

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF INDIANA**

**INSTRUCTIONS FOR PREPARING CASE
MANAGEMENT PLAN IN TRACK 3 PATENT CASES**

The following provisions apply to all patent cases filed in the United States District Court for the Southern District of Indiana in which *design* is at issue, as well as all patent cases assigned to Chief Judge Hamilton. This plan is intended for cases in which all relevant issues are contested. Alteration may be necessary in each individual case. Compression of the deadlines herein is expected for cases in which a preliminary injunction is sought.

Counsel should note that the court has made every effort to devise a realistic schedule for patent cases. In light of their complexity, and the court's past experience with such cases, the schedule has been expanded substantially beyond that of the court's usual case management plan. Accordingly, further expansion of the deadlines as the case progresses is very unlikely, and the parties should not anticipate that motions for extension of time will be granted absent a showing of good cause coupled with unexpected circumstances.

General Instructions For All Cases

Counsel for plaintiff(s) shall be responsible for coordinating timely completion of the CMP. **The deadline for filing the CMP is 90 days from the date the case was filed or removed.** The deadline for filing the CMP shall not be extended without written motion which establishes good cause to extend the deadline. Regardless of the status of the CMP, the parties are free to engage in discovery in compliance with the Federal Rules of Civil Procedure and Local Rules of this court.

The calculation of all deadlines for the CMP is based on the "Anchor Date," which means the date that the case was filed or removed to this court. Because all CMP deadlines are linked to the Anchor Date, plaintiff(s) must promptly effectuate service on all defendant(s). The court may entertain requests from defendant(s) to modify/lengthen all CMP deadlines if service is not made promptly.

District judges and magistrate judges regularly receive documents filed by all parties. Therefore, parties shall not bring "courtesy copies" to any chambers unless specifically directed to do so by the court. In accordance with Local Rule 26.2, discovery papers are not ordinarily filed with the court.

In addition to those conferences required by Local Rule 37.1, counsel are encouraged to hold informal conferences in person or by phone to resolve any disputes involving non-dispositive issues that may otherwise require submission of a motion to the court. Therefore, prior to filing any non-dispositive motion (including motions for extension of time), the moving party must contact opposing counsel to determine whether there is an objection to any non-dispositive motion (including motions for extension of time), and state in the motion whether opposing counsel objects to the motion. If an objection cannot be resolved by counsel, the

opposing counsel's position shall be stated within the motion. The motion should also indicate whether opposing counsel plans to file a written objection to the motion and the date by which the court can expect to receive the objection (within the time limits set in Local Rule 7.1). If after a reasonable effort, opposing counsel cannot be reached, the moving party shall recite in the motion the dates and times that messages were left for opposing counsel.

Often in patent cases, the parties and the court find regularly scheduled status conferences with the magistrate judge useful. These regular conferences often serve to minimize discovery motions and foster civility among counsel. Accordingly, the parties are encouraged to request a status conference with the magistrate judge at any time.

The format for the Case Management Plan should be as follows:

[INSERT CASE CAPTION]

CASE MANAGEMENT PLAN

I. Parties and Representatives

- A. [Insert correct name of each party]
- B. [Insert full name, address, telephone, fax number, and e-mail address of all counsel]

Counsel shall promptly file a notice if there is any change in this information.

II. Synopsis of Case

- A. [Insert brief statement of plaintiff's claims, including relevant facts, legal theories, basis for subject matter jurisdiction, and an estimate of damages.]
- B. [Insert brief responsive statement of defendant's claims, including relevant facts, legal theories, affirmative defenses, counterclaims, subject matter jurisdiction, and damages.]

III. Pretrial Pleadings and Disclosures

- A. The parties shall serve their Fed. R. Civ. P. 26 initial disclosures on or before _____ [no later than **120 days** from Anchor Date].¹
- B. All motions for leave to amend the pleadings and/or to join additional parties shall be filed on or before _____ [no later than **150 days** from Anchor Date].
- C. Plaintiff(s) shall serve Disclosure of Asserted Claims and Preliminary Infringement Contentions on or before _____ [no later than **150 days** from Anchor Date]² which shall contain the following information:

¹ Fed. R. Civ. P. 26(a)(1)(E) permits the parties to object to making initial disclosures or to stipulate to a different deadline for making such disclosures based upon the circumstances of the action. If any objection and/or stipulation is made to initial disclosures in the CMP, the parties shall briefly state the circumstances justifying their respective positions.

² Notes about additional suggestions not incorporated into this document:

(a) For complex cases, consider adding "preliminary noninfringement contentions" at the same deadline as "preliminary invalidity contentions" and adding "validity contentions" between the deadlines for "preliminary invalidity contentions" and "exchange list of claim terms to be construed"; and

1. Each claim of each patent in suit that is allegedly infringed by each opposing party;
2. Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus 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;
3. A Plaintiff’s Claim Chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element 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;
4. Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;
5. For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and
6. 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.

