

July 24, 2014

**INDIVIDUAL RULES OF PRACTICE IN CIVIL CASES**  
**KATHERINE B. FORREST, UNITED STATES DISTRICT JUDGE**

**Chambers**

United States District Court  
Southern District of New York  
500 Pearl Street, Room 1950  
New York, NY 10007  
(212) 805-0276

**Courtroom**

Joseph Pecorino, Courtroom Deputy  
Courtroom 15A  
500 Pearl Street  
(212) 805-0139

**Unless otherwise ordered by Judge Forrest, these Individual Rules of Practice shall apply to all civil matters, except that (i) in patent cases the procedures in Attachment B shall apply to the extent that they are inconsistent with these Individual Rules of Practice; and (ii) in cases designated to be part of one of the Court’s pilot programs or plans (e.g., the Section 1983 Plan), those procedures shall govern to the extent that they are inconsistent with these Individual Rules of Practice.**

**1. Communications with Chambers.**

**A. In General.** All communications with Chambers shall be submitted through the Electronic Case Filing (“ECF”) system only. All written communication with the Court shall include an ECF docket number.

For filings over 10 pages in length only, a hard copy shall be delivered to the Courthouse,<sup>1</sup> unless:

- i. Otherwise permitted by these rules; or
- ii. Otherwise permitted or ordered by the Court.

**B. Letters.** Communications about scheduling matters and discovery disputes shall be made by letter submitted via ECF only. Letters shall not exceed three (3) single-spaced pages in length (exclusive of letterhead and signature blocks) unless granted leave by the Court. Other motions may be made by letter as allowed by this Court; motions for summary judgment may never be submitted by letter.

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<sup>1</sup> Parties should not deliver letters directly to Chambers.

Letters that are informational in nature, and which do not request relief, should be filed using the ECF filing event “LETTER” under “OTHER DOCUMENTS.”

When counsel is seeking any of the relief described in the second bullet of Local ECF Rule 13.1, counsel shall use the ECF filing event “MOTION” and then indicate that the motion is a “LETTER-MOTION.”

When counsel is seeking by letter any other relief that the Court permits the parties to request by letter, including the relief described in Rule 2.F concerning discovery disputes, counsel shall use the ECF filing event “LETTER” under “OTHER DOCUMENTS.”

When communicating by letter, counsel shall not:

- i. Include the Court in correspondence between parties (unless relevant as an exhibit to a motion); or
- ii. Submit letters to Chambers containing argument or raising substantive disputes between the parties, except as permitted below under Rule 2.F or by Order of the Court.

**C. Telephone Calls.** Telephone calls to Chambers are permitted only for:

- i. Questions regarding docketing, scheduling, and calendar matters, see Rule 1.F and Rule 1.G below; and
- ii. Emergency situations requiring immediate attention. (In such situations only, call (212) 805-0276.)

The following calls to Chambers are never permitted:

- i. Ex parte calls (absent extraordinary justification, counsel for all affected parties should be on the line when a call to Chambers is placed, except that similarly situated parties may designate a lead counsel to represent them on such a call);
- ii. Calls from pro se litigants, which should be made to the Pro Se Office at (212) 805-0175; and
- iii. Calls requesting substantive or procedural legal advice.

**D. Faxes.** Faxes to Chambers are not permitted without prior permission.

E. **E-mails.** The Court does not accept e-mails with substance. Any substantial communications must be made by other means and filed on ECF. If an otherwise appropriate e-mail is being submitted, the title of the e-mail must include the name and case number in the subject line. If any party makes a request by e-mail, the request must be attached as a letter in .PDF format with a file name that includes the case number and date of the correspondence. Unless an e-mail contains materials to be reviewed in camera, all parties must be copied on all e-mails to the Court. The e-mail address to be used is [ForrestNYSDCChambers@nysd.uscourts.gov](mailto:ForrestNYSDCChambers@nysd.uscourts.gov).

F. **Docketing, Scheduling, and Calendar Matters.** For docketing, scheduling, and calendar matters, call (212) 805-0139 on weekdays between 9:00 A.M. and 4:30 P.M.

