COMMITTEE NO. 956  D. C. TOEDT III, Chair

SPECIAL COMMITTEE ON INTELLECTUAL PROPERTY LITIGATION FORMS

Scope of Committee: To prepare model provisions for documents typically used in intellectual property litigation, e.g., protective order, discovery plan, jury instructions.

Subject 1. MODEL CASE-MANAGEMENT AND PROTECTIVE ORDERS.

PROPOSED RESOLUTION 956-1
MODEL CASE-MANAGEMENT AND PROTECTIVE ORDERS

COUNCIL CLASSIFICATION:
CLASS 3 REST AS A COMMITTEE REPORT

RESOLVED, that the Section of Intellectual Property Law favors in principle the adoption by U.S. district courts of case-management orders containing reasonable provisions to help reduce the cost and improve the manageability of patent cases; and Specifically, the Section favors the use of the Model Case Management Order, version 3/13/98, as a starting point for discussions among parties to patent litigation with a view toward preparing a customized case-management order.

PROPOSED RESOLUTION 956-2
MODEL CASE-MANAGEMENT AND PROTECTIVE ORDERS

COUNCIL CLASSIFICATION:
CLASS 3 REST AS A COMMITTEE REPORT

RESOLVED, that the Section of Intellectual Property Law favors in principle the adoption by U.S. district courts of protective orders containing reasonable provisions for preserving parties' trade secrets and other confidential information; and Specifically, the Section favors the use of the Model Protective Order to Protect Confidential Information, version 11/24/97, as a starting point for discussions among parties to patent infringement or validity litigation with a view toward preparing a customized protective order.

Past Actions: None.

Discussion: The committee's first two projects have been (1) model provisions for a protective order, and (2) model provisions for a case management order. Several drafts of each model order have been reviewed in numerous mark-up conference calls by the committee. (The chair wishes to extend special thanks to Ken Adamo, Jerry Cohen, Rob Lindefeld, and John Lowe for their steadfast participation in the mark-up sessions.)

PRELIMINARY ORDER TO CONFER ABOUT THE MODEL ORDERS. The committee drafted a form of preliminary order that, when adopted by a court, directs counsel to confer about the model orders and to report to what extent those orders should be adopted. That way, in any given lawsuit, the court can provide counsel with the model orders as a starting point for working out one or more customized orders for their particular circumstances.

Adapted from local rules and Manual for Complex Litigation. Many of the provisions of Model Case Management Order are adapted from local rules of various federal district courts and from the Manual for Complex Litigation (3d ed. 1995). Other provisions are adapted from various other sources, e.g., the Northern District of California's Markman-hearing rules and the trial-management order used by Judge Roderick McKelvie (D. Del.).

Codification of routine or cost-saving practices. Both orders codify many practices that are already somewhat routine among experienced patent litigators, but which may be unfamiliar to a judge. They also include provisions to help reduce administrative and mechanical costs.

Avoidance of substantive controversy. By and large, the orders avoid "meddling" in controversial issues of substantive law. For example, the text of the Model Protective Order simply takes note of the issue whether in-house counsel should be given access to confidential information under a protective order. The associated commentary discusses some judicial opinions that have dealt with that issue, but the model order does not attempt to legislate a one-size-fits-all resolution.

Modular design. Most of the sections of the Model Case Management Order can be deleted without affecting other sections.


ELECTRONIC COPIES. Both model orders may be downloaded from the committee chair's personal Web site at http://www.lawnotes.com.

Feedback requested. Section members and others who have comments about either of the model orders, especially those who use one or both in actual litigation, are encouraged to contact the committee chair at 713-787-1408 or by email at dctoe@arnoldwhite.com.
**PLEADINGS, MOTIONS, ETC.** Several provisions of the Model Case Management Order are designed to reduce the cost of common pre-trial activities such as preparing, filing, serving, and responding to pre-trial papers such as pleadings, motions, briefs, and the like.

Section 1.1 permits participation in meetings of counsel by telephone, even if a local rule would otherwise require an in-person meeting.

Section 5.1 sets out procedures for service of papers by FAX or courier service.

Section 5.2 requires service of electronic copies of pleadings, motion papers, etc., along with the paper copies, to make it easier to prepare discovery responses and to use electronic document-management systems.

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Section 11.8 sets out a short-form style of stipulation that can be filed and signed by the court without a separate order.

**CASE MANAGEMENT PROCEDURES.** The Model Case Management Order takes advantage of the court's Rule 16 power to manage the case by creating some avenues for faster, more cost-effective resolution of pretrial issues.

Section 16.1 sets out a procedure for voluntary fast-track resolution of pretrial disputes by judge or magistrate judge.

Section 16.2 permits the parties to use a similar procedure to have a third party resolve such disputes.

Section 16.3 directs the parties to discuss a variety of other possible case-management procedures to see whether they might be useful in the case at hand.

Section 16.4 through 16.5 are reserved.

Sections 16.6 through 16.11 set out procedures for an early determination of the proper construction of patent claims; they are taken essentially verbatim from the new claim-construction procedures of the Northern District of California.

**DISCOVERY.** A number of provisions in the Model Case Management Order permit the parties to use variations on traditional discovery tools.

Section 26.1 provides that, if the court has opted out of the Initial-disclosure procedures of Rule 26(a), the parties agree to opt back into those procedures.

Section 26.2 specifies a standard, continuous numbering sequence for written discovery requests (e.g., a second set of requests for production must be numbered consecutively with the first set).

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Section 26.4 requires that objections to discovery requests be served early to permit the parties to try to work out the objections.

Section 26.5 sets out a framework for expert depositions.

Section 26.6 defines the information to be provided when withholding information on grounds of privilege, in somewhat more detail than do the Federal Rules.

Section 26.7 provides for scheduled, as opposed to ad hoc, supplementation of Rule-26 initial disclosures and of discovery responses.

Section 26.8 requires monthly discovery planning conferences by telephone. The purpose is to get counsel to discuss, in advance, the discovery that they plan to request in the upcoming month. The rationale is that counsel are less likely to get into discovery disputes if they are forced to talk to each other on a regular basis.

Section 29.1 makes it clear that, by stipulation, the parties can avoid the effect of local-rule discovery limits.

**DEPOSITIONS.** Many sections in the Model Case Management Order attempt to reduce the cost of depositions while still giving counsel the flexibility to pursue discovery as they see fit.

Section 30.1 permits a party to take a one-hour preliminary telephone deposition, limited to specific topics, to determine whether it would be worthwhile to take a more formal deposition. Up to ten of such preliminary depositions can be taken without counting against any applicable limit on the number of depositions.

Section 30.2 sets out a 25-deposition limit on the number of depositions other than experts and of parties under Rule 30(b)(6).

Section 30.3 imposes specific procedures for reasonable scheduling of deposition sessions. It requires that a deposition notice state a date and time at which the deposition session will end (no more "from day to day until concluded"). It permits any party to request a recess and a reconvening of the deposition, subject to specified scheduling procedures, for further questioning of the deponent.

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Section 30.13 permits "conference" depositions of multiple deponents at once, both in person and by phone. Such depositions may be useful in quickly establishing basic factual information.

Section 30.14 restricts attorney-deponent conferences during examination by an opposing counsel, but expressly permits such conferences during examination by the deponent's own attorney.

Section 30.15 is a cross-reference to a rule establishing a uniform method of numbering exhibits.

Section 30.16 requires counsel taking a deposition to provide copies of exhibits to opposing counsel.

Section 30.17 expressly permits selective transcription of only those portions of a deposition that are of interest to the counsel requesting the transcription.

Section 30.18 requires consecutive numbering of deposition transcript pages for a given deponent, even if the deposition is taken in multiple sessions.

Section 30.19 permits the parties to agree that depositions may be taken even after discovery cut-off.

INTERROGATORIES. The Rule-33 sections in the Model Case Management Order are directed to some common practices in propounding and answering interrogatories.

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Section 34.3 encourages the parties to agree on production of hard-copy documents in electronic form, e.g., on CD-ROM.

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REQUESTS FOR ADMISSION. Two sections of the Model Case Management Order give counsel more flexibility in using requests for admission as a discovery tool.

Section 36.1 provides that the parties can propound a reasonable number of requests for admission even if that number exceeds a limit prescribed by a local rule.

Section 36.2 states that a request for admission may include a contention interrogatory and a request for Rule-26 initial disclosure concerning the matter of which admission is requested (to the extent not already provided), in the same general manner as if the matter had been pleaded with specificity in a complaint, answer, counterclaim, etc.

TRIAL. The remainder of the Model Case Management Order implements some common-sense procedures for trial. Purely by coincidence, many of these procedures mirror some of the "ABA Civil Trial Practice Standards" that were approved by the House of Delegates in early February 1998.

Section 49.1 mandates the use of detailed special verdicts directed to specific factual issues. An extended comment provides cites and quotes from the Supreme Court's Warner-Jenkinson opinion and from Federal Circuit cases and commentary favoring special verdicts.

Section 52.1 prescribes an alternative format for jury instructions, organized around the special-verdict issues.

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Section 611.5 permits counsel to prepare exhibits consisting of excerpts from deposition transcripts and documents.

Section 611.6 requires the parties to prepare written narrative testimony in non-jury trials. It is adapted from the local rules of the Central District of California.

Section 611.7 sets out procedures for the use of video depositions at trial.

Section 611.8 deals with juror notebooks and note-taking.

Section 611.9 directs the parties to confer about about other possible trial-management and to report to the court whether any of them should be adopted.

Section 702.1 sets out some safe-harbor areas in which patent law experts can testify; it also prohibits expert testimony that would amount to jury instructions about the law or about the proper construction of patent claims except incidentally to otherwise-permissible testimony.

| Proposed resolution 956-1 | 13 | 0 | 0 | 6 |
| Proposed resolution 956-2 | 13 | 0 | 0 | 6 |
| Committee report | 12 | 0 | 1 | 6 |

Members approving resolutions and report:

Kenneth R. Adamo
Mark J. Cohen
Michael Harris
Michael A. Jacobs (abstain as to report)
Cynthia Kornick
William L. LaFuzze
Robert O. Lindefield

Members not heard from:

John L. Capone
Mary Kay McCalla Martire
Daniel W. McDonald

SPECIAL COMMITTEE ON INTELLECTUAL PROPERTY LITIGATION FORMS

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Committee Preface

Origins; Overview

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Section 611.6 requires the parties to prepare written narrative testimony in non-jury trials. It is adapted from the local rules of the Central District of California.

Section 611.7 sets out procedures for the use of video depositions at trial.
Section 611.8 deals with juror notebooks and note-taking.

Section 611.9 directs the parties to confer about about other possible trial-management and to report to the court whether any of them should be adopted.

Section 702.1 sets out some safe-harbor areas in which patent law experts can testify; it also prohibits expert testimony that would amount to jury instructions about the law or about the proper construction of patent claims except incidentally to otherwise- permissible testimony.
Introduction

This order is entered under Rule 1 and Rule 16 of the Federal Rules of Civil Procedure ("Federal Rules") to provide a discovery plan and to streamline the pretrial proceedings in certain respects. The Court determines that it is appropriate to enter such an order to promote the cost-effective use of judicial and party resources. To the extent that this order conflicts with a local rule, a general-purpose case management order of the Court, or the "bench rules" of the district judge or magistrate judge assigned to the case, this order shall control.

Except as otherwise indicated, references to specific rules are to the Federal Rules or to the Federal Rules of Evidence.

The section numbering of this order corresponds to particular rules of the Federal Rules or Federal Rules of Evidence; for example, Section 5.1 is the first section dealing with service of motions, etc., as provided under Rule 5.

Except where the context clearly indicates otherwise, references to a party are to (i) an unrepresented party, and (ii) counsel for a represented party.

Pleadings, Motions, Etc.

1.1 Participation in Meetings of Counsel by Telephone

If a local rule requires a meeting of counsel in person, but one or more of the counsel reside and practice outside the district in which the action is pending, then such counsel may attend the meeting by telephone or other remote electronic means (e.g., videoconference).

5.1 Service by FAX or Courier Service

(a) Papers required or permitted to be served under Rule 5(b) may be served, in addition to any other method of service permitted under the Federal Rules or local rules, by FAX transmission or by commercial courier service.

