

**Summary of the Proposed Amendments to the Local Patent
Rules of the Western District of New York to be
Effective January 1, 2023.**

The Western District of New York's Local Rules Committee, which is comprised of Court personnel and members of the bar of this Court, convenes on an annual basis to ensure that the Local Rules conform to the Federal Rules amendments and current practices of this Court, as well as to address any Local Rule concerns raised by our bar. The committee proposes amendments to the Court for consideration. This year's proposed amendments to the Local Patent Rules are set forth below.

Purpose of proposed amendments:

The Local Rules Committee's proposed amendments relate to the timelines in patent cases. The committee aimed to make changes that were more consistent with periods of time between deadlines and disclosures. The proposed amendments do not extend any deadlines because the intent of the amendments was to shorten the time it takes to complete patent litigation.

Redline version of proposed amendments:

UNITED STATES DISTRICT COURT

FOR THE

WESTERN DISTRICT OF NEW YORK



**LOCAL PATENT RULES
(Effective January 1, 2019)**

LOCAL PATENT RULES

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RULE 1
INTRODUCTION

1.1 Preamble

Because of the complexities and uniqueness of issues associated with the management of patent infringement litigation, and to ensure just, efficient, and economical handling of such cases, the United States District Court for the Western District of New York hereby enacts the following rules of practice for patent cases before the Court. These rules are calculated to provide a standard structure for addressing the issues which typically arise in such cases, and to foster predictability and facilitate planning for the litigants and the Court. A timeline reflecting the due dates for all submissions pursuant to these rules is attached as Appendix A.

1.2 Scope and Construction

These rules apply to all civil actions filed in or transferred to this Court which allege infringement of a patent in a complaint, counterclaim, cross-claim or third-party claim, or which seek a declaratory judgment that a patent is not infringed, is invalid or is unenforceable. The local civil rules of this Court shall also apply to such actions, except to the extent that they are inconsistent with these local patent rules.

1.3 Modifications of These Rules

The Court may, in its discretion, modify any of the obligations or deadlines set forth in these proposed rules based upon the circumstances of any particular case including, without limitation, the degree of complexity of the case as shown by the number of patents, products, or parties involved. Such modifications will in most instances be made at the initial Case Management Conference pursuant to Fed. R. Civ. P. 16, but may be made at other times by the Court either *sua sponte* or at the request of a party, upon a showing of good cause. In advance of submission (by letter or motion as appropriate) of any request for modification, the parties must meet and confer for the purpose of reaching an agreement, if possible, upon any modification.

1.4 Citation

These rules shall be cited as “L. Pat. R. ____.”

RULE 2

GENERAL PROVISIONS

2.1 Initial Case Management Conference

(a) At least twenty-one (21) days prior to the scheduled Case Management Conference (“CMC”) pursuant to Fed. R. Civ. P. 16, the parties must confer, in person or by telephone, pursuant to Fed. R. Civ. P. 26(f) to formulate a Case Management Plan and to address the following topics:

- (1)** Proposed modification of the obligations or deadlines set forth in these local patent rules to ensure that they are suitable for the circumstances of the particular case (*see* L. Pat. R. 1.3), including the scope and timing of any claim construction discovery, including disclosure of and discovery from any expert witness permitted by the Court;
- (2)** The format of the claim construction hearing, including whether the parties wish the Court to hear live testimony, the order of presentation, and the estimated length of the hearing;
- (3)** How the parties intend to educate the Court with respect to the patent(s) at issue;
- (4)** The need for alteration of the standard confidentiality order to supersede that which would otherwise be entered by the court pursuant to L. Pat. R. 2.2;
- (5)** The timing and scope of mandatory disclosures required pursuant to Fed. R. Civ. P. 26(a)(1). Among the disclosures which ordinarily must be made pursuant to Rule 26(a)(1) in cases covered by these rules is information and documentation regarding proof of patent ownership or standing to assert patent infringement claims; and
- (6)** Whether the Court should issue the “Model Order Regarding E-Discovery in Patent Cases” in a particular action. The presumption is that the Court will issue such an Order, which may be modified in the Court’s discretion or by agreement of the Parties. The Model Order Regarding E-Discovery in Patent Cases is attached to these rules as Appendix B.

(b) Not later than seven (7) days prior to the scheduled CMC the parties shall jointly file a proposed Case Management Plan addressing the various issues identified above and included in Fed. R. Civ. P. 26, based upon the parties’ discussions during their Rule 26(f) meeting.

2.2 Confidentiality

(a) Discovery cannot be withheld or delayed on the basis of confidentiality absent Court order. Pending entry of a confidentiality order, discovery and disclosures designated confidential by a party shall be produced to the adverse party for outside counsels' Attorneys' Eyes Only, solely for purposes of the pending case and shall not be disclosed to the client or any other person.

(b) Not later than fourteen (14) days after the initial CMC the parties shall submit either a stipulated confidentiality order pursuant to Fed. R. Civ. P. 26(c) or, if agreement cannot be reached, shall each submit a counter proposed confidentiality order for the Court's consideration, highlighting for the Court any areas of disagreement.

2.3 Relationship to Federal Rules of Civil Procedure

(a) Except as provided in this paragraph or as otherwise ordered, it shall not be a ground for objecting to an opposing party's discovery request (*e.g.*, interrogatory, document request, request for admission, deposition question) or declining to provide information otherwise required to be disclosed pursuant to Fed. R. Civ. P. 26(a)(1), that the discovery request or disclosure requirement is premature in light of, or otherwise conflicts with, these local patent rules, absent other legitimate objection. A party may object, however, to responding to the following categories of discovery requests (or decline to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) on the ground that they are premature in light of the timetable provided in these local patent rules:

- (1)** Requests seeking to elicit a party's claim construction position;
- (2)** Requests seeking to elicit from the patentee a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, design, variety of plant or other instrumentality;
- (3)** Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art; and
- (4)** Requests seeking to elicit from an accused infringer the identification of any advice of counsel received, and related documents.

(b) Where a party properly objects to a discovery request (or declines to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) as set forth above, that party shall provide the requested information on the date on which it is required to be disclosed to an opposing party under these local patent rules or as set by the Court, unless there exists another legitimate ground for objection.

2.4 Exchange of Expert Materials

(a) Disclosures of claim construction expert materials and depositions of such experts are governed by L. Pat. R. 4.3 and 4.5, unless otherwise ordered by the Court.

(b) Disclosure of expert materials related to issues other than claim construction will not be required until claim construction issues have been decided, and shall be governed by the provisions of L. Pat. R. 5.3 and 5.4.

RULE 3

PATENT DISCLOSURES

3.1 Disclosure of Asserted Claims and Infringement Contentions

Not later than fourteen (14) days after the initial CMC, a party claiming patent infringement shall serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.” Separately for each opposing party, the “Disclosure of Asserted Claims and Infringement Contentions” shall contain the following information:

(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;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, design, variety of plant 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, design, variety of plant 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) (i) Except for design or variety of plant patent claim(s), 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;

(ii) For each design patent or variety of plant patent claim that is alleged, a chart displaying each view of the design or variety of plant patent drawings and a view of the accused design or variety of plant from every available angle for all embodiments.

(d) 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 any 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) Except for design or variety of plant patent claims(s), 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 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; and

(h) If a party claiming patent infringement alleges willful infringement, all known bases for such allegation. A party claiming willful infringement shall be permitted to supplement its response to this subsection at or prior to the close of fact discovery, if necessary, to add facts developed through pretrial discovery.

(i) To comply with L. Pat. R. 3.1, a party claiming patent infringement may use a chart following the format provided in Appendix C.

