

United States Court of Federal Claims

717 MADISON PLACE, N.W.


WASHINGTON, D.C. 20439

CHAMBERS OF
JUDGE SUSAN G. BRADEN
(202) 357-6516
FAX: (202) 357-6522
susan_braden@ao.uscourts.gov

MEMORANDUM

April 26, 2016

TO: Chief Judge Patricia E. Campbell-Smith
Ms. Sarah Wilson, Esq., Covington & Burling
Members of the Advisory Council

FROM: Judge Susan G. Braden 

CC: Judge Nancy B. Firestone
Ms. Meredith Miller
Ms. Sophie L. Fortin

SUBJECT: Report of the United States Court of Federal Claims Advisory Council,
Intellectual Property Committee For May 2, 2016 Meeting

The following are members of the Committee:

John Fargo, United States Department of Justice
Professor Peter Menell, Berkeley Center of Law & Technology (not participating today)
Professor Lateef Mtima, Howard University School of Law
Michael Saywer, Covington & Burling
James Schaefer, Skadden, Arps, Slate, Meagher & Flom, Palo Alto, California
Andy Schwentker, Fish & Richardson
Stefani Vande Lune, Kirkland & Ellis

The IP Committee has accomplished the following tasks since our November 13, 2015 Report:

1. We gathered all of the rules implemented by the current pilot patent courts and other district courts with significant patent dockets. A first draft of proposed patent rules for our court was circulated to the Committee. The attached draft reflects initial comments from John Fargo. The IP Committee will continue to revise this draft over the summer so that they can be submitted to the Advisory Council and the court's Rules Committee in the fall. TAB A.
2. Professor Menell has been working with the Federal Judicial Center to finalize the next edition of Patent Case Management Judicial Guide that will include a section on the CFC.
3. We referred two additional *pro se* patent cases that have been referred to the CFC Bar Association *pro se* referral program.
4. Other outreach:

On January 21, 2016, I chaired a Giles Rich Inn of Court program with Roderick McKelvie, Covington & Burling, Professor Steve Salop, Georgetown Law School, and Patrick Coyne, Finnegan Henderson. The topic was "Non-Price Predation And Patent Litigation—The Elephant In The Court Room."

On February 4, 2016, I participated on a panel at the University of Pennsylvania School of Law with Judge Anthony J. Scirica of the Third Circuit.

On March 4, 2016, I participated in a panel discussion with Chief Judge Prost of the Federal Circuit, Carter Phillips of Sidley & Austin, and Don Dunner, Finnegan Henderson in the 12th Annual Institute for Intellectual Property and Social Justice at Howard Law School.

On March 11, 2016, I participated in a panel discussion with former Chief Judge Paul Michel, Judge Thomas B. Pender of the U.S. International Trade Commission, James Adducci, Adduci, Mastriani & Schamberg, and Elizabeth Weiswasser, Weil, Gotshal & Manges on claim construction at AIPLA's Quarterly Journal Symposium at the George Washington School of Law.

On April 6, 2016, I participated in a panel discussion with William Covey, Office of General Counsel, USPTO on Ethics at the Spring Meeting of the Intellectual Property Law Section of the American Bar Association.



**United States Court of Federal Claims
Local Patent Rules**

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PREAMBLE

[To be inserted]

1. SCOPE OF RULES

1.1. Title

These are the Local Rules of Practice for Patent Cases before the United States Court of Federal Claims. They should be cited as “LPRCFC ___.”

1.2. Application of Rules

The Local Patent Rules of the United States Court of Federal Claims (“LPRCFC”) will apply to all civil actions brought under 28 U.S.C. § 1498(a). The Rules of the United States Court of Federal Claims (“RCFC”) will also apply to such actions, except to the extent that they are inconsistent with the LPRCFC.

1.3. Modification of Rules

The Court may modify the requirements or deadlines provided for in the LPRCFC, based on circumstances of any particular case, including, without limitation, the simplicity or complexity of the case as shown by the patents, claims, products, or parties involved. Such modifications will, in most cases, be made at the Preliminary Scheduling Conference, but may be made at other times upon a showing of good cause. In advance of submission of any request for a modification, the parties will confer for purposes of reaching an agreement, if possible.

2. GENERAL PROVISIONS

2.1. Preliminary Scheduling Conference

When the parties confer, pursuant to RCFC Appendix A, paragraph 3, in addition to the matters covered by paragraph 3, the parties will discuss and address in the Joint Preliminary Status Report filed pursuant to RCFC Appendix A, paragraphs 4–6, the following topics:

- a. Proposed modification of the obligations or deadlines, provided for in the LPRCFC, to ensure that they meet the circumstances of the particular case, and the effect of any such modification on the date and time of the Claim Construction Hearing, if any;
- b. Proposed modification to the Default Protective Order in effect under LPRCFC 2.4.
- c. The scope and timing of any claim construction discovery, including disclosure of and discovery from any expert witness;

- d. The format of the Claim Construction Hearing, including whether the Court will hear live testimony and the order of presentation; and
- e. Whether and in what manner the parties are prepared, if requested by the Court, to educate the Court about the technology at issue.

2.2. Conference Requirement

In advance of submission of any request for a modification of the parties' obligations under the LPRCFC, the parties will confer for purposes of reaching an agreement about any issues to be raised with the Court.

2.3. Stay of Proceedings

The Court, upon motion, may order a stay of litigation, pending the outcome of a proceeding before the United States Patent and Trademark Office that concerns a patent at issue in the case, such as reexamination, *inter partes* review, or other post-grant review proceeding. Whether the Court stays litigation will depend on the circumstances of each particular case, including without limitation: (1) the stage of the litigation, (2) whether a stay will simplify the issues before the Court, and (3) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party.

2.4. Confidentiality

The Default Protective Order, attached as Appendix A to the LPRCFC, automatically governs the production of any documents or information in any case subject to the LPRCFC, unless the Court enters an alternative Protective Order.

2.5. Objections under the Rules of the United States Court of Federal Claims

A party may not object to mandatory disclosures under RCFC 26(a) or to a discovery request on the ground that it conflicts with or is premature under the LPRCFC, except to the following categories of requests and disclosures or as otherwise ordered by the Court:

- a. Requests for a party's claim construction position;
- b. Requests to a party claiming patent infringement for a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, or other instrumentality;
- c. Requests to a party claiming patent infringement for contentions regarding the presence of claim elements in the prior art;

- d. Requests to a party opposing a claim of patent infringement for a comparison of the asserted claims and the prior art; and
- e. Requests to a party opposing a claim of patent infringement for Invalidity Contentions.

If a party objects to a discovery request or declines to provide information under this Rule, that party will provide the requested information on the date on which it is required to be provided under the LPRCFC, or as otherwise ordered by the Court.

2.6. Good Faith Participation

A failure to make a good faith effort to provide patent disclosures, narrow disputed issues or the number of disputed claim construction terms, confer with other parties, or comply with any other of the obligations under the LPRCFC may subject counsel to sanctions, including under 28 U.S.C. § 1927.

3. PATENT DISCLOSURES

3.1. Certification of Disclosures

All disclosures made pursuant to the LPRCFC must be dated and signed by counsel of record (or by the party, if unrepresented by counsel) and are subject to the requirements of RCFC 26(g).

3.2. Admissibility of Disclosures

Statements, disclosures, or charts are admissible to the extent permitted by the Federal Rules of Evidence or RCFC. The statements and disclosures provided for in LPRCFC 4.1 and 4.2, however, are not admissible for any purpose, other than in connection with a motion seeking an extension or modification of the deadlines or obligations provided for in the LPRCFC.

3.3. Supplementation Requirements

The requirement to supplement disclosure and discovery responses under RCFC 26 will apply to all disclosures required under the LPRCFC.