With the “Disclosure of Asserted Claims and Preliminary 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

(b) For cases in which the accused product is not readily available (*e.g.*, source code), additional time should be permitted for “preliminary infringement contentions.”

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, 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. 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; and
- c. A copy of the file history for each patent in suit.

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

- D. Defendant(s) shall serve Preliminary Invalidity Contentions on or before _____ [no later than **195 days** from Anchor Date].

Each party opposing a claim of patent infringement shall serve on all parties its "Preliminary 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 shall 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. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s); (b) Whether each item of prior art anticipates each asserted claim or renders it obvious. If a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, must be identified; (c) A chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element 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 (d) Any grounds of invalidity based on 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.

With the “Preliminary Invalidity Contentions,” the party opposing a claim of patent infringement must produce or make available for inspection and copying: (a) Source code, specifications, schematics, flow charts, artwork, formulas, and other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its Plaintiff’s Claim Chart; (b) A copy of each item of prior art identified 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 must be produced.

- E. The parties shall simultaneously exchange lists of claim terms, phrases, or clauses which they contend should be construed by the Court and identify any claim element which they contend should be governed by 35 U.S.C 112(6) on or before _____ [no later than **210 days** from Anchor Date]. The parties shall thereafter meet and confer for the purposes of finalizing these lists, narrowing or resolving differences, and facilitating the ultimate preparation of a Joint Claim Construction Statement.
- F. On or before _____ [no later than **230 days** from Anchor Date], the parties shall disclose the name, address, and vita of each expert witness whom they intend to use in support of their *Markman* brief, call at the *Markman* hearing, and/or use in summary judgment briefing. If a party discloses an expert witness on this deadline, any party that did not identify an expert witness on this deadline may disclose the name, address and vita of an expert witness whom they intend to use in support of their *Markman* brief, call at the *Markman* hearing, and/or use in summary judgment briefing on or before _____ [no later than **235 days** from Anchor Date].
- G. On or before _____ [no later than **230 days** from Anchor Date] the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which the parties collectively have identified for claim construction purposes. Each such “Preliminary Claim Construction” shall for each element 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 element. By the same date, the parties also shall provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citation to learned treatises and prior art, and testimony of percipient or expert witnesses they contend support their respective claim constructions. The parties shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not produced. With respect to any percipient

witness, the parties shall also provide a brief description of the substance of that witness' proposed testimony.

- H. Within **10 days** after service of the statements of preliminary claim construction, the parties shall meet and confer to discuss issues relating to claim construction. During this meeting, the parties shall confer for the purposes of narrowing or resolving differences and facilitating the ultimate preparation of a Joint Claim Construction Statement.
- I. If the plaintiff(s) identified a *Markman* expert, plaintiff(s) shall serve the expert report required by Fed. R. Civ. P. 26(a)(2)(B), on or before _____ [no later than **360 days** from Anchor Date]. Also by that date, any party who identified a summary judgment expert on an issue on which that party bears the burden of proof shall serve the expert report required by Fed. R. Civ. P. 26(a)(2)(B).
- J. On or before _____ [no later than **375 days** from the Anchor Date if a *Markman* expert is identified or no later than **315 days** from Anchor Date if a *Markman* expert is not identified], each party opposing a claim of patent infringement that will rely on an opinion of counsel as part of a defense to a claim of willful infringement shall: (i) Produce the opinion(s) and any other documents relating to the opinion(s) as to which that party agrees the attorney-client or work product protection has been waived; and (ii) 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 opinion(s) which the party is withholding on the grounds of attorney-client privilege or work product protection.
- A party opposing a claim of patent infringement who does not comply with these requirements shall not be permitted to rely on an opinion of counsel as part of a defense to willful infringement absent a stipulation of all parties or by order of the Court, which shall be entered only upon a showing of good cause.
- K. If defendant(s) identified a *Markman* expert, defendant(s) shall serve the expert report required by Fed. R. Civ. P. 26(a)(2)(B) within 30 days after plaintiff(s) serves its expert witness disclosure; or if none, defendant(s) shall make its expert disclosures on or before _____ [no later than **390 days** from Anchor Date]. Also by that date, responsive summary judgment expert reports shall be served.
- L. The parties shall file a Joint Claim Construction Statement on or before _____ [no later than **400 days** from Anchor Date if a *Markman* expert is identified or no later than **340 days** from Anchor Date if a *Markman* expert is not identified]. The Joint Claim Construction Statement shall contain the following information: (a) the construction of those claims, terms, phrases, or

clauses on which the parties agree; (b) each party's proposed construction of each disputed claim, term, phrase, or clause; (c) the anticipated length of time necessary for the *Markman* hearing; and (d) whether any party proposes to call one or more witnesses, including experts, at the *Markman* hearing, 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.