3.2 Document Production Accompanying Infringement Disclosure

With 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:

(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 or is prior art under 35 U.S.C. § 102;

(b) 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 L. Pat. R. 3.1(f), whichever is earlier;

(c) A copy of the file history for each patent in suit;

(d) Documents evidencing ownership and maintenance of the patent rights by the party asserting patent infringement;

(e) If a party identifies instrumentalities pursuant to L. Pat. R. 3.1(g), documents sufficient to show the operation of any aspects or elements of such instrumentalities the patent claimant relies upon as embodying any asserted claims; and

(f) With respect to each of the above document productions, the producing party shall separately identify by production number which documents correspond to each category.

3.3 Non-Infringement and Invalidity

Not later than ~~sixty (60)~~fifty-six (56) days after service upon it of the “Disclosure of Asserted Claims and Infringement Contentions”, each party opposing a claim of patent infringement on the basis of non-infringement or patent invalidity shall serve on all parties its “Disclosure of Non-Infringement and Invalidity Contentions” which shall contain the following information:

- (a)**
 - (i) Except for design or variety of plant patent claim(s) Non-Infringement Contentions shall contain a chart, responsive to the chart required under L. Pat. R. 3.1(c)(i), that identifies as to each limitation in each asserted claim disclosed in the patentee’s claim chart, to the extent then known by the party alleging infringement, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality and, if not, the reason for such denial and the relevant distinctions;
 - (ii) For each design patent or variety of plant patent claim that is alleged, a chart, responsive to the chart required under L. Pat. R. 3.1(c)(ii), that displays a view from each angle of the accused design or variety of plant and of all embodiments and stating whether the accused design or variety of plant is substantially similar to the claimed design or variety of plant and, if not, the reasons for such a denial.

(b) Invalidity Contentions must contain the following information to the extent then known to the party asserting invalidity:¹

- (1)** Whether the first inventor to file provision of the Leahy-Smith America Invents Act (“AIA”) applies to each asserted claim.
- (2)** The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious, including in the case of a design or variety of plant patent, a view from every available angle and all available embodiments. 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, the location where the item was sold or publicly used, and the identity of the person or entity which made the use or which made and received the offer, or

¹ Consistent with the Leahy-Smith America Invents Act, references to 35 U.S.C. §§ 102, 103, and 112 in these Local Patent Rules refer to patents in dispute that were filed, or claim priority to a date, prior to March 16, 2013. To the extent a patent or patents in dispute were filed, or claim priority to a date, on or after March 16, 2013, any references to §§ 102, 103, and 112 should be interpreted under the applicable language and nomenclature provided in the Leahy-Smith America Invents Act.

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);

- (3) 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, the reason why one of ordinary skill in the art would have combined the references at the time of the invention in issue in the case, and identification of what the accused considers to be the primary reference;
- (4) A chart identifying where specifically in each alleged item of prior art each limitation or view of each asserted claim is found, and for utility patents, 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
- (5) 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.

(c) To comply with L. Pat. R. 3.3, a party opposing a claim of patent infringement may use a chart following the format provided in Appendix D.

3.4 Document Production Accompanying Non-Infringement and Invalidity Disclosure

With the “Disclosure of Non-Infringement and Invalidity Contentions”, the party opposing a claim of patent infringement shall produce or make available for inspection and copying, if not previously disclosed pursuant to Fed. R. Civ. P. 26(a)(1), the following:

(a) Source code, specifications, schematics, flow charts, artwork, drawings, photographs, video or other images from every available view or other documentation sufficient to show the operation, composition, design, variety of plant or structure of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its L. Pat. R. 3.1(c) chart;

(b) A copy or sample of the prior art identified pursuant to L. Pat. R. 3.3(b) 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. In addition, if any portion or complete English translation is in the possession of the producing party, and was relied upon, that too shall be produced; and

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

3.5 Responses to Invalidity Contentions

Not later than ~~thirty (30)~~twenty-eight (28) days after service upon it of the “Disclosure of Non-Infringement and Invalidity Contentions”, each party defending the validity of the patent shall serve on all parties its “Responses to Invalidity Contentions” which must include a response to each Invalidity Contention set forth under L. Pat. R. 3.3 including the following:

(a) If asserted by the party asserting invalidity, a response to whether the first to file provision of the AIA applies to each asserted claim;

(b) For each item of asserted prior art, the identification of each limitation of each asserted claim that the party believes is absent from the prior art, except for design patents, where the party shall supply an explanation why the prior art does not anticipate the claim;

(c) If obviousness is alleged, an explanation of why the prior art does not render the asserted claim obvious;

(d) The party’s responses shall follow the order of the invalidity chart required under L. Pat. R. 3.3(b)(4) and (c), and shall set forth the party’s agreement or disagreement with each allegation therein and the written basis thereof; and

(e) A response to each ground of invalidity asserted under L. Pat. R. 3.3(b)(5).

3.6 Disclosure Requirement in Patent Cases for Declaratory Judgment of Non-Infringement and Invalidity

(a) **Non-Infringement and 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 not infringed or is invalid, L. Pat. R. 3.1 and 3.2 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, not later than ~~forty-five (45)~~forty-two (42) days after the defendant serves its answer or ~~forty-five (45)~~forty-two (42) days after the CMC, whichever is later, the party seeking a declaratory judgment of non-infringement or invalidity shall serve upon each opposing party its “Disclosure of Non-Infringement and Invalidity Contentions” that conforms to L. Pat. R. 3.3 and produce or make available for inspection and copying the documents described in L. Pat. R. 3.4.

(b) **Inapplicability of Rule.** L. Pat. R. 3.6 shall not apply to cases in which a request for a declaratory judgment that a patent is not infringed or invalid is filed in response to a complaint for infringement of the same patent, in which case the provisions of L. Pat. R. 3.3 shall govern.

3.7 Final Infringement and Invalidity Contentions

A party claiming patent infringement must serve on all other parties “Final Infringement Contentions” containing the information required by L. Pat. R. 3.1 within twenty~~one~~ (21~~20~~) weeks after the due date for service of the initial Disclosure of Asserted Claims and Infringement Contentions. Each party asserting invalidity of a patent claim shall serve on all other parties, “Final Invalidity Contentions” containing the information required by L. Pat. R. 3.3, no later than the date that the Final Infringement Contentions are due.

3.8 Final Non-Infringement and Responses to Invalidity Contentions

Each party asserting non-infringement of a patent claim shall serve on all other parties “Final Non-Infringement Contentions” containing the information required by L. Pat. R. 3.3 within twenty-eight (28) days after service of the “Final Infringement Contentions.” Each party asserting patent infringement shall serve on all other parties “Final Responses to Invalidity Contentions” containing the information required by L. Pat. R. 3.5, no later than the date the “Final Non-Infringement Contentions” are due.

3.9 Document Production Accompanying Final Invalidity Contentions

(a) With the “Final Invalidity Contentions”, the party asserting invalidity of any patent claim shall produce or make available for inspection and copying, to the extent not previously produced or disclosed: a copy or sample of all prior art identified pursuant to L. Pat. R. 3.7, that does not appear in the file history of the patent(s) at issue. If any such item is not in English, an English translation of the portion(s) relied upon shall be produced.

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

3.10 Amendment to Contentions

(a) A party may amend its “Final Infringement Contentions”, “Final Non-Infringement Contentions and Final Invalidity Contentions”, or “Final Responses to Invalidity Contentions” only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery of the basis for the amendment. An example of a circumstance that may support a finding of good cause, absent undue prejudice to the non-moving party, includes a claim construction by the Court different from that proposed by the party seeking amendment. A motion to amend final contentions due to the Court’s claim construction order shall be filed, with proposed amendment(s) within fourteen (14) days of the entry of such claim construction order.