3.4. Disclosure of Preliminary Infringement Contentions

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Within sixty (60) days after the Preliminary Scheduling Conference, or as otherwise ordered by the Court, each party claiming patent infringement will serve on all parties a Disclosure of Infringement Contentions for each opposing party the following information:

- a. Each claim of each patent in suit that is allegedly infringed by each opposing party;
- b. Each product or process of each opposing party of which the party claiming infringement is aware that allegedly infringes each identified claim. The identification of each such product or process will be as specific as possible and include the name and model number, if known.
- c. A chart identifying where each limitation of each asserted claim is found within each identified product or process;
- d. Whether each limitation of each identified claim is alleged to be literally present or present under the doctrine of equivalents in the identified product or process; and
- e. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled.

3.5. Document Production Accompanying Disclosure of Infringement Contentions

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

- a. All documents concerning any disclosure, sale or transfer, or offer to sell or transfer of the claimed invention prior to the date of application for each of the patents in suit;
- b. If relevant to a patent in suit, all documents showing the conception and first reduction to practice of each claimed invention within that patent that were created on or before the date of application for the patent in suit or the priority date identified, pursuant to LPRCFC. 3.4(d);
- c. A copy of the file history with the United States Patent and Trademark Office for each patent in suit; and
- d. All documents showing ownership of the patent rights by the party claiming patent infringement.

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Nothing in these required disclosures will be considered an admission that such disclosures are prior art or evidence of prior art under 35 U.S.C. § 102 or § 103.

3.6. Disclosure of Preliminary Invalidity Contentions

Within sixty (60) days after receiving the Disclosure of Infringement Contentions, or as otherwise ordered by the Court, each party opposing a claim of patent infringement will serve on all parties its Disclosure of Invalidity Contentions with the following information:

- a. The identity of each item or combination of items of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent will be identified by its number, country of origin, and date of issue. Each prior art publication will be identified by title, date of publication, and where feasible, author and publisher. Prior art showing public use or sale will be presented by specifying the item publicly used or offered for sale, the date the use or offer took place, and the identity of the persons or entities that made the use, made the offer, and received the offer. The identification of prior art will include a description of where in each alleged item of prior art each limitation of each asserted claim is found;
- b. An explanation of how each item or combination of items of prior art anticipates each asserted claim or renders it obvious; and
- c. The identity and explanation of any other grounds for invalidity, including any under 35 U.S.C. § 101 or § 112, or unenforceability of any of the asserted claims.

3.7. Document Production Accompanying Disclosure of Invalidity Contentions

With the Disclosure of Invalidity Contentions, the party opposing a claim of patent infringement will produce to each opposing party or make available for inspection and copying:

- a. Documents sufficient to show the operation of any aspects or elements of the product or process identified by the party as allegedly infringing, and which are subject to dispute; and
- b. A copy of any additional items of prior art identified, pursuant to LPRCFC 3.6, which do not appear in the file history of the patent(s) at issue.

3.8. Response to Disclosure of Invalidity Contentions

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Within thirty (30) days after service of the Disclosure of Invalidity Contentions, each party claiming patent infringement will serve on all parties a Response to Disclosure of Invalidity Contentions. The Response to Disclosure of Invalidity Contentions will state as to each identified element in each asserted claim, to the extent known, whether the party admits to the identity of elements in the prior art or the identity of any other grounds for invalidity and, if not, the reason for such denial.

3.9. Amendment to Disclosures

A party may amend the Disclosure of Infringement Contentions or the Disclosure of Invalidity Contentions only by order of the Court upon a timely showing of good cause and absence of unfair prejudice to opposing parties. Non-exhaustive examples of circumstances that may, absent undue prejudice to the non-moving party, support a finding of good cause include:

- a. A claim construction by the Court different from that proposed by the party seeking amendment;
- b. Recent discovery of material prior art despite earlier diligent search; and
- c. Recent discovery of nonpublic information about the accused product or process, which was not discovered, despite diligent efforts, before the service of the Disclosure of Infringement Contentions.

The duty to supplement discovery responses does not excuse the need to obtain leave of Court to amend contentions.

4. CLAIM CONSTRUCTION

4.1. Exchange of Proposed Terms for Construction

Within fifteen (15) days after service of the Response to Disclosure of Invalidity Contentions, pursuant to LPRCFC 3.8, each party will serve on each other party a list of claim terms which that party contends should be construed by the Court and the identity of any claim term a party contends is governed by 35 U.S.C. § 112(f).

4.2. Exchange of Proposed Claim Constructions

Within fifteen (15) days after the exchange of Proposed Terms for Construction, each party will serve on each other party proposed constructions for each term identified by any party for claim construction. Each party's proposed constructions will include an identification of all intrinsic evidence that supports that construction, and an

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identification of any extrinsic evidence known to the party that will support the proposed construction.

Within seven (7) days after the exchange of Proposed Claim Constructions, the parties will confer for the purpose of narrowing the issues and limiting the number of terms to submit to the Court for construction, pursuant to LPRCFC 4.3. The parties should identify outcome-determinative or otherwise significant terms to the Court.

4.3. Limit on the Number of Proposed Terms for Construction

No more than ten (10) terms may be submitted to the Court for construction without prior leave of the Court upon a showing of good cause. If appropriate, the assertion of multiple non-related patents may constitute good cause. If the parties are unable to agree upon ten terms, then five will be allocated to all plaintiffs and five to all defendants. For each term to be submitted to the Court, the parties will certify whether it is outcome-determinative.

4.4. Joint Claim Construction Chart and Prehearing Statement

Within fifteen (15) days after the exchange of Proposed Terms for Construction, the parties will complete and file a Joint Claim Construction Chart and Prehearing Statement with the following information:

- a. A chart containing each party's proposed identification of the Person of Ordinary Skill in the Art, or a joint identification of the Person of Ordinary Skill in the Art, if the parties agree on such identification.
- b. A chart containing the construction of those terms on which the parties agree;
- c. A chart containing each party's proposed construction of each disputed term, together with an identification of all intrinsic evidence supporting that construction, and an identification of any extrinsic evidence on which the proposing party intends to rely to support a proposed construction or to oppose any other party's proposed construction. As permitted by law, such extrinsic evidence includes, but is not limited to, dictionary definitions, citations to learned treatises and prior art, and testimony of expert witnesses. Each party must identify each term that it intends to argue is indefinite;
- d. A Joint Appendix containing the patent(s) in dispute and the prosecution history for each patent. The prosecution history must be paginated, and all parties must cite to the Joint Appendix when referencing materials therein. Any party may file a separate appendix to its claim construction brief containing other supporting materials.

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- e. Whether a party intends to file a pre-Claim Construction Hearing brief or instead rely on the Joint Claim Construction Chart;
- f. A proposed schedule for the Claim Construction Hearing and the reasons for the proposed schedule;
- g. Whether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and a summary of his or her testimony including, for any expert, each opinion to be offered related to claim construction. Any such witnesses will promptly be made available for deposition;
- h. Whether any party intends to request a separate hearing on the issue of indefiniteness and the reasoning behind any such request. Upon showing of good cause, the Court may grant such a request and may order supplemental briefing on the issue of indefiniteness.

4.5. Claim Construction Status Conference

At the Court’s discretion, within seven (7) days of the submission of the Joint Claim Construction Chart and Prehearing Statement, the Court may hold a status conference with the parties, in person or by telephone, to discuss scheduling, witnesses, and any other matters relating to the Claim Construction Hearing.

4.6. Pre-Claim Construction Discovery

Without prior leave of the Court and upon a showing of good cause, there will be no discovery prior to the entry of the Court’s Claim Construction Opinion and Order.

