

[Shortly after the filing of a new patent case, the court will enter an order similar in content and form to the following. The parties in a patent case must use the proposed Scheduling Order and Discovery Plan attached to this order instead of the form ordinary utilized in civil cases in this court.]

## **ORDER FOR PRETRIAL SCHEDULING CONFERENCE IN PATENT CASE**

Because it appears this case might involve complex and unique scheduling issues, the parties are relieved of their obligation to submit a proposed scheduling order and discovery plan pursuant to Local Rule 16.1. Instead, this matter will come on for a scheduling conference before Judge Mark W. Bennett and U.S. Magistrate Judge Paul A. Zoss at [date and time to be set by the Court] in the third floor courtroom of the United States Courthouse in Sioux City, Iowa.

By [date to be set by the court], the parties must confer and discuss the following:

1. A deadline for the plaintiff to serve on the defendants a “Plaintiff’s Claim Chart,” identifying: (A) the patent claims the plaintiff alleges are being infringed; (B) the defendants’ specific products or devices which the plaintiff alleges infringe each patent claim described in (A); and (C) a detailed statement of how each such product or device identified in (B) allegedly causes the infringement described in (A), including identification of the specific characteristics of the product(s) or device(s) that allegedly cause the infringement specified in (A).

2. A deadline for the defendants to serve on the plaintiff a “Defendants’ Claim Chart,” indicating the characteristics listed in item (C) of the Plaintiff’s Claim Chart which the defendants admit are present in their accused product or device, the characteristics the defendants contend are absent from their product or device, and the defendants’ contentions based on the doctrine of equivalents.

3. A deadline for the parties simultaneously to exchange a list of claim terms, phrases, and clauses that the parties contend should be construed by the court.

4. A deadline for each party to provide the other party with a preliminary identification of its extrinsic evidence, including without limitation dictionary definitions,

citations to learned treatises and prior art, and testimony of percipient and expert witnesses, which each party contends supports its claim construction.

5. A deadline for the parties to file with the court a joint claim construction statement that will include the claim terms, phrases, and clauses on which the parties agree and disagree; each party's proposed construction of each disputed claim term, phrase, or clause; an identification of the extrinsic evidence upon which each party intends to rely, either in support of its proposed construction of a claim or to oppose any other party's proposed construction of a claim; the anticipated length of time necessary for a hearing pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996); whether any party proposes to call witnesses at the *Markman* hearing; the identity of each such witness; and, for each expert witness, a summary of each opinion to be offered, in sufficient detail to permit a meaningful deposition of that expert.

6. A deadline for the parties to serve and file briefs addressing the issues the parties anticipate will be placed before the court at the *Markman* hearing.

7. Deadlines for initial disclosures, motions to add parties, motions to amend pleadings, and designation of expert witnesses.

8. Procedures, scheduling, and deadlines relating to discovery.

9. The date by which the parties will be prepared for a *Markman* hearing.

10. A deadline for dispositive motions.

11. The date by which the case will be ready for trial.

12. The number of days that will be required for trial.

At the scheduling conference, the parties are to present to the court a technical tutorial on the background of the technology at issue in the case. Each party will be allowed one hour for its presentation. Before creating the tutorial, counsel should consult with the court's Information Services Department with any questions concerning the technology available for presentation in the third floor courtroom. (Jose Leon at 712-233-

3845 or Sue Young at 712-233-3844). At the conclusion of the tutorial, a copy of the tutorial must be submitted to Chief Judge Bennett on a DVD or CD-ROM.

**The tutorials must focus on the technology at issue and may not be used to argue the parties' claim construction contentions. The tutorials will be filed under seal, subject to any protective order in effect.**

**Within ten days after the presentation of the tutorials, a party may comment, in writing (in no more than five pages), on the opposing party's tutorial.**

By [deadline to be set by the court] the parties must serve and file any objections, suggestions, or other comments concerning the draft Scheduling Order and Discovery Plan attached to this order.

**IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF IOWA  
[CENTRAL] [WESTERN] DIVISION**

Plaintiff,

vs.

,

Defendants.

No. \_\_\_\_\_-MWB

**PROPOSED SCHEDULING ORDER,  
DISCOVERY PLAN, AND  
ORDER ON MISCELLANEOUS  
PRETRIAL MATTERS**

***[DRAFT]***

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The following Scheduling Order and Discovery Plan will control the administration of this case.