(b) The duty to supplement discovery responses under Fed. R. Civ. P. 26(e) does not excuse the need to obtain leave of Court to amend final contentions.

RULE 4

CLAIM CONSTRUCTION PROCEEDINGS

4.1 Inapplicability To Design and Variety of Plant Patents

Unless otherwise requested by a party and determined by the Court to be warranted, the provisions of this L. Pat. R. 4 shall not apply to design or variety of plant patents.

4.2 Exchange of Proposed Terms for Construction

(a) (i) Not later than ~~fourteen (14)~~seven (7) days after service of the “Final Non-Infringement Contentions” pursuant to L. Pat. R. 3.8, 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; or

(ii) In all cases in which a party files a complaint or other pleading seeking a declaratory judgment not based on validity, not later than twenty-one (21) days after the defendant serves an answer that does not assert a claim for patent infringement (and L. Pat. R. 3.1 does not apply), 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.

(b) The parties shall thereafter meet and confer for the purpose of limiting the terms in dispute by narrowing or resolving differences, and facilitating the ultimate preparation of a Joint Claim Construction and Prehearing Statement.

4.3 Exchange of Preliminary Claim Constructions and Extrinsic Evidence

(a) Not later than ~~thirty (30)~~twenty-one (21) days after the exchange of lists pursuant to L. Pat. R. 4.2, the parties shall simultaneously exchange preliminary proposed constructions of each term identified by any party for claim construction. Each such “Preliminary Claim Construction” shall also, for each term which any party contends is governed by 35 U.S.C. § 112 ¶ 6, identify the structure(s), act(s), or material(s) corresponding to that term’s function.

(b) At the same time the parties exchange their respective “Preliminary Claim Constructions”, each party shall also identify all references from the specification or prosecution history that support its preliminary proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses including expert witnesses. Extrinsic evidence shall be identified by production number or by producing a copy if not previously produced. With respect to all witnesses including experts, the identifying party shall also provide a description of the substance of that

witness' proposed testimony that includes a listing of any opinions to be rendered in connection with claim construction.

(c) The parties shall thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a "Joint Claim Construction and Prehearing Statement."

4.4 Joint Claim Construction and Prehearing Statement

(a) Not later than ~~forty five (45)~~twenty-eight (28) days after the exchange of "Preliminary Claim Constructions" under L. Pat. R. 4.3(a), the parties shall complete and file a "Joint Claim Construction and Prehearing Statement", which shall contain the following information:

- (1) The construction of those terms on which the parties agree;
- (2) Each party's proposed construction of each disputed term, together with an identification of all references from the intrinsic evidence that support that construction, and an identification of any extrinsic evidence known to the party upon which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses including experts;
- (3) A prioritization of the disputed terms, based upon their significance to the resolution of the case and the court's construction of those terms and whether they will be case or claim dispositive or substantially conducive to promoting settlement, together with a statement of the significance of each term to the claims and defenses in the case;
- (4) The anticipated length of time necessary for the Claim Construction Hearing;
- (5) Whether any party proposes to call any live witnesses to testify at the Claim Construction Hearing, the identity of each such witness and for each witness, a summary of his or her testimony including, for any expert, each opinion to be offered related to claim construction;
- (6) Any evidence that is not identified under L. Pat. R. [4.24.3\(b\)](#) shall not be included in the Joint Claim Construction and Prehearing Statement; and
- (7) This Rule does not apply to design patents.

4.5 Completion of Claim Construction Discovery

Not later than ~~forty-five (45)~~twenty-eight (28) days after filing of the “Joint Claim Construction and Prehearing Statement”, the parties shall complete all discovery relating to claim construction, including any depositions with respect to claim construction of any fact and expert witnesses, identified in the “Preliminary Claim Construction Statement” (L. Pat. R. 4.3) or “Joint Claim Construction and Prehearing Statement.” (L. Pat. R. 4.4).

4.6 Claim Construction Submissions

(a) Not later than ~~sixty (60)~~forty-two (42) days after filing the Joint Claim Construction and Prehearing Statement, the patentee shall file and serve its opening *Markman* submission (not to exceed 30 pages) and any evidence supporting claim construction, including experts’ certifications or declarations (“Opening *Markman* Submission”).

(b) Not later than ~~thirty (30)~~twenty-eight (28) days after the filing of the Opening *Markman* Submission, the accused infringer shall file and serve Responding *Markman* Submission (not to exceed 30 pages) and any evidence supporting claim construction, including any responding experts’ certifications or declarations.

(c) Not later than ~~fifteen (15)~~fourteen (14) days after the filing of the accused infringer’s Responding *Markman* Submission, the patentee shall file and serve its Reply *Markman* Brief (not to exceed 15 pages).

(d) Not later than ~~fifteen (15)~~fourteen (14) days after the filing of the patentee’s Reply brief, the accused infringer shall file and serve its Surreply *Markman* Brief (not to exceed 15 pages).

4.7 Claim Construction Hearing²

Within ~~fourteen (14)~~seven (7) days following the filing of the briefs and evidence specified in L. Pat. R. 4.6, counsel shall confer and propose to the Court a schedule for a “Claim Construction Hearing”, to the extent the parties believe and the Court deems it necessary to conduct such a hearing for construction of the claims at issue.

² The District Judge may refer the Claim Construction Hearing to the Magistrate Judge at his/her discretion.

RULE 5
POST CLAIM CONSTRUCTION PROCEDURES

5.1 For Cases Not Involving Separate Claim Construction Proceedings

For the purpose of L. Pat. R. 5, in the case where there is no Claim Construction Proceeding, then any date herein which is otherwise measured from entry of the Court's Claim Construction Order shall be measured instead from thirty (30) days from the date of service of materials under L. Pat. R. 3, namely the "Final Non-Infringement Contentions" and "Final Responses to Invalidity Contentions."

5.2 Advice of Counsel

Unless otherwise ordered by the Court, not later than ~~thirty (30)~~twenty-eight (28) days after entry of the Court's Claim Construction Order, or upon such other date as set by the Court, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall:

(a) Produce or make available for inspection and copying any written advice and documents related thereto for inspection and copying any written advice and documents related thereto for which the attorney-client and work product protection have been waived;

(b) Provide a written summary of any oral advice and produce or make available for inspection and copying that summary and documents related thereto for which the attorney-client and work product protection have been waived; and

(c) Serve a privilege log identifying any documents other than those identified in subpart (a) above, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the advice which the party is withholding on the grounds of attorney-client privilege or work product protection.

A party who does not comply with the requirements of L. Pat. R. 5.2 shall not be permitted to rely on advice of counsel for any purpose absent a stipulation of all parties or by order of the Court upon good cause shown.

5.3 Opening Expert Reports

A party expecting to offer expert testimony on issues other than claim construction on which it bears the burden of proof, including damages, shall disclose and serve upon all parties the name, address, and *curriculum vitae* of any expert witness expected to testify at trial, together with a list of publications authored by him or her within the past ten years, and a list of cases in which the expert has given deposition or trial testimony during the past four years, together with a report as required under Fed. R. Civ. P. 26(a)(2)(B), not later than ~~sixty (60)~~fifty-six (56) days after entry of the Court's claim construction order.

