

DISTRICT OF KANSAS – PATENT LOCAL RULES

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SCOPE OF RULES

1.1 Title

These are the Local Rules of Practice for Patent Cases before the United States District Court for the District of Kansas (“Patent Local Rules”). They should be cited as “D. Kan. Pat. Rule __.”

1.2 Scope and Construction

These rules govern the procedure in all civil actions before this court that allege infringement of a utility patent in a complaint, counterclaim, crossclaim, or third-party claim, or that seek a declaratory judgment that a utility patent is not infringed, is invalid, or is unenforceable. The Rules of Practice and Procedure of this court also apply to such actions, except to the extent that they are inconsistent with these Patent Local Rules.

1.3 Modification of these Patent Local Rules

The court may modify the obligations or deadlines set forth in these Patent Local Rules based on the circumstances of any particular case, including, without limitation, the simplicity or complexity of the case as shown by the patents, claims, products, or parties involved. Modifications must, in most cases, be made at the initial case management conference, but may be made at other times upon a showing of good cause. In advance of submission of any request for a modification, the parties must meet and confer for purposes of reaching an agreement, if possible, upon any modification.

1.4 Effective Date

These Patent Local Rules take effect on _____, 2017, and govern cases filed on or after that date.

GENERAL PROVISIONS

2.1 Governing Procedure

- (a) Notice of Pendency of Other Action or Proceedings Involving Same Patent or Related Patent.
 - (1) A party that knows or learns that actions concerning the same patent or a related patent have been filed within two years of each other must promptly file in each case a “Notice of Pendency of Other Action Involving Same Patent or Related Patent.” A party that knows or learns of the filing of any request for any post-grant proceeding (e.g., *inter partes* review, covered business method patent review, post-grant review, reexamination, etc.) regarding the same patent or a related patent must promptly file a “Notice of Pendency of Post-Grant Proceeding.” A party that knows or learns of any institution decision or final decision in any post-grant proceeding regarding the same patent or a related patent must promptly file a “Status Update of Post-Grant Proceeding.”
 - (2) A “related patent” includes: (i) any patent that, in whole or in part, claims priority to, or the benefit of the filing date of, any patent-in-suit, including any child, continuation, continuation-in-part, continuing prosecution, divisional, reissue, reexamination, substitution, or extension thereof, (ii) any patent from which any patent-in-suit claims the benefit of priority or otherwise claims the benefit of the filing date thereof, including any and all parent patents of any patent-in-suit, and (iii) any patent that claims the benefit of priority or otherwise claims the benefit of the filing date of any patent described in (ii).
- (b) Rule 16 Scheduling Conference. One week before the Rule 16 Scheduling Conference, the parties must submit a summary of their Rule 26(f) conference to the court. When the parties confer pursuant to Fed. R. Civ. P. 26(f), the parties must discuss the matters set out in Fed. R. Civ. P. 16(c)(2)(A)-(P), Fed. R. Civ. P. 26(f)(3)(A)-(F), and the following:
 - (1) Any proposed modifications to the obligations or deadlines set forth in these Patent Local Rules to ensure that these Patent Local Rules are suitable for the circumstances of the particular case. To the extent a party proposes a modification, the party must submit a concise explanation for the modification;
 - (2) Any case dispositive or settlement-driving issues;
 - (3) Any proposed limits on the number of asserted claims and prior art references or a timeframe for reaching a decision on asserted claims and prior art references;
 - (4) The scope and timing of any claim construction discovery including disclosure of and discovery from any expert witness permitted by the court;

- (5) How the parties intend to educate the court on the technology at issue; and
- (6) If the filings or actions in a patent case do not trigger the application of these Patent Local Rules under the terms set forth herein, the parties must discuss the application of these Patent Local Rules to the case.

2.2 Confidentiality

Discovery cannot be withheld on the basis of confidentiality absent court order. If any document or information produced is deemed confidential by the producing party and if the court has not entered a protective order, the producing party shall mark the document “Confidential – Outside Attorneys’ Eyes Only” and, until such time as the court enters a protective order, disclosure of the confidential document or information must be limited to each party’s outside attorney(s) of record, the employees of such outside attorney(s), and necessary outside document services, unless the parties agree to the contrary. The person(s) to whom disclosure of a confidential document or information is made under this rule must keep it confidential and use it only for the purpose of litigating the case.

