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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

AMERANTH, INC.,

Plaintiff,

v.

APPLE, INC.,

Defendant.

Civil No. 12-CV-2350-IEG (BGS)

**CASE MANAGEMENT CONFERENCE
ORDER REGULATING CLAIM
CONSTRUCTION AND OTHER
PRETRIAL PROCEEDINGS**
(Fed. R. Civ. P. 16)
(Local Rule 16.1)
(Fed. R. Civ. P. 26)
(Patent Local Rules)

On April 17, 2013, the Court held an Early Neutral Evaluation Conference. The case did not settle. Therefore, the Court held a Case Management Conference pursuant to Rule 16 of the Federal Rules of Civil Procedure and the Patent Local Rules immediately thereafter. After consulting with the attorneys of record for the parties and being advised of the status of the case, and good cause appearing,

IT IS HEREBY ORDERED:

1. Any motion to join other parties, to amend the pleadings, or to file additional pleadings shall be filed on or before **May 17, 2013**.

2. **Disclosure of Asserted Claims and Infringement Contentions.** On or before **July 22, 2013**, Plaintiff shall serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.” Separately for each opposing party, the “Disclosure of Asserted Claims and Infringement Contentions” must contain the following information:

a. Each claim of each patent in the suit that is allegedly infringed by each opposing party;

- 1 b. Separately for each asserted claim, each accused apparatus, product, device,
2 process, method, act, or other instrumentality (“Accused Instrumentality”) of each
3 opposing party of which the party is aware. This identification must be as
4 specific as possible. Each product, device and apparatus must be identified by
5 name or model number, if known. Each method or process must be identified by
6 name, if known, or by any product, device, or apparatus which, when used,
7 allegedly results in the practice of the claimed method or process;
- 8 c. A chart identifying specifically where each element of each asserted claim is
9 found within each Accused Instrumentality, including for each element that such
10 party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s),
11 act(s), or material(s) in the Accused Instrumentality that performs the claimed
12 function;
- 13 d. For each claim which is alleged to have been indirectly infringed, an
14 identification of any direct infringement and a description of the acts of the
15 alleged indirect infringer that contribute to or are inducing that direct
16 infringement. Insofar as alleged direct infringement is based on joint acts of
17 multiple parties, the role of each such party in the direct infringement must be
18 described;
- 19 e. Whether each element of each asserted claim is claimed to be literally present
20 and/or present under the doctrine of equivalents in the Accused Instrumentality;
- 21 f. For any patent that claims priority to an earlier application, the priority date to
22 which each asserted claim allegedly is entitled;
- 23 g. If a party claiming patent infringement asserts or wishes to preserve the right to
24 rely, for any purpose, on the assertion that its own apparatus, product, device,
25 process, method, act, or other instrumentality practices the claimed invention, the
26 party must identify, separately for each asserted claim, each such apparatus,
27 product, device, process, method, act, or other instrumentality that incorporates or
28 reflects that particular claim; and
- h. If a party claiming patent infringement alleges willful infringement, the basis for
such allegation.

3. **Document Production Accompanying Disclosure.** With the “Disclosure of Asserted
Claims and Infringement Contentions,” the party claiming patent infringement must produce to each
opposing party, or make available for inspection and copying, the following documents in the
possession, custody and/or control of that party:

- a. Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing
materials, offer letters, beta site testing 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 does 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

1 of application for the patent in suit or the priority date identified pursuant to
2 P.L.R. 3.1(e), whichever is earlier;

- 3 c. A copy of the file history for each patent in suit and each application to which a
4 claim for priority is made under P.L.R. 3.1(e);
- 5 d. Documents sufficient to evidence ownership of the patent rights by the party
6 asserting patent infringement; and
- 7 e. If a party identifies instrumentalities pursuant to Patent L.R. 3.1g, documents
8 sufficient to show the operation of any aspects or elements of such
9 instrumentalities the patent claimant relies upon as embodying any asserted
10 claims.

11 The producing party must separately identify by production number which documents
12 correspond to each category.

13 The party claiming patent infringement is required to use its best efforts to obtain the documents
14 to make a timely disclosure if the documents identified above are not in the possession, custody and/or
15 control of that party.

16 4. **Invalidity Contentions.** On or before **September 20, 2013**, Defendants shall serve on
17 all parties its “Invalidity Contentions” which must contain the following information:

- 18 a. The identity of each item of prior art that allegedly anticipates each asserted claim
19 or renders it obvious. This includes information about any alleged knowledge or
20 use of the invention in this country prior to the date of invention of the patent.
21 Each prior art patent must be identified by its number, country of origin, and date
22 of issue. Each prior art publication must be identified by its title, date of
23 publication, and where feasible, author and publisher. Prior art under 35 U.S.C.
24 §102(b) must be identified by specifying the item offered for sale or publicly used
25 or known, the date the offer or use took place or the information became known,
26 and the identity of the person or entity which made the use or which made and
27 received the offer, or the person or entity which made the information known or
28 to whom it was made known. Prior art under 35 U.S.C. §102(f) must 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) must 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 obviousness is alleged, an explanation of why the prior art renders the
asserted claim obvious; including an identification of any combinations of prior
art showing obviousness;
- 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;

- 1 d. Any grounds of invalidity based on indefiniteness under 35 U.S.C. §112(2) of any
- 2 of the asserted claims; and
- 3 e. Any grounds of invalidity based on lack of written description, lack of enabling
- 4 disclosure, or failure to disclose the best mode under 35 U.S.C. §112(1).

