

Pilot Program Implementing Proposed Local Patent Rules

On April 2, 2014 the United States District Court for the District of Colorado approved the following Pilot Program Implementing Proposed Local Patent Rules subject to public notice and comment. The period of public comment shall be thirty (30) days from the date of the public notice.

The purpose of the pilot program is to facilitate the efficient management of patent cases.

Under D.C.COLO.LCivR 1.1(h)(2), the term of the pilot program is not more than one year from the date of formal approval by the court, which term may be extended for one six-month period in conjunction with the promulgation of corresponding local rules.

The following local civil rules may be affected by the pilot program:

D.C.COLO.LCivR 7.1
D.C.COLO.LCivR 16.1
D.C.COLO.LCivR 16.2
D.C.COLO.LCivR 16.3
D.C.COLO.LCivR 26.1

PROPOSED LOCAL PATENT RULES

D.C.COLO.LPtR 1

SCOPE OF THE LOCAL RULES

- (a) Title and Citation.** Under the pilot program, these rules shall be known as the Local Rules of Practice of the United States District Court for the District of Colorado - Patent Rules. These rules shall be cited as D.C.COLO.LPtR Rule, Section, and Subsection (e.g., D.C.COLO.LPtR 3(a)).
- (b) Effective Date.** The pilot program shall become effective on approval by the Court.

- (c) **Scope and Applicability.** These rules apply to patent infringement, invalidity and unenforceability actions. A judicial officer may modify the obligations or deadlines set forth in these rules based on the circumstances of any particular case, including, without limitation, the nature of relief sought and/or the simplicity or complexity of the case as shown by the patents, claims, technology, products, or parties involved.
- (d) **Applicability of Local Civil Rules.** Except where inconsistent with these rules, the Local Rules of Practice of the United States District Court for the District of Colorado – Civil apply.
- (e) **Forms.** Forms are subject to modification without notice.

D.C.COLO.LPtR 2 INITIAL SCHEDULING CONFERENCE

Lead counsel for the parties shall participate in the conference under Fed. R. Civ. P. 26(f). The parties shall prepare and submit a proposed Patent Scheduling Order in the form [\(HERE\)](#).

D.C.COLO.LPtR 3 DISCOVERY OBJECTION; PRESERVING CONFIDENTIALITY; ENTRY OF PROTECTIVE ORDER

- (a) **Premature Discovery Objection.** A party may object to a request for discovery seeking information or documents in advance of the deadline in the Patent Scheduling Order for disclosure of such information or documents.
- (b) **Confidentiality.** The parties shall not delay making disclosures under Fed. R. Civ. P. 26(a) on the grounds of confidentiality. The parties shall not delay responding to discovery on the grounds of confidentiality. The producing party may designate a discovery response as “confidential” or use another confidential designation such as “outside attorneys’ eyes only”. Disclosure of a confidential document or information by the receiving party shall be limited by the designation of confidentiality.
- (c) **Protective Order.** No later than ten (10) days prior to the Rule 16 Scheduling Conference: (1) the parties shall submit an agreed proposed protective order; or (2) if they cannot agree, each party shall submit a separate proposed protective order which specifically identifies the provisions on which the parties agree and disagree. Each party simultaneously may submit a brief of no more than two (2) pages in support of its proposed protective order.

D.C.COLO.LPtR 4

DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS

- (a) **Infringement Contentions.** By the date specified in the Patent Scheduling Order, a party claiming patent infringement shall serve Infringement Contentions identifying with specificity each accused product or process (the "Accused Instrumentality").
- (b) **Claim Chart.** A party who serves Infringement Contentions also shall serve a claim chart for each Accused Instrumentality. If two or more Accused Instrumentalities have the same relevant characteristics, they may be grouped together in one claim chart. The claim chart(s) shall be specific and shall contain the following information:
- (1) Identification of each claim of each patent in suit that is allegedly infringed by the Accused Instrumentality;
 - (2) Identification of the specific location of each limitation of the claim within each Accused Instrumentality, including for each limitation that the party contends is governed by 35 U.S.C. §112(f), the identity of the structures, acts, or materials in the Accused Instrumentality that perform the claimed function;
 - (3) A statement of whether each limitation of each asserted claim is literally present in the Accused Instrumentality or present under the doctrine of equivalents; and,
 - (4) If an allegation of direct infringement is based on acts of multiple parties, a description of the role of each such party in the direct infringement.