5.4 Responsive Expert Reports

A party expected to offer responsive expert testimony on issues on which the opposing party bears the burden of proof shall disclose and serve upon all parties the name, address, and *curriculum vitae*, of any expert witnesses expected to testify at trial, together with a list of publications authored by him or her within the past ten years, and a list of cases in which the expert has given deposition or trial testimony during the past four years, together with a report as required under Fed. R. Civ. P. 26(a)(2)(B) not later than ~~thirty (30)~~twenty-eight (28) days after disclosure and service of the opposing party's expert report in accordance with L. Pat. R. 5.3.

5.5 Completion of Discovery

Not later than one hundred ~~twenty-twelve (120)~~112 days after entry of the Court's claim construction order, all discovery in the case, including expert depositions, must be completed.

5.6 Deadline For Filing Dispositive Motions

Not later than ~~forty-five (45)~~forty-two (42) days after the scheduled date for the end of all discovery, all dispositive motions in the case shall be filed.

RULE 6

AUTOMATIC MEDIATION

6.1 AUTOMATIC MEDIATION SCHEDULE

In addition to the initial mediation provided for in L.R. Civ. P. 16(a), a second and third mediation for patent cases shall be conducted as follows:

(a) Not later than twenty-one (21) days after the exchange of proposed claim constructions, the parties shall hold a second mediation consistent with this Court's Alternative Dispute Resolution plan (L.R. Civ. P. 16(a)); and

(b) Not later than forty ~~five~~two (~~45~~42) days after entry of the claim construction order, the parties shall hold a third mediation consistent with this Court's Alternative Dispute Resolution plan (L.R. Civ. P. 16(a)).

APPENDIX A

<u>TIMELINE</u>	
<u>Event</u>	<u>Deadline</u>
Rule 26(f) Meeting	21 days prior to Case Management Conference
Filing of Civil Case Management Plan	7 days prior to Case Management Conference
Patentee: Initial Infringement Contentions	14 days after Case Management Conference
Accused Infringer: Non-Infringement and Invalidity Contentions	60-56 days after Initial Infringement Contentions
Patentee: Responses to Invalidity Contentions	30-28 days after Non-Infringement and Invalidity Contentions
Final Infringement and Invalidity Contentions	21-20 weeks after Initial Infringement Contentions
Final Non-Infringement Contentions and Final Responses to Invalidity Contentions	28 days after Final Infringement and Invalidity Contentions
Exchange of Claim Terms for Construction	14-7 days after Final Infringement and Invalidity Contentions
Exchange of Proposed Constructions	30-21 days after Exchange of Claim Terms for Construction
Joint Claim Construction Statement	45-28 days after Exchange of Proposed Construction
Completion of Claim Construction Discovery	45-28 days after filing of Joint Claim Construction Statement
Patentee: Opening <i>Markman</i> Submissions	60-42 days after filing of Joint Claim Construction Statement
Accused Infringer: Responding <i>Markman</i> Submissions	30-28 days after Opening <i>Markman</i> Submission
Patentee: Reply <i>Markman</i> Brief	15-14 days after Responsive <i>Markman</i> Brief
Accused Infringer: Surreply <i>Markman</i> Brief	15-14 days after Reply <i>Markman</i> Brief
Advice of Counsel Disclosure	30-28 days after claim construction order
Initial Expert Reports (non-claim construction)	60-56 days after claim construction order

Responsive Expert Reports	30 <u>28</u> days after service of Initial Expert Reports
Completion of All Discovery	120 <u>112</u> days after claim construction order
Filing of Dispositive Motions	45 <u>42</u> days after close of all discovery

APPENDIX B

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

Plaintiff,

v.

Defendant.

Civil Action No. _____

[MODEL] ORDER REGARDING E-DISCOVERY IN PATENT CASES

The Court ORDERS as follows:

1. This Order supplements all other discovery rules and orders. It streamlines Electronically Stored Information (“ESI”) production to promote a “just, speedy, and inexpensive determination” of this action, as required by Federal Rule of Civil Procedure 1.
2. This Order may be modified in the Court’s discretion or by agreement of the parties. The parties shall jointly submit any proposed modifications within 30 days after the Federal Rule of Civil Procedure 16 conference. If the parties cannot resolve their disagreements regarding these modifications, the parties shall submit their competing proposals and a summary of their dispute.
3. Costs will be shifted for disproportionate ESI production requests pursuant to Federal Rule of Civil Procedure 26. Likewise, a party’s nonresponsive or dilatory discovery tactics will be cost-shifting considerations.

4. A party's meaningful compliance with this Order and efforts to promote efficiency and reduce costs will be considered in cost-shifting determinations.

5. Absent a showing of good cause, general ESI production requests under Federal Rules of Civil Procedure 34 and 45, or compliance with disclosure requirements of the Local Patent Rules, shall not include metadata. However, fields showing the date and time that the document was sent and received, as well as the complete distribution list, shall generally be included in the production if such fields exist.

6. General ESI production requests under Federal Rules of Civil Procedure 34 and 45, or compliance with disclosure requirements of the Local Patent Rules, shall not include email or other forms of electronic correspondence (collectively "email"). To obtain email parties must propound specific email production requests.

7. Email production requests shall only be propounded for specific issues, rather than general discovery of a product or business.

8. Email production requests shall be phased to occur after the parties have exchanged initial disclosures, infringement contentions and accompanying documents pursuant to the Local Patent Rules, and invalidity contentions and accompanying documents pursuant to the Local Patent Rules.

9. Email production requests shall identify the custodian, search terms, and time frame. The parties shall cooperate to identify the proper custodians, proper search terms and proper timeframe.

10. Each requesting party shall limit its email production requests to a total of five custodians per producing party for all such requests. The parties may jointly agree to modify this limit without the Court's leave. The Court shall consider contested requests for up to five additional custodians per producing party, upon showing a distinct need based on the size, complexity, and issues of this specific case. Should a party serve email production requests for additional custodians beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery.

11. Each requesting party shall limit its email production requests to a total of five search terms per custodian per party. The parties may jointly agree to modify this limit without the Court's leave. The Court shall consider contested requests for up to five additional search terms per custodian, upon showing a distinct need based on the size, complexity, and issues of this specific case. The search terms shall be narrowly tailored to particular issues. Indiscriminate terms, such as the producing company's name or its product name, are inappropriate unless combined with narrowing search criteria that sufficiently reduce the risk of overproduction. A conjunctive combination of multiple words or phrases (*e.g.*, "computer" and "system") narrows the search and shall count as a single search term. A disjunctive combination of multiple words or phrases (*e.g.*, "computer" or "system") broadens the search, and thus each word or phrase shall count as a separate search term unless they are variants of the same word. Use of narrowing search criteria (*e.g.*, "and,"

“but not,” “w/x”) is encouraged to limit the production and shall be considered when determining whether to shift costs for disproportionate discovery. Should a party serve email production requests with search terms beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery.

12. The receiving party shall not use ESI that the producing party asserts is attorney-client privileged or work product protected to challenge the privilege or protection.

13. Pursuant to Federal Rule of Evidence 502(d), the inadvertent production of a privileged or work product protected ESI is not a waiver in the pending case or in any other federal or state proceeding.

14. The mere production of ESI in a litigation as part of a mass production shall not itself constitute a waiver for any purpose.

15. Except as expressly stated herein, nothing in this Order affects the parties’ discovery obligation under the Federal or Local Rules.