5 **5. Document Production Accompanying Invalidity Contentions.** With the “Invalidity
6 Contentions,” the party opposing a claim of patent infringement must produce or make available for
7 inspection and copying:

- 8 a. Source code, specifications, schematics, flow charts, artwork, formulas, or other
- 9 documentation sufficient to show the operation of any aspects or elements of any
- 10 Accused Instrumentality identified by the patent claimant in the “Disclosure of
- 11 Asserted Claims and Preliminary Infringement Contentions;”
- 12 b. A copy of each item of prior art identified in the Preliminary Invalidity
- 13 Contentions, which does not appear in the file history of the patent(s) at issue. To
- 14 the extent any such item is not in English, an English translation of the portion(s)
- 15 relied upon must be produced.

16 **6. Exchange of Terms for Construction.** On or before **October 18, 2013**, the parties shall
17 exchange terms for construction.

18 **6. Exchange of Preliminary Claim Construction and Extrinsic Evidence.**

- 19 a. On or before **November 15, 2013**, the parties shall simultaneously exchange a
- 20 preliminary proposed construction of each claim term, phrase, or clause which the parties
- 21 have identified for claim construction purposes. Each such “Preliminary Claim
- 22 Construction” will also for each element which any party contends is governed by 35
- 23 U.S.C. §112(6), identify the structure(s), act(s), or material(s) corresponding to that
- 24 element.
- 25 b. At the same time the parties exchange their respective “Preliminary Claim
- 26 Constructions,” they must also provide a preliminary identification of extrinsic evidence,
- 27 including without limitation, dictionary definitions, citations to learned treatises and prior
- 28 art, and testimony of percipient and expert witnesses they contend support their
- 29 respective claim constructions. The parties must identify each such item of extrinsic
- 30 evidence by production number or produce a copy of any such item not previously
- 31 produced. With respect to any such witness, percipient or expert, the parties must also
- 32 provide a brief description of the substance of that witness’ proposed testimony.
- 33 c. On or before **December 16, 2013**, the parties shall simultaneously exchange
- 34 “Responsive Claim Constructions” identifying whether the responding party agrees with
- 35 the other party’s proposed construction, or identify an alternate construction in the
- 36 responding party’s preliminary construction, or set forth the responding party’s alternate
- 37 construction.
- 38 d. At the same time the parties exchange their respective “Responsive Claim
- 39 Constructions,” they must also provide a preliminary identification of extrinsic evidence,
- 40 including without limitation, dictionary definitions, citations to learned treatises and prior
- 41 art, and testimony of percipient and expert witnesses they contend support any responsive
- 42 claim constructions. The parties must identify each such item of extrinsic evidence by
- 43 production number or produce a copy of any such item not previously produced. With

1 respect to any such witness, percipient or expert, the parties must also provide a brief
2 description of the substance of that witness' proposed testimony.

3 e. The parties must thereafter meet and confer for the purposes of narrowing the
4 issues and finalizing preparation of a Joint Claim Construction Chart, Joint Claim
5 Construction Worksheet and Joint Hearing Statement.

6 7. **Joint Claim Construction Chart, Worksheet and Hearing Statement.** On or before
7 **January 31, 2014**, the parties shall complete and file a Joint Claim Construction Chart, Joint Claim
8 Construction Worksheet and Joint Hearing Statement.

9 a. The Joint Hearing Statement must include an identification of the terms whose
10 construction will be most significant to the resolution of the case up to a
11 maximum of ten (10) terms. The parties must also identify among the ten (10)
12 whose construction will be case or claim dispositive. If the parties cannot agree
13 on the ten most significant terms, the parties must identify the ones which they do
14 not agree are most significant and then they may evenly divide the remainder with
15 each party identifying what it believes are the remaining most significant terms.
16 However, the total terms identified by all parties as most significant cannot
17 exceed ten. For example, in a case involving two parties, if the parties agree on
18 the identification of five terms as most significant, each may only identify two
19 additional terms as most significant; if the parties agree on eight such terms, each
20 party may only identify one additional term as most significant.

