

Proposed Amendments to United States District Court for the District of Maryland Local Rules for Patent Cases.

Overview

The proposed amendments to the Court's Local Rules for Patent Cases seek to accomplish three goals:

1. Removal of outdated statutory citations.
2. Simplification of the rules pertaining to claim construction procedures by creating one subsection to establish such procedures for three types of cases and eliminating two lengthy and duplicative subsections.
3. Revising the procedures and sequence of the claim construction process for most cases by (a) requiring simultaneous, rather than staggered disclosure of parties' proposed claim constructions; (b) expressly providing for the filing of reply claim construction briefs; and (c) shifting the timing of the parties' Joint Claim Construction Statement from the beginning of the briefing process to after the completion of the briefing process.

Summary of Changes Effected by Proposed Amendments and Rationales

Proposed Change	Rationale
Removal of references to provisions of the Patent Act that were eliminated through the America Invents Act. The References to prior art under 35 U.S.C. §102(b) in the Initial Disclosure provisions were eliminated [e.g., 804(c)]. References to prior art under 35 U.S.C. §§102(f) and (g) are now specially in connection with pre-AIA claims.	Some of the statutory provisions referenced in the existing rules, which went into effect July 1, 2011, were eliminated when the America Invents Act (AIA) went into effect as of September 16, 2011. Pre-AIA 35 U.S.C. §§102(f) and (g) may still apply in cases involving patents issued prior to that date.
Removal of unnecessarily duplicative or unhelpful provisions.	
<ul style="list-style-type: none">• Revision of LR 805.1 to establish claim construction procedures applicable to infringement, invalidity and Hatch Waxman cases and eliminating existing Rules 805.2 and 805.3. The existing rules have three separate multi-page	Having the claim construction process defined for the three most common types of patent cases in one [Rev. 805.1], rather than three subsections is simpler and potentially less confusing.

<p>subsections [805.1, 805.2 and 805.3] setting forth schedules for procedural steps in the claim construction process for cases involving claims of infringement, cases seeking declaratory judgment of patent invalidity (and not claims of infringement), and cases arising under the Hatch Waxman Act (21 U.S.C. §355). Many parts of those sub-subsections are duplicative. The proposed revisions would set forth the schedules for all three of those case types in one subsection.</p>	
<ul style="list-style-type: none"> • Elimination of existing LR 807. Existing Rule 807, requiring motions requesting a stay of a case pending reexamination of a related patent by U.S. Patent and Trademark Office to be accompanied by a Reexamination Order and a First Office Action is ambiguous as to its application to matters in which (a) there are multiple patents in suit relating to the same invention and less than all of the patents are subject to re-examination; or (b) where more than one patent in suit is subject to reexamination and a First Office Actions has been issued as to one but not all. 	<p>Rather than fashioning a rule to capture all possible scenarios, the Committee thinks it makes more sense to eliminate the ambiguous rule and allow litigants and the Court to work out questions of stays on a case-by-case basis.</p>
<p>Changes to Claim Construction Procedure</p>	
<ul style="list-style-type: none"> • Revision of LR 805.1 to provide for simultaneous disclosure of initial proposed claim constructions. The existing rules begin the claim construction process by staggering the parties' disclosure of the proposed claim constructions, with one party (plaintiff in cases involving claims of infringement; defendant in cases seeking declaratory judgment of invalidity but no claims of infringement and in Hatch Waxman cases) serving a Proposed Claim Construction Statement 60 days after the entry of a Scheduling Order [805.1(b); 805.2(b); 805.3(b)], followed 30 days later by the opposing party's service of Responsive Claim Construction Statement. [805.1(d). 805.2(c), 805.3(c)] The parties file a Joint Claim Construction Statement and their opening claim 	<p>In the most common cases, involving claims of infringement <u>and</u> defenses or counterclaims seeking declarations of patent invalidity, the staggered approach of the existing rules results in defendants having sixty days to devise all of the arguments for their opening claim construction briefs and plaintiffs having only 30 days to formulate arguments regarding construction of claims identified for the first time by defendants. The Committee believes that simultaneous identification of claims the parties believe require construction and simultaneous exchange of proposed constructions in advance of opening claim construction briefs levels the playing field.</p>