(b) Service by FAX or commercial courier in accordance with this Section is effective upon receipt, except that:

(1) service of a paper that marks the beginning of a time period for response to the paper, e.g., a discovery request, is effective for that purpose one day after receipt if receipt is after
4:00 p.m. local time at the recipient’s location; and

(2) if a paper is served by FAX on the last day that it can be timely served, it will be deemed timely served if the FAX transmission commences before midnight local time at the location from which the transmission is made and proceeds substantially continuously until complete. Last-minute FAX transmission problems that prevent timely service by FAX, however, will not automatically be deemed good cause for failure to make timely service.

(3) In case of disputes whether a particular paper served by FAX or commercial courier service was actually received, the burden of proof is on the serving party.

Commentary

The 4:00 p.m. deadline in subparagraph (b)(1) is intended to reduce the temptation to play games with short-fuse deadlines by FAXing papers late in the afternoon. Note that under Rule 6(a), time periods of less than 11 days are business days.

5.2 Electronic Copies of Pleadings, Motion Papers, Etc.

(a) Each party serving a pleading, motion, or other paper on another party shall, at its own expense, provide the party served, contemporaneously with service of the paper, with an electronic copy of the paper. The purpose of this requirement is to reduce the expense of this action by 1) eliminating the need for retyping of discovery requests in connection with preparing responses thereto, and more generally 2) facilitating the use of electronic document-management systems by counsel.

(b) Unless otherwise agreed by the parties orally or in writing, the electronic copy shall be in ASCII text format on an MS-DOS compatible disk. If so agreed by the parties, the electronic copy may be transmitted by electronic mail.

11.1 Filing of FAXed Copies of Documents

Unless the Court orders otherwise, a party may file a FAX copy of a signed pleading, motion, or other paper to be filed with the Court, or of the signature page thereof, in lieu of the copy bearing the original signature if (a) the paper otherwise complies with the requirements of the Federal Rules and local rules concerning the form of papers to be filed, including re-
requirements concerning the type of paper, and (b) the original document, including the original
signature of the attorney, party or declarant, is maintained by the filing party until conclusion of
the case, including any applicable appeal period, subject to being produced upon reasonable
written notice. (See also Section 11.2 concerning the filing of multiple signature pages separated
from the underlying counterparts.) The previous sentence, however, does not permit filing of
papers by FAX transmission to the Court unless the Federal Rules, local rules, or other order of
the Court expressly permit such filing.

Commentary
Adapted from Local Rule 3.2 of the Central District of California.
Under this Section, local counsel can file papers that were signed
by lead counsel in other cities. That should reduce the expense of
filing by not requiring local counsel to perform a separate Rule-11
review of every paper before signing it.

11.2 Multiple-Signature Documents in Multiple Counterparts
(a) A document bearing multiple signatures (e.g., agreements of counsel, agreed motions,
etc.) may be executed in multiple counterparts; all signatures need not be on the same physical
page or pages. A photocopy or FAX copy of a page bearing such a signature shall have the same
effect as the page bearing the original such signature unless the Court orders otherwise for good
cause shown.

(b) The filing of a single counterpart with multiple signature pages attached constitutes a
representation by the attorney causing the filing that all of the signature pages so filed are from
identical counterparts of the same underlying document.

Commentary
This Section permits agreements to be entered into by FAX, e.g.,
wherein one party FAXes a signed letter to another who then
countersigns the letter and FAXes it back to the original sender.

11.3 Integrated Motion Papers
If the local rules require filing of various papers in connection with a motion (e.g., notice
of motion, statement of undisputed facts, declaration to authenticate exhibits, etc.), all such
papers may be filed in one integrated document bearing an appropriate title indicating what papers are included therein and appropriate headings identifying those papers.

11.4 Submission of Consolidated Briefing Packages

In filing motions, the parties are strongly encouraged to agree on a briefing schedule and to jointly file all motions, cross-motions, briefs, and similar materials (referred to as a consolidated briefing package) at the same time.

Commentary

Consolidated briefing materials are required by some judges in the District of New Jersey, and are sometimes used by other judges.

11.5 Joint Statements of Agreed and Disputed Facts

In motion practice, joint statements of fact may be set out in short point/counterpoint narrative paragraphs, labeled to identify agreed matters and the parties' respective positions concerning disputed matters. The format of such paragraphs may be as follows:

1. (Agreed:) [Agreed fact(s)]
2. (By ABC:) [ABC contention]
3. (By XYZ:) [XYZ contention].
4. (Agreed:) [Agreed fact(s)]
5. (Agreed:) [Agreed fact(s)]
6. (By XYZ:) [XYZ contention].
7. (By ABC:) [ABC contention]

11.6 Signature of Declarant on Brief Instead of on Declaration

A brief, memorandum of points and authorities, etc., may include, in addition to any required signature of the party or counsel for the party, the signature of a declarant certifying the truth of specifically identified facts or opinions set forth therein. Such a signature may be provided in lieu of a separate declaration reciting the same facts or opinions.

EXAMPLE: "I certify under penalty of perjury that the
matters recited in paragraphs 4, 6, and 9-10 of the foregoing, i.e., ABC's factual contentions, are true and correct. Executed on [date]. [signature] [declarant's printed name]."

Commentary

Allowing a declarant to certify the accuracy of specific factual statements in a brief may help cut down on the number of separate pieces of paper that must be filed, e.g., with a motion.

11.7 Joint Submission of Proposed Orders with Alternatives

In any situation in which a party is required to submit a proposed order for consideration by the Court, the parties are strongly encouraged to submit a joint proposed order that includes alternatives (e.g., in the form of check-off options) that can be selected by the Court to the extent it deems appropriate.

11.8 Form of Stipulations

A written stipulation requesting judicial action may be filed in a form that: (i) is titled "Stipulated Order _____ <describe action being ordered>," (ii) is signed by all affected parties or their counsel, and (iii) includes at the end the words, "Pursuant to stipulation, it is so ordered," with spaces designated for the date and signature of the judge.

Commentary

Adapted from Local Rule 7-12 of the Northern District of California.

Case Management Procedures

16.1 Fast-Track Resolution of Pretrial Disputes by Judge or Magistrate Judge

(a) Proceeding by agreement. If the parties so agree, they may submit any dispute concerning a pretrial matter for fast-track resolution by the district judge assigned to the case or a magistrate judge ("judicial officer") in accordance with the procedures set out in this Section.

(b) Scheduling. A party seeking relief under this Section shall telephone the case
manager or other administrative assistant of the judicial officer to determine if the judicial officer can hear the dispute in a hearing (in person or by telephone) and if so, to confirm a time for the hearing, with the other party or parties participating in the call if practicable.

(c) Confirmation of scheduling. If the judicial officer agrees to resolve the dispute pursuant to this Section, then promptly after confirming the time for the hearing, the party seeking relief shall FAX or deliver by courier to the judicial officer's chambers and to all other parties a letter confirming the time for the hearing and whether it is an in-person or telephone hearing and setting forth any agreed briefing schedule. (See also Section 11.4, concerning consolidated briefing packages, and Section 11.7, concerning proposed orders in alternative format.)

Commentary

This Section stems from the courts' general case management authority under Rule 16. It provides a fast-track way of submitting disputes for resolution.

16.2 Alternative Private Resolution of Pretrial Disputes

(a) If the parties so agree, and if resolution of the dispute in question will not affect a date imposed by a scheduling order, then without further order of the Court a dispute concerning a pretrial matter may be submitted to a third party, e.g., a neutral attorney, in the same general manner as set forth in Section 16.1 and in accordance with this Section.

(b) The parties shall submit one or more proposed recommendations to the third party instead of one or more proposed orders. The third party is not limited to the proposed recommendation(s) unless he or she has so agreed with the parties.

(c) The party seeking relief shall file the recommendation of the third party within two days after receipt thereof and serve notice of such filing by FAX on all other parties.

(d) The third party's recommendation shall be binding and enforceable by the Court as between the parties unless (i) the parties agree otherwise, or (ii) within five days after service of the notice of filing of the recommendation by the party seeking relief, a party objects to the recommendation, and the Court thereafter modifies or sets aside all or part of the recommendation, in the same manner as provided in Rule 72(a) for objections to an order of a
magistrate judge in a nondispositive matter.

**Commentary**

This Section sets out an optional way of getting disputes over pretrial matters resolved by submitting them to a neutral third party while preserving the court's ultimate authority over the dispute.

16.3 Consideration of Other Case-Management Possibilities

Counsel shall confer about each of the following practices and discuss which if any might be appropriate for more effective management of the pre-trial phase in this action. Either or both parties may propose the use of any such practice to the Court, but the Court expresses no view here as to whether any such proposal would be approved by the Court. As used below, “JTI” refers to NAT’L CENTER FOR STATE COURTS, JURY TRIAL INNOVATIONS (G. Thomas Munsterman, Paula L. Hannaford & G. Marc Whitehead, eds. 1997), and “MCL” refers to FEDERAL JUDICIAL CENTER, MANUAL FOR COMPLEX LITIGATION 3d (1995).

(a) **Special Master:** Referral of selected pre-trial issues, both substantive and procedural, to a special master in accordance with Rule 53 - see MCL § 21.52 at 111 (1995). For example, a special master might be appointed to be “on call” to handle all discovery disputes.

(b) **Summaries:** Joint preparation of the following documents for possible use by the Court in motion practice (including, as to disputed points, brief summaries of the parties’ respective positions) - see MCL § 22.31 at 136:

   (1) A glossary of technological terms.

   (2) A time line of relevant events.

   (3) A narrative of relevant events.

   (4) A logically organized summary of facts, both stipulated and disputed, with summaries of the parties’ respective contentions as to disputed facts and with appropriate cross-references to exhibits and deposition testimony.

(c) **Tutorial.** A tutorial to explain relevant technological issues to the Court - see JTI § IV-5 at 106.
Commentary

Section 16.3 is intended only as a helpful reminder of some possible case-management practices that could be adopted. In any particular case, some or all of these practices might be appropriate, or they might be clearly inappropriate. See also Section 611.9 (similar list of possible trial-management practices).

16.4 Reserved

16.5 Reserved


(a) Scope. In addition to complying with Rule 26, in all civil actions filed in this court which include a claim of patent infringement, or which seek a declaratory judgment that a patent is not infringed or is invalid, the parties shall also comply with the disclosure requirements and procedures set forth in Sections 16.6 through 16.11.

(b) Confidentiality. If any document or information produced under Sections 16.6 through 16.11 is deemed confidential by the producing party and if the Court has not entered a protective order, then until a protective order is issued by the Court, the document shall be marked "confidential" by the disclosing party and disclosure of the confidential document or information shall be limited to each party's outside attorney of record. If a party is not represented by outside attorney, disclosure of the confidential document or information shall be limited to a designated "in-house" attorney. The attorney to whom disclosure of a confidential document or information is made under this local rule shall keep it confidential and use it only for purposes of litigating the case.

(c) Certification and Admissibility of Initial Disclosures. All statements, disclosures or charts filed or served in accordance with these local rules must be dated and signed by counsel of record. Counsel's signature shall constitute a certification that to the best of his or her knowledge, information and belief, formed after an inquiry that is reasonable under the circumstances, the information contained in the statement, disclosure or chart is complete and correct at the time it is made.
(d) Duty to Supplement Disclosures. Unless otherwise ordered by the court, disclosures or charts governed by Sections 16.6 through 16.11 are subject to the duty of supplementation of Rule 26(e).

(e) Admissibility of Disclosures. Unless otherwise ordered by the court, statements, disclosures or charts governed by this local rule shall be admissible as evidence during the course of the action.

Commentary
Adapted essentially verbatim, with minor editorial changes, from Local Rule 16-6 of the Northern District of California, available at http://ndcal.stanford.edu/rules/Civil_L.R.html

16.7 Initial Disclosure of Asserted Claims and Prior Art

(a) Initial disclosure of asserted claims. No later than 45 days after filing a pleading that includes a claim for patent infringement, the party claiming patent infringement, except in those cases described in Section 16.8, must serve on all parties an “Initial Disclosure of Asserted Claims” in conformity with subparagraph (b) and must produce or make available for inspection and copying the documents described in subparagraph (c).