G. **Requests for Adjournments or Extensions.** Requests for adjournments, extensions of time, extensions of page lengths in memoranda, etc., shall be submitted to Chambers in writing, via ECF and e-mail.<sup>2</sup> Parties are not to submit stipulations sent through the Orders and Judgment Clerk. Requests shall:

- i. Be received in Chambers<sup>3</sup> at least two (2) business days prior to the scheduled appearance or deadline, absent an emergency; and
- ii. Include the following information:
  - a. The original due date (or page length, etc.);
  - b. The new date/dates (or page length, etc.) proposed by the party/parties (In general, the party/parties should propose the soonest suitable date.);
  - c. The number of previous requests for adjournment or extension;

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<sup>2</sup> If the letter and exhibits are over 10 pages in length, a courtesy must also be delivered to the Courthouse.

<sup>3</sup> Letters delivered to the Courthouse are not necessarily received by Chambers on the same day on which they arrive at the Courthouse. Counsel should anticipate up to a one-day delay from the time that a properly addressed letter arrives at the Courthouse to the time it reaches Chambers.

- d. Whether those previous requests were granted or denied;
- e. Whether the adversary consents, and, if not, the reasons given by the adversary for refusing consent; and
- f. A brief explanation of why the original date (or page length) is inappropriate and why the party/parties has/have chosen the new date (or page length).

**The Court will make an independent determination as to all scheduling. Parties should not expect the Court to automatically accept a stipulated agreement as to timing of any matter.**

Absent compelling circumstances, requests for extensions will be denied if not made before the expiration of the original deadline.

**H. Related Cases.** After an action has been accepted as related to a prior filing, all future court papers and correspondence must contain the docket number of the new filing, as well as the docket number of the case to which it is related (e.g., 11 Civ. 1234 [rel. 10 Civ. 4321]).

## **2. Motions.**

**A. Pre-Motion Conferences in Civil Cases.** Pre-motion letters or conferences are not required. Discovery disputes are governed by the procedures set forth in Rule 2.F. below.

**B. Filing of Motion Papers.** Motion papers shall be filed promptly after service. Discovery disputes are not raised by motion unless directed by the Court.

**C. Courtesy Copies.** One (1) courtesy copy of all motion papers and all accompanying exhibits, marked as such, should be delivered to the Courthouse directly after they are posted to ECF. All filings shall include the ECF docket number.

Parties should staple or spiral bind courtesy copies of memoranda of law separately from any accompanying exhibits. Parties should not velobind any documents or attach exhibits to the memoranda of law.

It is also helpful, but not required, to submit via e-mail or compact disc, electronic copies of all motion papers with hyperlinks to all citations. Parties should not submit such versions of their motion papers unless (1) their firms have the

capability to create such documents, and (2) creating such documents would not add materially to the expense of the litigation.

Parties need NOT submit courtesy copies of pro hac vice motions.

**D. Memoranda of Law.** Unless prior permission has been granted, memoranda of law in support of and in opposition to motions are limited to **25 pages**, and reply memoranda are limited to **10 pages**. Memoranda of 10 pages or more shall contain a table of contents and a table of authorities. Page limits are exclusive of signature block(s). Sur-reply memoranda will not be accepted without prior permission of the Court (and are generally disfavored). All memoranda shall be submitted in accordance with Local Civil Rule 11.1.

**E. Oral Argument on Motions.** The Court will determine whether argument will be heard and, if so, will advise counsel of the argument date. The Court does not hear argument on most motions.

**F. Discovery Disputes.** Parties shall follow Local Civil Rule 37.2, with the following modifications:

- i. Any party wishing to raise a discovery dispute with the Court must first confer in good faith with the opposing party, in person or by telephone, in an effort to resolve the dispute.
- ii. If the meet-and-confer process does not resolve the dispute, the party seeking relief may make a letter-motion setting forth the dispute.

Such letter-motion shall be no longer than three (3) single-spaced pages (exclusive of letterhead and signature block(s)), explaining the nature of the dispute, the meet-and-confer process, **the relief requested (in bold)**, and the party's rationale.

- iii. If the opposing party wishes to respond, it must do so within 72 hours of receipt of the original letter, unless the Court requests a shorter time. Letters not responded to within 72 hours shall be deemed unopposed. This means that:
  - a. If a letter-motion is submitted on a Monday, the response is due that Thursday.
  - b. If a letter-motion is submitted on a Tuesday, the response is due that Friday.

