

**Judge Phyllis J. Hamilton**  
Courtroom 3, 3rd Floor

Kelly Collins, Courtroom Deputy  
(510) 637-1296

## **STANDING ORDER FOR PATENT CASES**

The following instructions shall apply to all patent cases assigned to Judge Phyllis Hamilton.

### Joint Claim Construction Statement

1. The joint claim construction statement required by Pat. L. R. 4-3 must be truly joint. Disputed terms, phrases, and clauses must be clearly designated as disputed. All other terms will be presumed undisputed. For any term in dispute, the parties must agree on what the term actually is. With regard to disputed terms, phrases, or clauses, the joint statement must 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 joint claim construction statement is attached to this order.

2. 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.

### Claim Construction

3. As an initial matter, the court will construe no more than ten terms. If more than ten terms are in dispute, the parties must 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 must jointly propose the ten terms requiring construction.

4. If a party genuinely believes that it will require that more than approximately ten terms be construed, that party may move pursuant to Civ. L. R. 7-11 for leave to designate additional terms for construction. The requesting party must demonstrate good cause and explain why other methods of limiting the claims at issue (such as selecting representative claims or grouping claims 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, if necessary, schedule a second claim construction proceeding on the terms that exceed ten. If more than ten terms are submitted for construction without leave of court, the court will construe the first ten terms listed in the joint claim construction statement and sanctions may be imposed.

5. Claim construction briefs must address each disputed term, but only those that are truly disputed. The disputed terms must be addressed by both parties in the same order as they appear in the joint claim construction statement. Additionally, the parties shall advise the court terms disputed in the joint claim construction statement are no longer disputed in the briefs. And of course, the briefs may not address disputes that are not set forth in the joint claim construction statement. The court anticipates that a meaningful meet and confer preceding the preparation of the joint claim construction statement will obviate the need for a party to propose in its briefs a claim construction that differs from that proposed in the statement. While the court encourages the parties to negotiate mutually agreeable constructions, the court discourages the parties 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. However, 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. Additionally, that party shall revise the joint claim construction statement, so that the court will have one document reflecting all current proposed constructions.

#### Tutorial and Claim Construction Hearing

6. The court will schedule a tutorial to occur two to four weeks prior to the claim construction hearing. Each side will be permitted 30-45 minutes to present a summary of the background of the technology involved, an explanation of the nature of the problem the inventor sought to solve, and reference to the prior art in existence at the time of conception. The patent holder will make the first presentation. Visual aids are encouraged. The court prefers that someone other than counsel make the presentation. No argument or examination will be permitted. The proceeding is not recorded and statements made during the tutorial may not be cited as judicial admissions against a party.

7. Prehearing conferences are not generally held. However, either party may request a telephone conference within two weeks prior to the hearing, or the parties may address any prehearing issues at the tutorial.

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

9. The court will not ordinarily hear extrinsic evidence at the claim construction hearing. Should it become apparent that testimony will be necessary, counsel may request a telephone conference with the court within two weeks of the hearing to seek the court's approval.

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

11. The claim construction hearing will generally be scheduled for no longer than 3 hours on Wednesday's law and motion calendar. However, the court will specially set the hearing on a different day and for a longer period of time if warranted. Counsel should request a telephone conference with the court as soon as it is apparent that a special setting is necessary.

#### Subsequent Case Management Conference

12. Upon issuance of the claim construction ruling, the court will also set a date for a further case management conference. In the case management statement to be filed 7 calendar days prior to the conference, the parties must address the following topics:

- a) anticipated post-claim construction discovery;
- b) the filing of dispositive motions;
- 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 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;
- d) the progress of settlement discussions, if any;
- e) any other pretrial matters.

### Sample 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><b>'xxx Patent</b></p> <p>1. A method for counting <b>ducks</b>, comprising the steps of:</p> <p>[or]</p> <p><b>ducks</b></p> <p>Found in claim numbers:</p> <p>'xxx Patent: y, z</p> <p>'yyy Patent: a, b</p>	<p><b>duck</b></p> <p>PROPOSED CONSTRUCTION: a bird that quacks.</p> <p>DICTIONARY/TREATISE DEFINITIONS: Webster's Dictionary ("duck: bird that quacks"); Field Guide ("bird call: quack");</p> <p>INTRINSIC EVIDENCE: 'xxx Patent col. __:__ ("distinctive honking"); Prosecution History at __ ("This patent is distinguished from the prior art in that the quacking of the bird is featured").</p> <p>EXTRINSIC EVIDENCE: McDonald Depo. at xx:xx ("I'd say the quacking makes it a duck"); '123 Patent at col. __:__; Donald Decl. at ¶ __.</p>	<p><b>duck</b></p> <p>PROPOSED CONSTRUCTION: a bird that swims</p> <p>DICTIONARY/TREATISE DEFINITIONS: Random House Dictionary ("an aquatic bird"); Field Guide (same)</p> <p>INTRINSIC EVIDENCE: 'xxx 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>EXTRINSIC EVIDENCE: G. Marx Depo at xx:xx ("like a duck to water"); '456 Patent at col. __:__; Daffy Decl. at ¶ __.</p>

(Or any other substantively 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><b>'xxx Patent</b></p> <p>1. A method for counting <b>ducks</b> . . .</p>	<p><b>duck</b></p>	<p><b>counting ducks</b></p>