APPENDIX C

CLAIM LIMITATION	ACCUSED [STEP OR COMPONENT]	BASIS OF INFRINGEMENT CONTENTION

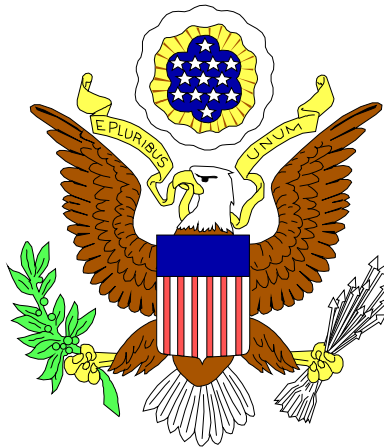
APPENDIX D

CLAIM LIMITATION	PRIOR ART OR OTHER EVIDENCE	BASIS OF INVALIDITY CONTENTION

CLAIM LIMITATION	ACCUSED [STEP OR COMPONENT]	BASIS OF NON-INFRINGEMENT CONTENTION

Final version of proposed amendments:

UNITED STATES DISTRICT COURT
FOR THE
WESTERN DISTRICT OF NEW YORK



LOCAL PATENT RULES
(Effective January 1, 2019)

**UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK**

IN RE ADOPTION OF LOCAL PATENT RULES

FOR THE

WESTERN DISTRICT OF NEW YORK

These Rules were prepared by the Judges of the United States District Court for the Western District of New York, in collaboration with the federal bar.

It is so ordered that these Rules, as amended, shall apply to all actions commenced on or after January 1, 2019, and, insofar as just and practicable, all actions then pending.

FRANK P. GERACI, JR.
Chief United States District Judge

ELIZABETH A. WOLFORD
United States District Judge

LAWRENCE J. VILARDO
United States District Judge

MICHAEL A. TELESKA
Senior United States District Judge

DAVID G. LARIMER
Senior United States District Judge

CHARLES J. SIRAGUSA
Senior United States District Judge

RICHARD J. ARCARA
Senior United States District Judge

WILLIAM M. SKRETNY
Senior United States District Judge

LOCAL PATENT RULES

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RULE 1
INTRODUCTION

6.2 Preamble

Because of the complexities and uniqueness of issues associated with the management of patent infringement litigation, and to ensure just, efficient, and economical handling of such cases, the United States District Court for the Western District of New York hereby enacts the following rules of practice for patent cases before the Court. These rules are calculated to provide a standard structure for addressing the issues which typically arise in such cases, and to foster predictability and facilitate planning for the litigants and the Court. A timeline reflecting the due dates for all submissions pursuant to these rules is attached as Appendix A.

6.3 Scope and Construction

These rules apply to all civil actions filed in or transferred to this Court which allege infringement of a patent in a complaint, counterclaim, cross-claim or third-party claim, or which seek a declaratory judgment that a patent is not infringed, is invalid or is unenforceable. The local civil rules of this Court shall also apply to such actions, except to the extent that they are inconsistent with these local patent rules.

6.4 Modifications of These Rules

The Court may, in its discretion, modify any of the obligations or deadlines set forth in these proposed rules based upon the circumstances of any particular case including, without limitation, the degree of complexity of the case as shown by the number of patents, products, or parties involved. Such modifications will in most instances be made at the initial Case Management Conference pursuant to Fed. R. Civ. P. 16, but may be made at other times by the Court either *sua sponte* or at the request of a party, upon a showing of good cause. In advance of submission (by letter or motion as appropriate) of any request for modification, the parties must meet and confer for the purpose of reaching an agreement, if possible, upon any modification.

6.5 Citation

These rules shall be cited as “L. Pat. R. ____.”

RULE 7

GENERAL PROVISIONS

7.1 Initial Case Management Conference

(a) At least twenty-one (21) days prior to the scheduled Case Management Conference (“CMC”) pursuant to Fed. R. Civ. P. 16, the parties must confer, in person or by telephone, pursuant to Fed. R. Civ. P. 26(f) to formulate a Case Management Plan and to address the following topics:

- (1)** Proposed modification of the obligations or deadlines set forth in these local patent rules to ensure that they are suitable for the circumstances of the particular case (*see* L. Pat. R. 1.3), including the scope and timing of any claim construction discovery, including disclosure of and discovery from any expert witness permitted by the Court;
- (2)** The format of the claim construction hearing, including whether the parties wish the Court to hear live testimony, the order of presentation, and the estimated length of the hearing;
- (3)** How the parties intend to educate the Court with respect to the patent(s) at issue;
- (4)** The need for alteration of the standard confidentiality order to supersede that which would otherwise be entered by the court pursuant to L. Pat. R. 2.2;
- (5)** The timing and scope of mandatory disclosures required pursuant to Fed. R. Civ. P. 26(a)(1). Among the disclosures which ordinarily must be made pursuant to Rule 26(a)(1) in cases covered by these rules is information and documentation regarding proof of patent ownership or standing to assert patent infringement claims; and
- (6)** Whether the Court should issue the “Model Order Regarding E-Discovery in Patent Cases” in a particular action. The presumption is that the Court will issue such an Order, which may be modified in the Court’s discretion or by agreement of the Parties. The Model Order Regarding E-Discovery in Patent Cases is attached to these rules as Appendix B.

(b) Not later than seven (7) days prior to the scheduled CMC the parties shall jointly file a proposed Case Management Plan addressing the various issues identified above and included in Fed. R. Civ. P. 26, based upon the parties’ discussions during their Rule 26(f) meeting.

2.2 Confidentiality

(c) Discovery cannot be withheld or delayed on the basis of confidentiality absent Court order. Pending entry of a confidentiality order, discovery and disclosures designated confidential by a party shall be produced to the adverse party for outside counsels' Attorneys' Eyes Only, solely for purposes of the pending case and shall not be disclosed to the client or any other person.

(d) Not later than fourteen (14) days after the initial CMC the parties shall submit either a stipulated confidentiality order pursuant to Fed. R. Civ. P. 26(c) or, if agreement cannot be reached, shall each submit a counter proposed confidentiality order for the Court's consideration, highlighting for the Court any areas of disagreement.

7.2 Relationship to Federal Rules of Civil Procedure

(a) Except as provided in this paragraph or as otherwise ordered, it shall not be a ground for objecting to an opposing party's discovery request (*e.g.*, interrogatory, document request, request for admission, deposition question) or declining to provide information otherwise required to be disclosed pursuant to Fed. R. Civ. P. 26(a)(1), that the discovery request or disclosure requirement is premature in light of, or otherwise conflicts with, these local patent rules, absent other legitimate objection. A party may object, however, to responding to the following categories of discovery requests (or decline to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) on the ground that they are premature in light of the timetable provided in these local patent rules:

- (1)** Requests seeking to elicit a party's claim construction position;
- (2)** Requests seeking to elicit from the patentee a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, design, variety of plant or other instrumentality;
- (3)** Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art; and
- (4)** Requests seeking to elicit from an accused infringer the identification of any advice of counsel received, and related documents.

(b) Where a party properly objects to a discovery request (or declines to provide information in its initial disclosures under Fed. R. Civ. P. 26(a)(1)) as set forth above, that party shall provide the requested information on the date on which it is required to be disclosed to an opposing party under these local patent rules or as set by the Court, unless there exists another legitimate ground for objection.

7.3 Exchange of Expert Materials

(a) Disclosures of claim construction expert materials and depositions of such experts are governed by L. Pat. R. 4.3 and 4.5, unless otherwise ordered by the Court.

(b) Disclosure of expert materials related to issues other than claim construction will not be required until claim construction issues have been decided, and shall be governed by the provisions of L. Pat. R. 5.3 and 5.4.

RULE 8

PATENT DISCLOSURES

8.1 Disclosure of Asserted Claims and Infringement Contentions

Not later than fourteen (14) days after the initial CMC, a party claiming patent infringement shall serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.” Separately for each opposing party, the “Disclosure of Asserted Claims and Infringement Contentions” shall contain the following information:

(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;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, design, variety of plant 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, design, variety of plant 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) (i) Except for design or variety of plant patent claim(s), 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;

(ii) For each design patent or variety of plant patent claim that is alleged, a chart displaying each view of the design or variety of plant patent drawings and a view of the accused design or variety of plant from every available angle for all embodiments.

