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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

STANDING ORDER FOR PATENT CASES BEFORE JUDGE JAMES DONATO

These instructions apply to all patent cases assigned to Judge James Donato.

JOINT CLAIM CONSTRUCTION STATEMENT

1. The initial joint claim construction statement required by Patent Local Rule 4-3 must be truly joint. Disputed terms, phrases, and clauses must be designated as disputed. All other terms will be presumed to be undisputed. For any term in dispute, the parties must agree on the identity of the term. With regard to disputed terms, phrases, or clauses, the joint statement will list each disputed term, phrase, or clause (listed by claim); each party’s proposed construction; and support for each party’s proposed construction side by side. A model construction statement is attached to this Order.

2. Parties must attach to the joint claim construction statement copies of all patents in dispute. Parties must also make a complete prosecution history for each patent available to the Court upon request.

CLAIM CONSTRUCTION

3. As an initial matter, the Court will generally construe no more than ten terms. If multiple terms present identical issues, they may be grouped together or a representative term may be chosen, and each group or representative term may be considered a single term for purposes of the ten-term limit. If more than ten terms are at issue, the parties must meet and confer before the preparation of the joint claim construction statement to narrow the number of terms that are to be construed by the Court and shall jointly propose the ten terms requiring construction.

1 4. If a party genuinely believes that it will require that more than ten terms be
2 construed, that party may request leave to designate additional terms for construction, pursuant to
3 Civil Local Rule 7-11. The requesting party must demonstrate good cause and explain why other
4 methods of limiting the terms at issue (such as the selection of representative terms or any
5 grouping of terms by issues presented) would be ineffective. The request must be filed no later
6 than two weeks before the deadline for filing the joint claim construction statement. If good cause
7 is shown, the Court will either agree to construe all terms or schedule a second claim construction
8 proceeding on the excess terms. If more than ten terms are submitted for construction without
9 leave of court, the Court will construe only the first ten terms listed in the joint claim construction
10 statement and sanctions may be imposed.

11 5. Claim construction briefs must address each disputed term, but only those that are
12 truly disputed, following the order of the joint statement. The opening and opposition briefs may
13 not exceed 20 pages; the reply brief may not exceed 10 pages. The Court anticipates that a
14 meaningful meet and confer between the parties preceding the preparation of the joint claim
15 construction statement will eliminate the need for a party to propose in its briefs a claim
16 construction that differs from that proposed in the statement. While the Court encourages the
17 parties to negotiate mutually agreeable constructions, the parties may not propose new
18 constructions for the first time in reply briefs or other filings that do not afford the opposing party
19 an opportunity to respond. If for some exceptional reason a party needs to propose a different
20 construction in its brief than that found in the joint claim construction statement, that party must
21 submit a short request for consideration to the Court that clearly sets forth the new construction
22 and explains the basis for the change.

23 6. At the time of filing the reply briefs, the parties shall file an amended, final joint
24 claim construction statement if there has been any change in the parties' claim construction
25 positions, including in the amended statement only the remaining disputed terms, phrases, and
26 clauses.

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TUTORIAL AND CLAIM CONSTRUCTION HEARING

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2 7. The Court may schedule a tutorial to occur one to two weeks prior to the claim
3 construction hearing. Each side will generally be permitted 45-60 minutes to present a short
4 summary and explanation of the technology at issue. The patent holder makes the first
5 presentation. Demonstrations and visual aids are encouraged. The Court prefers that someone
6 other than counsel make the presentation. Counsel will be permitted to make opening remarks and
7 then a brief summation following the presentation. No argument will be permitted. The
8 proceeding is not recorded and parties may not rely on statements made at the tutorial in other
9 aspects of the litigation.

10 8. Depending on the technology involved, the Court may determine that the assistance
11 of a neutral expert would be helpful. In such an instance, the Court may direct the parties to
12 confer and, if possible, reach an agreement as to three experts in the field who would be
13 appropriate to act as a neutral expert to assist the Court during the claim construction proceedings
14 and/or the trial. The Court will then choose one to appoint as a neutral expert pursuant to Federal
15 Rule of Evidence 706. In such a situation, the parties will split the cost of the expert equally.

16 9. Prehearing conferences generally are not held. However, either party may request a
17 telephone conference within two weeks prior to the hearing, or the parties may address any
18 prehearing issues at the tutorial.

19 10. The patent holder will act as the moving party for the purposes of claim
20 construction. Opening briefs in support of claim construction must be filed at least six weeks
21 before the date of the claim construction hearing, and the briefing schedule set forth at Patent
22 Local Rule 4-5 will apply.

23 11. The Court will not ordinarily hear extrinsic evidence at the claim construction
24 hearing. Should it become apparent that testimony will be necessary, counsel may request a
25 telephone conference with the Court within two weeks of the hearing to seek the Court's approval.

26 12. Demonstrative exhibits and visual aids are permissible at the hearing as long as
27 they are based on information contained in the papers already filed. Counsel will exchange copies
28 of exhibits no later than 48 hours prior to the hearing.

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Sample Claim Chart

Claim Language (Disputed Terms in Bold) 'xxx Patent	Plaintiff's Proposed Construction and Evidence in Support	Defendant's Proposed Construction and Evidence in Support
<p>1. A method for counting ducks, comprising the steps of:</p> <p>[or]</p> <p>ducks</p> <p>Found in claim numbers:</p> <p>'xxx Patent: y,z 'xxx Patent: a,b</p>	<p>PROPOSED CONSTRUCTION: a bird that quacks.</p> <p>DICTIONARY/TREATISE DEFINITIONS: Webster's Dictionary (A duck: bird that quacks); Field Guide (A bird call: quack).</p> <p>INTRINSIC EVIDENCE: 'xxx Patent col. _:__ (A distinctive honking); Prosecution History at __ (This patent is distinguished from the prior art in that the quacking of the bird is featured).</p> <p>EXTRINSIC EVIDENCE: McDonald Depo. at xx:xx (A: I'd say the quacking makes it a duck); '123 Patent at col _:__; Donald Decl. at xx.</p>	<p>PROPOSED CONSTRUCTION: a bird that swims.</p> <p>DICTIONARY/TREATISE DEFINITIONS: Random House Dictionary (A duck: an aquatic bird); Field Guide (same).</p> <p>INTRINSIC EVIDENCE: 'xxx Patent col _:__ (Ducks may be found on or near bodies of water); Prosecution History at __ (Water fowl are particularly amenable to being counted by this method).</p> <p>EXTRINSIC EVIDENCE: G. Marx Depo at xx:xx (A: Like a duck to water); '456 Patent at col _:__; Daffy Decl. at xx.</p>

(Or any other substantively similar format that permits the court to compare terms side by side.)