***Scheduling Order***

1. The deadline for the parties to make their initial disclosures is \_\_\_\_\_.
2. Fact discovery may begin \_\_\_\_\_.
3. The deadline for serving and filing motions to add parties is \_\_\_\_\_.
4. The deadline for serving and filing motions to amend pleadings is \_\_\_\_\_.
5. By \_\_\_\_\_, the party bearing the burden of proof as to a particular issue must serve expert reports (“Initial Expert Reports”), prepared in accordance with Fed. R. Civ. P. 26(a)(2)(B), for any expert the party intends to call as a witness at trial regarding that issue.

6. If a party intends to call an expert witness to rebut the testimony of another expert, then by \_\_\_\_\_, the party must serve an expert report (“Rebuttal Expert Report”), prepared in accordance with Fed. R. Civ. P. 26(a)(2)(B), regarding the testimony of the rebuttal witness.
7. All expert discovery, including expert depositions, must be commenced in time to be **completed** by \_\_\_\_\_.
8. All fact discovery must be commenced in time to be **completed** by \_\_\_\_\_.
9. All discovery must be commenced in time to be **completed** by \_\_\_\_\_.
10. All dispositive motions must be served and filed by \_\_\_\_\_.
11. The case will be ready for trial by \_\_\_\_\_.
12. The parties anticipate this case will require \_\_\_\_\_ days from the beginning of jury selection to the submission of the case to the jury after argument.

### ***Discovery Plan***

1. In responding to discovery requests, each party is to construe broadly terms of art used in the patent field (*e.g.*, “prior art,” “best mode,” “on sale,” etc.), and read them as requesting discovery relating to the issue as opposed to a particular definition of the term used. Compliance with this Order is not satisfied by the respondent’s including a specific definition of the term-of-art in its response, and limiting its response to that definition.
2. No more than 25 interrogatories (counted in accordance with Fed. R. Civ. P. 33(a)) may be served by each side without leave of court.
3. Excluding depositions of expert witnesses, each party is permitted to take no more than **15** depositions without leave of court. With respect to the deposition of a corporation under Fed. R. Civ. P. 30(b)(6), the party taking the deposition may

take no more than **35 hours** of testimony (irrespective of the number of 30(b)(6) notices served on that corporate party) without leave of court. The 35 hours includes all deposition time, including questions, reasonably succinct objections, and a reasonable number of recesses, but excludes any recess greater than 15 minutes. The parties may address any dispute concerning these time limits to the court. Regardless of the number of persons produced in response to a 30(b)(6) notice, any testimony taken pursuant to said 30(b)(6) notice counts as one deposition in determining the number of depositions allowed under this paragraph.

4. With respect to 30(b)(6) depositions, and other depositions as necessary and as agreed upon by the parties, the parties may exceed the seven-hour time limit imposed under Fed. R. Civ. P. 30(d)(2).
5. The plaintiff may not call more than **four** expert witnesses at trial. The defendants may not call more than **four** expert witnesses at trial.
6. The requirement of a written report under Fed. R. Civ. P. 26(a)(2)(B) applies only to those experts who are retained or specially employed to provide testimony in the case or whose duties as an employee of a party regularly involve the giving of such testimony. As to witnesses who will be called upon to provide opinions falling outside the scope of Rule 26(a)(2)(B), the party intending to call the witness has the obligation to notify the other parties of the identity and the subject matter about which the witness will testify. The opposing party has the right to depose the witness about the proposed testimony. Such depositions do not count against the number of fact depositions a party is allowed to take under paragraph 3, above.
7. Every expert report must begin with a succinct statement of the opinions the expert expects to give at trial.
8. Unless leave of court is applied for and given, no expert testimony that is not covered in a party's Expert Reports will be permitted at trial on behalf of the party.

9. Unless leave of court is applied for and given, an expert will not be permitted to use or refer to, at trial, any evidence, basis, or grounds in support of his/her opinion not disclosed in the parties' Expert Reports. Parties must disclose any demonstrative exhibit to opposing counsel at least 48 hours before the exhibit is used in a court proceeding.
10. Unless leave of court is applied for and given, no expert reports other than the Initial Expert Reports and the Rebuttal Expert Reports will be permitted, although generally, leave will be granted for a party to serve a supplemental expert report prepared and served promptly following the discovery of information not known or reasonably available to the party's expert at the time of the earlier report. Immediately following service of a supplemental expert report, the party offering the expert must make the expert available for deposition.
11. Anything shown or told to an expert relating to the issues on which he/she opines, or to the evidence, basis, or grounds in support of or countering the opinion, must be referenced in that expert's report, and is subject to discovery by the opposing party.
12. The parties are directed to agree on (A) whether drafts of expert reports must be retained and produced; and (B) whether inquiry will be permitted regarding who, if anyone, other than the expert participated in the drafting of the expert's report. In the absence of such an agreement, drafts of expert reports need not be produced, but inquiry into who participated in drafting the expert reports and the extent of their respective contributions is permitted. **The court will not entertain motions on these two issues.**