- c. If a letter-motion is submitted on a Wednesday, the response is due the following Monday.
  - d. If a letter-motion is submitted on a Thursday, the response is due the following Monday.
  - e. \*Friday Rule: If a letter-motion is submitted on a Friday, the response is due the following Wednesday at 12:00 P.M. E.S.T.
- iv. Except for pro se litigants, the parties must submit all discovery letter-motions and exhibits by ECF. If a letter contains exhibits, the party must also submit a hard copy. Pro se litigants should submit all materials directly to the pro se office.
  - v. Unless otherwise ordered, the Court will not accept replies in support of a discovery letter-motion.

**G. Default Judgments.** A plaintiff seeking a default judgment must proceed by way of a Motion for Default Judgment, pursuant to the procedure set forth in Attachment A.

### **3. Pretrial Procedures.**

**A. Joint Pretrial Orders in Civil Cases.** On the date directed by the Court—or, if no date is specifically directed, then no later than two business days before the final pretrial conference (“FPTC”)—parties in a civil jury case shall submit to the Court one (1) courtesy copy of a Joint Pretrial Order (“JPTO”). The JPTO for a jury trial shall include the following:

- i. The full caption of the action.
- ii. The names, addresses (including law firm names), and telephone and fax numbers of trial counsel.
- iii. The number of trial days requested.
- iv. Any jointly agreed stipulations or statements of fact or law.
- v. A statement by each party as to the actual witnesses whose testimony is expected to be offered in its case in chief, indicating whether such witnesses will testify in person or by deposition, and the true

estimated length of the testimony. The opposing party shall state the estimated length of time for cross-examination of any witnesses who will testify live. Absent exceptional circumstances, each witness testifying live will be called only once, even if multiple parties wish to make a direct examination of that witness. As such, for any witnesses to be called live, the parties should list such witness only once in the JPTO, along with the estimated total time that each party plans to examine that witness, including both direct and cross-examination.

- vi. A spreadsheet (preferably in Excel format) setting forth any/all designations of deposition testimony to be offered in each party's case in chief. The chart shall include four columns: (1) the offering party's designations of testimony; (2) any cross-designations or objections to the designations, including the basis and legal support for any objections; (3) the offering party's responses to any objections; and (4) an empty column for the Court's rulings. Any explanation should be concise, but sufficient to enable the Court to fully understand the basis for the objection/response and to rule on the objection.

An example may be found on the Court's website at [http://www.nysd.uscourts.gov/cases/show.php?db=judge\\_info&id=966](http://www.nysd.uscourts.gov/cases/show.php?db=judge_info&id=966)

Designations and counter-designations should be made in a full mini-script copy of the transcript of any deposition in which a party is designating testimony, with designations and counter-designations printed in different colors on the transcript. Objections maintained shall be colored red.

An example may be found on the Court's website at [http://www.nysd.uscourts.gov/cases/show.php?db=judge\\_info&id=965](http://www.nysd.uscourts.gov/cases/show.php?db=judge_info&id=965)

Parties should not submit deposition designations for witnesses appearing live.

- vii. A spreadsheet (preferably in Excel format) containing a list by each party of exhibits to be offered in its case in chief. The chart shall include four columns: (1) the exhibit number (PX1, PX2, DX1, DX2, etc.); (2) a brief description of the exhibit (e.g., "X-Ray image of

plaintiff's fibula\*\*"), marked with one star indicating where no party objects on grounds of authenticity and with two stars where no party objects on any ground; (3) the basis and any legal support for any objection to the exhibit; and (4) the offering party's responses to any objections. Any explanation should be concise, but sufficient to enable the Court to fully understand the basis for the objection/response and to rule on the objection.

An example may be found on the Court's website at [http://www.nysd.uscourts.gov/cases/show.php?db=judge\\_info&id=966](http://www.nysd.uscourts.gov/cases/show.php?db=judge_info&id=966)

All trial exhibits must be pre-marked by letter to indicate the party and by number to indicate the exhibit.