(b) Content of initial disclosure of asserted claims. Separately for each opposing party, the “Initial Disclosure of Asserted Claims,” shall contain the following information:

(1) each claim of each patent in suit that is allegedly infringed by each opposing party;

(2) separately for each allegedly infringed claim, each accused apparatus, product, device, process, method, act or other instrumentality (“accused instrumentality”) of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device or apparatus which, when used, results in the practice of the claimed method or process;

(3) the date of conception and the date of reduction to practice of each asserted claim.

(c) Document production accompanying initial disclosure of asserted claims. At the time
of filing the "Initial Disclosure of Asserted Claims," the party claiming patent infringement must produce to each opposing party or make available for inspection and copying all documents relating to:

(1) any offers to sell each claimed invention prior to the date of application for the patent; and

(2) research, design, and development of each claimed invention.

(d) Initial disclosure of prior art. No later than 55 days after service upon it of an "Initial Disclosure Of Asserted Claims," each opposing party shall serve on all parties an "Initial Disclosure Of Prior Art" which conforms to subparagraph (e) and must produce or make available for inspection and copying the documents described in subparagraph (f).

(e) Content of initial disclosure of prior art. The Initial Disclosure of Prior Art shall contain the following information:

(1) each item of prior art that the party contends anticipates the claim or renders it obvious;

(2) for each item of prior art, whether it anticipates the claim or renders it obvious, if a combination of prior art references renders a claim obvious, that combination must be identified.

(3) the identification of prior art must be as specific as possible. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication, shall be identified by its title, date of publication and, where feasible, its author and publisher. Other prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used, the date the offer or use took place, and the identity of the person or entity which made the use or which made and received the offer.

(f) Document production accompanying initial disclosure of prior art. At the time of filing the "Disclosure of Prior Art," each opposing party must produce or make available for inspection and copying any source code, specifications, schematics, flow charts, artwork, formulas or other documentation on any accused instrumentality.
16.8 Initial Disclosure Requirement in Declaratory-Judgment Cases

In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is not infringed or is invalid, subparagraphs (a) through (d) of Section 16.7 shall not apply. Within 45 days of filing such a pleading the party seeking the declaratory judgment shall initiate the disclosure process by serving on each opposing party a statement entitled "Initial Disclosure Of Prior Art" which conforms to subparagraph (e) of Section 16.7 and by producing or making available for inspection and copying the documents described in subparagraph (f) of Section 16.7. This Section shall not apply to cases in which a request for a declaratory judgment that a patent is not infringed or is invalid is filed in response to a complaint for infringement of the same patent.

16.9 Claim Chart

(a) Service and content of claim chart. No later than 70 days after service upon it of an "Initial Disclosure Of Prior Art," under either subparagraph (d) of Section 16.7 or Section 16.8, any party claiming patent infringement shall serve upon all parties a "Claim Chart." Separately, with respect to each opposing party against whom a claim of patent infringement is made, the Claim Chart must contain the following information:

1. each claim of any patent in suit which the party alleges was infringed;
2. the identity of each apparatus, product, device, process, method, act or other instrumentality of each opposing party which allegedly infringes each claim;
3. whether such infringement is claimed to be literal or under the doctrine of equivalents;
(4) where each element of each infringed claim is found within each apparatus, product, device, process, method, act or other instrumentality; and

(5) if a party claiming patent infringement wishes to preserve the right to rely on its own apparatus, product, device, process, method, act or other instrumentality as evidence of commercial success, the party must identify, separately for each claim, each such apparatus, product, device, process, method, act or other instrumentality that incorporates or reflects that particular claim.

(b) Response chart. No later than 60 days after service of upon it of a "Claim Chart," each party opposing a claim of patent infringement, shall serve on all parties a "Response Chart" which must contain the following information:

(1) the identity of each item of prior art that anticipates the claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher. Other prior art under 35 U.S.C. § 102(b) shall be identified by the item offered for sale or publicly used, the date the offer or use took place, the identity of the person or entity which made the use or which made and received the offer; and

(2) whether it anticipates the claim or renders it obvious. If a combination of prior art references makes a claim obvious, that combination must be identified;

(3) where, specifically, within each item of prior art each element of the claim is found;

(4) all grounds of invalidity other than anticipation or obviousness of any of the claims listed in Claimant's Claim Chart. This identification must be as specific as possible. For example, if a best mode defense is raised, the adverse party must set forth with particularity what constitutes the inventor's best mode, specifically citing information or materials obtained in discovery to the extent feasible. If an enablement defense is raised, the adverse party must set forth with particularity what is lacking in the specification to enable one skilled in the art to make or use the invention; and

(5) if the claimant has alleged willful infringement, the date and a document reference number of each opinion of counsel upon which the party relies to support a defense to the willfulness allegation, including but not limited to, issues of validity, and infringement of any
patent in suit.

(c) Amendment to claim chart or response chart. Amendment of a Claims Chart or a Response Chart may be made only on stipulation of all parties or by order of the Court, which shall be entered only upon a showing of excusable subsequent discovery of new information or clearly excusable neglect.

Commentary

Adapted essentially verbatim, with minor editorial changes, from Local Rule 16-9 of the Northern District of California, available at http://ndcal.stanford.edu/rules/Civil_L.R.html

16.10 Claim Construction Proceedings

(a) Proposed claim construction statement. No later than 70 days after service of the "Initial Disclosure of Prior Art," pursuant to subparagraph (d) of Section 16.7, each party claiming patent infringement must serve on all parties a "Proposed Claim Construction Statement," which shall contain the following information for each claim in issue:

1. identification of any special or uncommon meanings of words or phrases in the claim;
2. all references from the specification that support, describe, or explain each element of the claim;
3. all material in the prosecution history that describes or explains each element of the claim; and
4. any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions and citations to learned treatises, as permitted by law.

(b) Response to proposed claim construction statement. No later than 60 days after service upon it of a Proposed Claim Construction Statement, each opposing party must serve on each party a "Response to Proposed Claim Construction Statement." The response shall contain the following information:

1. identification of any special or uncommon meanings of words or phrases in the claim in addition to or contrary to those disclosed pursuant to subparagraph (a)(1) of this Section;
(2) all references from the specification that support, describe, or explain each element of the claim in addition to or contrary to those disclosed pursuant to subparagraph (a)(2) of this Section;

(3) all material in the prosecution history that describes or explains each element of the claim in addition to or contrary to those disclosed pursuant to subparagraph (a)(3) of this Section; and

(4) any extrinsic evidence that supports the proposed construction of the claim, including, but not limited to, expert testimony, inventor testimony, dictionary definitions and citations to learned treatises, as permitted by law.

Commentary
Adapted essentially verbatim, with minor editorial changes, from Local Rule 16-10 of the Northern District of California, available at http://ndcal.stanford.edu/rules/Civil_L.R.html

16.11 Claim Construction Hearing

(a) Meet and confer. No later than 21 days after the “Responses to Proposed Claim Construction Statement” required by Section 16.7 have been served, all parties shall meet and confer for the purpose of preparing a Joint Claim Construction Statement pursuant to subsection (b) of this Section.

(b) Joint claim construction statement. No later than 15 days after the parties meet and confer pursuant to subparagraph (a) of this Section, the parties must complete and file a Joint Claim Construction Statement, which shall contain the following information:

(1) the construction of those claims and terms on which the parties agree;

(2) each party’s proposed construction of each disputed claim and term, supported by the same information that is required under subparagraphs (a) and (b) of Section 16.10;

(3) the jointly agreeable dates for a claims construction hearing on all disputed issues of claim construction. The suggested dates shall take into consideration the briefing schedule pursuant to subsection (d) of this Section and the calendar of the assigned judge; and

(4) for any party who proposes to call one or more witnesses at the claims construction hearing, the identity of each such witness, the subject matter of each witness'
testimony and an estimate of the time required for the testimony.

(c) Claim construction hearing. No later than 30 days after the parties have filed their Joint Claims Construction Statement, the court will send a notice of the date and time of a Claim Construction Hearing. Unless the notice states otherwise, the parties shall be prepared to call at the hearing all the witnesses they identified under subparagraph (b)(4) of this Section.

(d) Briefing schedule. With respect to a Claim Construction Hearing, the parties shall comply with the following briefing schedule:

1. not less than 35 days before the hearing, the party claiming patent infringement must serve and file its opening brief and supporting evidence;
2. not less than 21 days before the hearing, each opposing party must serve and file its responsive brief and supporting evidence; and
3. not less than 14 days before the hearing, the party claiming patent infringement must serve and file any reply brief and any evidence directly rebutting the supporting evidence contained in an opposing party's response.

Commentary

Adapted essentially verbatim, with minor editorial changes, from Local Rule 16-11 of the Northern District of California, available at http://ndcal.stanford.edu/rules/Civil_L.R.html

Discovery

26.1 Observance of Federal Rule 26(a)

Even if the Court has opted out of the mandatory disclosure procedures of Rule 26(a), those procedures shall nevertheless apply in this case except to the extent otherwise agreed by the parties or specifically ordered by the Court.

26.2 Numbering of Written Discovery Requests

Each party shall number its interrogatories, requests for production of documents, and requests for admission in a respective single sequence, i.e., without repeating the numbers used on any prior set of interrogatories or requests for production or admission propounded by that
26.3 Uniform Definitions for Written Discovery Requests

(a) The following definitions apply to all discovery requests unless otherwise agreed by the parties:

(1) Communication. The term "communication" means the transmittal of information (in the form of facts, ideas, inquiries or otherwise).

(2) Concerning. The term "concerning" means relating to, referring to, describing, evidencing or constituting.

(3) Document. The term "document" is defined to be synonymous in meaning and equal in scope to the usage of this term in Federal Rule of Civil Procedure 34(a), including, without limitation, electronic or computerized data compilations. A draft or non-identical copy is a separate document within the meaning of this term.

(4) Identify (with respect to persons). When referring to a person, "to identify" means to give, to the extent known, the person's full name, present or last known address, and when referring to a natural person, additionally, the present or last known place of employment. Once a person has been identified in accordance with this subparagraph, only the name of that person need be listed in response to subsequent discovery requesting the identification of that person.

(5) Identify (with respect to documents). When referring to documents, "to identify" means to give, to the extent known, the (i) type of document; (ii) general subject matter; (iii) date of the document; and (iv) author(s), addressee(s) and recipient(s).

(6) Parties. The terms "plaintiff" and "defendant" as well as a party's full or abbreviated name or a pronoun referring to a party mean the party and, where applicable, its officers, directors, employees, partners, corporate parent, subsidiaries or affiliates. This definition is not intended to impose a discovery obligation on any person who is not a party to the litigation.

(7) Person. The term "person" is defined as any natural person or any business,
legal or governmental entity or association.

(d) The following rules of construction apply to all discovery requests:

(1) **All; Each.** The terms "all" and "each" shall be construed as all and each.

(2) **And; Or.** The connectives "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the discovery request all responses that might otherwise be construed to be outside of its scope.

(3) **Number.** The use of the singular form of any word includes the plural and vice versa.

*Commentary*

Adapted from Local Rule 26.3 of the Southern District of New York.

26.4 Early Deadline for Objections to Written-Discovery Requests

Unless otherwise agreed by the parties, objections to requests for admission, requests for production of documents, and interrogatories shall be served within ten days after service of the request.

*Commentary*

Two work weeks should be enough time to serve objections to a written discovery request. That would give the parties two more weeks in which to try to work out an agreed resolution to the objections before the 30-day deadline for responding to the request.

26.5 Expert Depositions

(a) Each party shall be allowed to depose any expert identified by another party pursuant to Rule 26(a)(2)(A), even if that expert is not required to submit a report under Rule 26(a)(2)(B). If the scheduling order does not set forth a specific cut-off date for expert discovery, then unless otherwise agreed by the parties, all expert depositions shall be completed no later than one month after the cut-off date for fact discovery or two weeks before trial, whichever is earlier.

(b) An individual previously deposed in a non-expert deposition who is designated as an
expert subsequent to the non-expert deposition may be re-deposed in his or her capacity as an expert.