<p>construction briefs 30 days later. [805.1(f), (g); 805.2(e), (f); 805.3(e), (f)] The proposed revisions would have the claim construction process begin with all parties in such cases simultaneously serving lists of the claims they assert will require construction [Rev. 805.1(a)], followed 14 days later by a simultaneous exchange of Preliminary Claim Constructions [Rev. 805.1(b)], with the parties' opening claim construction briefs due 35 days later. [Rev. 805.1(c)]</p>	
<ul style="list-style-type: none"> • Revision of LR 805.1 to provide for reply claim construction briefs. The existing rules contemplate the filing of opening and responsive claim construction briefs, but not reply briefs. The proposed revisions would provide for reply briefs to be filed within 14 days of the filing of responsive briefs. [Rev. 805.1(c)(iii)] With slight adjustments to other deadlines, the deadline for the reply briefs would only extend the total pre-hearing claim construction process by 9 days to 159 days from the date a Scheduling Order is issued, compared to 150 days under the current rules. 	<p>The Court's general Local Rules for Civil matters contemplate the filing of reply briefs and the Committee expects that reply claim construction briefs are frequently filed in patent cases notwithstanding the lack of mention in the current rules. Adding a provision expressly permitting replies will eliminate a need to file requests for leave to file replies, and better joins the issues for the Court to decide.</p>
<ul style="list-style-type: none"> • Revision of LR 805.1 to schedule filing of Joint Claim Construction Statement after close of briefing. The existing Rules contemplate that the parties in cases involving claims of infringement, cases seeking declaratory judgment of patent invalidity (and not claims of infringement), and cases arising under the Hath Waxman Act will file a Joint Claim Construction Statement with the Court simultaneously with the filing of opening claim construction briefs. [805.1(f), (g); 805.2(e), (f); 805.3(e), (f)] The revised rule would have the parties submit file the Joint Claim Construction Statement 7 days after the completion of the briefing process (including reply briefs). [Rev. 805.1(d)] 	<p>Parties' positions on claim construction are usually not fully developed until the briefing process is completed. Scheduling the filing of a Joint Claim Construction Statement to occur after the completion of the briefing process should result in a joint statement that is more helpful to the Court.</p>

Claim Construction Process Timelines

Days from Scheduling Order	Existing Rules		Days from Scheduling Order	Proposed Amended Rules	
60 ¹	<p>In cases involving claims of infringement Party asserting infringement serves Claim Chart and Proposed Claim Construction Statement.</p> <p>In cases seeking declaratory judgment of invalidity (and there are no infringement claims) Party asserting invalidity serves Claim Chart and Proposed Claim Construction Statement focusing on claims allegedly invalid.</p> <p>In Hatch Waxman Act cases Defendant serves Claim Chart and Proposed Claim Construction Statement</p>	<p>805.1(a), (b)</p> <p>805.2(a), (b)</p> <p>805.3(a), (b)</p>	<p>70</p> <p>42²</p>	<p>Parties simultaneously exchange proposed Terms for Construction in cases.</p> <p>In cases involving claims of infringement (including Hatch Waxman Act cases)</p> <p>In cases seeking declaratory judgment of invalidity (and there are no infringement claims)</p>	Rev. 805.1(a)

¹ The Claim Construction schedule in the Existing Rules is expressly keyed to the date the Scheduling Order is issued.

² The Claim Construction schedule in the Proposed Amended Rules starts 14 days from the Initial Disclosure of Invalidity Contentions, the deadline for which, as amended, would be 56 days from the date of the Scheduling Order in cases involving claims of infringement, and 28 days in cases seeking only declaratory judgment of invalidity. Rev. 804.1(c). Thus, the schedule under the Proposed Amended Rules starts as late as 70 days from the date of the Scheduling Order for cases involving claims of infringement, including Hatch Waxman cases, and 42 days from the date of the Scheduling order for cases seeking only declaratory judgment of invalidity.

Days from Scheduling Order	Existing Rules		Days from Scheduling Order	Proposed Amended Rules	
90	In cases involving claims of infringement Alleged infringer serves Responsive Claim Chart and Responsive Claim Construction Statement	805.1(c), (d)	84 56	Simultaneous exchange of Preliminary Claim Constructions and identity of extrinsic evidence	Rev. 805.1(b)(i), (ii)
	In cases seeking declaratory judgment of invalidity (and there are no infringement claims) Opposing parties serve Responsive Construction Statement	805.2(c)		In cases involving claims of infringement (including Hatch Waxman Act cases)	
	In Hatch Waxman Act cases Plaintiff serves Responsive Claim Construction Statement.	805.3(c)		In cases seeking declaratory judgment of invalidity (and there are no infringement claims)	
120	In cases involving claims of infringement Parties file Joint Claim Construction Statement and opening claim construction briefs	805.1(f), (g)	119 91	Simultaneous filing of opening claim construction briefs	Rev. 805.1(c)(i)
	In cases seeking declaratory judgment of invalidity (and there are no infringement claims)	805.2(e), (f)		In cases involving claims of infringement (including Hatch Waxman Act cases) In cases seeking declaratory judgment of invalidity (and	

Days from Scheduling Order	Existing Rules		Days from Scheduling Order	Proposed Amended Rules	
	Parties file Joint Claim Construction Statement and opening claim construction briefs In Hatch Waxman Act cases Parties file Joint Claim Construction Statement and opening claim construction briefs	805.3(e), (f)		there are no infringement claims)	
150	In cases involving claims of infringement Parties file responsive claim construction briefs In cases seeking declaratory judgment of invalidity (and there are no infringement claims) Parties file responsive claim construction briefs In Hatch Waxman Act cases Parties file responsive claim construction briefs	805.1(h) 805.2(g) 805.3(g)	137 119	Simultaneous filing of responsive claim construction briefs In cases involving claims of infringement (including Hatch Waxman Act cases) In cases seeking declaratory judgment of invalidity (and there are no infringement claims)	Rev. 805.1(c)(ii)
			152	Simultaneous filing of reply claim construction briefs	Rev. 805.1(c)(iii)

