

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
JUDGE EDWARD J. DAVILA

STANDING ORDER FOR PATENT CASES

I. Application of Standing Order

Unless otherwise indicated by the Court, this Standing Order applies to all actions asserting claims for patent infringement and for declaratory judgment of non-infringement assigned to Judge Edward J. Davila.

Parties and counsel shall comply with all aspects of this Standing Order, the Standing Order for Civil Cases, the Federal Rules of Civil Procedure, the Civil and Patent Local Rules, and all General Orders of the Northern District of California.

II. Patent Disclosures

Cross-references: Patent L.R. 3-1–3-6

Referral to Magistrate Judge. Any dispute regarding any party’s Patent Disclosures are referred to the assigned Magistrate Judge. Requests to amend a party’s Infringement or Invalidity Contentions are likewise referred to the assigned Magistrate Judge.

III. Joint Claim Construction and Prehearing Statement

Cross-reference: Patent L.R. 4-3

A. **Contents.** Any disputed terms, phrases, and clauses (hereinafter, for simplicity, “terms”) 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, the joint statement shall list each term, each party’s proposed construction, and support for each party’s construction side by side. Parties are reminded that proposed constructions should be suitable for incorporation in a jury instruction. A model statement is included as Attachment A to this Order.

B. **Attachments.** Parties shall attach to the joint claim construction statement one copy of each patent in dispute. Parties shall also be prepared to make the complete prosecution history for each patent available to the Court upon request.

IV. Claim Construction Briefing

Cross-references: Patent L.R. 4-3 & 4-5

A. **Scope.** As an initial matter, the Court will construe only those terms designated by the parties as “most significant” pursuant to Patent L.R. 4-3(c). The claim construction briefs shall address each of those terms and only those terms.

B. **Enlarging the Scope.** If any party genuinely believes that construing more than

ten terms is necessary, that party may request leave to designate additional terms for construction by filing an administrative motion under 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 claims by issues presented) would be ineffective. If all parties agree that more than ten terms should be construed, the motion should be made jointly. Any such request, whether unilateral or joint, must be made on or before the deadline for filing the Joint Claim Construction and Prehearing Statement. If good cause is shown, the Court may agree to construe all terms or schedule a second claim construction proceeding on the excess terms.

- C. **Format.** The opening and responsive briefs shall not exceed 25 pages; the reply brief shall not exceed 15 pages.
- D. **Timing.** Briefing deadlines are usually set forth in a Patent Scheduling Order. Otherwise, the default schedule established by Patent L.R. 4-5 applies.
- E. **Evolving Claim Construction Positions.** The Court encourages the continuing negotiation of mutually agreeable constructions even during the briefing process. However, parties are discouraged from proposing new constructions for the first time in reply briefs or other filings which do not afford the opposing party an opportunity to respond. If it becomes necessary for a party to propose a different construction in its brief than that found in the joint claim construction statement, that party must clearly set forth the new construction and explain the basis for the change. Concurrently with the filing of the reply briefs, the parties shall file an amended joint claim construction statement if there has been any change in the parties' claim construction positions.

V. Tutorial and Claim Construction Hearing
Cross-reference: Patent L.R. 4-6

- A. **Scheduling.** By default, the Court will schedule a tutorial and claim construction hearing for a half day (i.e., three hours) on a Tuesday, Wednesday, or Thursday. The Court may allocate more time for the tutorial and hearing upon a showing of good cause made by stipulation or administrative motion.
- B. **Prehearing Conference.** Generally, the Court does not hold prehearing conferences. The parties may raise any prehearing issues on the day of the hearing. Many administrative and prehearing matters may also be resolved by contacting the Courtroom Deputy, Adriana Kratzmann, at (408) 535-5356, or, if necessary, by administrative motion.
- C. **Tutorial.** The purpose of the tutorial is for the parties to inform and educate the Court about the technology involved in the case. The parties will have one hour—30 minutes per side—for the tutorial. Unless the parties agree otherwise, the patent holder makes the first presentation. Demonstrations and visual aids are encouraged. Any experts present are encouraged to participate. No argument or cross-examination will be permitted, but the Court may pose questions to parties

and witnesses. Statements made at the tutorial may not be used against a party in other aspects of the litigation. The Court encourages the parties to make a joint presentation and will entertain requests for additional time in those circumstances.