(c) The Court retains the power to limit the number of experts identified by each side to a reasonable number in view of the complexity of the case.

26.6 Assertions of Privilege

(a) Where a claim of privilege is asserted in objecting to any means of discovery or disclosure, including but not limited to a deposition, and an answer is not provided on the basis of such assertion,

(1) the attorney asserting the privilege shall identify the nature of the privilege (including work product) which is being claimed and, if the privilege is governed by state law, indicate generally the state's privilege rule being invoked; and

(2) the following information shall be provided unless divulgence of such information would cause disclosure of the allegedly privileged information:

(A) for documents: (i) the type of document, e.g., letter or memorandum; (ii) the general subject matter of the document; (iii) the date of the document; and (iv) such other information as is sufficient to identify the document for a subpoena duces tecum, including, where appropriate, the author of the document, the addressees of the document, and any other recipients shown in the document, and, where not apparent, the relationship of the author, addressees, and recipients to each other;

(B) for oral communications: (i) the name of the person making the communication and the names of persons present while the communication was made and, where not apparent, the relationship of the persons present to the person making the communication; (ii) the date and place of communication; and (iii) the general subject matter of the communication.

(b) Where a claim of privilege is asserted during a deposition, and information is not provided on the basis of such assertion, the information set forth in paragraph (a) above shall be furnished (1) at the deposition, to the extent it is readily available from the witness being deposed or otherwise, and (2) to the extent the information is not readily available at the deposition, in writing within ten days after the deposition session at which the privilege is asserted, unless otherwise ordered by the Court.
(c) Where a claim of privilege is asserted in response to discovery or disclosure other than a deposition, and information is not provided on the basis of such assertion, the information set forth in paragraph (a) above shall be furnished in writing at the time of the response to such discovery or disclosure or within ten days thereafter, unless otherwise ordered by the Court.

Commentary

Adapted from Local Rule 26.2 of the Southern District of New York. This Section simply formalizes what most counsel do already.

26.7 Scheduled Supplementation of Disclosures and Responses

Unless otherwise agreed, no later than the last business day of each calendar quarter, each party shall supplement its disclosures and responses in accordance with Rule 26(e).

26.8 Monthly Discovery Planning Conferences

(a) Unless otherwise agreed by the parties, each month during the period in which discovery is permitted, counsel for the parties shall confer informally, in person or by telephone, to help determine what if any discovery might be requested during the following month and to attempt to resolve any objections that might be apparent.

(b) Each party is strongly encouraged to FAX to the other parties, in advance of each discovery planning conference, drafts of the written discovery requests it proposes to propound and a schedule of depositions it desires to take during the upcoming month so that objections may be discussed at the conference with a view toward resolving the objections by agreement.

(c) Each such discovery planning conference will commence at 4:00 p.m. Eastern time on the last Tuesday of the month, or at such other time as the parties may agree. Unless otherwise agreed, counsel for the first-named plaintiff shall make any necessary conference-call arrangements; the parties are encouraged to agree on a rotation for each party's counsel to handle such arrangements in turn.
Commentary

The discovery planning conference is an experimental procedure. It is designed to force counsel to talk to each other on a regular, systematic basis, not just in the initial meet-and-confer required by Rule 26(f), in the hope of minimizing disputes over discovery.

29.1 Stipulations Regarding Discovery Procedure

Unless expressly directed otherwise by the Court in an order entered in the action, the parties may by written stipulation modify the discovery limitations of the Federal Rules and, if applicable, of the local rules or of any general-purpose case management order.

Commentary

Some local rules set out their own limits, e.g., the number of interrogatories and requests for admission that can be propounded. This Section permits the parties to dispense with those limits by agreement.

Depositions

30.1 One-Hour Preliminary Telephone Deposition

(a) Any party may take a deposition, by telephone or other remote electronic means, of an individual or non-individual deponent in accordance with Rule 30(b)(7) and the procedures in this Order to ascertain any or all of the following:

1. the personal history of an individual deponent, e.g., the deponent’s education and career history;

2. the basis and extent of any first-hand knowledge possessed by a deponent (but not the knowledge itself unless agreed by the deponent);

3. the name and, if known, the address and telephone number of individuals likely to have discoverable information;

4. the categories and locations of discoverable documents, data compilations, and tangible things in the possession, custody, or control of the deponent, and

5. any other topic agreed to by the deponent.
(b) Any such deposition is referred to for convenience as a "preliminary telephone deposition." The use of the term "preliminary" does not imply that the party taking the deposition is obligated to take a regular deposition of the same deponent. Questioning the deponent on the topics listed in paragraph (a) during a preliminary telephone deposition shall not preclude the deposing party from subsequently asking the same or similar questions of the deponent during a regular deposition. Moreover, any party may reserve its cross-examination of the deponent on the subjects addressed in the preliminary telephone deposition until the deponent’s regular deposition is taken.

(c) A party may take up to ten preliminary telephone depositions without having them be counted as depositions for purposes of any applicable limit on the number of depositions permitted to be taken by that party. Otherwise, a preliminary telephone deposition and any subsequent regular deposition of the same deponent shall together be counted as one deposition for purposes of any applicable limit on the number of depositions.

(d) The fact that a person has been deposed in a preliminary telephone deposition shall not preclude that person under Rule 30(a)(2)(B) from subsequently being deposed in a regular deposition. Absent an oral or written agreement by the parties and the deponent, however, no person shall be deposed in a preliminary telephone deposition more than once.

(e) In a preliminary telephone deposition, counsel are strongly encouraged not to make objections as to the form of questions directed to categories (1) through (4) of paragraph (a) above except as necessary to protect an applicable privilege. See also Rule 30(d)(1) (objections to be stated concisely and in non-argumentative manner).

(f) No party shall examine a deponent in a preliminary telephone deposition for more than one hour without the consent of the deponent.
Commentary

The preliminary telephone deposition is another experimental procedure. Counsel taking a preliminary telephone deposition should be able to obtain some basic factual information in a cost-effective manner, without having to prepare for a full-blown deposition, to travel, or to hire a court reporter. On the other hand, because of the limited range of topics permitted, counsel defending such a deposition can do so without having to engage in extensive preparation of the deponent.

The intent of paragraph (a)(2) is to permit counsel to establish, e.g., that a deponent does not have first-hand knowledge without having to do so in a formal deposition. For example, counsel might ask "Were you present when the inventor conducted his first test of the invention?" followed by "Who else was present?" (if the first answer was yes) or "So far as you know, who was present?" (if the first answer was no).

30.2 Numeric Limitations on Non-Expert Depositions

(a) Numerical limit. Each side shall be limited to twenty-five (25) depositions, exclusive of depositions of persons designated as experts and depositions of parties under Rule 30(b)(6) (hereinafter “non-expert depositions”).

(b) Deposition of motion declarant. A party may take the deposition of an individual who submits a declaration in support of or in opposition to a motion for summary judgment or for preliminary injunction, either before or after an applicable discovery cut-off date and regardless whether the individual has previously been deposed, provided that the deposition questioning (1) shall not be unnecessarily duplicative or cumulative of previous deposition questioning of the same individual and (2) shall be limited in scope to matters relating to (i) assertions made in the declaration, and (ii) the credibility of the individual. Such a deposition shall not count against the total number of non-expert depositions allotted to each side.

(c) Completion date. Absent leave of the Court or agreement by all parties, all non-expert depositions must be noticed and taken before the close of non-expert discovery.
30.3 Scheduling of Deposition Sessions

(a) Multiple sessions. Every deposition shall occur either (i) in a single session (which may extend for more than one day and need not occur in consecutive days) or (ii) in multiple sessions that are scheduled and conducted pursuant to this Section.

(b) Advance scheduling. Before serving a notice of a deposition session, counsel for the party serving the notice shall contact the deponent or the deponent’s counsel and counsel for all other parties. All concerned shall make reasonable, good-faith efforts to reach agreement on a mutually convenient place, beginning date and time, and ending date and time for the deposition session, taking into account each party’s anticipated need for time for direct examination, cross examination, etc. (See also Section 26.8, requiring the parties to conduct monthly telephone discovery planning conferences.) Written proposals among parties for scheduling of deposition sessions, as well as formal deposition notices, shall be served by FAX.

(c) Scheduling limitations. Unless otherwise agreed by all parties and the deponent or ordered by the Court:

1. no deposition session shall take place without ten days prior notice;
2. an individual deponent who is not being deposed in his or her capacity as an expert need not appear to answer questions in any city other than that of his or her residence or employment; and
3. no deposition shall be conducted on a Saturday, Sunday, or legal holiday in the jurisdiction where the deponent is located, nor outside the hours of 9:00 a.m. to 6:00 p.m. local time where the deponent is located.

(d) Notice of deposition session. The notice of deposition for any deposition session shall state specific dates and times certain for the session to begin and end. Phrases such as “the deposition will continue from day to day during normal business hours until concluded” are not a substitute for such dates and times and will be of no effect.

(e) Request for recess. A party that desires to continue its examination or cross-examination of the deponent past the scheduled end time for a deposition session may make or join in a request, on the record and before the actual end of the deposition session, that the deposition be recessed instead of ended. If a party makes such a request, then at the scheduled end time for the deposition session (or such other time as the parties and the deponent agree), the
officer before whom that deposition session is conducted shall recess the deposition. The party desiring to continue its examination or cross-examination shall schedule and notice a later deposition session in accordance with this Section in time to comply with any applicable discovery cut-off date. That later deposition session shall then be conducted as a continuation or resumption of the same deposition in which the prior deposition session occurred.

(2) If no request for recess. If no request for recess of a deposition is made as described in subparagraph (1), then the deposition shall be ended at the scheduled end time or at such other time as the parties and the deponent agree. Thereafter, no later deposition sessions for that deponent shall be permitted absent agreement of the deponent and the parties or order of the Court.

(3) Terms for resumption of deposition. If the parties and the deponent agree on terms for a later deposition session, either on the record or in a post-recess writing, then that agreement shall control. (The parties and the deponent are strongly encouraged to negotiate mutually agreeable terms — for example, resuming the deposition by telephone or other remote electronic means to avoid duplicative travel expenses.) Absent agreement of the deponent and the parties or an order of the Court, the later deposition session may not begin until at least ten days after the date on which the prior deposition session was recessed.

(4) Notice of topics for resumed deposition. If any deposing party schedules and notices a later deposition session for the same deponent in which it intends to conduct additional direct examination (as opposed to re-direct examination that is limited to the scope of cross-examination), then the deposing party shall serve by FAX upon the deponent and upon all other parties, at least two days before the scheduled beginning of the later deposition session, a list of specific topics for the additional direct examination it intends to conduct during that later deposition session. The scope of that party's additional direct examination during that later deposition session may not exceed the listed topics unless the parties and the deponent agree otherwise. The absence of such an agreement, however, does not in itself preclude the deposing party from scheduling and noticing still another deposition session, in accordance with the procedures in this Section, to cover additional topics. (The parties are encouraged to negotiate a schedule of deposition sessions in which specific topics will be covered.) The Court reminds all parties and their counsel that an attorney or party who signs a discovery request, including a
notice of a deposition session to resume a previously recessed deposition, is deemed thereby to make several certifications under Rule 26(g)(2), including that the request is not interposed for any improper purpose and that the request is not unreasonable or unduly burdensome.

(5) Order of examination in resumed deposition. If, in a prior deposition session, (i) the deposing party completed or suspended its direct examination and (ii) any party began its cross-examination relating to that direct examination, then, absent agreement of the parties, the deposing party shall not resume its direct examination until all parties have had the opportunity to conduct their respective cross-examinations relating to the earlier direct examination. The foregoing sentence shall not preclude a party other than the deposing party from electing to reserve its cross-examination until after the deposing party's resumed direct examination.

(f) Factors for protective order re resumed depositions. Any motion by a party or a deponent for a protective order limiting a party's ability to resume a recessed deposition will be evaluated in part on the extent to which the party seeking to resume the deposition had attempted and was able to obtain the desired information in a prior deposition session or using other discovery devices, including the propounding of written questions of the deponent and of interrogatories or requests for admission to another party.

Commentary

Patent cases can involve extremely complex facts. As a result, in such cases it can be counterproductive to limit the parties to one deposition per deponent without a court order, as set forth in Rule 30(a)(2)(B).