21 b. The Joint Claim Construction Chart must have a column listing complete
22 language of disputed claims with the disputed terms in bold type and separate
23 columns for each party's proposed construction of each disputed term. Each
24 party's proposed construction of each disputed claim term, phrase, or clause, must
25 identify all references from the specification or prosecution history that support
26 that construction and an identification of any extrinsic evidence known to the
27 party on which it intends to rely either to support its proposed construction of the
28 claim or to oppose any other party's proposed construction of the claim,
including, but not limited to, as permitted by law, dictionary definitions, citations
to learned treatises and prior art, and testimony of percipient and expert witnesses.
For every claim with a disputed term, each party must identify with specificity the
impact of the proposed constructions on the merits of the case.

c. The parties Joint Claim Construction Worksheet must be in the format set forth in
Appendix A and include any proposed constructions to which the parties agree,
as well as those in dispute. The parties must jointly submit the Joint Claim
Construction Worksheet on computer disk in both Word and Wordperfect format
or in such other format as the court may direct.

d. The Joint Hearing Statement must include:

1. The anticipated length of time necessary for the Claim Construction Hearing;
2. Whether any party proposes to call one or more witnesses, including experts, at the Claim Construction 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; and

1 3. The order of presentation at the Claims Construction hearing.

2 e. At the court's discretion, within 5 calendar days of the submission of the Joint
3 Claim Construction Chart, Joint Claim Construction Worksheet and Joint Hearing
4 Statement, the court will hold a status conference with the parties, in person or by
5 telephone, to discuss the schedule, witnesses and any other matters regarding the
6 Claim Construction Hearing.

7 8. **Completion of Claim Construction Discovery.** The parties shall complete all
8 discovery, including any depositions of any witnesses, including experts, the parties intend to use in the
9 Claim Construction Hearing by **February 28, 2014**. Fed. R. Civ. P. 30 applies to depositions, except as
10 to experts. An expert witness identified in a party's Joint Hearing Statement may be deposed on claim
11 construction issues. The identification of said expert in the Joint Hearing Statement may be deemed
12 good cause for a further deposition on all substantive issues.

13 9. **Claim Construction Briefs.**

14 a. On or before **February 28, 2014**, the parties shall simultaneously file and serve
15 opening briefs and any evidence supporting their claim construction.

16 b. On or before **March 28, 2014**, the parties shall simultaneously file and serve
17 briefs responsive to the opposing party's opening brief and any evidence directly
18 rebutting the supporting evidence contained in the opposing party's opening brief.

19 c. Absent leave of court, the provisions of Civ.L.R. 7.1h for length of briefs for
20 supporting and reply memoranda will apply to the length of opening and
21 responsive claim construction briefs.

22 10. **Claim Construction Hearing.** On **May 1, 2014**, at **9:00 a.m.**, the **Honorable Irma E.**
23 **Gonzalez** will conduct a Claim Construction Hearing, to the extent that parties or the court believe a
24 hearing is necessary for construction of the claims at issue.

25 11. **Second Case Management Conference.** A Second Case Management Conference will
26 be held on **June 30, 2014**, at **1:30 p.m.**, in the chambers of Magistrate Judge Bernard G. Skomal in
27 order to schedule the future discovery and trial dates.

28 12. If the parties desire further settlement conferences prior to the Second Case Management
Conference, they are to contact the chambers of Magistrate Judge Bernard G. Skomal to request a date.

13. The dates and times set forth herein **will not** be modified except for good cause shown.
Fed. R. Civ. P. 16(b)(4). Counsel are reminded of their duty of diligence and that they must "take all
steps necessary to bring an action to readiness for trial." Civil Local Rule 16.1(b). Any requests for
extensions must be made by filing a Joint Motion. The motion shall include a declaration from counsel

1 of record detailing the steps taken to comply with the dates and deadlines set in this order, and the
2 specific reasons why deadlines cannot be met

3 14. Plaintiff's counsel shall serve a copy of this order on all parties that enter this case
4 hereafter.

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6 DATED: April 17, 2013

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Hon. Bernard G. Skomal
U.S. Magistrate Judge
United States District Court

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APPENDIX A
APPROVED FORM OF
JOINT CLAIM CONSTRUCTION WORKSHEET

CLAIM CONSTRUCTION WORKSHEET

PATENT CLAIM	AGREED PROPOSED CONSTRUCTION	PLAINTIFF'S PROPOSED CONSTRUCTION	DEFENDANT'S PROPOSED CONSTRUCTION	COURT'S CONSTRUCTION
1. Claim language as it appears in the patent with terms and phrases to be construed in bold.	Proposed construction if the parties agree.	Plaintiff's proposed construction if parties disagree.	Defendant's proposed construction if parties disagree.	Blank column for Court to enter its construction.
2. Claim language as it appears in the patent with terms and phrases to be construed in bold.	Proposed construction if the parties agree.	Plaintiff's proposed construction if parties disagree.	Defendant's proposed construction if parties disagree.	Blank column for Court to enter its construction.
3. Claim language as it appears in the patent with terms and phrases to be construed in bold.	Proposed construction if the parties agree.	Plaintiff's proposed construction if parties disagree.	Defendant's proposed construction if parties disagree.	Blank column for Court to enter its construction.