## *Other Matters*

### 1. **Markman Hearing**

- A. By \_\_\_\_\_, the plaintiff must serve on the defendants a “Plaintiff’s Claim Chart,” identifying (A) the patent claims the plaintiff alleges are being infringed; (B) the defendants’ specific products or devices which the plaintiff alleges infringe each patent claim described in (A); and (C) a detailed statement of how each such product or device identified in (B) allegedly causes the infringement described in (A), including identification of the specific characteristics of the product(s) or device(s) that allegedly cause the infringement specified in (A). If any of the plaintiff’s claims of infringement arise under the doctrine of equivalents, then the plaintiff must indicate that separately on its Claim Chart, and in addition to the information required for literal infringement, the plaintiff also must explain each of the functions, ways, and results that it contends are equivalent, and why it contends any differences are not substantial.
- B. By \_\_\_\_\_, the defendants must serve on the plaintiff “Defendants’ Claim Chart,” in which the defendants must indicate the characteristics listed in item (C) of the Plaintiff’s Claim Chart which the defendants admit are present in its accused product or device, the characteristics the defendants contend are absent from its product or device, and the defendants’ contentions based on the doctrine of equivalents. As to the doctrine of equivalents, the defendants must indicate on their chart their contentions concerning any differences in functions, ways, or results, and why they contend the differences are substantial. The defendants also must explain in detail in Defendants’ Claim Chart any other grounds for asserting invalidity of the plaintiffs’ claims.

- C. On \_\_\_\_\_, the parties simultaneously must identify to each other their extrinsic evidence, including without limitation dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses, which each party contends supports its claim construction. With respect to any such witness, the parties also must provide a brief description of the substance of the witness's proposed testimony. With respect to all other extrinsic evidence, the parties are to identify each item of extrinsic evidence with specificity (e.g., by production number), or produce a copy of any such item not produced previously. On the same date, the parties simultaneously must exchange lists of claim terms, phrases, and clauses which the parties contend should be construed by the court.
- D. By \_\_\_\_\_, the parties must confer for the purpose of narrowing and resolving their differences to facilitate the preparation of a joint claim construction statement, which must be filed with the court by \_\_\_\_\_. The joint claim construction statement must contain the following information:
- i. The construction of those claim terms, phrases, and clauses on which the parties agree;
  - ii. Each party's proposed construction of each disputed claim term, phrase, and clause, together with citations to all authorities and references that support that construction, and an identification of any extrinsic evidence (including dictionary definitions, citation to learned treatises and prior art, and testimony of percipient and expert witnesses) known to the party and upon which the party intends to rely either in support of its proposed construction of the claim or to oppose any other party's proposed construction of the claim;

- iii. The anticipated length of time necessary for the *Markman* hearing; and
  - iv. Whether each party proposes to call any witnesses, including expert witnesses, at the *Markman* hearing, and if so, the identity of each such witness, and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert.
- E. By \_\_\_\_\_, the parties must serve and file briefs addressing the issues the parties anticipate will be placed before the court at the *Markman* hearing. Rebuttal briefs must be served and filed by \_\_\_\_\_.
- G. A *Markman* hearing will be held before Chief Judge Bennett at \_\_\_\_\_ .m. on \_\_\_\_\_, 2005, in the third floor courtroom of the United States Courthouse in Sioux City, Iowa. (*Before submitting this proposed order, the parties must contact Judge Bennett's Assistant, Jennifer Gill, at 712-233-3852, to obtain a date for the Markman hearing.*)

**2. Prior Art**

- A. By \_\_\_\_\_, the defendants must serve on the plaintiff "Defendants' Prior Art Statement," which must contain a list of all of the prior art on which the defendants rely, and a complete and detailed explanation of what the defendants allege the prior art shows and how that prior art invalidates the claims asserted by the plaintiff.
- B. By \_\_\_\_\_, the plaintiff must serve on the defendants "Plaintiff's Prior Art Statement," which must contain a complete and detailed response to the Defendants' Prior Art Statement.