- viii. One copy of each documentary exhibit to which there is an objection, contained in a loose-leaf binder, organized by exhibit number. Each documentary exhibit should have the exhibit number stamped on the face of the document, in addition to any binder dividers that indicate the exhibit number.
- ix. Any motions in limine, with accompanying exhibits, which should be filed in a single document. Responses to such in limine motions shall be served at least three (3) business days prior to the Final Pretrial Conference, unless a different schedule is set by the Court.
- x. Joint requests to charge, joint verdict forms, and joint proposed voir dire questions. For any requests to charge, verdict form entries, or proposed voir dire for which the parties cannot agree, each party should clearly set forth its proposed charge or question, as well as the grounds on which the Court should use that charge or question and should include citations to any supporting case law sufficient to enable the Court to render a decision. All proposed charges should include footnotes with citations to the source of the proposed charge(s). When feasible, proposed jury charges should also be submitted via e-mail or compact disc in Microsoft Word 2007 format.

**B. Civil Bench Trials.** On the date directed by the Court—or, if no date is specifically directed, then no later than two business days before the final pretrial conference (“FPTC”)—parties in a civil bench trial shall submit to the Court one (1)



courtesy copy of a Joint Pretrial Order (“JPTO”). The JPTO for a bench trial shall include the following:

- i. All items set forth in sections (i)-(ix) above;
- ii. Proposed findings of fact and conclusions of law. Proposed findings of fact must have specific citations to the record, or expected testimony (or direct testimony submitted by affidavit), for each factual proposition (or that finding of fact shall be disregarded); and
- iii. Affidavits/declarations constituting the direct testimony of each trial witness, except for testimony of an adverse party, a person whose attendance must be compelled by subpoena, or a person for whom a party has requested and the Court has agreed to hear direct testimony during the trial.

**C. Trial Schedule.** Trials will generally be conducted Monday through Thursday from 9:00 A.M. to 5:00 P.M., with lunch from approximately 12:45 P.M. to 2:00 P.M. Parties should always be prepared to call their subsequent witnesses or, if no additional witnesses remain, to rest and make closing statements. The Court will direct parties to call their next witness or begin a closing statement even where the prior witness or statement has finished near the end of the trial day. If parties are not prepared to present their next witness before the end of a trial day, they will be deemed to have rested.

#### **4. Conferences.**

**A. Principal Trial Counsel.** The attorney who will serve as principal trial counsel must appear at all conferences with the Court.

**B. Initial Case Management Conference.** The Court will issue an Order scheduling the Initial Pretrial Conference (“IPTC”) on ECF. Once the Court has scheduled the IPTC, the parties shall comply with the following requirements:

- i. In actions where not all parties have appeared through counsel via ECF, all counsel in receipt of the Order scheduling the IPTC shall, forthwith:
  1. Notify all other parties (or, if known, their attorneys) of the IPTC by serving each of them with a copy of the Order

scheduling the IPTC and with a copy of these rules; and

2. File proof of such service with the Court.
- ii. At least four business days prior to the conference:
1. Counsel for all parties shall jointly submit a copy of a completed Scheduling Order form (available at <http://nysd.uscourts.gov/judge/Forrest>) via e-mail to [ForrestNYSChambers@nysd.uscourts.gov](mailto:ForrestNYSChambers@nysd.uscourts.gov); and
  2. If subject matter jurisdiction is based on diversity of citizenship, the party asserting diversity jurisdiction shall submit a letter explaining the basis for jurisdiction, see Rule 6.C below; and
  3. Each party shall submit one courtesy copy of any pleadings it has filed.
- iii. Prior to the conference, counsel for all parties shall:
1. Register as filing users in accordance with the Procedures for ECF;
  2. Confer with each other regarding each of the subjects to be considered at a Federal Rule of Civil Procedure 16 conference;
- iv. If one party is proceeding pro se, counsel for the other party or parties shall coordinate with the pro se litigant to ensure that the requirements of these rules are satisfied.

**C. Additional Conferences.** Additional conferences will be scheduled as needed.

**5. Withdrawal or Substitution as Counsel.**

Any attorney who has appeared as attorney of record and who seeks to withdraw as counsel or any party who seeks substitution of counsel shall comply with Local Civil Rule 1.4, and shall also apply to the Court in a letter or motion, which the Court will assess for such issues as prejudice to the parties and timing. The Court will so order a stipulation of substitution of counsel only if the parties have first or simultaneously submitted such a letter or motion.