(d) 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 any 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) Except for design or variety of plant patent claims(s), 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 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; and

(h) If a party claiming patent infringement alleges willful infringement, all known bases for such allegation. A party claiming willful infringement shall be permitted to supplement its response to this subsection at or prior to the close of fact discovery, if necessary, to add facts developed through pretrial discovery.

(i) To comply with L. Pat. R. 3.1, a party claiming patent infringement may use a chart following the format provided in Appendix C.

8.2 Document Production Accompanying Infringement Disclosure

With 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:

(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 or is prior art under 35 U.S.C. § 102;

(b) 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 L. Pat. R. 3.1(f), whichever is earlier;

(c) A copy of the file history for each patent in suit;

(d) Documents evidencing ownership and maintenance of the patent rights by the party asserting patent infringement;

(e) If a party identifies instrumentalities pursuant to L. Pat. R. 3.1(g), documents sufficient to show the operation of any aspects or elements of such instrumentalities the patent claimant relies upon as embodying any asserted claims; and

(f) With respect to each of the above document productions, the producing party shall separately identify by production number which documents correspond to each category.

8.3 Non-Infringement and Invalidity

Not later than fifty-six (56) days after service upon it of the “Disclosure of Asserted Claims and Infringement Contentions”, each party opposing a claim of patent infringement on the basis of non-infringement or patent invalidity shall serve on all parties its “Disclosure of Non-Infringement and Invalidity Contentions” which shall contain the following information:

- (a)**
- (i) Except for design or variety of plant patent claim(s) Non-Infringement Contentions shall contain a chart, responsive to the chart required under L. Pat. R. 3.1(c)(i), that identifies as to each limitation in each asserted claim disclosed in the patentee’s claim chart, to the extent then known by the party alleging infringement, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality and, if not, the reason for such denial and the relevant distinctions;
 - (ii) For each design patent or variety of plant patent claim that is alleged, a chart, responsive to the chart required under L. Pat. R. 3.1(c)(ii), that displays a view from each angle of the accused design or variety of plant and of all embodiments and stating whether the accused design or variety of plant is substantially similar to the claimed design or variety of plant and, if not, the reasons for such a denial.

(a) Invalidity Contentions must contain the following information to the extent then known to the party asserting invalidity:³

- (1)** Whether the first inventor to file provision of the Leahy-Smith America Invents Act (“AIA”) applies to each asserted claim.
- (2)** The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious, including in the case of a design or variety of plant patent, a view from every available angle and all available embodiments. 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

³ Consistent with the Leahy-Smith America Invents Act, references to 35 U.S.C. §§ 102, 103, and 112 in these Local Patent Rules refer to patents in dispute that were filed, or claim priority to a date, prior to March 16, 2013. To the extent a patent or patents in dispute were filed, or claim priority to a date, on or after March 16, 2013, any references to §§ 102, 103, and 112 should be interpreted under the applicable language and nomenclature provided in the Leahy-Smith America Invents Act.

offered for sale or publicly used or known, the date the offer or use took place or the information became known, the location where the item was sold or publicly used, 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);

- (3) 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, the reason why one of ordinary skill in the art would have combined the references at the time of the invention in issue in the case, and identification of what the accused considers to be the primary reference;
- (4) A chart identifying where specifically in each alleged item of prior art each limitation or view of each asserted claim is found, and for utility patents, 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
- (5) 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.

(b) To comply with L. Pat. R. 3.3, a party opposing a claim of patent infringement may use a chart following the format provided in Appendix D.

8.4 Document Production Accompanying Non-Infringement and Invalidity Disclosure

With the “Disclosure of Non-Infringement and Invalidity Contentions”, the party opposing a claim of patent infringement shall produce or make available for inspection and copying, if not previously disclosed pursuant to Fed. R. Civ. P. 26(a)(1), the following:

(a) Source code, specifications, schematics, flow charts, artwork, drawings, photographs, video or other images from every available view or other documentation sufficient to show the operation, composition, design, variety of plant or structure of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its L. Pat. R. 3.1(c) chart;

(b) A copy or sample of the prior art identified pursuant to L. Pat. R. 3.3(b) 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. In addition, if any portion or complete English translation is in the possession of the producing party, and was relied upon, that too shall be produced; and

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

8.5 Responses to Invalidity Contentions

Not later than twenty-eight (28) days after service upon it of the “Disclosure of Non-Infringement and Invalidity Contentions”, each party defending the validity of the patent shall serve on all parties its “Responses to Invalidity Contentions” which must include a response to each Invalidity Contention set forth under L. Pat. R. 3.3 including the following:

(a) If asserted by the party asserting invalidity, a response to whether the first to file provision of the AIA applies to each asserted claim;

(b) For each item of asserted prior art, the identification of each limitation of each asserted claim that the party believes is absent from the prior art, except for design patents, where the party shall supply an explanation why the prior art does not anticipate the claim;

(c) If obviousness is alleged, an explanation of why the prior art does not render the asserted claim obvious;

(d) The party’s responses shall follow the order of the invalidity chart required under L. Pat. R. 3.3(b)(4) and (c), and shall set forth the party’s agreement or disagreement with each allegation therein and the written basis thereof; and

(e) A response to each ground of invalidity asserted under L. Pat. R. 3.3(b)(5).

8.6 Disclosure Requirement in Patent Cases for Declaratory Judgment of Non-Infringement and Invalidity

(a) Non-Infringement and 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 not infringed or is invalid, L. Pat. R. 3.1 and 3.2 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, not later than forty-two (42) days after the defendant serves its answer or forty-two (42) days after the CMC, whichever is later, the party seeking a declaratory judgment of non-infringement or invalidity shall serve upon each opposing party its “Disclosure of Non-Infringement and Invalidity Contentions” that conforms to L. Pat. R. 3.3 and produce or make available for inspection and copying the documents described in L. Pat. R. 3.4.

(b) Inapplicability of Rule. L. Pat. R. 3.6 shall not apply to cases in which a request for a declaratory judgment that a patent is not infringed or invalid is filed in response to a complaint for infringement of the same patent, in which case the provisions of L. Pat. R. 3.3 shall govern.

8.7 Final Infringement and Invalidity Contentions

A party claiming patent infringement must serve on all other parties “Final Infringement Contentions” containing the information required by L. Pat. R. 3.1 within twenty (20) weeks after the due date for service of the initial Disclosure of Asserted Claims and Infringement Contentions. Each party asserting invalidity of a patent claim shall serve on all other parties, “Final Invalidity Contentions” containing the information required by L. Pat. R. 3.3, no later than the date that the Final Infringement Contentions are due.

8.8 Final Non-Infringement and Responses to Invalidity Contentions

Each party asserting non-infringement of a patent claim shall serve on all other parties “Final Non-Infringement Contentions” containing the information required by L. Pat. R. 3.3 within twenty-eight (28) days after service of the “Final Infringement Contentions.” Each party asserting patent infringement shall serve on all other parties “Final Responses to Invalidity Contentions” containing the information required by L. Pat. R. 3.5, no later than the date the “Final Non-Infringement Contentions” are due.

8.9 Document Production Accompanying Final Invalidity Contentions

(a) With the “Final Invalidity Contentions”, the party asserting invalidity of any patent claim shall produce or make available for inspection and copying, to the extent not previously produced or disclosed: a copy or sample of all prior art identified pursuant to L. Pat. R. 3.7, that does not appear in the file history of the patent(s) at issue. If any such item is not in English, an English translation of the portion(s) relied upon shall be produced.

