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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

STANDING ORDER FOR PATENT CASES
(Effective April 18, 2017)

The following instructions shall apply to all patent cases assigned to Magistrate Judge Sallie Kim.

Joint Claim Construction Statement

1. The initial joint claim construction statement required by Patent Local Rule 4-3 shall be truly joint. Disputed terms, phrases, and clauses shall be designated as disputed. All other terms shall be presumed undisputed. For any term in dispute, the parties must agree on the identity of the term. With regard to disputed terms, phrases, or clauses, the joint statement shall list each disputed term, phrase, or clause (listed by claim); each party’s proposed construction; and support for each party’s proposed construction in table format.
2. Parties shall attach to the joint claim construction statement copies of all patents in dispute.

Claim Construction

3. As an initial matter, the Court will construe no more than ten terms. If more than ten terms are at issue, the parties shall meet and confer before the preparation of the joint claim construction statement on narrowing the selection of terms to be construed by the Court and shall jointly propose the ten terms requiring construction.
4. If a party genuinely believes construing more than ten terms is necessary, that party may request leave to designate additional terms for construction, pursuant to Civil Local Rule 7-11(b). The requesting party must demonstrate good cause and explain why other methods of limiting the claims at issue (such as the selection of representative claims or any grouping of

1 claims by issues presented) would be ineffective. The request must be filed no later than two
2 weeks before the deadline for filing the joint claim construction statement. If good cause is
3 shown, the Court will either agree to construe all terms or schedule a second claim construction
4 proceeding on the excess terms.

5 5. Claim construction briefs shall address each disputed term, but only those that are
6 truly disputed, following the order of the joint statement. The opening and opposition briefs shall
7 not exceed 25 pages; the reply brief shall not exceed 15 pages. The Court anticipates that the
8 parties will meet and confer before preparing the joint claim construction statement and that such a
9 process will obviate the need for a party to propose in its briefs a claim construction that differs
10 from that proposed in the statement. While the Court encourages the parties to negotiate mutually
11 agreeable constructions, the Court discourages the parties from proposing new constructions for
12 the first time in reply briefs or other filings which do not afford the opposing party an opportunity
13 to respond. However, if it becomes necessary for a party to propose a construction that is different
14 from the one found in the joint claim construction statement, that party must clearly set forth the
15 new construction and explain the basis for the change. Additionally, that party shall revise the
16 joint claim construction statement, so that the Court will have one document reflecting all current
17 proposed constructions.

18 6. If there have been changes since the joint claim construction statement was filed,
19 the parties shall file an amended, final joint claim construction statement, including only the
20 remaining disputed terms, phrases, and clauses at the time when the reply brief is filed.

21 Tutorial and Claim Construction Hearing

22 7. The Court will schedule a tutorial to occur one week prior to the claim construction
23 hearing. The purpose of the tutorial is for the parties to inform and educate the Court about the
24 technology involved in the case. Each side will be permitted 45-60 minutes to present a short
25 summary and explanation of the technology at issue. The Court encourages counsel to meet and
26 confer and, if possible, to present a joint tutorial. If the parties cannot agree on a joint
27 presentation, then the patent holder makes the first presentation. Visual aids are encouraged. The
28 Court strongly prefers that someone other than counsel make the presentation. Counsel will be

1 permitted to make opening remarks and then a brief summation following the presentation. No
2 argument will be permitted. The proceeding is not recorded, and the parties may not rely on
3 statements made at the tutorial in other aspects of the litigation.

4 8. Depending on the technology involved, the Court may determine that the assistance
5 of a neutral expert would be helpful. In such an instance, the Court may direct the parties to
6 confer and, if possible, reach an agreement as to three experts in the field who would be
7 appropriate to act as a neutral expert to assist the Court during the claim construction proceedings
8 and/or the trial. The Court will then choose one to appoint as a neutral expert pursuant to Federal
9 Rule of Evidence 706. In such a situation, the parties will split the cost of the expert equally.

10 9. The Court generally does not conduct prehearing conferences. However, either
11 party may request a telephone conference two weeks prior to the hearing, or the parties may
12 address any prehearing issues at the tutorial, if any.

13 10. The patent holder will act as the moving party for the purposes of claim
14 construction. Opening briefs in support of claim construction must be filed at least six weeks
15 before the date of the claim construction hearing, and the briefing schedule set forth at Patent
16 Local Rule 4-5 will apply.

17 11. The Court will not ordinarily hear extrinsic evidence at the claim construction
18 hearing. Should it become apparent that testimony will be necessary, counsel may submit a
19 request within two weeks of the hearing to seek the Court's prior approval for such a request.