- D. **Claim Construction.** The parties will have two hours—one hour per side—for the claim construction hearing. The hearing will proceed term-by-term with the patentee arguing first on odd-numbered terms. The parties’ arguments should focus on intrinsic evidence, i.e., the patent itself and the prosecution history. Live testimony at claim construction is disfavored; it will be allowed only by court order upon an administrative motion explaining why the testimony would be useful. Such a motion must be filed at least 14 days before the hearing.
- E. **Demonstratives.** Demonstrative exhibits and visual aids are permissible at the tutorial and the claim construction hearing as long as they are based on information contained in papers previously filed.

No later than one week prior to the tutorial and/or claim construction hearing, counsel shall exchange copies of any exhibits and visual aids, and shall submit to the Court three bound copies of the exhibits and visual aids.

VI. Subsequent Case Management Conference

Cross-references: Civil L.R. 16-9 & 16-10; Standing Order for All Judges of the Northern District of California re Contents of Joint Case Management Statement

A. At the time the claim construction ruling issues, the Court will also set a further case management conference. In a joint case management statement to be filed no later than 7 days before the conference, the parties must address the following topics:

- 1) whether either party wishes to certify the claim construction ruling for immediate appeal to the Federal Circuit;
- 2) the filing of dispositive motions, and timing of those motions;
- 3) if willful infringement has been asserted, whether the party accused of infringement wishes to rely on the advice-of-counsel defense. If so, the parties should be prepared to address proposals for resolving any attorney–client privilege issues that arise, and whether the parties believe bifurcation of the trial into liability and damages phases would be appropriate;
- 4) anticipated post-claim construction discovery;
- 5) any other pretrial matters;
- 6) the progress of settlement discussions, if any; and
- 7) any changes or updates to any of the information requested in the Standing Order for All Judges of the Northern District of California re Contents of Joint Case Management Statement that have arisen since the filing of the

parties' previous case management statement.

The Court will review the statement to determine whether the conference is necessary, and will enter any appropriate orders.

VII. Dispositive Motions

- A. **Application.** To the extent it contains requirements that differ from any other standing order applicable to civil cases, this section controls in cases asserting claims for patent infringement or for declaratory judgment of non-infringement.
- B. **Summary Judgment.** Before filing a summary judgment motion on issues of infringement or invalidity, a party must meet and confer with opposing counsel to prepare one joint statement of undisputed facts. The statement should be filed concurrently with the motion. Separate statements are not permitted. Once a hearing date for the motion has been set and the briefing is closed, the moving party shall compile a three ring binder to be lodged with the Court containing (1) the statement of undisputed facts, (2) the motion and any supporting memorandum of law, (3) the opposition memorandum, (4) any reply memorandum, and (5) any exhibits in support or opposition to the motion, which shall be clearly labeled. At the beginning of each binder the moving party shall include jointly prepared charts signed by all parties' counsel formatted as shown in Attachment B to this order. Each statement in the chart shall be supported by appropriate citations to the motion papers and or exhibits.

VIII. Miscellaneous

Opportunities for Junior Lawyers. The Court strongly encourages parties to permit less experienced lawyers to have an important role in hearings and at trial.

IT IS SO ORDERED.

Dated: May 3, 2019


EDWARD J. DAVILA
United States District 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)</p> <p>[or]</p> <p>ducks</p> <p>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. ¶ 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 ... <u>birds that quack</u> ...</p>	<p>wild ducks ... <u>birds that quack and have never lived in captivity</u> ...</p>

ATTACHMENT B

Chart 1
Summary of Infringement Issues

Patent Claim Elements	Stipulated Construction or Court Construction	Accused Product(s)	Defense(s) Asserted
'000 Patent, Claim 1			
An apparatus comprising:	apparatus means "device"	Riverside Model 2	—
1. a handle	handle means "a part held by the human hand"	Riverside Model 2 part no. 80015	the product lacks a handle
...

Chart 2
Summary of Invalidity Issues

Patent Claim	Basis of Challenge	Summary of Argument in Support	Summary of Argument in Opposition	Comments
'123 Patent, Claim 1	Lack of disclosure of best mode	The specification states that the inventor was aware of a specific undisclosed method (See '123 Patent col. 3:5-10.)	The reference is to a different invention	This issue is controlled by the Court's construction of the term "wild ducks"

(Or other substantially similar formats that give a structured overview of the issues presented.)