4.7. Contents and Length of Claim Construction Briefs

Unless otherwise ordered by the Court, all claim construction briefs will conform to the requirements set forth in RCFC 5.4, except that all claim construction briefs need not include the items referred to in RCFC 5.4(a)(2)(C), (D), and (E).

4.8. Pre-Claim Construction Hearing Briefs

Pre-Claim Construction Hearing briefs are optional and any party may choose to rely instead on the Joint Claim Construction Chart. If any party chooses to file a pre-Claim Construction Hearing brief, it will be subject to the following schedule:

- a. Within thirty (30) days after filing the Joint Claim Construction Chart and Prehearing Statement, the parties claiming patent infringement may serve and

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file their Preliminary Opening Claim Construction Brief. The Preliminary Opening Claim Construction Brief will contain alternate proposed constructions for each disputed claim term in addition to constructions relying on “plain and ordinary meaning” and will include any evidence supporting the parties’ proposed claim constructions.

- b. Within thirty (30) days after the filing of the Preliminary Opening Claim Construction Brief or, if the parties claiming patent infringement elect not to file a Preliminary Opening Claim Construction Brief, within thirty (30) days after filing of the Joint Claim Construction Chart, the parties opposing a claim of patent infringement may serve and file their Preliminary Responsive Claim Construction Brief and any evidence supporting their claim constructions.
- c. If the parties opposing patent infringement elect to file a Preliminary Responsive Claim Construction Brief, within fifteen (15) days after the filing of the Preliminary Responsive Claim Construction Brief, the parties claiming patent infringement may serve and file a Preliminary Reply Claim Construction Brief and any evidence directly rebutting the supporting evidence contained in the Preliminary Responsive Claim Construction Brief.

4.9. Claim Construction Hearing

Unless otherwise ordered, the Court will hold a Claim Construction Hearing within fifteen (15) days following the deadline to submit the Reply to Responsive Claim Construction Brief, if the parties request and the Court deems it necessary to conduct such a hearing. Either before or after the filing of claim construction briefs, the Court will issue an order describing the schedule and procedures for a claim construction hearing. Any exhibits, including demonstrative exhibits, to be used at a claim construction hearing will be exchanged no later than three (3) days before the hearing.

4.10. Expert Witnesses at Claim Construction Hearing

Expert witnesses may be called at the Claim Construction Hearing only with the prior leave of the Court and upon a showing of good cause.

4.11. Post-Claim Construction Hearing Briefs

Parties will file post-Claim Construction Hearing briefs according to the following schedule:

- a. Within thirty (30) days after the Court convenes a Claim Construction Hearing, the parties claiming patent infringement will serve and file their Final Opening Claim Construction Brief. The Final Opening Claim

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Construction Brief will contain alternate proposed constructions for each disputed claim term in addition to constructions relying on “plain and ordinary meaning” and will include any evidence supporting the parties’ proposed claim constructions.

- b. Within thirty (30) days after the filing of the Final Opening Claim Construction Brief, the parties opposing a claim of patent infringement will serve and file their Final Responsive Claim Construction Brief and any evidence supporting their claim constructions.
- c. Within fifteen (15) days after the filing of the Final Responsive Claim Construction Brief, the parties claiming patent infringement may serve and file a Final Reply Claim Construction Brief and any evidence directly rebutting the supporting evidence contained in the Final Responsive Claim Construction Brief.

5. SETTLEMENT

5.1. Mandatory Settlement Discussions

When all the parties are represented by counsel, in addition to any requirements provided for in the RCFC, the parties will confer, in person or by telephone, upon the possibility of settlement in all cases subject to the LPRCFC as follows:

- a. Within seven (7) days after entry of the Court’s Claim Construction Opinion and Order;
- b. Within seven (7) days after entry of the Court’s Indefiniteness Order, if any, or any other order that narrows the issues in question before the Court; and
- c. Within seven (7) days after completion of the trial.

5.2. Joint Statement of Compliance and Result

Within five (5) days after each settlement discussion, the parties will file with the Court one of the following:

- a. A joint statement of compliance with LPRCFC 5.1, indicating that the settlement discussion was conducted, and apprising the Court of the outcome of the discussion; or
- b. A joint statement identifying a settlement agreement and requesting that the proceeding be dismissed.

Appendix A

In the United States Court of Federal Claims

No. _____
Filed: [Date]

_____,

Plaintiff,

v.

THE UNITED STATES,

Defendant

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PROTECTIVE ORDER

The Court enters the following Protective Order pursuant to Federal Rule of Civil Procedure 26(c)(1).

This Protective Order does not specify the procedures under which access to National Security Information is to be provided and shall not be construed as requiring the production of any information that is classified for reasons of national security. Access to such information shall be governed solely by existing laws and regulations pertaining to national security.

IT IS HEREBY ORDERED that the following provisions shall govern the conduct of further proceedings in this action:

1. As used in this Protective Order, these terms have the following meanings:
 - (a) Attorneys: counsel of record;
 - (b) Documents: all materials within the scope of RCFC 34;

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- (c) “Restricted—Attorneys’ Eyes Only” documents: the subset of Restricted documents that are designated pursuant to Paragraph 5;
 - (d) Written Assurance: an executed document in the form found in LPR Appendix B;
 - (e) Litigation support contractors: contractors who are subject to an obligation, either by contract or trade practice, to maintain the confidentiality of any material received in performance of services related to this litigation and rendered for the attorneys of record in this litigation (by way of example and not limitation, “litigation support contractors” include copying services, court reporters, videographers, document storage and management contractors, database management contractors, and information technology and network support contractors);
 - (f) Experts: outside persons who are used by a party or its attorneys to furnish technical or expert services, and/or to give expert testimony in this litigation; and
 - (g) Third Party: Any party not directly involved in this litigation.
2. By identifying a document as “Restricted,” a party may designate any document, including interrogatory response, other discovery response, and/or transcript that it, in good faith, contends constitutes or contains trade secret, proprietary, source selection sensitive, or other similarly sensitive information which the owner thereof has taken reasonable measures to protect from disclosure to the public or competitors. In the case of the United States, other information and documents that may be identified as “Restricted” shall include:
- (a) Documents categorized as “FOR OFFICIAL USE ONLY (FOUO),” including unclassified information in the possession of, or under the control of the Department of Defense; and
 - (b) Trade secret, proprietary, source-selection sensitive, or other similarly sensitive information belonging to non-parties, but within the control or custody of the United States.
3. All Restricted 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

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those specified in Paragraph 4. Prohibited purposes include, but are not limited to, use for competitive purposes or the prosecution of additional intellectual property rights.

4. Absent a further Court order, access to any Restricted document shall be limited to:

- (a) The Court and its personnel;
- (b) Attorneys of record in the above-captioned litigation, to the extent they have agreed to be bound by this Protective Order, and any members or employees of their respective law firms or, in the case of the United States, the attorneys, legal assistants, and legal support staffs of the Department of Justice and any agency or department of the United States involved in this litigation;
- (c) Persons shown on the face of the document to have authored or received it;
- (d) Litigation support contractors;
- (e) Inside counsel of the parties, subject to the conditions of Paragraph 8;
- (f) A party's officers and employees directly involved in this litigation, whose access to the information is reasonably required to supervise, manage, or participate in this litigation, subject to the conditions of Paragraph 8;
- (g) Experts, subject to the conditions of Paragraph 8; and
- (h) Any other person or entity that the parties (including third parties, to the extent the third party has designated the document as "Restricted") mutually agree, in writing, may have access to Restricted documents.

5. The parties shall have the right to further designate Restricted documents or portions of Restricted documents as "Restricted—Attorneys' Eyes Only." Absent a further Court order, disclosure of such information shall be limited to the persons designated in Paragraphs 4(a), (b), (c), (d), (g) and, in addition, persons designated in Paragraph 4(h), to the extent the parties mutually agree in writing that the individual may have access to "Restricted—Attorneys' Eyes Only" documents.