20 12. Demonstrative exhibits and visual aids are permissible at the hearing as long as
21 they are based on information contained in the papers already filed. Counsel shall exchange
22 copies of exhibits no later than forty-eight hours prior to the hearing.

23 13. The claim construction hearing generally will be scheduled for no longer than two
24 hours. The Court will set the hearing date at the initial case management conference.

25 Subsequent Case Management Report

26 14. Within thirty days of the filing of the claim construction ruling, the parties shall file
27 a further joint case management status report. In that report, the parties must address the
28 following topics:

- 1 a) whether either party wishes to certify the claim construction ruling for
- 2 immediate appeal to the Federal Circuit;
- 3 b) the filing of dispositive motions and timing of those motions;
- 4 c) if willful infringement has been asserted, whether the allegedly-infringing
- 5 party wishes to rely on the advice of counsel defense. If so, the parties should be prepared to
- 6 address proposals for resolving any attorney-client privilege issues that arise, and whether the
- 7 parties believe bifurcation of the trial into liability and damages phases would be appropriate;
- 8 d) anticipated post-claim construction discovery;
- 9 e) any other pretrial matters; and
- 10 f) the progress of settlement discussions, if any.

11 The Court will review the report and, if necessary, schedule a further case management
12 conference and enter any appropriate orders.

13 Miscellaneous

14 15. All stipulated protective orders and filings shall comply with Civil Local Rule 79-5.
15 Any party who submits a request to file under seal pursuant to Civil Local Rule 79-5 shall include
16 a statement to inform the Court: (1) whether the document, or portion thereof, has been the subject
17 of a previous request to file under seal; and (2) if so, provide the docket numbers of the request
18 and order on the request, and describe whether the request was granted or denied. Parties shall
19 also submit a complete unredacted chambers copy of any brief or supporting papers lodged under
20 seal with all confidential material highlighted.

21 16. The Court strongly encourages parties to permit less experienced lawyers to have
22 an important role in hearings and at trial. The Court will extend the time limits for an associate
23 with fewer than five years.

24 **IT IS SO ORDERED.**

25 Dated: April 18, 2017

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SALLIE KIM
United States Magistrate Judge

ATTACHMENT A

Model Joint Claim Construction Statement

Claim Language (Disputed Terms in Bold)	Plaintiff’s Proposed Construction and Evidence in Support	Defendant’s Proposed Construction and Evidence in Support
<p>1. A method for counting wild ducks, comprising the steps of . . . (’123 Patent, Claims 1 & 2) [or] ducks Found in: ’123 Patent, Claims 1, 2 ’456 Patent, Claims 1, 8</p>	<p>PROPOSED CONSTRUCTION: <u>birds that quack</u></p> <p>INTRINSIC EVIDENCE: ’123 Patent col. 5:8 (“distinctive honking”); Response to Office Action, 4/15/09, at 3 (“This patent is distinguished from the prior art in that the quacking of the bird is featured”).</p> <p>DICTIONARY/TREATISE DEFINITIONS: Webster’s Dictionary (“duck: bird that quacks”); Field Guide (“bird call: quack”);</p> <p>EXTRINSIC EVIDENCE: McDonald Dep. at 12:10 (“I’d say the quacking makes it a duck”); ’456 Patent at col. 9:4; Donald Decl. ¶ 6.</p>	<p>PROPOSED CONSTRUCTION: <u>birds that swim</u></p> <p>INTRINSIC EVIDENCE: ’123 Patent col 5:10 (“ducks may be found on or near bodies of water”); Response to Office Action, 4/15/09, at 4 (“water fowl are particularly amenable to being counted by this method”).</p> <p>DICTIONARY/TREATISE DEFINITIONS: Random House Dictionary (“An aquatic bird”); Field Guide (same)</p> <p>EXTRINSIC EVIDENCE: Marx Dep. at xx:xx (“like a duck to water”); ’456 Patent at col. 1:38; Daffy Decl. at ¶ 7.</p>

(Or any other substantially similar format that permits the court to compare terms side by side.)

NOT:

Claim Language (Disputed Terms in Bold)	Plaintiff’s Proposed Construction and Evidence in Support	Defendant’s Proposed Construction and Evidence in Support
<p>1. A method for counting wild ducks, comprising the steps of</p>	<p>ducks ... birds that quack ...</p>	<p>wild ducks ... birds that quack and have never lived in captivity ...</p>

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