

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

**STANDING ORDER FOR PATENT CASES BEFORE
DISTRICT JUDGE HAYWOOD S. GILLIAM, JR.**

CONFORMITY TO RULES

1. Parties and counsel shall follow the Federal Rules of Civil Procedure, the Patent Local Rules, and the General Orders of the Northern District of California, except as superseded by this Court’s standing orders.

REFERRAL TO MAGISTRATE JUDGE

2. Any dispute regarding any party’s patent disclosures pursuant to Patent Local Rules 3-1 to 3-5 typically is referred to the assigned Magistrate Judge. Requests to amend or strike a party’s infringement contentions or invalidity contentions are likewise typically referred to the assigned Magistrate Judge.

JOINT CLAIM CONSTRUCTION STATEMENT

3. The initial joint claim construction statement required by Patent Local Rule 4-3 must be truly joint. Disputed terms, phrases, and clauses must be designated as disputed. All other terms will be presumed to be 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 will list each disputed term, phrase, or clause (listed by claim); each party’s proposed construction; and support for each party’s proposed construction side by side. A model claim construction statement is attached to this Order.

4. Parties must attach to the joint claim construction statement copies of all patents in dispute. Parties must also make a complete prosecution history for each patent available to the Court upon request.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

CLAIM CONSTRUCTION

5. The Court will generally construe no more than 10 terms. If multiple terms present identical issues, they may be grouped together or a representative term may be chosen, and each group or representative term may be considered a single term for purposes of the ten-term limit. If more than ten terms are at issue, the parties must meet and confer before the preparation of the joint claim construction statement to narrow the number of terms that are to be construed by the Court and shall jointly propose the ten terms requiring construction.

6. If a party has a good-faith basis for believing that more than ten terms need to be construed, that party may request leave to designate additional terms for construction, pursuant to Civil Local Rule 7-11. The requesting party must demonstrate good cause and explain why other methods of limiting the terms at issue (such as the selection of representative terms or any grouping of terms by issues presented) would be ineffective. The request must be filed no later than two weeks before the deadline for filing the joint claim construction statement. If good cause is shown, the Court will either agree to construe all terms or schedule a later proceeding to construe the remaining terms before trial. If more than ten terms are submitted for construction without leave of court, the Court will construe only the first ten terms listed in the joint claim construction statement and sanctions may be imposed.

TUTORIAL AND CLAIM CONSTRUCTION HEARING

7. All hearings and appearances will be held in Courtroom 2 on the 4th Floor of the United States Courthouse, 1301 Clay Street, Oakland, California.

8. At the tutorial, each side will generally be permitted 45 minutes to present a short summary and explanation of the technology at issue. The patentee presents first. Non-argumentative demonstrations and visual aids are encouraged, and the Court generally prefers that someone other than counsel make the presentation. No argument will be permitted.

9. Depending on the technology involved, the Court may determine that the assistance of a neutral expert would be helpful. In that case, the Court may direct the parties to confer and, if possible, reach an agreement as to three experts in the field who would be appropriate to act as a neutral expert to assist the Court during the claim construction proceedings and/or the trial. The

1 Court will then choose one of the three to appoint as a neutral expert pursuant to Federal Rule of
2 Evidence 706. The parties will split the cost of the expert equally.

3 10. At the claim construction hearing, each side will generally be permitted 90 minutes
4 to present its argument. Claim construction will proceed like a typical oral argument, not a
5 PowerPoint lecture. Demonstrative exhibits and visual aids that are duplicative of the arguments
6 made in the parties' claim construction briefs are strongly discouraged.

7 11. If the either party wishes to present testimony at the claim construction hearing,
8 counsel must seek leave of Court by filing an administrative motion pursuant to Civil Local Rule
9 7-11 at least seven days in advance of the hearing.

10 **SUBSEQUENT CASE MANAGEMENT REPORT**

11 12. Upon issuance of the claim construction ruling, the Court will also set a date for the
12 filing of a further joint case management status report. In that report, the parties must address the
13 following topics:

- 14 a. whether either party wishes the Court to certify the claim construction ruling
for immediate appeal to the Federal Circuit;
- 15 b. the filing of dispositive motions, and the timing of those motions;
- 16 c. if willful infringement has been asserted, whether the allegedly-infringing party
wishes to rely on the advice of counsel defense—if so, the parties should be
17 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;
- 18 d. anticipated post-claim construction discovery;
- 19 e. proposed deadlines and court dates for the remainder of the case schedule;
- 20 f. any other pretrial matters; and
- g. the progress of settlement discussions, if any.

21 The Court will review the reports and, if necessary, schedule a further case management
22 conference and enter any appropriate orders.

23 **IT IS SO ORDERED.**

24 Dated: March 10, 2017

25 
26 HAYWOOD S. GILLIAM, JR.
United States District Judge

27
28

Sample Claim Chart

'123 Patent		
<u>Claim Language (Disputed Terms in Bold)</u>	<u>Plaintiff's Proposed Construction and Evidence in Support</u>	<u>Defendant's Proposed Construction and Evidence in Support</u>
<p>1. A method for counting ducks, comprising the steps of:</p> <p>[or]</p> <p>ducks</p> <p>Found in asserted claim numbers: a, b, c, d</p>	<p>a bird that quacks</p> <p>INTRINSIC EVIDENCE: '123 Patent col. __: __ (“a distinctive honking”); Prosecution History at __ (“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 (“A duck: bird that quacks”); Field Guide (“A bird call: quack”).</p> <p>EXTRINSIC EVIDENCE: McDonald Depo. at __: __ (“I’d say the quacking makes it a duck.”); Donald Decl. at __.</p>	<p>a bird that swims</p> <p>INTRINSIC EVIDENCE: '123 Patent col. __: __ (“Ducks may be found on or near bodies of water.”); Prosecution History at __ (“Water fowl are particularly amenable to being counted by this method.”).</p> <p>DICTIONARY/TREATISE DEFINITIONS: Random House Dictionary (“A duck: an aquatic bird”).</p> <p>EXTRINSIC EVIDENCE: G. Marx Depo. at __: __ (“Like a duck to water.”); Daffy Decl. at __.</p>

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