6. Notwithstanding any other provision of this Protective Order, no information designated "Restricted—Attorneys' Eyes Only" shall be disclosed under this Protective Order to any individual

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involved in the prosecution of patent applications related to the subject matter of the claimed invention involved in this litigation. Individuals to whom “Restricted—Attorneys’ Eyes Only” information has been disclosed under this Protective Order, however, may provide copies of material prior art or other non-confidential information to counsel involved in prosecution to be provided to the United States Patent and Trademark Office. Unless otherwise agreed upon by the parties, no individual to whom “Restricted—Attorneys’ Eyes Only” information has been disclosed under this Protective Order shall be involved in the prosecution of patent applications related to the subject matter of the claimed invention involved in this litigation until one (1) year after the final disposition of this action, including all related appeals (the “Prosecution Bar”). The parties expressly agree that the Prosecution Bar set forth herein shall be personal to any attorney who reviews information designated “Restricted—Attorneys’ Eyes Only” and shall not be imputed to any other persons or attorneys at the attorney’s law firm or company unless information concerning that designated information was communicated to an individual by one who reviewed such designated information. For purposes of the Prosecution Bar, “prosecution” includes: (i) the drafting or amending of patent claims, or the supervising of the drafting or amending of patent claims; (ii) participating in or advising on any reexamination, reissue, *inter partes* review, or other post-grant review proceeding, except as specified below; and (iii) advising any client concerning strategies for obtaining or preserving patent rights related to the subject matter of the claimed invention involved in this litigation before the United States Patent and Trademark Office or other similar foreign government or agency. “Prosecution” does not include participating in or advising on any reexamination, reissue, *Inter Partes* review, or other post-grant review proceeding by a party’s lawyers with respect to any patents in which an opposing party involved in this litigation has any interest, or any patent involved in the pending action. Nothing contained herein shall preclude lawyers having access to documents designated as “Restricted—Attorneys’ Eyes Only” from having discussions with their clients about the general status of the case and about settlement offers so long as during any such discussions such lawyers do not impart any Restricted—Attorneys’ Eyes Only information to their clients.

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7. Third parties producing documents in the course of this litigation may also designate documents as “Restricted” or “Restricted—Attorneys’ Eyes Only,” subject to the same protections and constraints as the parties to the litigation. A copy of this Protective Order shall be served along with any subpoena served in connection with this litigation. All documents produced by such third parties, even if not designated by such third parties as “Restricted” or “Restricted—Attorneys’ Eyes Only,” shall be treated by the parties to this action as “Restricted—Attorneys’ Eyes Only” for a period of fifteen (15) days from the date of their production. During that fifteen day period, any party may designate such documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” pursuant to the terms of this Protective Order.

8. Each person who is to receive Restricted information pursuant to Paragraphs 4(e), (f), or (g) shall execute a “Written Assurance” document in the form found in the LPRCFC Appendix B. Opposing counsel shall be notified in writing at least ten (10) days prior to disclosure of Restricted information to any such person. Such notice shall provide a reasonable description of the outside person to whom disclosure is sought sufficient to permit objection to be made. Upon good cause (which does not include challenging the qualifications of such outside person), a party may object in writing to such disclosure within ten (10) days after receipt of notice by setting forth in detail the grounds on which the party’s objection is based. If a party objects within the ten-day period, no disclosure shall be made until the party seeking disclosure obtains the prior approval of the Court or the objecting party.

9. All depositions or portions of depositions taken in this litigation that contain information that may be designated “Restricted” or “Restricted—Attorneys’ Eyes Only,” according to Paragraphs 2 and 5, may themselves be so designated and thereby obtain the protections accorded other “Restricted” or “Restricted—Attorneys’ Eyes Only” documents. 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 final transcript. Unless otherwise agreed depositions shall be treated as “Restricted—Attorneys’ Eyes Only” until ten (10) days after receipt of the final transcript. The deposition of any witness (or any portion of such deposition) that includes Restricted information shall be taken only in the presence of persons who are qualified to have access to such information.

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10. Any party who fails to designate documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” may designate the documents after production to the same extent as it may have designated the documents before production by providing written notice of the error and substituting copies of the documents bearing appropriate designations. The party receiving the designation shall, upon receiving the replacement set of documents, immediately return or destroy the documents that lacked the designation to the designating party, and the parties shall undertake reasonable efforts to correct any disclosure of such information contrary to the designation. No showing of error, inadvertence, or excusable neglect shall be required for a party to avail itself of the provisions of this paragraph.

11. In addition to the requirements imposed by Federal Rule of Evidence 502 and RCFC 26(b)(5)(B), any party who inadvertently discloses documents that are privileged or otherwise immune from discovery shall, promptly upon discovery of the error, so advise in writing the receiving party and request that the documents be returned. The receiving party shall return or certify destruction of the documents, including all copies, within ten (10) days of receiving such a written request. The party returning or destroying such documents may thereafter seek reproduction of any such documents pursuant to applicable law, although the party seeking reproduction may not use the fact that the documents were previously produced inadvertently to argue that privilege or any other immunity from discovery has been waived. No showing of error, inadvertence, or excusable neglect shall be required for a party to avail itself of the provisions of this paragraph.

12. If a party intends to file a document containing Restricted information with the Court, this Protective Order grants leave to make such filing under seal. Prior to disclosure at trial or a hearing of materials or information “Restricted” or “Restricted—Attorneys’ Eyes Only,” the parties may seek further protections against public disclosure from the Court.

13. Any party may request a change in the designation of any information designated “Restricted” or “Restricted—Attorneys’ Eyes Only.” Any such document shall be treated as designated until such request is approved by the Court. If the disclosing party does not agree to the requested change in designation, the party seeking the change may move the Court for appropriate relief, providing notice to any third party

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whose designation of produced documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” in the litigation may be affected. The party asserting that the material is Restricted shall have the burden of proving that the information in question is within the scope of protection afforded by this Protective Order and RCFC 26(c).

14. Not later than sixty (60) days after the termination this litigation, including all related appeals, each party shall either destroy or return to the disclosing party all documents designated by the disclosing party as “Restricted” or “Restricted—Attorneys’ Eyes Only,” and all copies of such documents, and shall destroy all extracts and/or data taken from such documents. Each party shall provide a certification in writing to the disclosing party as to such return or destruction within the sixty-day period. Attorneys shall be entitled to retain, however, one set of all documents filed with the Court, obtained during discovery, or generated as correspondence in connection with the action, including one copy of documents designated “Restricted” or “Restricted—Attorneys’ Eyes Only.” Nothing in this order shall require deletion of data from tapes or other storage maintained solely for the purpose of permitting the rebuilding or recovery of files, provided that access to this data is restricted to those otherwise permitted access under this Protective Order.

15. Any party may move 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 access to documents as may be appropriate.

16. The obligations imposed by this Protective Order shall survive the termination of this litigation and all related appeals and shall remain in effect until the party designating the documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” agrees otherwise in writing or a further court order otherwise directs.

17. Not later than sixty (60) days after the termination of this litigation, including all related appeals, the parties shall file a motion with the Court seeking leave to remove any physical materials designated “Restricted” or “Restricted—Attorneys’ Eyes Only” from the office of the Clerk of Court.

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18. Nothing in this Protective Order shall be construed to prevent any party from disclosing its own Restricted information in any manner that it considers appropriate.

19. In the event that any party seeks the production of documents containing material that may be classified, subject to International Traffic in Arms Regulations or other export controls, or otherwise restricted by federal law, the parties will confer regarding an appropriate resolution consistent with federal law. Notwithstanding anything contained in this Protective Order, National Security Information shall be controlled according to applicable statute.

