

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

No. 1:00-cv-00000

XXXX,

Plaintiff,

v.

XXXXX,

Defendant.

SCHEDULING ORDER FOR ALLEGED PATENT INFRINGEMENT

Pursuant to Federal Rule of Civil Procedure 16(b) and the Local Rules of this Court (except as modified herein), the Court enters the following schedule. Unless otherwise directed, the parties must observe the Federal Rules of Civil Procedure and this District's Local Rules.

Except with regard to venue, jurisdictional, and claim construction-related discovery, all other discovery is stayed until one business day after the claim construction hearing. The stay does not excuse the initial disclosures required by Paragraph 1. Notwithstanding the stay, the Court will permit limited discovery by agreement of the parties, or on request where exceptional circumstances warrant, such as discovery abroad under the Hague Convention.

A party may amend its preliminary contentions without leave of court if counsel certifies that it undertook reasonable efforts to prepare them and that the amendment rests on material identified after service. A party must do so upon identifying that material. Amending to add patent claims requires leave. After the deadlines in Paragraphs 13 and 14, leave is required for any amendment to infringement or invalidity contentions. Nothing in this paragraph shall relieve a party of

its duty to amend promptly in response to additional material.

The parties generally may agree to extend discovery deadlines, including the close of discovery, provided that the extension does not affect any subsequent deadlines and the parties notify the Court in writing. The Court retains the right to reject an agreed extension of a discovery deadline. Extensions of non-discovery deadlines and continuances of proceedings will not be granted, even upon joint motion, absent a showing of actual diligence and extraordinary cause.

If referred, the Magistrate Judge has the authority to adjust the scheduling order dates.

1.	[14 days following the initial pre-trial conference]	Initial Disclosures. The parties must serve the disclosures required by Rule 26(a)(1). The stay of discovery does not apply to this deadline. Preliminary Infringement Contentions. The party claiming patent infringement shall serve on all parties Preliminary Infringement Contentions ("PIC"). Separately for each opposing party, the PIC must include the following: (a) Each claim of each patent in suit that is allegedly infringed by each opposing party, including for each claim the applicable statutory subsections of 35 U.S.C. § 271 asserted;
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		(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus shall be identified by name or model number, if known. Each method or process shall be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process; (c) A chart identifying specifically where and how each limitation of each asserted claim is found within each Accused Instrumentality, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function; (d) For each claim which is alleged to have been indirectly
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		infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement. Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described; (e) Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality; (f) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; (g) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own or its licensee's apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party shall identify, separately for each asserted claim, each such
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		apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim; and (h) If a party claiming patent infringement alleges willful infringement, the basis for such allegation. With the PIC, the party claiming patent infringement shall produce to each opposing party or make available for inspection and copying: (a) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, or any public use of, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences
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		or is prior art under 35 U.S.C. § 102; (b) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified above, whichever is earlier; (c) A copy of the file history for each patent in suit; (d) All documents evidencing ownership of the patent rights by the party asserting patent infringement; and (e) All agreements, including licenses, transferring an interest in any patent in suit. The producing party shall separately identify by production number which documents correspond to each category. The party claiming patent infringement should assert no more claims than are reasonably necessary and should minimize the number of asserted claims.
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2.	[+60 days]	Preliminary Invalidity Contentions. Each party opposing a claim of patent infringement shall serve on all parties Preliminary Invalidity Contentions containing the following: (a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication shall be identified by its title, date of publication, and where feasible, author and publisher. Each alleged sale or public use shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known; (b) Whether each item of prior art anticipates each asserted claim or renders it obvious. If obviousness is alleged, an
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		explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness and the motivation to combine; (c) A chart identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; (d) An identification of any limitations the party contends are indefinite under 35 U.S.C. § 112(2) or lack enablement or written description under 35 U.S.C. § 112(1); and (e) An identification of any claims the party contends are directed to ineligible subject matter under 35 U.S.C. § 101. The § 101 contention shall (i) identify the alleged abstract idea, law of nature, and/or natural phenomenon in each challenged claim; (ii) identify each claim element alleged to be well-understood,
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		routine, and/or conventional; and (iii) to the extent not duplicative of the §§ 102 and 103 contentions, identify prior art for the contention that claim elements are well-understood, routine, and/or conventional. With the Preliminary Invalidity Contentions, the party opposing a claim of patent infringement shall produce or make available for inspection and copying: (a) All prior art referenced in the invalidity contentions that does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon shall be produced; and (b) Technical documents, including source code where applicable and necessary, sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified in the chart served under Paragraph 2. The producing party shall separately identify by production number which
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		documents correspond to each category. A party opposing a claim of patent infringement should rely on no more prior art references than are reasonably necessary and should minimize the number of references asserted.
3.	[+14 days]	Exchange of Claim Terms for Construction. The parties shall concurrently exchange a list of claim terms that a party believes should be construed by the Court and identify any claim element a party contends should be governed by 35 U.S.C. § 112(f). The parties should endeavor to limit the terms submitted to those genuinely in dispute and most significant to resolving the case.
4.	[+21 days]	Exchange of Proposed Constructions and Extrinsic Evidence. The parties shall concurrently exchange proposed constructions of each term identified by either party. For each term that any party contends is governed by 35 U.S.C. § 112(f), the exchange shall identify the structure(s), act(s), or material(s) corresponding to that term's function.