**6. Policy on the Use of Electronic Devices.**

**A. Mobile Phones and Personal Electronic Devices.** Attorneys' use of mobile phones, smart phones, and other personal electronic devices within the Courthouse and its environs is governed by Standing Order M10-468 (available at <http://www.nysd.uscourts.gov/file/forms/standing-order-electronic-devices>).

**B. Computers, Printers, or Other Electronic Equipment.** In order for an attorney to bring into the Courthouse any computer, printer, or other electronic equipment not qualifying as a "personal electronic device," specific authorization is required by Court Order.

Any party seeking to bring such equipment into the Courthouse should file a letter as well as a completed copy of a draft Order pursuant to Standing Order M10-468 (available at <http://www.nysd.uscourts.gov/file/forms/standing-order-electronic-devices-form>) on ECF at least five (5) business days prior to the start of the proceedings in which such equipment is to be used. The draft Order shall identify the type(s) of equipment to be used and the name(s) of the attorney(s) or individual(s) who will be using the equipment. Chambers will coordinate with the District Executive's Office to issue the Order and forward a copy to counsel. The Order must be shown upon entering the Courthouse with the equipment.

**6. Other Pretrial Guidance.**

**A. Redactions and Filing Under Seal.** Any redactions or filings under seal should be made pursuant to a protective order "So Ordered" by the Court. In addition to the one (1) (unredacted) courtesy copy (which contain the legend "Filed Under Seal") provided pursuant to Rule 2.C., the parties should also provide the Court with one (1) redacted courtesy copy of the full set of papers in connection with any motion. Where the entirety of a voluminous filing (such as an administrative record) is to be filed under seal, the parties need not provide the Court with a redacted copy. The parties

should not have any expectation that materials filed under seal at one point in time will remain under seal for the entirety of the litigation.

**B. Settlement Agreements.** The Court will not retain jurisdiction to enforce settlement agreements except in unusual circumstances. Unless the parties demonstrate good cause why the Court should retain jurisdiction before providing the Court with the proposed settlement agreement, the Court will assume that the parties have consented to the agreement both as written and with the provision requiring the Court to retain jurisdiction stricken.

When the law requires Court approval of a settlement or when the parties have a particular request regarding their proposed settlement, the parties may either provide a copy of the settlement agreement for the Court to endorse or include the terms of their settlement agreement in their stipulation of settlement and dismissal.

In FLSA actions, parties seeking to settle or voluntarily dismiss their claims should submit:

- i. Any proposed settlement, in full;
- ii. A clear breakdown of what portion of the settlement, if any, will go toward attorneys' fees; and
- iii. Supporting papers demonstrating the fairness of any proposed settlement.

**C. Diversity Jurisdiction Cases.** In an action in which subject matter jurisdiction is based on diversity of citizenship under 28 U.S.C. § 1332, the party asserting the existence of such jurisdiction shall, prior to the IPTC, submit to the Court a letter not exceeding two (2) single-spaced pages (exclusive of letterhead and signature block(s)) explaining the basis for that party's belief that diversity jurisdiction exists. Where a party is a corporation, the letter shall state both the place of incorporation and the principal place of business. In cases in which a party is a partnership, limited partnership, limited liability company, or trust, the letter shall state the citizenship of each of the entity's members, shareholders, partners, and/or trustees.

**D. Bankruptcy Appeals.** Briefs in bankruptcy appeals shall be submitted in accordance with Fed. R. Bankr. P. 8009-10.

**E. Protective Orders.** Counsel should spend as little time as possible negotiating protective orders. Model protective orders are available on the Court's

website. If the parties cannot agree on a protective order, they should submit competing drafts, and the Court will So Order one of them.