2.3 Protective Order

No later than 14 days before the Rule 16 Scheduling Conference, the parties must either (1) submit an agreed proposed protective order that complies with the written guidelines for agreed protective orders (available at www.ksd.uscourts.gov/guidelines-for-agreed-protective-orders-district-of-kansas/), or (2) if they cannot agree, a joint proposed protective order that specifically identifies the provisions on which the parties agree and disagree and a concise explanation supporting each party’s position. A model form agreed protective order is provided for the convenience of counsel, the parties, and the court (available at http://www.ksd.uscourts.gov/forms/?f=2#item_2).

2.4 Certification of Disclosures

All statements, disclosures, or charts filed or served in accordance with these Patent Local Rules must be dated and signed by at least one counsel of record. See Fed. R. Civ. P. 26(g). Counsel’s signature constitutes a certification that to the best of his or her knowledge, information, and belief, formed after an inquiry that is reasonable under the circumstances, the information contained in the statement, disclosure, or chart is complete and correct at the time it is made.

2.5 Admissibility of Disclosures

Statements, disclosures, or charts governed by these Patent Local Rules are admissible to the extent permitted by the Federal Rules of Evidence or Federal Rules of Civil Procedure. But the statements and disclosures provided for in D. Kan. Pat. Rule 4.1 and 4.2 are not admissible for any purpose other than in connection with motions seeking an extension or modification of the time periods within which actions contemplated by these Patent Local Rules must be taken.

2.6 Relationship to the Federal Rules of Civil Procedure

Except as provided in this paragraph or as otherwise ordered, a party may not object to an opposing party's discovery request (e.g., interrogatory, document request, request for admission, deposition question) or decline to provide information otherwise required to be disclosed under Fed. R. Civ. P. 26(a)(1), on the basis that the discovery request or disclosure is premature in light of, or otherwise conflicts with, these Patent Local 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 grounds that they are premature in light of the timetable provided in the Patent Local Rules:

- (a) Requests seeking to elicit a party's claim construction position;
- (b) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, product, device, process, method, act, or other instrumentality;
- (c) Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art; and
- (d) Requests seeking to elicit from an accused infringer the identification of any advice of counsel and related documents.

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 must, without further request, provide the requested information on the date on which it is required to be provided to an opposing party under these Patent Local Rules or as set by the court, unless there exists another legitimate ground for objection.

PATENT DISCLOSURES

3.1 Disclosure of Asserted Claims and Infringement Contentions

Not later than 14 days after the Rule 16 Scheduling Conference, a party claiming patent infringement must 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” must 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, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware. This identification must be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;
- (c) A chart identifying specifically where each limitation of each asserted claim is found within each Accused Instrumentality. For each limitation that such party contends is governed by pre-America Invents Act (“AIA”) 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f), the chart must include the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function. If two or more Accused Instrumentalities have the same relevant characteristics, they may be grouped together in one claim chart;
- (d) For each claim that is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts or the alleged indirect infringers that contribute to or are inducing that direct infringement. Insofar as alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described;
- (e) Whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;
- (f) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;
- (g) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim;

- (h) If a party claiming patent infringement alleges willful infringement, the principal facts supporting such allegation; and
- (i) If the parties disagree about the applicability of pre- or post-AIA law regarding 35 U.S.C. § 102, a detailed statement for each disputed patent explaining the party's contention. The parties must meet and confer beforehand to determine whether any such disagreement exists.

3.2 Document Production Accompanying Disclosure

With the “Disclosure of Asserted Claims and Infringement Contentions,” the party claiming patent infringement must 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 before the date of application for the patent in suit. A party's production of a document as required by these rules does not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102;
- (b) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified under D. Kan. Pat. Rule 3.1(f), whichever is earlier;
- (c) A copy of the file history for each patent-in-suit;
- (d) All documents evidencing ownership of the patent rights by the party asserting patent infringement; and
- (e) If a party identifies instrumentalities under D. Kan. Pat. Rule 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.

The producing party must separately identify by production number the documents that correspond to each category.

3.3 Invalidity Contentions

Not later than 49 days after service upon it of the “Disclosure of Asserted Claims and Infringement Contentions,” each party opposing a claim of patent infringement, must serve on all parties its “Invalidity Contentions,” which must contain the following information:

- (a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent must be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher.