20. The court reserves the right, after reviewing the record and other information submitted by the parties, to modify this Protective Order, or the parties' designation of materials or proceedings as "Restricted" or "Restricted—Attorneys' Eyes Only," in the event such materials or proceedings are not properly classified as confidential, privileged, proprietary, competition-sensitive, or otherwise protectable.

IT IS SO ORDERED.

/s/ _____
[Name of Judge]
Judge

Appendix B

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WRITTEN ASSURANCE

I, _____, declare that:

1. My address is _____, and the address of my present employer is _____.
2. My present occupation or job description is _____
_____.
3. My present relationship to plaintiff/defendant(s) is _____
_____.
4. I have received a copy of the Stipulated Protective Order (the “Protective Order”) in this action.
5. I have carefully read and understand the provisions of the Protective Order, agree to be bound by it, and specifically agree I will not use or disclose to anyone any of the contents of any Restricted information received under the protection of the Protective Order.
6. I understand that I am to retain all copies of any of the materials that I receive which have been so designated as Restricted in a container, cabinet, drawer, room, or other safe place in a manner consistent with the Protective Order and that all copies are to remain in my custody until I have completed my assigned or legal duties. I will destroy or return to counsel all Restricted documents and things that come into my possession. I acknowledge that such return or the subsequent destruction of such materials shall not relieve me from any of the continuing obligations imposed upon me by the Protective Order.

I declare under penalty of perjury under the laws of the state where executed that the foregoing is true and correct.

Executed this _____ day of _____, 20_____, in the State of _____.

Signature



**United States Court of Federal Claims
Local Patent Rules**

DRAFT

For Circulation and Comment Only

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PREAMBLE

[To be inserted]

1. SCOPE OF RULES

1.1. Title

These are the Local Rules of Practice for Patent Cases before the United States Court of Federal Claims. They should be cited as “LPRCFC ___.”

1.2. Application of Rules

The Local Patent Rules of the United States Court of Federal Claims (“LPRCFC”) will apply to all civil actions brought under 28 U.S.C. § 1498(a). The Rules of the United States Court of Federal Claims (“RCFC”) will also apply to such actions, except to the extent that they are inconsistent with the LPRCFC.

1.3. Modification of Rules

The Court may modify the requirements or deadlines provided for in the LPRCFC, based on circumstances of any particular case, including, without limitation, the simplicity or complexity of the case as shown by the patents, claims, products, or parties involved. Such modifications will, in most cases, be made at the Preliminary Scheduling Conference, but may be made at other times upon a showing of good cause. In advance of submission of any request for a modification, the parties will confer for purposes of reaching an agreement, if possible.

2. GENERAL PROVISIONS

2.1. Preliminary Scheduling Conference

When the parties confer, pursuant to RCFC Appendix A, paragraph 3, in addition to the matters covered by paragraph 3, the parties will discuss and address in the Joint Preliminary Status Report filed pursuant to RCFC Appendix A, paragraphs 4–6, the following topics:

- a. Proposed modification of the obligations or deadlines, provided for in the LPRCFC, to ensure that they meet the circumstances of the particular case, and the effect of any such modification on the date and time of the Claim Construction Hearing, if any;
- b. Proposed modification to the Default Protective Order in effect under LPRCFC 2.4.
- c. The scope and timing of any claim construction discovery, including disclosure of and discovery from any expert witness;

- d. The format of the Claim Construction Hearing, including whether the Court will hear live testimony and the order of presentation; and
- e. Whether and in what manner the parties are prepared, if requested by the Court, to educate the Court about the technology at issue.

2.2. Conference Requirement

In advance of submission of any request for a modification of the parties' obligations under the LPRCFC, the parties will confer for purposes of reaching an agreement about any issues to be raised with the Court.

2.3. Stay of Proceedings

The Court, upon motion, may order a stay of litigation, pending the outcome of a proceeding before the United States Patent and Trademark Office that concerns a patent at issue in the case, such as reexamination, *inter partes* review, or other post-grant review proceeding. Whether the Court stays litigation will depend on the circumstances of each particular case, including without limitation: (1) the stage of the litigation, (2) whether a stay will simplify the issues before the Court, and (3) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party.

2.4. Confidentiality

The Default Protective Order, attached as Appendix A to the LPRCFC, automatically governs the production of any documents or information in any case subject to the LPRCFC, unless the Court enters an alternative Protective Order.

2.5. Objections under the Rules of the United States Court of Federal Claims

A party may not object to mandatory disclosures under RCFC 26(a) or to a discovery request on the ground that it conflicts with or is premature under the LPRCFC, except to the following categories of requests and disclosures or as otherwise ordered by the Court:

- a. Requests for a party's claim construction position;
- b. Requests to a party claiming patent infringement for a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, or other instrumentality;
- c. Requests to a party claiming patent infringement for contentions regarding the presence of claim elements in the prior art;

- d. Requests to a party opposing a claim of patent infringement for a comparison of the asserted claims and the prior art; and
- e. Requests to a party opposing a claim of patent infringement for Invalidity Contentions.

If a party objects to a discovery request or declines to provide information under this Rule, that party will provide the requested information on the date on which it is required to be provided under the LPRCFC, or as otherwise ordered by the Court.

2.6. Good Faith Participation

A failure to make a good faith effort to provide patent disclosures, narrow disputed issues or the number of disputed claim construction terms, confer with other parties, or comply with any other of the obligations under the LPRCFC may subject counsel to sanctions, including under 28 U.S.C. § 1927.

3. PATENT DISCLOSURES

3.1. Certification of Disclosures

All disclosures made pursuant to the LPRCFC must be dated and signed by counsel of record (or by the party, if unrepresented by counsel) and are subject to the requirements of RCFC 26(g).

3.2. Admissibility of Disclosures

Statements, disclosures, or charts are admissible to the extent permitted by the Federal Rules of Evidence or RCFC. The statements and disclosures provided for in LPRCFC 4.1 and 4.2, however, are not admissible for any purpose, other than in connection with a motion seeking an extension or modification of the deadlines or obligations provided for in the LPRCFC.

3.3. Supplementation Requirements

The requirement to supplement disclosure and discovery responses under RCFC 26 will apply to all disclosures required under the LPRCFC.

3.4. Disclosure of Preliminary Infringement Contentions

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Within sixty (60) days after the Preliminary Scheduling Conference, or as otherwise ordered by the Court, each party claiming patent infringement will serve on all parties a Disclosure of Infringement Contentions for each opposing party the following information:

- a. Each claim of each patent in suit that is allegedly infringed by each opposing party;
- b. Each product or process of each opposing party of which the party claiming infringement is aware that allegedly infringes each identified claim. The identification of each such product or process will be as specific as possible and include the name and model number, if known.
- c. A chart identifying where each limitation of each asserted claim is found within each identified product or process;
- d. Whether each limitation of each identified claim is alleged to be literally present or present under the doctrine of equivalents in the identified product or process; and
- e. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled.

3.5. Document Production Accompanying Disclosure of Infringement Contentions

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

- a. All documents concerning any disclosure, sale or transfer, or offer to sell or transfer of the claimed invention prior to the date of application for each of the patents in suit;
- b. If relevant to a patent in suit, all documents showing the conception and first reduction to practice of each claimed invention within that patent that were created on or before the date of application for the patent in suit or the priority date identified, pursuant to LPRCFC. 3.4(d);
- c. A copy of the file history with the United States Patent and Trademark Office for each patent in suit; and
- d. All documents showing ownership of the patent rights by the party claiming patent infringement.

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Nothing in these required disclosures will be considered an admission that such disclosures are prior art or evidence of prior art under 35 U.S.C. § 102 or § 103.