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

8.10 Amendment to Contentions

(a) A party may amend its “Final Infringement Contentions”, “Final Non-Infringement Contentions and Final Invalidity Contentions”, or “Final Responses to Invalidity Contentions” only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery of the basis for the amendment. An example of a circumstance that may support a finding of good cause, absent undue prejudice to the non-moving party, includes a claim construction by the Court different from that proposed by the party seeking amendment. A motion to amend final contentions due to the Court’s claim construction order shall be filed, with proposed amendment(s) within fourteen (14) days of the entry of such claim construction order.

(b) The duty to supplement discovery responses under Fed. R. Civ. P. 26(e) does not excuse the need to obtain leave of Court to amend final contentions.

RULE 9

CLAIM CONSTRUCTION PROCEEDINGS

9.1 Inapplicability To Design and Variety of Plant Patents

Unless otherwise requested by a party and determined by the Court to be warranted, the provisions of this L. Pat. R. 4 shall not apply to design or variety of plant patents.

9.2 Exchange of Proposed Terms for Construction

(a) (i) Not later than seven (7) days after service of the “Final Non-Infringement Contentions” pursuant to L. Pat. R. 3.8, 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; or

(ii) In all cases in which a party files a complaint or other pleading seeking a declaratory judgment not based on validity, not later than twenty-one (21) days after the defendant serves an answer that does not assert a claim for patent infringement (and L. Pat. R. 3.1 does not apply), 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.

(b) The parties shall thereafter meet and confer for the purpose of limiting the terms in dispute by narrowing or resolving differences, and facilitating the ultimate preparation of a Joint Claim Construction and Prehearing Statement.

9.3 Exchange of Preliminary Claim Constructions and Extrinsic Evidence

(a) Not later than twenty-one (21) days after the exchange of lists pursuant to L. Pat. R. 4.2, the parties shall simultaneously exchange preliminary proposed constructions of each term identified by any party for claim construction. Each such “Preliminary Claim Construction” shall also, for each term which any party contends is governed by 35 U.S.C. § 112 ¶ 6, identify the structure(s), act(s), or material(s) corresponding to that term’s function.

(b) At the same time the parties exchange their respective “Preliminary Claim Constructions”, each party shall also identify all references from the specification or prosecution history that support its preliminary proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses including expert witnesses. Extrinsic evidence shall be identified by production number or by

producing a copy if not previously produced. With respect to all witnesses including experts, the identifying party shall also provide a description of the substance of that witness' proposed testimony that includes a listing of any opinions to be rendered in connection with claim construction.

(c) The parties shall thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a "Joint Claim Construction and Prehearing Statement."

9.4 Joint Claim Construction and Prehearing Statement

(a) Not later than twenty-eight (28) days after the exchange of "Preliminary Claim Constructions" under L. Pat. R. 4.3(a), the parties shall complete and file a "Joint Claim Construction and Prehearing Statement", which shall contain the following information:

- (1)** The construction of those terms on which the parties agree;
- (2)** Each party's proposed construction of each disputed term, together with an identification of all references from the intrinsic evidence that support that construction, and an identification of any extrinsic evidence known to the party upon which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of all witnesses including experts;
- (3)** A prioritization of the disputed terms, based upon their significance to the resolution of the case and the court's construction of those terms and whether they will be case or claim dispositive or substantially conducive to promoting settlement, together with a statement of the significance of each term to the claims and defenses in the case;
- (4)** The anticipated length of time necessary for the Claim Construction Hearing;
- (5)** Whether any party proposes to call any live witnesses to testify at the Claim Construction Hearing, the identity of each such witness and for each witness, a summary of his or her testimony including, for any expert, each opinion to be offered related to claim construction;
- (6)** Any evidence that is not identified under L. Pat. R. 4.3(b) shall not be included in the Joint Claim Construction and Prehearing Statement; and
- (7)** This Rule does not apply to design patents.

9.5 Completion of Claim Construction Discovery

Not later than twenty-eight (28) days after filing of the “Joint Claim Construction and Prehearing Statement”, the parties shall complete all discovery relating to claim construction, including any depositions with respect to claim construction of any fact and expert witnesses, identified in the “Preliminary Claim Construction Statement” (L. Pat. R. 4.3) or “Joint Claim Construction and Prehearing Statement.” (L. Pat. R. 4.4).

9.6 Claim Construction Submissions

(a) Not later than forty-two (42) days after filing the Joint Claim Construction and Prehearing Statement, the patentee shall file and serve its opening *Markman* submission (not to exceed 30 pages) and any evidence supporting claim construction, including experts’ certifications or declarations (“Opening *Markman* Submission”).

(b) Not later than twenty-eight (28) days after the filing of the Opening *Markman* Submission, the accused infringer shall file and serve Responding *Markman* Submission (not to exceed 30 pages) and any evidence supporting claim construction, including any responding experts’ certifications or declarations.

(c) Not later than fourteen (14) days after the filing of the accused infringer’s Responding *Markman* Submission, the patentee shall file and serve its Reply *Markman* Brief (not to exceed 15 pages).

(d) Not later than fourteen (14) days after the filing of the patentee’s Reply brief, the accused infringer shall file and serve its Surreply *Markman* Brief (not to exceed 15 pages).

9.7 Claim Construction Hearing⁴

Within seven (7) days following the filing of the briefs and evidence specified in L. Pat. R. 4.6, counsel shall confer and propose to the Court a schedule for a “Claim Construction Hearing”, to the extent the parties believe and the Court deems it necessary to conduct such a hearing for construction of the claims at issue.

⁴ The District Judge may refer the Claim Construction Hearing to the Magistrate Judge at his/her discretion.

RULE 10
POST CLAIM CONSTRUCTION PROCEDURES

10.1 For Cases Not Involving Separate Claim Construction Proceedings

For the purpose of L. Pat. R. 5, in the case where there is no Claim Construction Proceeding, then any date herein which is otherwise measured from entry of the Court's Claim Construction Order shall be measured instead from thirty (30) days from the date of service of materials under L. Pat. R. 3, namely the "Final Non-Infringement Contentions" and "Final Responses to Invalidity Contentions."

10.2 Advice of Counsel

Unless otherwise ordered by the Court, not later than twenty-eight (28) days after entry of the Court's Claim Construction Order, or upon such other date as set by the Court, each party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall:

(a) Produce or make available for inspection and copying any written advice and documents related thereto for inspection and copying any written advice and documents related thereto for which the attorney-client and work product protection have been waived;

(b) Provide a written summary of any oral advice and produce or make available for inspection and copying that summary and documents related thereto for which the attorney-client and work product protection have been waived; and

(c) Serve a privilege log identifying any documents other than those identified in subpart (a) above, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the advice which the party is withholding on the grounds of attorney-client privilege or work product protection.

A party who does not comply with the requirements of L. Pat. R. 5.2 shall not be permitted to rely on advice of counsel for any purpose absent a stipulation of all parties or by order of the Court upon good cause shown.

10.3 Opening Expert Reports

A party expecting to offer expert testimony on issues other than claim construction on which it bears the burden of proof, including damages, shall disclose and serve upon all parties the name, address, and *curriculum vitae* of any expert witness expected to testify at trial, together with a list of publications authored by him or her within the past ten years, and a list of cases in which the expert has given deposition or trial testimony during the past four years, together with a report as required under Fed. R. Civ. P. 26(a)(2)(B), not later than fifty-six (56) days after entry of the Court's claim construction order.