D.C.COLO.LPtR 5

DOCUMENT PRODUCTION ACCOMPANYING INFRINGEMENT CONTENTIONS

Contemporaneously with service of the Infringement Contentions, the party claiming patent infringement shall produce to each party (or make available for inspection and copying) the following documents and identify by production number which documents correspond to each category:

- (a) All documents demonstrating each disclosure, sale (or offer to sell), or any public use, of the claimed invention before the application date or the priority date (whichever is earlier) for each patent in suit;
- (b) All documents created on or before the application date or the priority date (whichever is earlier) for each patent in suit that demonstrate each claimed invention's conception and earliest reduction to practice;
- (c) A copy of the patent(s) in suit and all communications with the United States Patent and Trademark Office regarding the patent(s) in suit and any related application(s); and
- (d) All documents demonstrating ownership of the patent rights by the party claiming patent infringement.

**D.C.COLO.LPtR 6
RESPONSE TO INFRINGEMENT CONTENTIONS**

By the date specified in the Patent Scheduling Order, a party opposing a claim of patent infringement shall serve its Response to Infringement Contentions, which shall be specific and include the following:

- (a) A clear identification of each limitation of each asserted claim alleged not to be present in the Accused Instrumentality;
- (b) A detailed description of the factual and legal grounds for each limitation identified in subdivision (a); and
- (c) To the extent that the Response to Infringement Contentions is based on claim interpretation, identification of any relevant claim term.

**D.C.COLO.LPtR 7
DOCUMENT PRODUCTION ACCOMPANYING RESPONSE
TO INFRINGEMENT CONTENTIONS**

Contemporaneously with service of the Response to Infringement Contentions, a party opposing a claim of patent infringement shall produce to each party (or make available for inspection or copying) the following:

- (a) All documents sufficient to show the operation of any aspect or elements of an Accused Instrumentality identified by the party claiming patent infringement in its Infringement Contentions under D.C.COLO.LPtR 4; and

- (b) If relevant, source code, specifications, schematics, flow charts, artwork, formulas, and any other description of the operation of the Accused Instrumentality.

D.C.COLO.LPtR 8 INVALIDITY CONTENTIONS

- (a) **Invalidity Contentions.** By the date specified in the Patent Scheduling Order, a party opposing a claim of patent infringement shall serve its Invalidity Contentions, if any.
- (b) **Claim Chart.** The Invalidity Contentions shall include a chart (or charts) identifying each allegedly invalid claim, and each item of prior art that anticipates or renders each claim obvious, including the specific location in the items of prior art of each limitation of each asserted claim. Claim charts shall be specific and contain the following information:
 - (1) An explanation, including the relevant statutory language, of how the item qualifies as prior art;
 - (2) If anticipation is alleged, identification of each item of prior art and an explanation of how it anticipates the asserted claim;
 - (3) If obviousness is alleged, identification of each item of prior art or combination of items of prior art, and, separately for each item of prior art or combination of items of prior art, an explanation of how the item or combination of items renders the asserted claims obvious; and
 - (4) A statement explaining any other grounds of invalidity of any asserted claims.

D.C.COLO.LPtR 9 PRODUCTION OF PRIOR ART WITH INVALIDITY CONTENTIONS

Contemporaneously with service of the Invalidity Contentions, a party opposing a claim of patent infringement shall produce to each party (or make available for inspection and copying) a copy of each item of prior art identified under D.C.COLO.LPtR 8 which does not appear in the file history of any patent at issue. If an item of prior art is not in English, an English translation shall be provided.

D.C.COLO.LPtR 10
RESPONSE TO INVALIDITY CONTENTIONS

- (a) **Response to Invalidity Contentions.** By the date specified in the Patent Scheduling Order, a party claiming patent infringement shall serve a Response to Invalidity Contentions.
- (b) **Claim Chart.** The Response to Invalidity Contentions shall include a chart or charts which respond to the corresponding Invalidity Contentions. A claim chart shall be specific and contain the following information:
- (1) For each item of asserted prior art, identification of each limitation of a claim that the party believes is absent from the prior art.
 - (2) If the Response is based on claim interpretation, identification of the relevant claim term; and
 - (3) If obviousness is alleged, an explanation of why the prior art does not render the asserted claim obvious.
- (c) **Information for Design Patents.** For design patents, a party shall explain why the prior art does not anticipate the claim.

D.C.COLO.LPtR 11
DOCUMENTS ACCOMPANYING RESPONSE TO INVALIDITY CONTENTIONS

Contemporaneously with service of the Response to Invalidity Contentions, a party claiming patent infringement shall produce to each party (or make available for inspection and copying) any document, electronically stored information, or thing supporting the Response.