3.6. Disclosure of Preliminary Invalidity Contentions

Within sixty (60) days after receiving the Disclosure of Infringement Contentions, or as otherwise ordered by the Court, each party opposing a claim of patent infringement will serve on all parties its Disclosure of Invalidity Contentions with the following information:

- a. The identity of each item or combination of items of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent will be identified by its number, country of origin, and date of issue. Each prior art publication will be identified by title, date of publication, and where feasible, author and publisher. Prior art showing public use or sale will be presented by specifying the item publicly used or offered for sale, the date the use or offer took place, and the identity of the persons or entities that made the use, made the offer, and received the offer. The identification of prior art will include a description of where in each alleged item of prior art each limitation of each asserted claim is found;
- b. An explanation of how each item or combination of items of prior art anticipates each asserted claim or renders it obvious; and
- c. The identity and explanation of any other grounds for invalidity, including any under 35 U.S.C. § 101 or § 112, or unenforceability of any of the asserted claims.

3.7. Document Production Accompanying Disclosure of Invalidity Contentions

With the Disclosure of Invalidity Contentions, the party opposing a claim of patent infringement will produce to each opposing party or make available for inspection and copying:

- a. Documents sufficient to show the operation of any aspects or elements of the product or process identified by the party as allegedly infringing, and which are subject to dispute; and
- b. A copy of any additional items of prior art identified, pursuant to LPRCFC 3.6, which do not appear in the file history of the patent(s) at issue.

3.8. Response to Disclosure of Invalidity Contentions

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Within thirty (30) days after service of the Disclosure of Invalidity Contentions, each party claiming patent infringement will serve on all parties a Response to Disclosure of Invalidity Contentions. The Response to Disclosure of Invalidity Contentions will state as to each identified element in each asserted claim, to the extent known, whether the party admits to the identity of elements in the prior art or the identity of any other grounds for invalidity and, if not, the reason for such denial.

3.9. Amendment to Disclosures

A party may amend the Disclosure of Infringement Contentions or the Disclosure of Invalidity Contentions only by order of the Court upon a timely showing of good cause and absence of unfair prejudice to opposing parties. Non-exhaustive examples of circumstances that may, absent undue prejudice to the non-moving party, support a finding of good cause include:

- a. A claim construction by the Court different from that proposed by the party seeking amendment;
- b. Recent discovery of material prior art despite earlier diligent search; and
- c. Recent discovery of nonpublic information about the accused product or process, which was not discovered, despite diligent efforts, before the service of the Disclosure of Infringement Contentions.

The duty to supplement discovery responses does not excuse the need to obtain leave of Court to amend contentions.

4. CLAIM CONSTRUCTION

4.1. Exchange of Proposed Terms for Construction

Within fifteen (15) days after service of the Response to Disclosure of Invalidity Contentions, pursuant to LPRCFC 3.8, each party will serve on each other party a list of claim terms which that party contends should be construed by the Court and the identity of any claim term a party contends is governed by 35 U.S.C. § 112(f).

4.2. Exchange of Proposed Claim Constructions

Within fifteen (15) days after the exchange of Proposed Terms for Construction, each party will serve on each other party proposed constructions for each term identified by any party for claim construction. Each party's proposed constructions will include an identification of all intrinsic evidence that supports that construction, and an

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identification of any extrinsic evidence known to the party that will support the proposed construction.

Within seven (7) days after the exchange of Proposed Claim Constructions, the parties will confer for the purpose of narrowing the issues and limiting the number of terms to submit to the Court for construction, pursuant to LPRCFC 4.3. The parties should identify outcome-determinative or otherwise significant terms to the Court.

4.3. Limit on the Number of Proposed Terms for Construction

No more than ten (10) terms may be submitted to the Court for construction without prior leave of the Court upon a showing of good cause. If appropriate, the assertion of multiple non-related patents may constitute good cause. If the parties are unable to agree upon ten terms, then five will be allocated to all plaintiffs and five to all defendants. For each term to be submitted to the Court, the parties will certify whether it is outcome-determinative.

4.4. Joint Claim Construction Chart and Prehearing Statement

Within fifteen (15) days after the exchange of Proposed Terms for Construction, the parties will complete and file a Joint Claim Construction Chart and Prehearing Statement with the following information:

- a. A chart containing each party's proposed identification of the Person of Ordinary Skill in the Art, or a joint identification of the Person of Ordinary Skill in the Art, if the parties agree on such identification.
- b. A chart containing the construction of those terms on which the parties agree;
- c. A chart containing each party's proposed construction of each disputed term, together with an identification of all intrinsic evidence supporting that construction, and an identification of any extrinsic evidence on which the proposing party intends to rely to support a proposed construction or to oppose any other party's proposed construction. As permitted by law, such extrinsic evidence includes, but is not limited to, dictionary definitions, citations to learned treatises and prior art, and testimony of expert witnesses. Each party must identify each term that it intends to argue is indefinite;
- d. A Joint Appendix containing the patent(s) in dispute and the prosecution history for each patent. The prosecution history must be paginated, and all parties must cite to the Joint Appendix when referencing materials therein. Any party may file a separate appendix to its claim construction brief containing other supporting materials.

- e. Whether a party intends to file a pre-Claim Construction Hearing brief or instead rely on the Joint Claim Construction Chart;
- f. A proposed schedule for the Claim Construction Hearing and the reasons for the proposed schedule;
- g. Whether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and a summary of his or her testimony including, for any expert, each opinion to be offered related to claim construction. Any such witnesses will promptly be made available for deposition;
- h. Whether any party intends to request a separate hearing on the issue of indefiniteness and the reasoning behind any such request. Upon showing of good cause, the Court may grant such a request and may order supplemental briefing on the issue of indefiniteness.

4.5. Claim Construction Status Conference

At the Court's discretion, within seven (7) days of the submission of the Joint Claim Construction Chart and Prehearing Statement, the Court may hold a status conference with the parties, in person or by telephone, to discuss scheduling, witnesses, and any other matters relating to the Claim Construction Hearing.

4.6. Pre-Claim Construction Discovery

Without prior leave of the Court and upon a showing of good cause, there will be no discovery prior to the entry of the Court's Claim Construction Opinion and Order.

4.7. Contents and Length of Claim Construction Briefs

Unless otherwise ordered by the Court, all claim construction briefs will conform to the requirements set forth in RCFC 5.4, except that all claim construction briefs need not include the items referred to in RCFC 5.4(a)(2)(C), (D), and (E).

4.8. Pre-Claim Construction Hearing Briefs

Pre-Claim Construction Hearing briefs are optional and any party may choose to rely instead on the Joint Claim Construction Chart. If any party chooses to file a pre-Claim Construction Hearing brief, it will be subject to the following schedule:

- a. Within thirty (30) days after filing the Joint Claim Construction Chart and Prehearing Statement, the parties claiming patent infringement may serve and

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file their Preliminary Opening Claim Construction Brief. The Preliminary Opening Claim Construction Brief will contain alternate proposed constructions for each disputed claim term in addition to constructions relying on “plain and ordinary meaning” and will include any evidence supporting the parties’ proposed claim constructions.

- b. Within thirty (30) days after the filing of the Preliminary Opening Claim Construction Brief or, if the parties claiming patent infringement elect not to file a Preliminary Opening Claim Construction Brief, within thirty (30) days after filing of the Joint Claim Construction Chart, the parties opposing a claim of patent infringement may serve and file their Preliminary Responsive Claim Construction Brief and any evidence supporting their claim constructions.
- c. If the parties opposing patent infringement elect to file a Preliminary Responsive Claim Construction Brief, within fifteen (15) days after the filing of the Preliminary Responsive Claim Construction Brief, the parties claiming patent infringement may serve and file a Preliminary Reply Claim Construction Brief and any evidence directly rebutting the supporting evidence contained in the Preliminary Responsive Claim Construction Brief.