10.4 Responsive Expert Reports

A party expected to offer responsive expert testimony on issues on which the opposing party bears the burden of proof shall disclose and serve upon all parties the name, address, and *curriculum vitae*, of any expert witnesses expected to testify at trial, together with a list of publications authored by him or her within the past ten years, and a list of cases in which the expert has given deposition or trial testimony during the past four years, together with a report as required under Fed. R. Civ. P. 26(a)(2)(B) not later than twenty-eight (28) days after disclosure and service of the opposing party's expert report in accordance with L. Pat. R. 5.3.

10.5 Completion of Discovery

Not later than one hundred twelve (112) days after entry of the Court's claim construction order, all discovery in the case, including expert depositions, must be completed.

10.6 Deadline For Filing Dispositive Motions

Not later than forty-two (42) days after the scheduled date for the end of all discovery, all dispositive motions in the case shall be filed.

RULE 11

AUTOMATIC MEDIATION

11.1 AUTOMATIC MEDIATION SCHEDULE

In addition to the initial mediation provided for in L.R. Civ. P. 16(a), a second and third mediation for patent cases shall be conducted as follows:

(a) Not later than twenty-one (21) days after the exchange of proposed claim constructions, the parties shall hold a second mediation consistent with this Court's Alternative Dispute Resolution plan (L.R. Civ. P. 16(a)); and

(b) Not later than forty-two (42) days after entry of the claim construction order, the parties shall hold a third mediation consistent with this Court's Alternative Dispute Resolution plan (L.R. Civ. P. 16(a)).

APPENDIX A

<u>TIMELINE</u>	
<u>Event</u>	<u>Deadline</u>
Rule 26(f) Meeting	21 days prior to Case Management Conference
Filing of Civil Case Management Plan	7 days prior to Case Management Conference
Patentee: Initial Infringement Contentions	14 days after Case Management Conference
Accused Infringer: Non-Infringement and Invalidity Contentions	56 days after Initial Infringement Contentions
Patentee: Responses to Invalidity Contentions	28 days after Non-Infringement and Invalidity Contentions
Final Infringement and Invalidity Contentions	20 weeks after Initial Infringement Contentions
Final Non-Infringement Contentions and Final Responses to Invalidity Contentions	28 days after Final Infringement and Invalidity Contentions
Exchange of Claim Terms for Construction	7 days after Final Infringement and Invalidity Contentions
Exchange of Proposed Constructions	21 days after Exchange of Claim Terms for Construction
Joint Claim Construction Statement	28 days after Exchange of Proposed Construction
Completion of Claim Construction Discovery	28 days after filing of Joint Claim Construction Statement
Patentee: Opening <i>Markman</i> Submissions	42 days after filing of Joint Claim Construction Statement
Accused Infringer: Responding <i>Markman</i> Submissions	28 days after Opening <i>Markman</i> Submission
Patentee: Reply <i>Markman</i> Brief	14 days after Responsive <i>Markman</i> Brief
Accused Infringer: Surreply <i>Markman</i> Brief	14 days after Reply <i>Markman</i> Brief
Advice of Counsel Disclosure	28 days after claim construction order
Initial Expert Reports (non-claim construction)	56 days after claim construction order
Responsive Expert Reports	28 days after service of Initial Expert Reports

Completion of All Discovery	112 days after claim construction order
Filing of Dispositive Motions	42 days after close of all discovery

APPENDIX B

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF NEW YORK

Plaintiff,

v.

Defendant.

Civil Action No. _____

[MODEL] ORDER REGARDING E-DISCOVERY IN PATENT CASES

The Court ORDERS as follows:

16. This Order supplements all other discovery rules and orders. It streamlines Electronically Stored Information (“ESI”) production to promote a “just, speedy, and inexpensive determination” of this action, as required by Federal Rule of Civil Procedure 1.

17. This Order may be modified in the Court’s discretion or by agreement of the parties. The parties shall jointly submit any proposed modifications within 30 days after the Federal Rule of Civil Procedure 16 conference. If the parties cannot resolve their disagreements regarding these modifications, the parties shall submit their competing proposals and a summary of their dispute.

18. Costs will be shifted for disproportionate ESI production requests pursuant to Federal Rule of Civil Procedure 26. Likewise, a party’s nonresponsive or dilatory discovery tactics will be cost-shifting considerations.

19. A party's meaningful compliance with this Order and efforts to promote efficiency and reduce costs will be considered in cost-shifting determinations.

20. Absent a showing of good cause, general ESI production requests under Federal Rules of Civil Procedure 34 and 45, or compliance with disclosure requirements of the Local Patent Rules, shall not include metadata. However, fields showing the date and time that the document was sent and received, as well as the complete distribution list, shall generally be included in the production if such fields exist.

21. General ESI production requests under Federal Rules of Civil Procedure 34 and 45, or compliance with disclosure requirements of the Local Patent Rules, shall not include email or other forms of electronic correspondence (collectively "email"). To obtain email parties must propound specific email production requests.

22. Email production requests shall only be propounded for specific issues, rather than general discovery of a product or business.

23. Email production requests shall be phased to occur after the parties have exchanged initial disclosures, infringement contentions and accompanying documents pursuant to the Local Patent Rules, and invalidity contentions and accompanying documents pursuant to the Local Patent Rules.

24. Email production requests shall identify the custodian, search terms, and time frame. The parties shall cooperate to identify the proper custodians, proper search terms and proper timeframe.

25. Each requesting party shall limit its email production requests to a total of five custodians per producing party for all such requests. The parties may jointly agree to modify this limit without the Court's leave. The Court shall consider contested requests for up to five additional custodians per producing party, upon showing a distinct need based on the size, complexity, and issues of this specific case. Should a party serve email production requests for additional custodians beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery.

26. Each requesting party shall limit its email production requests to a total of five search terms per custodian per party. The parties may jointly agree to modify this limit without the Court's leave. The Court shall consider contested requests for up to five additional search terms per custodian, upon showing a distinct need based on the size, complexity, and issues of this specific case. The search terms shall be narrowly tailored to particular issues. Indiscriminate terms, such as the producing company's name or its product name, are inappropriate unless combined with narrowing search criteria that sufficiently reduce the risk of overproduction. A conjunctive combination of multiple words or phrases (*e.g.*, "computer" and "system") narrows the search and shall count as a single search term. A disjunctive combination of multiple words or phrases (*e.g.*, "computer" or "system") broadens the search, and thus each word or phrase shall count as a separate search term unless they are variants of the same word. Use of narrowing search criteria (*e.g.*, "and,"

“but not,” “w/x”) is encouraged to limit the production and shall be considered when determining whether to shift costs for disproportionate discovery. Should a party serve email production requests with search terms beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery.

27. The receiving party shall not use ESI that the producing party asserts is attorney-client privileged or work product protected to challenge the privilege or protection.

28. Pursuant to Federal Rule of Evidence 502(d), the inadvertent production of a privileged or work product protected ESI is not a waiver in the pending case or in any other federal or state proceeding.

29. The mere production of ESI in a litigation as part of a mass production shall not itself constitute a waiver for any purpose.

30. Except as expressly stated herein, nothing in this Order affects the parties’ discovery obligation under the Federal or Local Rules.

APPENDIX C

CLAIM LIMITATION	ACCUSED [STEP OR COMPONENT]	BASIS OF INFRINGEMENT CONTENTION

APPENDIX D

CLAIM LIMITATION	PRIOR ART OR OTHER EVIDENCE	BASIS OF INVALIDITY CONTENTION

CLAIM LIMITATION	ACCUSED [STEP OR COMPONENT]	BASIS OF NON-INFRINGEMENT CONTENTION