Accordingly, this Section sets out a procedure by which a deposition is allowed to take place in stages, but only within carefully defined limits. For example, a witness might be deposed in a first session to ascertain basic facts, then be deposed again in another session to follow up on matters raised in other discovery or investigation. As discussed below, there are significant restrictions on that capability which are intended as safeguards against abuses.

Subparagraph (d) requires that deposition notices include a stated end time. This requirement is included to permit the deponent and counsel for other parties to plan their schedules.
Few things are more aggravating than having a deposition go into extra days, especially when that has the effect of disrupting travel arrangements and the deponent's and counsel's other work.

Subparagraph (e)(1) sets out procedures for recessing and resuming a deposition. It formalizes what many counsel already do anyway.

Subparagraph (e)(3) requires that ten days elapse before a deposition can resume (absent agreement). This requirement is intended to give the deponent and the other parties more flexibility in planning their schedules.

Subparagraph (e)(4) requires a quid pro quo of a deposing party that wishes to extend its direct examination beyond the time that it originally scheduled for its first deposition session. The deposing party presumably scheduled the first deposition session to give it the amount of time that it thought it would need for direct examination. During that first deposition session, the deposing party is free to conduct direct examination on any proper topic, without prior notice of the exact topics to be covered. If the deposing party wants to continue its direct examination beyond its own (self-imposed) time limit, however, it must provide the deponent and the other parties with an advance list of topics to be covered in the resumed direct examination.

30.4 Disputes in the Timing or Sequence of Depositions

If a dispute arises about the sequence in which deposition sessions for two or more deponents should be scheduled within a given two-week period, then unless otherwise ordered by the Court for good cause shown, the first party to make a specific schedule proposal in writing in accordance with Section 30.3 is entitled to have its deposition session go first if it FAXes the other party a written notice to that effect within five days after receiving the other party's deposition proposal.

EXAMPLE: Suppose that at noon on January 15, Party A FAXes Party B a letter proposing that Witness 1 be deposed on
February 15. Party B responds at noon on January 20 with a FAX letter proposing that Witness 2 be deposed on February 14. Now suppose that at noon on January 23, Party A replies by FAXing Party B a notice of its claim to priority. If a dispute arises as to who should go first, then Party B's deposition session for Witness 2 normally will not begin before the conclusion of the deposition session for Witness 1 noticed by Party A.

Commentary
In the interest of avoiding gamesmanship by counsel, this Section provides a limited exception to the last clause of Rule 26(d), which states that "the fact that a party is conducting discovery, whether by deposition or otherwise, shall not operate to delay any other party's discovery."

30.5 Nonstenographic Recording
If a party taking or otherwise attending a deposition elects to have the testimony recorded by other than stenographic means (e.g., by audio- or videotape) in addition to stenographic recording, then any additional cost incurred by that party as a result of causing the deposition to be recorded by other than stenographic means in addition to stenographic recording shall not be a recoverable cost, absent a showing that additional means of recording were necessary to the outcome of the case.

30.6 Videotaped Recording of Depositions
(a) Video operator. The operator(s) of the videotape recording equipment shall be subject to the disqualification-for-interest provisions of Rule 28(c). At the commencement of the deposition the operator(s) shall swear or affirm to record the proceedings fairly and accurately.

(b) Time coding. A party that causes a deposition to be recorded both by sound-and-visual means (a "video deposition" or "video recording") and by stenographic means is strongly encouraged to use a recording method that permits time-coding or other automatic synchronization of the video recording with the stenographic recording.
(c) **Attendance.** Each witness, attorney, and other person attending the deposition shall be identified on camera at the commencement of the deposition. Thereafter, only the deponent (and demonstrative materials used during the deposition) shall be videotaped.

(d) **Standards.** The deposition will be conducted in a manner to replicate, to the extent feasible, the presentation of evidence at trial.

1. Unless physically incapacitated, the deponent shall be seated at a table or in a witness box except when reviewing or presenting demonstrative materials for which a change in position is needed.

2. To the extent practicable, the deposition will be conducted in a neutral setting, against a solid background, with only such lighting as is required for accurate video recording. Lighting, camera angle, lens setting, and field of view will be changed only as necessary to record accurately the natural body movements of the deponent or to portray exhibits and materials used during the deposition.

3. Sound levels will be altered only as necessary to record satisfactorily the voices of counsel and the deponent.

4. Eating and smoking by deponents or counsel during the deposition will not be permitted.

(e) **Interruptions.** [The videotape shall run continuously throughout the active conduct of the deposition.] [Videotape recording will be suspended during all “off the record” discussions.]

(f) **Index.** The videotape operator shall use a counter on the recording equipment and after completion of the deposition shall prepare a log, cross-referenced to counter numbers, that identifies the positions on the tape at which examination by different counsel begins and ends, at which objections are made and examination resumes, at which exhibits are identified, and at which any interruption of continuous tape recording occurs, whether for recess, “off the record” discussions, mechanical failure, or otherwise.

(g) **Filing.** [The operator shall preserve custody of the original videotape in its original condition until further order of the court.] [The original of the tape recording, together with the operator’s log index and a certificate of the operator attesting to the accuracy of the tape, shall be filed with the clerk.]

(h) **Public release.** No part of a videotaped deposition shall be released or made available.
to any member of the public unless authorized in writing or on the record by the deponent and all parties or authorized by the Court.

Commentary

This Section is adapted from MCL § 41.38 at 466.

Subparagraph (b) encourages counsel to use a recording method that permits time-coding of video depositions to synchronize them with the corresponding transcripts. Video presentation of deposition testimony from a multimedia CD-ROM or laser disk is being increasingly used in trials of complex cases such as patent infringement actions. Automatic synchronization of a deposition videotape with the transcript can significantly reduce the cost of preparing such presentations and also permit “closed captioning” of the video playback.

30.7 Photographs of Deponent

Unless the Court orders otherwise, during a deposition, with prior notice to the deponent and other parties, either in writing or on the record, any party may cause one or more photographs of the deponent to be taken in a manner that does not disrupt the deposition.

Commentary

In some trials, photographs of witnesses are used to help the jurors remember who said what. This Section expressly permits deponent photographs to be taken for possible use at trial. While a deponent might have legitimate privacy concerns, a still photo would be no more intrusive than using a freeze-frame taken from a videotaped deposition.

30.8 Real-Time Deposition Transcription

The parties are encouraged to agree in advance as to whether depositions recorded by stenographic means will be recorded in a manner that permits real-time electronic viewing of the transcript (e.g., on a notebook computer connected to the court reporter’s transcription machine) by counsel present at the deposition. If a notice of deposition does not specify whether the deposition will be so recorded, then any other party may arrange with the court reporter, at its
own expense, for such recording so that the other party can have access to such real-time viewing.

30.9 Telephone and Other Remote Electronic Depositions

(a) Any party may take a deposition by telephone or other remote electronic means, including by videoconference ("telephone deposition") in accordance with Rule 30(b)(7) by so indicating in the notice of deposition, which shall also indicate the location where the deponent will appear to answer questions.

(b) The fact that a party notices such a deposition shall not preclude counsel for any other party from attending the deposition in person at that location.

(c) If so specified in the notice of the deposition session and not objected to in writing by another party at least two days before the beginning of the deposition session, or if otherwise so agreed by the parties, either in writing or on the record, the deponent in a telephone deposition may be put on oath or affirmation remotely, i.e., by a person at the other end of a phone line or video hookup who is authorized to administer oaths in the jurisdiction where such person is located, as an alternative to being put on oath or affirmation in the physical presence of such a person.

Commentary

In some circumstances, it may be very cost-effective to take a deposition by 1) serving written questions per Section 30.11 in advance of the deposition, and 2) transcribing only selected portions of the recording in accordance with Section 30.17. Taking the deposition by telephone may reduce the cost even more.

Subparagraph (c) permits the deponent to be put on oath by an officer at the other end of a phone line, video hookup etc. As a practical matter, however, it may be preferable to have the deponent put on oath or affirmation in person, e.g., by a notary public such as a legal secretary.

30.10 Deposition by Conference Call

(a) If so agreed by the parties, the officer before whom a telephone deposition is taken
may himself or herself participate in the deposition by telephone or other remote electronic means from a remote location. A deposition in which the officer and one or more counsel participate by telephone is referred to as a "conference-call deposition."

(b) In a conference-call deposition, upon request by any party, the officer shall ask each counsel who participates in the deposition whether such counsel has any knowledge suggesting that the person who identifies him- or herself as the person designated as the deponent in the notice of deposition is in fact not that person. Each counsel so asked shall respond truthfully on the record.

30.11 Written Questions for Oral Deposition

(a) Any party ("questioning party") may serve written questions upon a deponent whose deposition has been noticed, with a copy to all other parties.

(b) The written questions may include any question that might properly be asked of the deponent in a deposition by oral examination. The fact that a questioning party propounds written questions shall not in itself preclude the questioning party from subsequently asking the same or similar questions of the deponent during the deposition.

(c) The written questions shall preferably be served no later than two days before the scheduled beginning of the oral examination, but in no event later than the conclusion of the oral examination; if served later than five days prior to the beginning of the oral examination, service shall be by hand delivery, by FAX, or by same-day or overnight commercial courier.

(d) The deponent may elect to answer none, some, or all of the written questions in writing. If the deponent elects to answer some or all of the written questions in writing, then such answers, executed under penalty of perjury, shall be served on the questioning party no later than the conclusion of the oral examination. As to any question, failure to serve such a written answer prior to the conclusion of the deposition constitutes the deponent's election not to answer that question in writing. The questioning party shall promptly serve copies of the answers, if any, upon all other parties.

(e) If such written questions are served upon a non-party deponent other than by hand delivery at the deposition, the written questions shall be preceded by a statement, prominently displayed, as follows: "You are requested to provide written answers to these written questions."
If you choose to provide written answers, that likely will shorten the time required to complete your deposition. If you choose not to provide written answers, no penalty will be imposed and your choice will not be held against you in any way. In that event, however, you may still be asked the same questions in person during your deposition. If served by hand delivery at the deposition, counsel for the party propounding the written questions shall read the above-quoted sentences to the deponent on the record.

(f) A written answer to a question may state an objection to the form of the question; other objections are not waived by failure to make them before providing the written answer to the deposing party. If objection is made to a written question, the question may, but need not, be answered subject to and without waiver of the objection.

(g) A written question to which the deponent provides an answer in writing as set forth above, together with such answer, shall be deemed a part of the deposition of the deponent for all purposes, including cross-examination by parties other than the deposing party.

(h) A party giving notice of its intent to take a deposition may not cancel the deposition as a result of the deponent’s providing of written answers, satisfactory to the deposing party, of written questions, without the agreement of all other parties. With reasonable notice to the deponent and to other parties, however, the deposing party may amend its deposition notice in view of the deponent’s written answers, for example, postponing the deposition; changing from an in-person deposition to a telephone deposition; or providing for electronic recording only of the deposition.

Commentary

Written questions may help reduce the time needed for oral examination in a deposition. A deposing party can serve written questions to get at least some information from a deponent in advance. Counsel for the deposing party can then follow up with oral questions, possibly in a telephone deposition, if desired.

Subparagraph (c) permits counsel to serve written questions during a deposition and to ask the deponent to answer the questions in writing during a recess.

Subparagraph (f) allows a deponent to answer a written question subject to and without waiver of a stated objection. This is intended to reduce the number of objections that are ultimately
brought to the Court for resolution.

Subparagraph (h) requires that, absent agreement, a deposition must go forward even if the deposing party gets everything it wants in the answers to its written questions. The reason for this requirement is that Rule 30(a)(2)(B) imposes a one-deposition-per-deponent rule. If the preliminary written questions are considered part of a deposition, it would not be fair to permit the deposing party to cancel the oral deposition after getting satisfactory answers to its written questions, thus leaving other parties without a good way of asking follow-up questions. The deposing party can still change its deposition plans to avoid unnecessary expense while still giving other parties the opportunity to cross-examine the deponent.