4.9. Claim Construction Hearing

Unless otherwise ordered, the Court will hold a Claim Construction Hearing within fifteen (15) days following the deadline to submit the Reply to Responsive Claim Construction Brief, if the parties request and the Court deems it necessary to conduct such a hearing. Either before or after the filing of claim construction briefs, the Court will issue an order describing the schedule and procedures for a claim construction hearing. Any exhibits, including demonstrative exhibits, to be used at a claim construction hearing will be exchanged no later than three (3) days before the hearing.

4.10. Expert Witnesses at Claim Construction Hearing

Expert witnesses may be called at the Claim Construction Hearing only with the prior leave of the Court and upon a showing of good cause.

4.11. Post-Claim Construction Hearing Briefs

Parties will file post-Claim Construction Hearing briefs according to the following schedule:

- a. Within thirty (30) days after the Court convenes a Claim Construction Hearing, the parties claiming patent infringement will serve and file their Final Opening Claim Construction Brief. The Final Opening Claim

Construction Brief will contain alternate proposed constructions for each disputed claim term in addition to constructions relying on “plain and ordinary meaning” and will include any evidence supporting the parties’ proposed claim constructions.

- b. Within thirty (30) days after the filing of the Final Opening Claim Construction Brief, the parties opposing a claim of patent infringement will serve and file their Final Responsive Claim Construction Brief and any evidence supporting their claim constructions.
- c. Within fifteen (15) days after the filing of the Final Responsive Claim Construction Brief, the parties claiming patent infringement may serve and file a Final Reply Claim Construction Brief and any evidence directly rebutting the supporting evidence contained in the Final Responsive Claim Construction Brief.

5. SETTLEMENT

5.1. Mandatory Settlement Discussions

When all the parties are represented by counsel, in addition to any requirements provided for in the RCFC, the parties will confer, in person or by telephone, upon the possibility of settlement in all cases subject to the LPRCFC as follows:

- a. Within seven (7) days after entry of the Court’s Claim Construction Opinion and Order;
- b. Within seven (7) days after entry of the Court’s Indefiniteness Order, if any, or any other order that narrows the issues in question before the Court; and
- c. Within seven (7) days after completion of the trial.

5.2. Joint Statement of Compliance and Result

Within five (5) days after each settlement discussion, the parties will file with the Court one of the following:

- a. A joint statement of compliance with LPRCFC 5.1, indicating that the settlement discussion was conducted, and apprising the Court of the outcome of the discussion; or
- b. A joint statement identifying a settlement agreement and requesting that the proceeding be dismissed.

Appendix A

In the United States Court of Federal Claims

No. _____
Filed: [Date]

_____,

Plaintiff,

v.

THE UNITED STATES,

Defendant

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PROTECTIVE ORDER

The Court enters the following Protective Order pursuant to Federal Rule of Civil Procedure 26(c)(1).

This Protective Order does not specify the procedures under which access to National Security Information is to be provided and shall not be construed as requiring the production of any information that is classified for reasons of national security. Access to such information shall be governed solely by existing laws and regulations pertaining to national security.

IT IS HEREBY ORDERED that the following provisions shall govern the conduct of further proceedings in this action:

1. As used in this Protective Order, these terms have the following meanings:
 - (a) Attorneys: counsel of record;
 - (b) Documents: all materials within the scope of RCFC 34;

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- (c) “Restricted—Attorneys’ Eyes Only” documents: the subset of Restricted documents that are designated pursuant to Paragraph 5;
 - (d) Written Assurance: an executed document in the form found in LPR Appendix B;
 - (e) Litigation support contractors: contractors who are subject to an obligation, either by contract or trade practice, to maintain the confidentiality of any material received in performance of services related to this litigation and rendered for the attorneys of record in this litigation (by way of example and not limitation, “litigation support contractors” include copying services, court reporters, videographers, document storage and management contractors, database management contractors, and information technology and network support contractors);
 - (f) Experts: outside persons who are used by a party or its attorneys to furnish technical or expert services, and/or to give expert testimony in this litigation; and
 - (g) Third Party: Any party not directly involved in this litigation.
2. By identifying a document as “Restricted,” a party may designate any document, including interrogatory response, other discovery response, and/or transcript that it, in good faith, contends constitutes or contains trade secret, proprietary, source selection sensitive, or other similarly sensitive information which the owner thereof has taken reasonable measures to protect from disclosure to the public or competitors. In the case of the United States, other information and documents that may be identified as “Restricted” shall include:
- (a) Documents categorized as “FOR OFFICIAL USE ONLY (FOUO),” including unclassified information in the possession of, or under the control of the Department of Defense; and
 - (b) Trade secret, proprietary, source-selection sensitive, or other similarly sensitive information belonging to non-parties, but within the control or custody of the United States.
3. All Restricted 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

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those specified in Paragraph 4. Prohibited purposes include, but are not limited to, use for competitive purposes or the prosecution of additional intellectual property rights.

4. Absent a further Court order, access to any Restricted document shall be limited to:

- (a) The Court and its personnel;
- (b) Attorneys of record in the above-captioned litigation, to the extent they have agreed to be bound by this Protective Order, and any members or employees of their respective law firms or, in the case of the United States, the attorneys, legal assistants, and legal support staffs of the Department of Justice and any agency or department of the United States involved in this litigation;
- (c) Persons shown on the face of the document to have authored or received it;
- (d) Litigation support contractors;
- (e) Inside counsel of the parties, subject to the conditions of Paragraph 8;
- (f) A party's officers and employees directly involved in this litigation, whose access to the information is reasonably required to supervise, manage, or participate in this litigation, subject to the conditions of Paragraph 8;
- (g) Experts, subject to the conditions of Paragraph 8; and
- (h) Any other person or entity that the parties (including third parties, to the extent the third party has designated the document as "Restricted") mutually agree, in writing, may have access to Restricted documents.

5. The parties shall have the right to further designate Restricted documents or portions of Restricted documents as "Restricted—Attorneys' Eyes Only." Absent a further Court order, disclosure of such information shall be limited to the persons designated in Paragraphs 4(a), (b), (c), (d), (g) and, in addition, persons designated in Paragraph 4(h), to the extent the parties mutually agree in writing that the individual may have access to "Restricted—Attorneys' Eyes Only" documents.

6. Notwithstanding any other provision of this Protective Order, no information designated "Restricted—Attorneys' Eyes Only" shall be disclosed under this Protective Order to any individual

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involved in the prosecution of patent applications related to the subject matter of the claimed invention involved in this litigation. Individuals to whom “Restricted—Attorneys’ Eyes Only” information has been disclosed under this Protective Order, however, may provide copies of material prior art or other non-confidential information to counsel involved in prosecution to be provided to the United States Patent and Trademark Office. Unless otherwise agreed upon by the parties, no individual to whom “Restricted—Attorneys’ Eyes Only” information has been disclosed under this Protective Order shall be involved in the prosecution of patent applications related to the subject matter of the claimed invention involved in this litigation until one (1) year after the final disposition of this action, including all related appeals (the “Prosecution Bar”). The parties expressly agree that the Prosecution Bar set forth herein shall be personal to any attorney who reviews information designated “Restricted—Attorneys’ Eyes Only” and shall not be imputed to any other persons or attorneys at the attorney’s law firm or company unless information concerning that designated information was communicated to an individual by one who reviewed such designated information. For purposes of the Prosecution Bar, “prosecution” includes: (i) the drafting or amending of patent claims, or the supervising of the drafting or amending of patent claims; (ii) participating in or advising on any reexamination, reissue, *inter partes* review, or other post-grant review proceeding, except as specified below; and (iii) advising any client concerning strategies for obtaining or preserving patent rights related to the subject matter of the claimed invention involved in this litigation before the United States Patent and Trademark Office or other similar foreign government or agency. “Prosecution” does not include participating in or advising on any reexamination, reissue, *Inter Partes* review, or other post-grant review proceeding by a party’s lawyers with respect to any patents in which an opposing party involved in this litigation has any interest, or any patent involved in the pending action. Nothing contained herein shall preclude lawyers having access to documents designated as “Restricted—Attorneys’ Eyes Only” from having discussions with their clients about the general status of the case and about settlement offers so long as during any such discussions such lawyers do not impart any Restricted—Attorneys’ Eyes Only information to their clients.