		At the same time, the parties shall disclose all extrinsic evidence, including without limitation dictionary definitions, citations to learned treatises and prior art, and the identity of any expert witness a party may rely upon with respect to claim construction or indefiniteness. With respect to any expert identified, the parties shall identify the scope of the topics for the witness's expected testimony. A claim construction expert report is not required. Any party may rely upon a rebuttal expert in response to a brief in which another party relies upon expert testimony. With respect to items of extrinsic evidence, the parties shall identify each such item by production number or produce a copy of any such item if not previously produced.
5.	[+14 days]	Meet and Confer to Narrow Terms. The parties shall meet and confer to narrow the terms in dispute by resolving differences and identifying the terms most significant to resolving the case. Within 5 business days after the conference, the parties shall file a joint report stating the terms on which they have agreed upon a construction, the terms remaining in dispute, and each party's proposed construction of each remaining term.

		Close of Claim Construction Discovery. The parties shall complete all claim construction discovery, including any depositions of witnesses identified under Paragraph 4.
6.	[+21 days]	Opening Claim Construction Brief. The party opposing a claim of patent infringement shall file its Opening Claim Construction Brief, with supporting evidence and any expert declarations. Limit: 20 pages, exclusive of the caption, signature block, any certificate, and exhibits.
7.	[+21 days]	Responsive Claim Construction Brief. The party claiming patent infringement shall file its Responsive Claim Construction Brief, with supporting evidence and any responsive expert declarations. Limit: 20 pages, exclusive of the caption, signature block, any certificate, and exhibits.
8.	[+14 days]	Reply Claim Construction Brief. The party opposing a claim of patent infringement shall file its Reply Claim Construction Brief. Limit: 10 pages, exclusive of the caption, signature block, any certificate, and exhibits.
9.	[+14 days]	Sur-Reply Claim Construction Brief.

		The party claiming patent infringement shall file its Sur-Reply Claim Construction Brief. Limit: 10 pages, exclusive of the caption, signature block, any certificate, and exhibits.
10.	[3 business days following the Sur-Reply]	Joint Claim Construction Statement. The parties shall file a Joint Claim Construction Statement containing: (a) Each term submitted for construction, each party's proposed construction, and an indication of which party or side proposed that term or whether it was proposed jointly; (b) The construction of those terms on which the parties agree; (c) The anticipated length of time necessary for the claim construction hearing; (d) Whether any party proposes to call one or more witnesses at the claim construction hearing, and the identity of each such witness; and (e) An identification of any factual findings requested from the Court related to claim construction. (f) Any plan to educate the Court on the technical issues at the claim construction hearing.

11.	As later set by the Court.	Claim Construction Hearing. The stay of discovery lifts one business day after the claim construction hearing.
12.	[10 days following the Court's claim construction order]	Joint Proposed Amended Scheduling Order. The parties shall jointly file a proposed amended scheduling order setting the deadlines in Paragraphs 13 through 23 as calendar dates, and email an editable copy to chambers. The parties must identify, and provide reasons supporting, any material deviation from the intervals set out below. If the parties cannot agree, they shall jointly file a proposed order briefly setting forth their respective positions on each deadline in dispute. The intervals in Paragraphs 13 through 23 govern unless and until the Court enters an amended scheduling order.
13.	[30 days following the claim construction order]	Final Infringement Contentions. The party claiming patent infringement shall serve its Final Infringement Contentions. No party may offer expert testimony, evidence, or argument at trial on any theory of infringement or invalidity,

		or on any prior art reference or combination of references, that was not disclosed in its final contentions.
14.	[+30 days]	Final Invalidity Contentions. Each party opposing a claim of patent infringement shall serve its Final Invalidity Contentions.
15.	[+30 days]	Motions to add new parties. The party causing the addition of a new party must provide copies of this Order and all previously entered Orders to the new party. This deadline does not modify the requirements of the Federal Rules of Civil Procedure regarding court action to join parties. <i>See, e.g.,</i> Fed. R. Civ. P. 21.
16.	[+30 days]	Motions for leave to amend pleadings. This deadline does not modify the requirements of the Federal Rules of Civil Procedure regarding leave of court to amend pleadings. <i>See, e.g.,</i> Fed. R. Civ. P. 15(a).
17.	[+30 days]	First Conference to Narrow Claims and Prior Art. The parties shall meet and confer to discuss significantly narrowing the number of asserted claims and prior art references at issue, and shall file a joint report on the results within 5 business days . Unless the parties