30.12 Contention Depositions of a Party-Deponent

(a) A deposing party may examine a party-deponent about the party-deponent’s factual or legal contentions, including without limitation:

1. the party-deponent’s proposed construction of any claim of a patent in suit;
2. the party-deponent’s contentions concerning infringement of any claim of a patent in suit;
3. the party-deponent’s contentions concerning the validity of any claim of a patent in suit;
4. the basis for the party-deponent’s responses to written interrogatories, requests for admission, or requests for production.

(b) Unless otherwise agreed by the parties, a deposing party desiring to examine a party-deponent about the party-deponent’s factual or legal contentions shall serve on the party-deponent, by FAX or hand-delivery, at least ten days prior to the beginning of the deposition session in question, a list of the specific contentions as to which the deposing party wishes to examine the party-deponent (in addition to complying with Rule 30(b)(6) if applicable).

EXAMPLE: “ABC Corp. will examine XYZ Corp. about the basis for XYZ Corp.’s responses to ABC Corp.’s requests for admission nos. 1-10.”
(2) The party-deponent may respond to a question about a contention topic that was not served in advance as described in subparagraph (1) with an objection that the party-deponent was not given prior notice and is not prepared to answer the question, and may decline to answer the question on that ground. If the party-deponent answers the question, however, such objection is waived to that extent.

(c) A party-deponent may designate, as the party-deponent's representative for answering contention questions, one or more persons who agrees to respond to one or more deposition questions about the party's factual or legal contentions. A party's litigation counsel who agrees to be so designated and who answers contention questions in a deposition on behalf of the party-deponent shall not thereby be disqualified from acting as trial counsel.

**Commentary**

Contention depositions can allow the parties to exchange contention information quickly and efficiently, but they also require extensive and expensive preparation of the person testifying. This Section sets out a reasonable compromise by encouraging the deposing party to notify the party-deponent of the contention topics to be covered. That way, the party-deponent will know in advance whether it needs to spend time and money preparing for questions about its contentions.

30.13 "Conference" Depositions

With prior notice to all other parties and all deponents, a party may depose more than one person in the same deposition session. In such a "conference" deposition, the various deponents may be examined in person, by telephone or other remote electronic means, or both.

**Commentary**

Adapted from a suggestion at MCL § 21.423 at 62. If credibility is not a particular concern, a "conference" deposition may be a time-saving way of establishing basic facts.

30.14 Attorney-Deponent Conferences During Deposition

During examination of a deponent by counsel other than counsel for the deponent or a
party identified with the deponent ("the deponent's counsel"), the deponent shall not confer with the deponent's counsel except (i) during a recess, or (ii) in the deposition room for the sole purpose of determining whether a privilege should be asserted.

Commentary

An opposing counsel who asks a question in deposition is entitled to get the deponent's answer without coaching by the deponent's counsel. On the other hand, allowing the deponent's counsel to confer with the deponent during his (or her) own examination of the deponent may save time. Suppose that the deponent's counsel asks a question and that the deponent gives an answer that was other than what his counsel wanted. The deponent would later be entitled to correct the deposition transcript with advice of his counsel. That might cause the opposing counsel to want to come back to ask follow-up questions. Allowing the deponent's counsel to "coach" the deponent during his own examination would give the opposing counsel a chance to ask such follow-up questions during the same deposition session.

30.15 Deposition Exhibit Numbering

See Section 611.1 concerning numbering of exhibits.

30.16 Copies of Exhibits at Depositions

Counsel who ask a deponent to examine a document should provide copies of the document to counsel for other parties present at the deposition.

30.17 Selective Transcription of Deposition

(a) A party taking a deposition may specify, either in the notice of deposition or on the record during the deposition, that the party does not presently intend to have the entire stenographic or nonstenographic recording transcribed into a written deposition transcript. In such event, the deponent or any party may request, on the record before completion of the deposition or by written notice to all concerned within ten days thereafter, that a transcription be
made of some or all of the recording and that the transcription be submitted to the deponent for review in accordance with Rule 30(e).

(b) If the request is that less than all of the recording be transcribed, the requester shall designate specific portions of the recording to be transcribed, either by so stating on the record or in the written notice referred to in subparagraph (a). In similar fashion within five days after such designation, the deponent or any party may counter-designate other portions of the recording to be transcribed.

Commentary
Allowing only selected portions of a deposition recording to be transcribed can reduce the expense of the deposition. There will always be times when counsel do not want to "tip their hand" by designating specific portions of a deposition recording to be transcribed. Such counsel are free to designate the entire recording to be transcribed, but they will have to pay for it.

If a notice of deposition states that only a nonstenographic recording is to be made of a deposition, counsel for other parties may wish to record the deposition themselves, or to make arrangements with the court reporter to obtain a copy of the recording, or to make specific notes about the times of particular testimony of interest, so that they can counter-designate portions of the deposition to be transcribed if they so desire. Pursuant to Rule 30(b)(3), the expense of the transcription shall be borne pro rata by the persons or parties requesting the transcription.

30.18 Numbering of Deposition Transcript Pages
The pages of the deposition of a single witness, even if taken at different times, shall be numbered sequentially.

Commentary
Adapted essentially verbatim from Local Rule 30.3(a) of the Northern District of California.
30.19 Depositions After Discovery Cut-Off

If the parties so agree, or if the Court so orders for good cause shown, a deponent may be deposed after a discovery cut-off date imposed by a scheduling order.

Interrogatories

33.1 Subparts of Interrogatories

For purposes of determining the number of interrogatories propounded, subparts of a basic interrogatory which are logical extensions of the basic interrogatory and seek only to obtain particularized information with respect to the basic interrogatory shall not be counted separately from the basic interrogatory.

33.2 Contention Interrogatories

(a) Use permitted. A party may propound one or more interrogatories to ascertain the factual or legal contentions of another party, including without limitation the specific contentions enumerated in Section 30.12 (relating to contentions of a party-deponent). For purposes of any applicable limitations on the number of interrogatories that may be propounded by a party, all contention interrogatories taken together shall count as a single interrogatory.

(b) Timing. Except as otherwise set forth in this Section, contention interrogatories may be propounded at any time during which discovery may be had, but shall be propounded in time for compliance with any applicable discovery cut-off date. The Court encourages counsel to serve contention interrogatories early in discovery.

(c) Responses. A party responding to a contention interrogatory shall answer to the best of its ability as of the response date. It shall not be grounds for objection to a contention interrogatory that the responding party is not yet able to formulate a complete statement of its contention in question, e.g., because of the early stage of the case or the lack of complete discovery.

(d) Signature. A party's response to a contention interrogatory may be signed by counsel for the party in lieu of being signed under oath or penalty of perjury by the party itself.
33.3 Citation of Records as Answer to Interrogatory

Whenever a party answers any interrogatory by reference to records from which the answer may be derived or ascertained, as permitted in Federal Rule of Civil Procedure 33(d):

(a) the specifications of documents to be produced shall be in sufficient detail to permit the interrogating party to locate and identify the records and to ascertain the answer as readily as could the party from whom discovery is sought;

(b) the producing party shall also make available any computerized information or summaries thereof that it either has, or can adduce by a relatively simple procedure, unless these materials are privileged or otherwise immune from discovery;

(c) the producing party shall also provide any relevant compilations, abstracts or summaries in its custody or readily obtainable by it, unless these materials are privileged or otherwise immune from discovery; and

(d) unless otherwise ordered by the court, the documents shall be made available for inspection and copying within ten days after service of the answers to interrogatories or at a date agreed upon by the parties.

Commentary

Adapted essentially verbatim from Local Rule 33.1 of the Southern District of New York.

Document Production

34.1 Numbering of Production Documents

(a) Counsel shall meet and confer to assign blocks of machine numbers (e.g., "Bates numbers") to the respective parties for use in labeling the pages of documents produced.

(b) Any party producing documents is strongly encouraged to number all such documents using (i) the first initial or initials of the party's name, and (ii) a numerical code indicating the location from which the document was produced, as a prefix to the appropriate machine numbers, and to produce to requesting parties a list of such numerical codes and the corresponding locations. If two or more parties have the same first initial, then counsel are encouraged to agree on appropriate initial or combinations of initials to use. EXAMPLE: In the hypothetical document number ABC-1-00985, ABC signifies that the document was produced by
ABC Corporation; 1 signifies that the document was produced from the desk files of ABC's vice president for research and development; and 00985 is the sequence number of the document.

34.2 Production of Documents That Are Available in Electronic Form

Upon request by a party requesting production of documents under Rule 34, all documents produced in response to the Rule-34 request that already exist in an electronic form reasonably available to the producing party shall be produced to the requesting party in such electronic form unless the electronic form is privileged or otherwise immune from discovery.

34.3 Production of Hard-Copy Documents in Electronic Form

The parties are encouraged to agree on procedures for producing copies of hard-copy documents in electronic form, e.g., on CD-ROM.

34.4 Exchange of Document-Index Databases

The Court recognizes that, if each party develops its own database for indexing production documents, the parties' efforts are partially duplicated and costs are increased as a result. Consequently, the parties are encouraged to agree on procedures whereby each party that produces a large volume of documents will also produce an electronic database, in an agreed format, containing basic identifying information about the documents being produced.

Requests for Admission

36.1 Limits on Requests for Admission

If the number of requests for admission that can be propounded by a party is limited by local rules or a general-purpose case management order, a party may nevertheless propound a greater number of such requests, not to exceed a number that is reasonable under the circumstances. The Court reminds all parties and their counsel that an attorney or party who signs a discovery request, including a request for admission, is deemed thereby to make several certifications under Rule 26(g)(2), including that the request is not interposed for any improper purpose and that the request is not unreasonable or unduly burdensome.
Requests for admission can be particularly useful in patent cases, and can help shorten trials, by providing agreed statements of fact and by authenticating documents in advance. Some local rules limit the number of requests for admission that can be propounded because of the possibility that a party might attempt to inundate its adversary with such requests. This Section addresses that possibility by permitting a party to propound a reasonable number of requests.

36.2 Combining Requests for Admission and Other Discovery Requests

(a) A request for admission may include a statement such as the following: "Please admit, or alternatively state your position concerning, the following: <statement of the matter(s) of which admission is requested>." The request shall be deemed to include a contention interrogatory concerning the matter of which admission is requested.

(b) The response to a request for admission in accordance with subparagraph (a), if other than an unqualified admission, shall:

(1) state the responding party's contentions concerning the matter of which admission is requested in the same manner as a response to a contention interrogatory, and

(2) provide the disclosures described in Rule 26(a)(1)(A) and (B) concerning the matter of which admission is requested, in the same general manner as if the matter in question had been alleged in the pleadings, to the extent that the same has not already been provided in prior disclosures or in discovery. The information so provided shall be supplemented in the same manner as required for Rule 26 disclosures.

Commentary

Adapted from a suggestion in MCL § 21.424 at 62.

Trial

49.1 Special Verdict to be Used

(a) The Court will require the jury to return a special verdict in the form of a special written finding upon each issue of fact.
(b) At the time specified by local rules, if any, but in any case sufficiently in advance of
the beginning of the trial, the parties shall jointly submit a set of proposed preliminary special-
verdict questions (colloquially referred to as "special verdicts"), both on paper and on disk, for
the jury's use during the trial. For ideas about possible phrasing and organization of the
special verdicts, counsel for the parties are strongly encouraged to refer to Appendix B, examples
no. 1-4, 6, and 8-10, in Railroad Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1522-23 (Fed.
Cir. 1984) (the remaining examples arguably are no longer appropriate in view of intervening
changes in the case law).

(c) The parties shall jointly submit a set of proposed final (i.e., post-trial) special verdicts,
both on paper and on disk, at such time as directed by the Court.

(d) If the parties do not agree on the form of a particular special verdict, each party's
version should be set out separately together with a brief supporting argument.

