinois Patent Case Schedule

<u>Event</u>	<u>Scheduled Time</u>	<u>Total Time After Complaint</u>
Service of Complaint		
Answer or Other Response to Complaint		7 weeks
Initial Disclosures of Both Parties (LPR 2.1)	14 days After Answer or other Responsive Pleading	9 weeks
Initial Infringement Contentions (LPR 2.2)	14 days After Initial Disclosures	11 weeks
Initial Non-infringement and Invalidity Contentions (LPR 2.3)	14 days After Infringement Contentions	13 weeks
Initial Response to Invalidity Contentions (LPR 2.5)	14 days After Invalidity Contentions	15 weeks
Final Infringement Contentions and Final Unenforceability and Invalidity Contentions (LPR 3.1)	21 weeks After Initial Infringement Contentions	32 weeks
Final Non-infringement Contentions and Final Contentions in Response to Final Unenforceability and Invalidity Contentions (LPR 3.2)	28 days After Plaintiff's Final Infringement Contentions	36 weeks
Exchange of Claim Terms Needing Construction (LPR 4.1)	14 days After Final Invalidity Contentions	38 weeks
Opening Claim Construction Brief (LPR 4.2(a))	35 days After Exchange of Claims Terms	43 weeks
Responsive Claim Construction Brief (LPR 4.2(c))	28 days After Plaintiff's Claim Construction Brief	47 weeks
Reply Claim Construction Brief (LPR 4.2(d))	14 days After Responsive Construction Briefs	49 weeks
Joint Claim Construction Chart (LPR 4.2(e))	7 days After Reply Claim Construction Briefs	50 weeks
Claim Construction Hearing (LPR 4.3)	28 days After Reply Claim Construction Brief	53 weeks
Claim Construction Ruling	Approximately six weeks	59 weeks
Close of Fact Discovery After Claim Construction Ruling	42 days After Claim Construction Ruling	65 weeks
Expert Reports of Parties with Burden of Proof (LPR 5.1(b))	21 days After close of discovery after the Claim Construction Ruling	68 weeks
Rebuttal Expert Reports (LPR 5.1)	35 days After Initial Expert Reports	73 weeks
Completion of Expert Witness Depositions (LPR 5.2)	35 days After Rebuttal Expert Reports	78 weeks
Final Day for Filing Dispositive Motions (LPR 6.1)	28 days After Close of All Discovery	82 weeks
Case Ready for Trial	20 weeks After Filing Dispositive Motions	102 weeks

Key Time Intervals:

To Final Infringement
Contentions: 7.5 months

To Claim Construction
Hearing: 12 months

To Summary Judgment
Motions: 19 months

To Trial: 23 months

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Intellectual Property Litigation Group

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