- (1) For cases governed by pre-AIA 35 U.S.C. § 102, the party opposing a claim of patent infringement must identify 35 U.S.C. §102(b) prior art by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity that made the use or that made and received the offer, or the person or entity that made the information known or to whom it was made known. The party must identify 35 U.S.C. § 102(f) prior art by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. The party must identify 35 U.S.C. § 102(g) prior art 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);
 - (2) For cases governed by post-AIA 35 U.S.C. § 102, the party opposing a claim of patent infringement must identify 35 U.S.C. §102(a)(1) prior art by specifying the item offered for sale, in public use, or otherwise available to the public, the date the offer or use took place or the claimed invention was made available, and the identity of the person or entity that made the use or that made or received the offer, or the person or entity that made the claimed invention available or to whom it was available. The party must identify 35 U.S.C. § 102(a)(2) prior art by its number, country of origin, and date of issue if it is a patent, or by its application number, country of origin, and filing date if it is a patent application. The party must identify 35 U.S.C. § 102(a)(2) prior art patents or applications by specifying the effective filing date to which the party believes such patents or applications are entitled;
- (b) 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;
 - (c) A chart identifying where specifically in each alleged item of prior art each limitation of each asserted claim is found, including for each limitation that such party contends is governed by pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function;
 - (d) A statement of any grounds of invalidity based on ineligibility under 35 U.S.C. § 101, indefiniteness under pre-AIA 35 U.S.C. § 112(2) or post-AIA 35 U.S.C. § 112(b), or enablement or written description under pre-AIA 35 U.S.C. § 112(1) or post-AIA 35 U.S.C. § 112(a) of any of the asserted claims; and
 - (e) If the parties disagree about the applicability of pre- or post-AIA law regarding 35 U.S.C. § 102, a detailed statement for each disputed patent explaining the party's contention. The parties must meet and confer beforehand to determine whether any such disagreement exists.

3.4 Document Production Accompanying Invalidity Contentions

With the “Invalidity Contentions,” the party opposing a claim of patent infringement must produce or make available for inspection and copying:

- (a) Documents (e.g., specifications, schematics, flow charts, artwork, formulas, source code, or other documentation) sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its D. Kan. Pat. Rule 3.1(c) chart; and
- (b) A copy or sample of the prior art identified under D. Kan. Pat. Rule 3.3(a) that does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon must be produced.

The producing party must separately identify by production number the documents that correspond to each category.

3.5 Amendment to Contentions

- (a) Amendment of the Infringement Contentions or the Invalidity Contentions may be made only by order of the court upon a timely showing of good cause. Non-exhaustive examples of circumstances that typically will, absent undue prejudice to the non-moving party, support a finding of good cause include:
 - (1) A claim construction by the court different from that proposed by the party seeking amendment;
 - (2) Recent discovery of material, prior art despite earlier diligent search; or
 - (3) Recent discovery of nonpublic information about the Accused Instrumentality that was not discovered, despite diligent efforts, before the service of the Infringement Contentions.

The duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.

- (b) The court will not entertain any motion seeking leave to amend the Infringement Contentions or the Invalidity Contentions until the following requirements have been satisfied:
 - (1) Counsel for the moving party has in good faith conferred or attempted to confer by telephone or in person with opposing counsel concerning the amendment before filing the motion. Merely writing a letter is not sufficient. Counsel for the moving party must certify compliance with this rule in any subsequent motion for leave to amend; and
 - (2) If the parties resolve the issue, the moving party must file an unopposed motion for leave to amend expressly noting that opposing counsel does not oppose the

motion. If, however, the proposed amendment remains unresolved after the attorneys have conferred in person or by telephone, counsel for the moving party must contact the magistrate judge and arrange a telephone conference with the magistrate judge and opposing counsel. No written motion on a contested amendment may be filed until this telephone conference has been held.

3.6 Advice of Counsel

Not later than 35 days after service by the court of its claim construction ruling, each party relying upon an advice of counsel as part of a patent-related claim or defense for any reason must:

- (a) Produce or make available for inspection and copying any written advice and documents related thereto for which the attorney-client and work production 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 other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the advice that 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 D. Kan. Pat. Rule 3.6 will not be permitted to rely on advice of counsel for any purpose absent a stipulation of all parties or by order of the court.

CLAIM CONSTRUCTION PROCEEDINGS

4.1 Exchange of Proposed Terms for Construction

- (a) Each party must serve on each other party a list of claim terms that the party contends should be construed by the court and identify any claim term that the party contends should be governed by pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f). Service must occur not later than 14 days after service of the “Invalidity Contentions” pursuant to D. Kan. Pat. Rule 3.3.
- (b) The parties must thereafter meet and confer for the purposes of limiting the terms in dispute by narrowing and resolving differences and facilitating the ultimate preparation of a Joint Claim Construction Statement. The parties must also jointly identify the 10 terms likely to be most significant to resolving the parties’ dispute, including those terms for which construction may be case or claim dispositive.