Commentary

"The Supreme Court recently emphasized that patent cases are
particularly well suited for special verdicts." Richardson-Vicks Inc.
v. Upjohn Co., 122 F.3d 1476, 1485, 44 USPQ2d 1181 (Fed. Cir.
U.S. __, 117 S. Ct. 1040, 1053 n.8, 137 L.Ed.2d 146, 41 USPQ2d
1865, 1875 n.8 (1997). In Warner-Jenkinson, the Supreme Court
expressly suggested the use of special verdicts and Interrogatories
for doctrine-of-equivalents issues to facilitate appellate review:
"With regard to the concern over unreviewability due to black-box
jury verdicts, we offer only guidance, not a specific mandate. . . .
Finally, in cases that reach the jury, a special verdict and/or
interrogatories on each claim element could be very useful in
facilitating review, uniformity, and possibly postverdict judgments

The Federal Circuit has made no secret of its own preference for
special verdicts or Interrogatories, even for issues such as
obviousness (although so far it has refused to require district
courts to use them). "Sorting through the record in a case such as
this when the issue is the correctness of a jury verdict is made
considerably more difficult by the absence of specific findings by
the jury. The effort by the successful plaintiff to support the jury verdict in its favor is also made more difficult. The preferred route would have been to submit the underlying factual issues to the jury in the form of a special verdict under rule 49(a) . . . Given the nuances of patent law combined with the added complications of technology, the advantages of a special fact verdict are even more pronounced."

Richardson-Vicks Inc., 122 F.3d at 1484-85 (emphasis added). "The role of the trial judge in deciding upon motions for JNOV and new trial, and that of this court on review, are greatly facilitated when the jury has answered a series of factual inquiries in writing. When obviousness is an issue, Interrogatories seeking answers in writing to inquiries drawn about those listed in Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545, 148 USPQ 459 (1966), insofar as the evidence adduced at trial relate to those inquiries, should be employed." Railroad Dynamics, Inc. v. A. Stucki Co., 727 F.2d 1506, 1516-17 (Fed. Cir. 1984); see also, e.g., Weiner v. Rollform Inc., 744 F.2d 797, 809-10 (Fed. Cir. 1984). The Railroad Dynamics opinion even provided an appendix with sample special verdict questions and Interrogatories. See 727 F.2d at 1521-23.

Several individual judges of the Federal Circuit have been strong proponents of special verdicts. "The [Supreme Court's] encouragement to use Rule 49 special verdicts and/or Interrogatories for each claim element echoes sentiments most recently expressed by the late Judge Nies and the very much alive Judge Michel, and earlier pressed by former Chief Judge Markey."


In a much-discussed article, Judge Michel of the Federal Circuit argued for increased use of special verdicts: "Just as better [jury] instructions would help, so too would more common use of special verdicts or Interrogatories. Use of special verdicts and Interrogatories that direct juries to sequentially address the specific
issues presented could greatly enhance the rationality, reliability, and predictability of jury verdicts, and their reviewability on post-trial motions and on appeal as well.” Paul R. Michel & Michelle Rhyu, Improving Patent Jury Trials, 6 FED. CIR. B.J. 89, 94 (1996) (footnote omitted). Judge Michel pointed out that “[a]lthough the Federal Circuit has neither demanded special verdicts/interrogatories nor offered direction as to their content, several of the regional circuit courts have. Most notably, in an in banc decision, the Seventh Circuit has exercised its supervisory power to mandate the use of special verdicts on the issue of obviousness.” Id. at 97 (footnote omitted).

Finally, the patent bar appears to be virtually unanimous that special verdicts and interrogatories should be used in patent cases, especially after the Supreme Court’s Warner-Jenkinson opinion. “[A]s a result of the Warner-Jenkinson decision, jury instructions and special interrogatories or special verdicts will become very important to the trial in order to have the jury address the correct issues.” Laurence H. Pretty & Janene Bassett, Reconciling Section 112, Paragraph 6 With the Doctrine Of Equivalents In The Wake Of Warner-Jenkinson Co. v. Hilton Davis Chemical Co., in PRACTISING LAW INSTITUTE, PATENTS, COPYRIGHTS, TRADEMARKS, AND LITERARY PROPERTY COURSE HANDBOOK SERIES, PLI Order No. G4-4008, at 392 (1997); see also, e.g., Stephen S. Komiczky & Don W. Martens, Verdict Forms - A Peek Into the "Black Box" 23 AIPLA Q.J. 617, 630-32 (1995).

52.1 Jury Instructions

(a) Jurors will be given oral and written instructions as prescribed in this Section. The Court will give oral preliminary instructions to the jury prior to opening statements, and oral final instructions concerning the substantive law prior to closing arguments. Copies of the written preliminary and final jury instructions approved by the Court will be given to the jury before the Court delivers the corresponding oral instructions so that the jury can use the written instructions to follow along with the oral instructions.
(b) The parties shall jointly submit a set of proposed preliminary (i.e., pre-trial) jury instructions, both on paper and on disk, at the time specified in the local rules of the Court. The parties shall jointly submit a set of proposed final (i.e., post-trial) jury instructions, both on paper and on disk, at such time as directed by the Court.

(c) Each proposed instruction shall be directed to a single special verdict or interrogatory (see Section 49.1). The instruction shall contain the following sections, with each section preceded by a heading with the italicized text below:

1. **Facts Agreed to by the Parties.** The instruction shall state any applicable stipulated facts.

2. **The Parties' Factual Contentions.** Each party may state briefly, in non-argumentative and non-perjorative form, its factual contentions to which the instruction in question is applicable. To the greatest extent possible, the factual contentions shall be phrased in terms of ultimate, dispositive facts. The Court will exercise appropriate oversight over the language of the contentions.

3. **The Law to Be Applied.** The instruction shall state the applicable law in short sentences and paragraphs. It shall use simple, direct, layman's language, free of boilerplate and verbosity. It shall use the names of the parties. It shall refer, where applicable, to specific witnesses or evidence. To the greatest extent possible, it shall set out the narrowest legal principle that is applicable to the evidence and the stipulated facts. If appropriate, it should cross-reference a more detailed written instruction to be provided to the jury. If the parties do not agree on the statement of the law for the instruction, each party's version should be set out separately together with a brief supporting argument.

4. **The Question You Must Answer.** The instruction shall reproduce the text of the special verdict or interrogatory in question.

### 52.2 Example of Jury Instruction

The following example of a jury instruction is provided as a guide and not as necessarily representing a correct statement of the law:
Instructions for Special Verdict No. 1:  
Ownership of the '123 Patent

Facts agreed to by the parties: The '123 patent was originally issued in the name of the named inventor, Dr. Iris Inventor. A document entitled “Assignment,” a copy of which was introduced as Exhibit 425, purports to state that Dr. Inventor has assigned her ownership rights in the '123 patent to ABC. Exhibit 425 contains a signature over the typed words “Iris Inventor.”

Summary of ABC’s contentions: The signature on Exhibit 425 is that of Iris Inventor, the named inventor of the '123 patent, and therefore ABC is the owner of the '123 patent.

Summary of XYZ’s contentions: ABC has failed to prove that the signature on Exhibit 425 is that of Iris Inventor, and therefore it has failed to prove that it is the owner of the '123 patent.

The law to be applied: Only the owner of a patent is entitled to bring a lawsuit for infringement of the patent (except in circumstances that are not applicable here). ABC must show, by a preponderance of the evidence, that it owns the '123 patent. To do so on the facts of this case, it must show, by a preponderance of the evidence, that the signature on Exhibit 425 is that of Iris Inventor.

The question you must answer: Has ABC, Inc. proved, by a preponderance of the evidence, that the signature above the name “Iris Inventor” on Exhibit 425 is that of Iris Inventor, the named inventor of the '123 patent?  YES ___ (for ABC) or NO ___ (for XYZ).
Commentary

"Most judges provide jurors with copies of the instructions for use during deliberations." MCL § 22.434 at 153. "Instructions on the law may make closing arguments easier to understand, and counsel, instead of previewing the court's instructions during argument, can refer to instructions already given in arguing their application to the facts. Hearing the instructions may also help counsel structure their arguments. The court should, however, reserve the final closing instructions until after arguments, reminding the jury of the instructions previously given and instructing them about the procedures to be followed in deliberations." Id.

The form of jury instruction is a variation on one implemented in an actual patent-infringement trial, as described in John C. Lowe, Making Complex Litigation Clear, TRIAL, April 1997, at 46. Some of the specific language from that article is used with the permission of the author, who is an active member of the committee.

The form of special verdict identifies who the prevailing party would be in each possible answer. The intent is to reduce the chance of unintended answers arising out of juror confusion.
56.1 *Markman* Summary Judgment Motions

(a) The parties are strongly encouraged to identify potentially dispositive issues of patent claim construction as early as possible, and where appropriate, to file one or more motions and/or cross-motions for complete or partial summary judgment directed to such issue(s) ("Markman motions"), preferably in consolidated form in accordance with Section 11.4. See also Sections 16.6 through 16.11 concerning claim-construction proceedings.

(b) The parties are strongly encouraged to agree on issues such as a briefing schedule and a period for any discovery necessary for disposition of the motions(s) (including expert discovery) as applicable.

(c) Absent a consolidated filing or an agreed briefing schedule, a party upon whom a *Markman* motion is served shall have 21 days after the effective date of service in which to serve and file a brief or memorandum in opposition (together with supporting materials as required by the Federal Rules and/or local rules). The moving party shall have 14 days after the effective date of such service in which to serve and file a reply.

Commentary

In *Markman v. Westview Instruments, Inc.*, __ U.S. __, 118 S.Ct. 1384, 1393-96 (1996), affirming 52 F.3d 967 (Fed. Cl. 1995) (in banc), the Supreme Court held that the construction of a patent claim is properly a matter for the court, not the jury, to decide, even if the decision necessarily involves resolution of underlying factual issues.

611.1 Numbering of Exhibits

(a) Sequential numbering. Documents identified as exhibits during the course of depositions, other pretrial proceedings and at trial shall be numbered sequentially. Only one exhibit number shall be assigned to any given document throughout the case, including at trial.

(b) Conference of counsel. Prior to the commencement of discovery, counsel for all parties shall confer and estimate the total number of documents that may be identified.

(c) Assignment of numbers. The attorney for plaintiff shall assign blocks of exhibit numbers to each party after consultation with counsel for other parties. If plaintiff is appearing
pro se, that responsibility shall reside with the attorney for defendant.

(d) Method of assignment.

(1) Counsel shall attempt to determine the total number of exhibits to be used by the parties and assign blocks of numbers to meet the needs of each party. EXAMPLE: If the parties estimate that 130 exhibits will be used, numbers 1-99 may be assigned to plaintiff and numbers 100-199 to defendant. If plaintiff later anticipates having more than 100 exhibits, numbers 200-299 may be assigned to plaintiff for use after numbers 1-99 have been exhausted. Numbers 300-399 may then be reserved to defendant, alternating thereafter until the numbers necessary to accommodate each party have been used.

(2) If more than two parties appear in the litigation, successive blocks may be assigned in a similar fashion.

(e) Duplicate exhibits. Any exhibit which is an exact duplicate of an exhibit previously numbered shall bear the same exhibit number regardless which party is using the exhibit. Any version of any exhibit which is not an exact duplicate shall be marked and treated as a different exhibit bearing a different exhibit number.

(f) Inadvertent numbering of a duplicate exhibit. If through inadvertence, the same exhibit has been marked with different exhibit numbers, the parties shall assign the lowest such exhibit number to the exhibit and conform all deposition transcripts and exhibits to reflect the lowest number. The superseded number shall not be reused by the parties. EXAMPLE: If the same exhibit has been marked as 52 in the deposition of A and 125 in the depositions of B, C and/or D, the exhibit marked 125 shall be renumbered 52 and the depositions of B, C and D shall be conformed to the renumbered exhibit. Thereafter, number 125 shall not be used.

(e) Gaps in exhibit numbering. It is recognized that these procedures may result in gaps in the sequence of exhibits offered at trial. For example, only Exhibit Nos. 1-6, 10-25, 208, 323-329 and 383 may be offered at trial and not all those exhibits may be admitted into evidence.

(f) Designation of exhibit sub-parts. If it is necessary to identify sub-parts of a document that has been marked as an exhibit, then such sub-parts shall be designated by the number of the exhibit followed by a number designation. EXAMPLE: If a three-page contract is marked as Exhibit No. 12, the pages of the contract may be marked as Exhibits 12-1, 12-2, and 12-3; the entire document shall be referred to as Exhibit 12.
(g) **Internal control numbering.** In addition to exhibit numbers, documents may bear other numbers or letters used by the parties (e.g., "Bates numbers") for internal control purposes.