- M. A settlement conference before the assigned magistrate judge or, if the parties prefer, private mediation, will be held approximately **10 days** after the parties file the Joint Claim Construction Statement.
- N. The parties shall file initial *Markman* briefs and any summary judgment motions on or before _____ [no later than **420 days** from Anchor Date if a *Markman* expert is identified or no later than **360 days** from Anchor Date if a *Markman* expert is not identified]. Both shall be briefed pursuant to the schedule set forth in Local Rule 56.1.
- O. The parties should anticipate that a *Markman* hearing will be held approximately [no later than **420 days** after the Anchor Date if a *Markman* expert is identified or no later than **480 days** from Anchor Date if a *Markman* expert is not identified].
- P. The Court will schedule a case management conference approximately 15 days following the Court's *Markman* decision. Deadlines for damages expert reports, if applicable, will be determined at this conference; it is expected that damages discovery should have been conducted while the *Markman* issues were under advisement. If required by the Court's *Markman* decision, parties can request that supplemental non-damages expert reports and/or additional summary judgment motion practice be added to the CMP.
- Q. A party claiming patent infringement may, **within 30 days after the Court's *Markman* decision**, serve "Final Infringement Contentions" that amend its Preliminary Infringement Contentions if that party in good faith believes that the Court's Claim Construction Ruling or the documents produced by the other part(ies) during the course of discovery so require.
- R. Not later than **30 days after the Court's *Markman* decision**, plaintiff(s) shall serve (but not file with the Court) a statement of damages to be sought at trial, if any, and make a settlement demand. Defendant(s) shall serve (but not file with the Court) a response thereto within **30 days** after receipt of the demand.
- S. All parties shall file and serve their final witness and exhibit lists **30 days after the Court's *Markman* decision; these lists shall be updated (narrowed) every 30 days until trial witness lists are filed**. The final witness lists shall include a brief description of each witness' anticipated testimony and certification by

counsel that each witness has either been deposed in this action or interviewed by counsel.

- T. Not later than **60 days after the Court's *Markman* decision**, each party opposing a claim of patent infringement may serve "Final Invalidation Contentions" without leave of Court that amend its "Preliminary Invalidation Contentions" if: (i) a party claiming patent infringement has served "Final Invalidation Contentions," or (ii) the party opposing a claim of patent infringement believes in good faith that the Court's Claim Construction Ruling so requires.
- U. Amendment or modification of the Preliminary or Final Invalidation Contentions or the Preliminary or Final Invalidation Contentions, other than as expressly permitted herein, may be made only by order of the Court, which shall be entered only upon a showing of good cause.
- V. Unless otherwise determined at the case management conference, all discovery (including damages discovery) shall be completed by **90 days after the Court's *Markman* decision**.
- W. Any party who believes that bifurcation at trial is appropriate with respect to any issue or claim shall file a motion to that effect as soon as practicable, but in no event later than **105 days after the Court's *Markman* decision**; responses shall be filed **within 15 days**; replies shall be filed **within 10 days**.
- X. Any motions to exclude or limit expert testimony at trial (*Daubert* motions) shall be filed by not later than **105 days after the Court's *Markman* decision**; responses shall be filed **within 15 days**; replies shall be filed **within 10 days**.

IV. **Referral to Magistrate Judge**

At this time, all parties _____ [do/do not] consent to refer this matter to the Magistrate Judge pursuant to 28 U.S.C. § 636(b) and Federal Rule of Civil Procedure 73 for all further proceedings including trial. [If the parties consent to the referral of this case to the Magistrate Judge, they must file signed consents.]

V. **Required Pre-Trial Preparation**

- A. **SIXTY DAYS BEFORE THE FINAL PRETRIAL CONFERENCE**, the parties shall:
 - I.. File a list of witnesses who are expected to be called to testify at trial.
 - II.. Number in sequential order all exhibits, including graphs, charts and the like, that will be used during the trial. Provide the court with a list of these

exhibits, including a description of each exhibit and the identifying designation. Make the original exhibits available for inspection by opposing counsel. Stipulations as to the authenticity and admissibility of exhibits are encouraged to the greatest extent possible.

3. Submit all stipulations of facts in writing to the court. Stipulations are always encouraged so that at trial, counsel can concentrate on relevant contested facts.
4. A party who intends to offer any depositions into evidence during the party's case in chief shall prepare and file with the court and copy to all opposing parties either:
 - a. brief written summaries of the relevant facts in the depositions that will be offered. (Because such a summary will be used in lieu of the actual deposition testimony to eliminate time reading depositions in a question and answer format, this is strongly encouraged.); or
 - b. if a summary is inappropriate, a document which lists the portions of the deposition(s), including the specific page and line numbers, that will be read, or, in the event of a video-taped deposition, the portions of the deposition that will be played, designated specifically by counter-numbers.
5. Provide all other parties and the court with any trial briefs, along with all proposed jury instructions, voir dire questions, and areas of inquiry for voir dire (or, if the trial is to the court, with proposed findings of fact and conclusions of law).
6. File any motions in limine, which shall be briefed according to Local Rule 7.1.
7. Notify the court and opposing counsel of the anticipated use of any evidence presentation equipment.