4.2 Exchange of Preliminary Claim Constructions and Extrinsic Evidence

- (a) Not later than 21 days after the exchange of the lists pursuant to D. Kan. Pat. Rule 4.1, the parties must simultaneously exchange proposed constructions of each term identified by either party for claim construction. Each such “Preliminary Claim Construction” must also, for each term that any party contends is governed by pre-AIA 35 U.S.C. § 112(6) or post-AIA 35 U.S.C. § 112(f), 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 Construction,” each party must also identify all references from the specification or prosecution history that support its proposed construction and designate any supporting extrinsic evidence including, without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses. Extrinsic evidence must be identified by production number or by producing a copy if not previously produced. With respect to any supporting witness, percipient or expert, the identifying party must also provide an affidavit containing the witness’s proposed testimony including, for any expert, the items listed in Fed. R. Civ. P. 26(a)(2)(B)(i)-(iii).
- (c) The parties must thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a Joint Claim Construction Statement.

4.3 Joint Claim Construction Statement

Not later than 42 days after the parties exchange the list of claim terms requiring construction pursuant to D. Kan. Pat. Rule 4.1, the parties must complete and file a “Joint Claim Construction Statement,” which must contain the following information:

- (a) The construction of those terms on which the parties agree;

- (b) Each party's proposed construction of each disputed term, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction or to oppose any other party's proposed construction, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses;
- (c) An identification of the terms whose construction will be most significant to the resolution of the case up to a maximum of 10. The parties must also identify any term among the 10 whose construction will be case or claim dispositive. If the parties cannot agree on the 10 most significant terms, the parties must identify the ones that they do agree are most significant and then they may evenly divide the remainder with each party identifying what it believes are the remaining most significant terms. However, the total terms identified by all parties as most significant cannot exceed 10. For example, in a case involving two parties, if the parties agree upon the identification of five terms as most significant, each may only identify two additional terms as most significant; if the parties agree upon eight such terms, each party may only identify one additional term as most significant;
- (d) The anticipated length of time necessary for any Claim Construction Hearing; and
- (e) The proposed format of any Claim Construction Hearing, including whether any party proposes to call one or more witnesses, the identity of each such witness, the order of presentation of terms and argument, and the estimated length of any hearing.

4.4 Completion of Claim Construction Discovery

Not later than 28 days after filing of the Joint Claim Construction Statement, the parties must complete all discovery relating to claim construction, including any depositions with respect to claim construction of any witnesses, including experts, identified in the Preliminary Claim Construction and (D. Kan. Pat. Rule 4.2) or Joint Claim Construction Statement (D. Kan. Pat. Rule 4.3).

4.5 Claim Construction Briefs

- (a) Not later than 42 days after serving and filing the Joint Claim Construction Statement, the party opposing infringement (or the party asserting invalidity if there is no infringement issue present in the case) must serve and file an opening brief and any evidence supporting its claim construction. Consistent with D. Kan. Rule 7.1, the argument and authorities section of the brief must not exceed 30 pages absent court order.
- (b) Not later than 28 days after service upon it of an opening brief, the opposing party must serve and file its responsive brief and supporting evidence. Consistent with D. Kan. Rule 7.1, the argument and authorities section of the brief must not exceed 30 pages absent court order.

- (c) Not later than 14 days after service upon it of a responsive brief, the party opposing infringement (or the party asserting invalidity if there is no infringement issue present in the case) must serve and file any reply brief and any evidence directly rebutting the supporting evidence contained in an opposing party's response. The argument and authorities section of the brief must not exceed 10 pages absent court order.

4.6 Claim Construction Hearing

If the court chooses to conduct a claim construction hearing, subject to the convenience of the court's calendar, and unless the court orders otherwise, the court will generally conduct any Claim Construction Hearing within 28 days following submission of the reply brief specified in D. Kan. Pat. Rule 4.5(c). If the court chooses to conduct a Claim Construction Hearing, the parties must jointly file a "Final Claim Construction Chart" at least 10 days before the hearing.

- (a) The chart must include a column listing complete language of disputed claims with disputed terms in bold type and separate columns for each party's proposed construction of each disputed term. The chart must also include a column entitled "Court's Construction" and otherwise left blank. Additionally, the chart must also direct the court's attention to the patent and claim number(s) where the disputed term(s) appear(s).
- (b) The chart may include constructions for claim terms to which the parties have agreed. If the parties choose to include agreed constructions, each party's proposed construction column must state "[AGREED]" and the agreed construction must be inserted in the "Court's Construction" column.
- (c) The purpose of the Final Claim Construction Chart is to assist the court and the parties in tracking and resolving disputed terms. Accordingly, aside from the requirements set forth in this rule, the parties are afforded substantial latitude in the chart's format so that they may fashion a chart that most clearly and efficiently outlines the disputed terms and proposed constructions.