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7. Third parties producing documents in the course of this litigation may also designate documents as “Restricted” or “Restricted—Attorneys’ Eyes Only,” subject to the same protections and constraints as the parties to the litigation. A copy of this Protective Order shall be served along with any subpoena served in connection with this litigation. All documents produced by such third parties, even if not designated by such third parties as “Restricted” or “Restricted—Attorneys’ Eyes Only,” shall be treated by the parties to this action as “Restricted—Attorneys’ Eyes Only” for a period of fifteen (15) days from the date of their production. During that fifteen day period, any party may designate such documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” pursuant to the terms of this Protective Order.

8. Each person who is to receive Restricted information pursuant to Paragraphs 4(e), (f), or (g) shall execute a “Written Assurance” document in the form found in the LPRCFC Appendix B. Opposing counsel shall be notified in writing at least ten (10) days prior to disclosure of Restricted information to any such person. Such notice shall provide a reasonable description of the outside person to whom disclosure is sought sufficient to permit objection to be made. Upon good cause (which does not include challenging the qualifications of such outside person), a party may object in writing to such disclosure within ten (10) days after receipt of notice by setting forth in detail the grounds on which the party’s objection is based. If a party objects within the ten-day period, no disclosure shall be made until the party seeking disclosure obtains the prior approval of the Court or the objecting party.

9. All depositions or portions of depositions taken in this litigation that contain information that may be designated “Restricted” or “Restricted—Attorneys’ Eyes Only,” according to Paragraphs 2 and 5, may themselves be so designated and thereby obtain the protections accorded other “Restricted” or “Restricted—Attorneys’ Eyes Only” documents. 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 final transcript. Unless otherwise agreed depositions shall be treated as “Restricted—Attorneys’ Eyes Only” until ten (10) days after receipt of the final transcript. The deposition of any witness (or any portion of such deposition) that includes Restricted information shall be taken only in the presence of persons who are qualified to have access to such information.

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10. Any party who fails to designate documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” may designate the documents after production to the same extent as it may have designated the documents before production by providing written notice of the error and substituting copies of the documents bearing appropriate designations. The party receiving the designation shall, upon receiving the replacement set of documents, immediately return or destroy the documents that lacked the designation to the designating party, and the parties shall undertake reasonable efforts to correct any disclosure of such information contrary to the designation. No showing of error, inadvertence, or excusable neglect shall be required for a party to avail itself of the provisions of this paragraph.

11. In addition to the requirements imposed by Federal Rule of Evidence 502 and RCFC 26(b)(5)(B), any party who inadvertently discloses documents that are privileged or otherwise immune from discovery shall, promptly upon discovery of the error, so advise in writing the receiving party and request that the documents be returned. The receiving party shall return or certify destruction of the documents, including all copies, within ten (10) days of receiving such a written request. The party returning or destroying such documents may thereafter seek reproduction of any such documents pursuant to applicable law, although the party seeking reproduction may not use the fact that the documents were previously produced inadvertently to argue that privilege or any other immunity from discovery has been waived. No showing of error, inadvertence, or excusable neglect shall be required for a party to avail itself of the provisions of this paragraph.

12. If a party intends to file a document containing Restricted information with the Court, this Protective Order grants leave to make such filing under seal. Prior to disclosure at trial or a hearing of materials or information “Restricted” or “Restricted—Attorneys’ Eyes Only,” the parties may seek further protections against public disclosure from the Court.

13. Any party may request a change in the designation of any information designated “Restricted” or “Restricted—Attorneys’ Eyes Only.” Any such document shall be treated as designated until such request is approved by the Court. If the disclosing party does not agree to the requested change in designation, the party seeking the change may move the Court for appropriate relief, providing notice to any third party

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whose designation of produced documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” in the litigation may be affected. The party asserting that the material is Restricted shall have the burden of proving that the information in question is within the scope of protection afforded by this Protective Order and RCFC 26(c).

14. Not later than sixty (60) days after the termination this litigation, including all related appeals, each party shall either destroy or return to the disclosing party all documents designated by the disclosing party as “Restricted” or “Restricted—Attorneys’ Eyes Only,” and all copies of such documents, and shall destroy all extracts and/or data taken from such documents. Each party shall provide a certification in writing to the disclosing party as to such return or destruction within the sixty-day period. Attorneys shall be entitled to retain, however, one set of all documents filed with the Court, obtained during discovery, or generated as correspondence in connection with the action, including one copy of documents designated “Restricted” or “Restricted—Attorneys’ Eyes Only.” Nothing in this order shall require deletion of data from tapes or other storage maintained solely for the purpose of permitting the rebuilding or recovery of files, provided that access to this data is restricted to those otherwise permitted access under this Protective Order.

15. Any party may move 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 access to documents as may be appropriate.

16. The obligations imposed by this Protective Order shall survive the termination of this litigation and all related appeals and shall remain in effect until the party designating the documents as “Restricted” or “Restricted—Attorneys’ Eyes Only” agrees otherwise in writing or a further court order otherwise directs.

17. Not later than sixty (60) days after the termination of this litigation, including all related appeals, the parties shall file a motion with the Court seeking leave to remove any physical materials designated “Restricted” or “Restricted—Attorneys’ Eyes Only” from the office of the Clerk of Court.

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18. Nothing in this Protective Order shall be construed to prevent any party from disclosing its own Restricted information in any manner that it considers appropriate.

19. In the event that any party seeks the production of documents containing material that may be classified, subject to International Traffic in Arms Regulations or other export controls, or otherwise restricted by federal law, the parties will confer regarding an appropriate resolution consistent with federal law. Notwithstanding anything contained in this Protective Order, National Security Information shall be controlled according to applicable statute.

20. The court reserves the right, after reviewing the record and other information submitted by the parties, to modify this Protective Order, or the parties' designation of materials or proceedings as "Restricted" or "Restricted—Attorneys' Eyes Only," in the event such materials or proceedings are not properly classified as confidential, privileged, proprietary, competition-sensitive, or otherwise protectable.

IT IS SO ORDERED.

/s/ _____
[Name of Judge]
Judge

Appendix B

WRITTEN ASSURANCE

I, _____, declare that:

1. My address is _____, and the address of my present employer is _____.
2. My present occupation or job description is _____
_____.
3. My present relationship to plaintiff/defendant(s) is _____
_____.
4. I have received a copy of the Stipulated Protective Order (the “Protective Order”) in this action.
5. I have carefully read and understand the provisions of the Protective Order, agree to be bound by it, and specifically agree I will not use or disclose to anyone any of the contents of any Restricted information received under the protection of the Protective Order.
6. I understand that I am to retain all copies of any of the materials that I receive which have been so designated as Restricted in a container, cabinet, drawer, room, or other safe place in a manner consistent with the Protective Order and that all copies are to remain in my custody until I have completed my assigned or legal duties. I will destroy or return to counsel all Restricted documents and things that come into my possession. I acknowledge that such return or the subsequent destruction of such materials shall not relieve me from any of the continuing obligations imposed upon me by the Protective Order.

I declare under penalty of perjury under the laws of the state where executed that the foregoing is true and correct.

Executed this _____ day of _____, 20_____, in the State of _____.

Signature