		agree to narrowing, they shall contact the Court to arrange a conference to resolve the disputed issues.
18.	[+30 days]	Experts (other than attorney's fees).¹ All parties with the initial burden of proof on an issue must file their designation of testifying experts and serve on all parties, but not file, the required report under Rule 26(a)(2).
19.	[+30 days]	Rebuttal experts. All parties opposing an issue on which another party bears the initial burden of proof must file their designation of testifying experts and serve on all parties, but not file, the required report under Rule 26(a)(2).
20.	[+35 days]	Completion of Discovery. The parties shall complete all discovery, including expert discovery, by this date. Discovery requests are not timely if the deadline for response under the Federal Rules of Civil Procedure falls after this date.
21.	[+14 days]	Second Conference to Narrow Claims and Prior Art. The parties shall meet and confer to discuss narrowing the number of

¹ Attorney's-fees experts are not subject to the expert-designation deadlines in this Order. Any claim for attorney's fees shall be presented after entry of final judgment by motion under Rule 54(d)(2), supported by affidavit.

		asserted claims and prior art references at issue to triable limits, and shall file a joint report on the results within 5 business days. Unless the parties agree to narrowing, they shall contact the Court to arrange a conference to resolve the disputed issues.
22.	[+7 days]	Mediation or settlement conference. By this date, but after the close of discovery, the parties and their respective lead counsel shall either attend mediation or hold a face-to-face meeting to discuss settlement. Individual parties and their counsel shall participate in person—not virtually. All other parties shall participate by both (1) counsel and (2) a representative or representatives who has settlement authority and who must participate in person. If a party has liability-insurance coverage as to any claim made against a party in this case, a representative of each insurance company providing such coverage, who shall have full authority to offer policy limits in settlement, shall be present at and participate in person. Within 7 days of the mediation or joint settlement conference, the parties must jointly prepare and file a written report, which must be signed by

		counsel for each party, detailing the date on which the mediation or settlement conference was held, the persons present (including the capacity of any representative), a statement regarding whether meaningful progress toward settlement was made, and a statement regarding the prospects of settlement.
23.	[+21 days]	Dispositive motions, <i>Daubert</i> motions, and nondispositive motions. No party may file any motion, except for a motion <i>in limine</i>, after this date without a showing of good cause. An objection to the reliability of an expert's proposed testimony under Federal Rule of Evidence 702 shall be made by motion filed on or before this date, specifically stating the basis for the objection and identifying the objectionable testimony. To the extent that parties anticipate seeking extensions of time to file a response or reply brief to a motion, the Court encourages the parties to submit an agreed briefing schedule rather than separate or <i>seriatim</i> extension requests. Motions to submit overlength briefs are disfavored. If no party files a dispositive motion, the parties must jointly file a notice informing the

		Court that no such motions will be filed, so that the Court may schedule the matter for trial.
24.	As later set by the Court.	Joint Pretrial Order and Motions <i>in Limine</i>. The parties must jointly file a Final Pretrial Order containing the information required by Local Rule CV-16(e), plus the following: <i>Witness narratives and classification.</i> For each witness identified under CV-16(e)(5), include (i) a brief narrative summary of expected testimony, (ii) a statement whether the witness has been deposed, and (iii) a designation as “probable,” “possible,” “expert,” or “record custodian.” A copy of the consolidated witness list shall be furnished to the court reporter before trial. <i>Joint annotated jury charge.</i> The proposed jury instructions and verdict form required by CV-16(e)(7) shall be submitted jointly, in Word format, annotated, with each disputed instruction identifying the proposing party and accompanied by citations to pattern instructions or controlling authority.

		<i>Deposition designations limited to unavailable witnesses.</i> The deposition designations required by CV-16(e)(6) shall be made only for witnesses qualifying as “unavailable” under Federal Rule of Civil Procedure 32(a)(4). The party offering the designation shall brief the basis for unavailability. Live witnesses shall not be presented by deposition. <i>Trial briefs</i> may be filed but are not required unless requested by the Court. The parties must file any motions <i>in limine</i>. Motions <i>in limine</i> should not be filed as a matter of course. Any motions should include an overview of the relevant factual background and citations to applicable law. The parties are ordered to meet and confer to resolve any disputes before filing any motion <i>in limine</i>. Any motion <i>in limine</i> must certify that the parties have satisfied this requirement. Any response to a motion <i>in limine</i> must be filed within 7 days of the day the motion is filed. Replies to
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		responses are not permitted except by leave of court.
25.	As later set by the Court.	Pretrial Conference. The Court will set this case for a final pretrial conference at a later time. The final pretrial conference shall be attended in person by at least one of the attorneys who will conduct the trial for each of the parties and by any unrepresented parties.
26.	As later set by the Court.	Jury Selection and Trial. Jury selection may be conducted by a Magistrate Judge and may occur the Friday before the case is set for trial.

So ordered by the Court on [Month Day, Year].

ANDREW DAVIS
United States District Judge