## ATTACHMENT A

### **DEFAULT JUDGMENT PROCEDURE**

1. Obtain a certificate of default for each defaulting defendant from the Clerk's Office pursuant to Federal Rule of Civil Procedure Rule 55(a) and Local Civil Rule 55.1.
2. File a Motion for Default Judgment on ECF pursuant to Federal Rule of Civil Procedure 55(b)(2) and Local Civil Rule 55.2(b).
3. In connection with the Motion for Default Judgment, file the following on ECF (and deliver a courtesy copy to chambers):
  - a. A declaration or affidavit setting forth the basis for entering a default judgment, including:
    - i. A description of the method and date of service of the summons and complaint;
    - ii. The relevant procedural history, if any;
    - iii. Whether, if the default is applicable to fewer than all of the defendants, the Court may appropriately order a default judgment on the issue of damages prior to resolution of the entire action;
    - iv. The elements of each cause of action for which default is being sought and the allegations contained in the Complaint – with paragraph numbers specified – that support each of those elements;
    - v. The proposed damages, including interest, attorney's fees, and costs;
    - vi. Evidence in support of the proposed damages, including contemporaneous records and other such documentation;
    - vii. Legal authority for why an inquest is or is not necessary as to damages.
  - b. A proposed default judgment.
  - c. Copies of all pleadings.
  - d. A copy of the affidavit of service of the summons and Complaint.
  - e. If failure to answer is the basis for the default, a Certificate from the Clerk of Court stating that no answer has been filed.

## **ATTACHMENT B**

### **JUDGE FORREST'S PROCEDURES FOR PATENT CASES**

These patent procedures apply to all patent cases assigned to Judge Forrest. **The Individual Rules of Practice of this Court shall also apply to such actions, except to the extent that they are inconsistent with these procedures** (the parties should, for instance, propose dates by which all fact and expert discovery shall be completed, using the Court's proposed Scheduling Order (available on the Court's website)).

Unless other timeframes are set by the Court, the parties should comply with the following timeframes:

#### **1. Patent Disclosures.**

- a. Disclosure of Asserted Claims and Infringement Contentions.** Not later than **14 days after the initial pretrial conference**, a party claiming patent infringement shall serve a "Disclosure of Asserted Claims and Infringement Contentions." The "Disclosure of Asserted Claims and Infringement Contentions" shall contain the following information:
  - i. 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;
  - ii. 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;
  - iii. A chart identifying specifically where 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.
  - iv. For each claim that is alleged to have been indirectly 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.

- v. Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;
- vi. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and
- vii. If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party shall identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.
- viii. If a party claiming patent infringement alleges willful infringement, the basis for such allegation.

**b. Document Production Accompanying Disclosure.** Not later than 14 days after service of the “Disclosure of Asserted Claims and Infringement Contentions,” the party claiming patent infringement shall produce to each opposing party or make available for inspection and copying:

- i. 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 or is prior art under 35 U.S.C. § 102;
- ii. 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 pursuant to Procedure 1.a.vi, whichever is earlier;
- iii. A copy of the file history for each patent in suit; and



- iv. All documents evidencing ownership of the patent rights by the party asserting patent infringement.
- v. If a party identifies instrumentalities pursuant to Procedure 1.a.vii, documents sufficient to show the operation of any aspects or elements of such instrumentalities the patent claimant relies upon as embodying any asserted claims.

The producing party shall separately identify by production number which documents correspond to each category.

**c. Invalidity Contentions.** Not later than 14 days after service upon it of the document production accompanying the “Disclosure of Asserted Claims and Infringement Contentions,” each party opposing a claim of patent infringement shall serve its “Invalidity Contentions” which shall contain the following information:

- i. 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.

Prior art under 35 U.S.C. § 102(b) 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.

Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived.

Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

- ii. Whether each item of prior art anticipates each asserted claim or renders it obvious. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness;

- iii. A chart identifying where specifically 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; and
- iv. Any grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims.

**d. Document Production Accompanying Invalidity Contentions.** Not later than 14 days after service of the “Invalidity Contentions,” the party opposing a claim of patent infringement shall produce or make available for inspection and copying:

- i. Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its Procedure 1.a.iii chart; and
- ii. A copy or sample of the prior art identified pursuant to Procedure 1.c.i. which 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.

The producing party shall separately identify by production number which documents correspond to each category.