- C. After service of the Plaintiff's Prior Art Statement, the defendants may add prior art to their original Statement only with leave of court, upon a showing that:
- i. the prior art was not known to the defendants when the Defendants' Prior Art Statement was served on the plaintiff;
  - ii. the prior art reasonably could not have been discovered earlier by the defendants;
  - iii. it is not merely cumulative of prior art already listed; and
  - iv. the defendants will be prejudiced if leave is denied, and the plaintiff will not be prejudiced if leave is given.

**3. Pleading of defenses:**

- A. The plaintiff may not assert an objection to any discovery on the grounds that the discovery relates to defenses not pled by the defendants, when the evidence needed to support such defenses is, in whole or in part, in the hands of the plaintiff.
- B. If the defendants rely on advice of counsel as a defense to the charge of willfulness, the defendants must produce to the plaintiff, within fourteen business days after the *Markman* hearing, the following:
- i. copies of all written advice they received concerning the patents the defendants are charged with infringing; and
  - ii. an identification of any oral advice the defendants received concerning the patents they are charged with infringing, including:
    - (a) the giver(s) of the advice;
    - (b) the recipient(s) of the advice;
    - (c) the date(s) the advice was given; and
    - (d) the substance of the advice.

#### 4. Privilege and Related Issues

##### A. Foreign Prosecution

- i. If requested by the defendants, the plaintiff must produce:
  - (a) all prior art cited against foreign counterparts of the U.S. application for the patent-in-suit; and
  - (b) all communications to or from foreign patent offices regarding counterparts of the U.S. application for the patent-in-suit.
- ii. “Foreign counterparts” is to be interpreted broadly and includes applications based on specifications similar to those for the patent-in-suit, regardless of their claims.
- iii. There is a presumption that communications between persons prosecuting foreign counterpart applications (attorneys or patent agents), on the one hand, and (a) the inventors, (b) U.S. prosecution counsel, and (c) each other, on the other hand, are privileged. If such communications are requested by the defendants, and the plaintiff objects on privilege grounds, no motion to compel may be filed unless the defendants can show, with specificity, what they expect the communications to show (“something damaging to the plaintiff’s position” or similar language is not a sufficiently specific showing), and how they intend to use the information discovered if the information shows what is expected. If a sufficient showing by the defendants is made, the court will receive the communications for inspection *in camera*, and will release them to the defendants only if they do show what the defendants expected.

B. Patent Owner/Prosecution Counsel Communications

- i. Communications during patent prosecution between the inventor and owner of the patent-in-suit, on the one hand, and counsel prosecuting the patent, on the other hand, are presumptively privileged, and need not be produced by the plaintiff unless the defendants can state:
  - (a) with reasonable specificity what information they believe is contained within such communications, and the basis for such belief; and
  - (b) for what purpose they would use the information at trial.
- ii. If the defendants make the required showing, the documents in question will be produced to the court for *in camera* inspection to determine whether they do, in fact, contain the information specified by the defendants and whether it could be used for the purpose proposed by the defendants. The documents will be produced to the defendants only if both conditions are satisfied.

C. Withheld Document Log

Absent an agreement of counsel to the contrary, any document requested that is not produced must be identified in a log of withheld documents (“Withheld Document Log”). For each document listed on the Withheld Document Log, the following information must be given:

- (a) the author(s);
- (b) the recipient(s);
- (c) the position held by each author and each recipient, including whether they are lawyers;
- (d) the date;
- (e) the basis or bases for withholding the document;

- (f) a description of the document in such detail that the requesting party can determine whether to challenge the basis or bases set forth pursuant to subparagraph (e), above (e.g., “the document contains legal advice from X to Y concerning the subject of marking with the patent number”).

D. Inventor Testimony

In depositions of the inventor(s) of the patent-in-suit, no attorney is permitted to instruct the witness not to answer questions posed by an attorney unless the objection is expressly permitted by the Federal Rules of Civil Procedure. Questions calling for the inventor(s) to state an opinion or interpret a document relevant to issues in the case are not objectionable, and must be answered if the deponent has an opinion or considers himself or herself able to give an interpretation. An inventor can decline to answer the question only if, in truth, the inventor has no opinion or is unable to interpret the document, but in such case, the inventor will be barred from giving an opinion interpreting such document at trial, and opposing counsel may advise the fact finder at trial that the inventor declined to answer the question during his/her deposition.