D.C.COLO.LPtR 12
**DISCLOSURE REQUIREMENT IN PATENT CASES SEEKING
DECLARATORY JUDGMENT**

If a party files a pleading seeking a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable and the responsive pleading does not include a claim for patent infringement, then D.C.COLO.LPtR 4 shall not apply. If a party does not assert a claim for patent infringement in its answer to the pleading requesting declaratory judgment, then the party seeking a declaratory judgment shall proceed under D.C.COLO.LPtR 8 by the date specified in the Patent Scheduling Order.

D.C.COLO.LPtR 13
OPINION OF COUNSEL

- (a) **Production of Opinion.** By the date specified in the Patent Scheduling Order, a party relying on an opinion of counsel to defend a claim of willful infringement or inducement of infringement or to assert that a case is exceptional shall disclose the identity of counsel and produce (or make available for inspection and copying) the written opinion and any document containing the facts and data considered by counsel in forming the opinion.
- (b) **Privilege Log.** A party relying on an opinion of counsel shall serve a privilege log complying with Fed. R. Civ. P. 26 (b)(5)(A).

D.C.COLO.LPtR 14
JOINT CLAIM TERMS CHART

By the date specified in the Patent Scheduling Order, the parties shall file a Joint Disputed Claim Terms Chart identifying the disputed claim terms and phrases and each party's proposed construction with citations to supporting intrinsic and extrinsic evidence.

D.C.COLO.LPtR 15
CLAIM CONSTRUCTION BRIEFING

Unless otherwise ordered, by the date specified in the Patent Scheduling Order:

- (a) A party opposing a claim of patent infringement and/or asserting invalidity (if there is no infringement issue in the case) shall file an opening claim construction brief which shall include all supporting evidence;
- (b) An opposing party shall file a response which shall include all supporting evidence;
- (c) A party filing an opening claim construction brief may file a reply; and
- (d) Contemporaneously with the completion of claim construction briefing, the parties shall file a "Joint Motion for Determination."

D.C.COLO.LPtR 16
FINAL PATENT CONTENTION DISCLOSURES

- (a) **Final Infringement Contentions.**

- (1) **Due Date.** No later than 28 days after the claim construction order is filed, a party asserting infringement shall serve its Final Infringement Contentions.
 - (2) **Contents.** Unless otherwise ordered, a party shall not assert at trial an infringement contention not contained in its Final Infringement Contentions.
 - (3) **Amendments.** Final Infringement Contentions shall not identify additional accused products or processes not contained in the preliminary infringement contentions without good cause (e.g., discovery of previously undiscovered information or an unanticipated claim-construction ruling). The party asserting infringement shall include a separate statement of good cause for any amendment.
 - (4) **Exclusion.** Accused infringers may seek to exclude an amendment to Final Infringement Contentions on grounds that good cause does not exist.
 - (5) **Due Date for a Motion to Exclude.** A motion to exclude shall be filed no later than 14 days after service of the Final Infringement Contentions.
 - (6) **Failure to Object.** Any unopposed amendment to the Final Infringement Contentions shall be included.
- (b) **Final Invalidity Contentions.**
- (1) **Due Date.** No later than 21 days after service of the Final Infringement Contentions, each accused infringer shall serve its Final Invalidity Contentions.
 - (2) **Contents.** Final Invalidity Contentions shall include a party's final statement of all contentions. A party shall not assert at trial any invalidity contention not contained in its Final Invalidity Contentions.
 - (3) **Amendments.** If the Final Invalidity Contentions identify additional prior art, the amendment shall be supported by good cause (e.g., discovery of previously undiscovered information or an unanticipated claim-construction ruling) and an accused infringer shall include a separate statement of good cause for any amendment.

- (4) **Exclusion.** A party asserting infringement may seek to exclude an amendment to the Final Invalidity Contentions on grounds that good cause does not exist.
- (5) **Due Date for a Motion to Exclude.** A motion to exclude shall be filed no later than 14 days after service of the Final Invalidity Contentions.
- (6) **Failure to Object.** Any unopposed amendment to the Final Invalidity Contentions shall be included.

D.C.COLO.LPtR 17

WORD LIMITS; CERTIFICATE OF COMPLIANCE

Unless otherwise ordered:

- (a) A claim construction brief or brief on a dispositive motion shall not exceed 10,000 words, double spaced, in Arial 12 point font.
- (b) If a party files a supporting brief and a reply brief, the two briefs together shall not exceed 10,000 words, double spaced, in Arial 12 point font.
- (c) Each brief shall include a Certificate of Compliance stating the number of words in the brief.