**e. Disclosure Requirement in Patent Cases for Declaratory Judgment of Invalidity.**

- i. Invalidity Contentions If No Claim of Infringement. In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is invalid Procedures 1.a and 1.b shall **not** apply unless and until a claim for patent infringement is made by a party. If the defendant does not assert a claim for patent infringement in its answer to the complaint, no later than 14 days after the defendant serves its answer, or 14 days after the Initial Pretrial Conference, whichever is later, the party seeking a declaratory judgment of invalidity shall serve upon each opposing party its Invalidity Contentions that conform to Procedure 1.c and produce or make available for inspection and copying the documents described in Procedure 1.d.

- ii. Inapplicability of Procedure. This Procedure 1.e shall not apply to cases in which a request for a declaratory judgment that a patent is invalid is filed in response to a complaint for infringement of the same patent.

f. **Amendment to Contentions.** Amendment of the Infringement Contentions or the Invalidity Contentions may be made only by order of the Court upon a timely showing of good cause.

## 2. **Claim Construction Proceedings.**

### a. **Exchange of Proposed Terms for Construction, Preliminary Constructions and Extrinsic Evidence.**

- i. Not later than 14 days after service of the “Invalidity Contentions” each party shall serve on each other party a list of claim terms which that party contends should be construed by the Court, and identify any claim term which that party contends should be governed by 35 U.S.C. § 112(6). Any party contending a claim should be construed shall also clearly and fully set forth its basis for its proposed construction.
- ii. Such party shall identify all references from the specification or prosecution history that support its proposed construction and designate any supporting extrinsic evidence. Extrinsic evidence shall be identified by production number or by producing a copy if not previously produced. With respect to any supporting witness, percipient or expert, the identifying party shall also provide a description of the substance of that witness’s proposed testimony that includes a listing of any opinions to be rendered in connection with claim construction.
- iii. The parties shall thereafter meet and confer for the purposes of limiting the terms in dispute by narrowing or resolving differences and preparing the Joint Claim Construction and Prehearing Statement.
- iv. The parties shall also jointly identify the 10 terms likely to be most significant to resolving the parties’ dispute, including those terms for which construction may be case or claim dispositive.

b. **Joint Claim Construction and Prehearing Statement.** Not later than 20 days after the exchange of proposed terms and preliminary constructions, the parties shall file with the Court a Joint Claim Construction and Chart, which shall contain the following information:

- i. The construction of those terms on which the parties agree;
- ii. Each party's proposed construction of each disputed term, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction;
- iii. An identification of the terms whose construction will be most significant to the resolution of the case up to a maximum of 10. The parties shall also identify any term among the 10 whose construction will be case or claim dispositive. If the parties cannot agree on the 10 most significant terms, the parties shall identify the ones which they do agree are most significant and then they may evenly divide the remainder with each party identifying what it believes are the remaining most significant terms. However, the total terms identified by all parties as most significant cannot exceed 10. For example, in a case involving two parties, if the parties agree upon the identification of five terms as most significant, each may only identify two additional terms as most significant; if the parties agree upon eight such terms, each party may only identify only one additional term as most significant.

**c. Claim Construction Briefs.**

- i. Not later than 20 days after serving and filing the Joint Claim Construction Chart, the party claiming patent infringement, or the party asserting invalidity if there is no infringement issue present in the case, shall serve and file an opening brief and any evidence supporting its claim construction.
- ii. Not later than 10 days after service upon it of an opening brief, each opposing party shall serve and file its responsive brief and supporting evidence.
- iii. Not later than 5 days after service upon it of a responsive brief, the party claiming patent infringement, or the party asserting invalidity if there is no infringement issue present in the case, shall serve and file any reply brief and any evidence directly rebutting the supporting evidence contained in an opposing party's response.
- iv. The page-length guidelines set forth in Rule 2(D) above for motions also apply to claim construction briefs.

- d. Technical Tutorials.** If either party intends to provide a “technical tutorial,” the Court prefers that those be accomplished through expert affidavit/PowerPoint/video, and be submitted at least one week in advance of the *Markman* hearing. The parties should confer with the Court as to whether “attorney argument” would be useful or acceptable in connection with any technical tutorial.
- e. Claim Construction Hearing.** Subject to the convenience of the Court’s calendar and to the extent necessary for claim construction, two weeks following submission of the reply brief specified in Procedure 2.c.iii, the Court shall conduct a *Markman* hearing.