B. THIRTY DAYS BEFORE THE FINAL PRETRIAL CONFERENCE, the parties shall:

1. Notify opposing counsel in writing of any objections to the proposed exhibits. If the parties desire a ruling on the objection prior to trial, a motion should be filed noting the objection and a description and designation of the exhibit, the basis of the objection, and the legal authorities supporting the objection.

2. If a party has an objection to the deposition summary or to a designated portion of a deposition that will be offered at trial, or if a party intends to offer additional portions at trial in response to the opponent's designation, and the parties desire a ruling on the objection prior to trial, the party shall submit the objections and counter summaries or designations to the court in writing. Any objections shall be made in the same manner as for proposed exhibits. However, in the case of objections to video-taped depositions, the objections shall be brought to the court's immediate attention to allow adequate time for editing of the deposition prior to trial.
3. File any objections to proposed instructions and voir dire questions submitted by the opposing parties.
4. Notify the court and opposing counsel of requests for separation of witnesses at trial.

VI. Other Matters

Anything shown or told to a testifying expert relating to the issues on which he/she opines, or to the bases or grounds in support of or countering the opinion, is subject to discovery by the opposing party.

The parties shall agree that: (A) drafts of expert reports [will/will not] be retained and produced; and (B) inquiry [is/is not] permitted into who, if anyone, other than the expert participated in the drafting of his/her report. The court will not entertain motions on these two issues. In the absence of such an agreement, drafts of expert reports need not be produced, but inquiry into who participated in the drafting and what their respective contributions were is permitted.

At the final pretrial conference, the parties will inform the court whether the parties agree that the video "An Introduction to the Patent System," distributed by the Federal Judicial Center, should be shown to the jurors in connection with its preliminary jury instructions.

Exhibit numbering shall, to the extent possible, be maintained with a single and unique exhibit number throughout the entire case. A party first marking a document as an exhibit (whether with a pleading or declaration, for a deposition or trial, or otherwise) shall mark it, and the parties shall cooperatively track which documents are so marked, and shall thereafter use that exhibit numbering for all purposes. While it is preferable to have exhibits marked sequentially, the parties may also agree to ranges of exhibit numbers for their respective, initial marking. If the same document is marked with more than one exhibit number inadvertently, such multiple exhibit numbers shall remain. The parties are not to mark exhibits as letters, but may, and are encouraged to, mark related documents

(such as duplicates with different bates numbers, or related versions of the same document) with numbers followed by letters (e.g. Exh. 7, Exh. 7-A, and Exh. 7-B).

[Insert any other matters any party believes should be brought to the Court's attention]

[INSERT SIGNATURE BLOCKS FOR ALL COUNSEL TO SIGN THE CMP HERE]

	PARTIES APPEARED IN PERSON/BY COUNSEL ON _____ FOR A PRETRIAL/STATUS CONFERENCE.	
	APPROVED AS SUBMITTED.	
	APPROVED AS AMENDED.	
	APPROVED AS AMENDED PER SEPARATE ORDER	
	APPROVED, BUT ALL OF THE FOREGOING DEADLINES ARE SHORTENED/LENGTHENED BY _____ MONTHS.	
	APPROVED, BUT THE DEADLINES SET IN SECTION(S) _____ OF THE PLAN IS/ARE SHORTENED/LENGTHENED BY _____ MONTHS.	
	THIS MATTER IS SET FOR TRIAL BY _____ ON _____ . A FINAL PRETRIAL CONFERENCE IS SCHEDULED FOR _____ AT _____ .M., ROOM _____.	
	A SETTLEMENT/STATUS CONFERENCE IS SET IN THIS CASE FOR _____ AT _____ .M. COUNSEL SHALL APPEAR:	
		_____ IN PERSON IN ROOM _____; OR
		_____ BY TELEPHONE, WITH COUNSEL FOR _____ INITIATING THE CALL TO ALL OTHER PARTIES AND ADDING THE COURT JUDGE AT (____) _____; OR
		_____ BY TELEPHONE, WITH COUNSEL CALLING THE JUDGE'S STAFF AT (____) _____.

		DISPOSITIVE MOTIONS SHALL BE FILED NO LATER THAN.

Upon approval, this Plan constitutes an Order of the Court. Failure to comply with an Order of the Court may result in sanctions for contempt, or as provided under Rule 16(f), to and including dismissal or default.

Approved and So Ordered.

Date

.....
 U. S. District Court
 Southern District of Indiana