**Commentary**

*Adapted essentially verbatim, with minor editorial changes, from Local Rule 8.5 of the Central District of California.*

### 611.2 Daily Exchange of Lists of Upcoming Evidence

No later than 7:00 p.m. on the day before each trial day, counsel for any party expecting to present part of its case-in-chief or rebuttal case during that trial day shall serve by FAX or hand delivery on counsel for all other parties:

(a) a list of all witnesses to be called on that trial day, in the order in which they are to be called;

(b) for each such witness, a list of all exhibits expected to be used in the examination of that witness, other than for impeachment or rehabilitation purposes, along with copies of any such exhibits not previously produced;

(c) a list of any other exhibits expected to be offered into evidence on that trial day, other than for impeachment or rehabilitation purposes, along with copies of any such exhibits not previously produced;

(d) a list of any portions of depositions to be read on that trial day, other than for impeachment or rehabilitation purposes; and

(e) a complete videotape copy of all video deposition excerpts which the party intends to play on that trial day, other than for impeachment or rehabilitation purposes, in exactly the form and sequence in which the excerpts are to be played.

**Commentary**

*Suggested in MCL § 22.23 at 134.*

### 611.3 Redaction of Trial Exhibits

Trial exhibits may be redacted to eliminate irrelevant matter.

**Commentary**

*Suggested in MCL 22.32 at 137.*
611.4 Marking of Designated Portions of Exhibits or Transcripts

(a) **Flagging of specific pages.** Any party may mark, with colored tape flags, particular pages of an exhibit, deposition transcript, or (where permitted by the Court) daily-copy trial transcript that is to be offered into evidence. Each party shall use a different color of tape flag. Tape flags may include handwritten numbers corresponding to specific special verdicts or jury interrogatories; if so authorized by the Court, such numbers may be added by counsel just prior to the jury’s deliberation (counsel should work together in doing so to avoid questions whether one party’s tape flags were intentionally or accidentally removed by another party).

(b) **Highlighting.** Any party may mark, with a colored highlighter, specific portions of an exhibit, deposition transcript, or (where permitted by the Court) daily-copy trial transcript that is to be offered into evidence. The color scheme for such highlighting shall be the same as for colored tape flags under subparagraph (a).

**Commentary**


611.5 Excerpt Exhibits

In lieu of, or in addition to, introducing one or more entire documents or transcripts into evidence, a party may introduce one or more exhibits containing textual or graphic excerpts from the document(s) or transcript(s) in question for more convenient examination by the jury.

(a) The parties are encouraged to agree on joint excerpt exhibits concerning particular issues to be considered by the jury.

(b) Any document excerpted in an excerpt exhibit must (i) have been produced to other parties during discovery, or (ii) be produced in conjunction with a pre-trial exchange of exhibits, or (iii) itself be admitted into evidence, or (iv) otherwise have been made available in advance to other parties.

(c) Each excerpt exhibit shall include, in addition to the excerpt(s) in question, only the following information:

(1) a non-argumentative title that identifies the party introducing the excerpt
exhibit, and optionally, a cross-reference to a particular general verdict, special verdict, or jury interrogatory (the number thereof may be left blank and, with the approval of the Court, may be filled in by counsel after the introduction of the excerpt exhibit into evidence). EXAMPLE: "ABC Corp.'s Excerpts from Documents and Testimony Relating to Infringement – Special Verdict No. 2";

(2) for each excerpt, a citation, preferably in small but readable print, to (i) the exhibit number or production number (and page, if applicable) of the document in question, or (ii) the name of the deponent and the page- and line numbers of the deposition transcript(s) in question; and

(3) optionally, one or more non-argumentative headings and subheadings to help the jury put the excerpts in context.

**Commentary**

The excerpt-exhibit technique of this Section is adapted from (evidence) Rule 1006, which permits introduction into evidence of summaries of voluminous writings, recordings, or photographs which cannot be conveniently examined. This Section is not based on Rule 1006, however, but on the Court's general power to manage the presentation of evidence under Rule 611(a). See, e.g., United States v. Scales, 594 F.2d 558 (6th Cir. 1979) (affirming conviction; district court's admission into evidence of charts summarizing trial testimony, prepared by prosecution, was not improper); cf. United States v. Baker, 10 F.3d 1374, 1410-13 (9th Cir. 1993) (affirming conviction; prosecution's presentation of wrap-up witness who summarized key points of prior testimony was a valid exercise and did not unduly prejudice the defense). See also MICHAEL H. GRAHAM, FEDERAL PRACTICE AND PROCEDURE § 7031 (1997).

Subparagraph (c)(3) requires that the title, headings, and subheadings be non-argumentative. This requirement should help avoid the criticism expressed by the Fifth Circuit in United States v. Crockett, 49 F.3d 1357 (5th Cir. 1995). In that case the court affirmed the appellant's conviction, despite the fact that the prosecutor had used overhead transparencies in closing argument that
Included some argumentative words and phrases. The appellate court ruled that the argumentative phrases did not constitute improper closing argument and therefore did not require reversal. It warned, however, that trial judges should be cautious about allowing written summaries of evidence to be used as a pedagogical device.

611.6 Written Narrative Testimony in Non-Jury Trials

If this action is tried to the Court, and in any non-jury evidentiary hearing, each party shall file, not less than seven (7) days before the date set for commencement of the trial, the direct testimony of all witnesses reasonably available to the party, in declaration or narrative form. Each witness shall adopt his or her written testimony orally in open court and shall be subject to cross-examination by each opposing party, otherwise his or her narrative testimony will not be considered unless adoption and cross-examination are waived.

Commentary

Adapted from Local Rules 9.11.2 and 13.5 of the Central District of California.

611.7 Use of Video Depositions at Trial

(a) A party desiring to offer a videotape deposition at trial shall be responsible for having available appropriate playback equipment and a trained operator.

(b) If a party designates portions of a video deposition to be played at trial (the "designating party"), and another party makes counter-designations of other portions of the same video deposition (the "counter-designating party"), the counter-designating party may elect to have its counter-designated portions played for the jury (1) in sequence with the portions of the designating party, or (2) as cross-examination, i.e., subsequent to the portions of the designating party.

(c) Upon request by any party, any portion of a video deposition played at trial shall include a continuously-displayed subtitle or similar on-screen legend indicating which party designated or cross-designated the portion to be played (e.g., "Designated by XYZ Corp." or
"Cross-designated by ABC Corp.").

(d) Overruled objections and attorney colloquy may be edited out of a video deposition prior to introduction of portions of the video deposition at trial only by order of the Court or agreement of the parties.

(e) No notice is required to use a video deposition or a part thereof at trial for purposes of cross-examination.

611.8 Juror Notebooks and Note-Taking

The parties shall jointly prepare, and counsel for plaintiff shall submit to the Court prior to jury selection, three-ring binder notebooks for each juror. Each juror notebook shall initially contain, separated by appropriate tabs: (i) a copy of each patent in suit; (ii) a copy of the Court's preliminary jury instructions, if any; (iii) a list of exhibits included in the notebook as agreed by the parties or as ordered by the Court from time to time, the list to be updated daily; (iv) copies of the included exhibits; and (v) blank paper which may be used by jurors to take notes during the trial. Jurors will not be permitted to remove their notebooks from the courtroom without leave of the Court.

611.9 Transition Statements

The Court encourages counsel to make brief statements to the jury during the trial. The statements should be in the nature of an opening statement.

Commentary

Adapted essentially verbatim from paragraph 2(1) of Judge McKelvie's Trial Management Order. See also MCL § 22.34 at 143 (discussing interim statements and arguments).

611.10 Filled-Out Example of Special Verdict Form During Closing Argument

During closing argument, counsel may prepare and submit to the jury examples of how the verdict form should be filled out.
Commentary
Adapted verbatim from paragraph 2(q) of Judge McKelvie's Trial Management Order.

611.11 Consideration of Other Trial-Management Possibilities

In connection with preparation of the final pretrial order, counsel shall confer about each of the following practices and discuss which if any might be appropriate for a more effective trial in this action. Either or both parties may propose the use of any such practice to the Court, but the Court expresses no view here as to whether any such proposal would be approved. As used below, "JTI" refers to NAT'L CENTER FOR STATE COURTS, JURY TRIAL INNOVATIONS (G. Thomas Munsterman, Paula L. Hannaford & G. Marc Whitehead, eds. 1997), and "MCL" refers to FEDERAL JUDICIAL CENTER, MANUAL FOR COMPLEX LITIGATION 3d (1995).

(a) Special Master; Court-Appointed Expert; Etc.

(1) Referral of selected issues to a special master in accordance with Rule 53 - see MCL § 21.52 at 111 (1995).

(2) Use of a court-appointed expert in accordance with Rule 706 - see MCL § 21.51 at 109; id. § 33.653 at 365.

(3) Trial of selected issues (e.g., purely equitable issues) to the district judge or a magistrate judge instead of to the jury - see MCL § 21.62 at 118.

(b) Jury Aids. Joint preparation of the following documents for possible use as exhibits and inclusion in the jurors' notebooks (including, as to disputed points, brief summaries of the parties' respective positions) - see MCL § 22.31 at 136:

(1) A glossary of technological terms.

(2) A time line of relevant events.

(3) A narrative of relevant events.

(4) A logically organized summary of facts, both stipulated and disputed, with summaries of the parties' respective contentions as to disputed facts and with appropriate cross-references to exhibits and deposition testimony.

(5) Photographs of witnesses - see MCL § 22.42 at 149; JTI § IV-7 at 110.

(c) Limitations on Evidence
(1) Limits on the number of witnesses or exhibits to be offered on a particular issue or in the aggregate - see MCL § 21.643 at 124.

(2) Limits on the length of examination and cross-examination of particular witnesses - see MCL § 21.643 at 124.

(3) Limits on the total time to be allowed each side for all direct and cross-examination - see MCL § 21.643 at 124.

(4) Narrowing the issues by order or stipulation - see MCL § 21.643 at 124.

(d) Presentation of Evidence

(1) Jury tutorials at the beginning of the trial about technological issues, by the parties' experts and/or by a court-appointed expert, possibly in an informal lecture format with questions by jurors - see JTI § IV-5 at 105.

(2) Presentation of evidence by issues, with all evidence relating to one issue being presented by both parties, then all evidence relating to another issue, etc. - see MCL § 22.34 at 143.

(3) "Dueling experts," where one party's expert testimony on an issue is followed immediately by another party's expert testimony on the same issue - see JTI § IV-3 at 98.

(4) "Videotape trial," where the testimony of selected witnesses is videotaped outside the jury's presence and played to the jury after objections are decided - see JTI § V-2 at 129.

(5) Remote testimony of selected witnesses by telephone or by video hookup - see MCL § 22.334 at 142.

(6) Juror questions for witnesses - see MCL § 22.42 at 150; JTI § V-7 at 144.

(7) Juror discussion of evidence during the trial - see JTI § V-5 at 138.

(8) Interim statements and arguments by counsel - see MCL § 22.34 at 143; JTI § V-10 at 154.

(9) Arguments presented by issues - see MCL § 22.34 at 143.

(10) Sequential verdicts on particular issues - see MCL § 22.34 at 143.
Commentary

Section 611.11 is intended only as a helpful reminder of some possible trial-management practices that could be adopted. In any given case, some or all of these practices might be appropriate, or they might be clearly inappropriate. See also Section 16.3 (similar list of pre-trial management practices).

702.1 Use of Patent Law Experts

(a) Permissible testimony. Any party may call a suitably qualified expert in patent law ("patent expert") to testify about some or all of the following topics, as well as any other topic appropriate under Fed. R. Evid. 702:

(1) the general manner in which the U.S. Patent and Trademark Office conducts proceedings such as patent application examinations, patent reexaminations, patent reissue proceedings, interference proceedings, and the like;

(2) the meaning and factual significance of particular papers, or the absence thereof, in the prosecution history of a specific patent; and

(3) the meaning and factual significance of any opinion of counsel offered into evidence by an accused infringer in connection with an allegation of willful infringement.

(b) Prohibited testimony. It is the province of the Court to instruct the jury about (1) the principles of patent law that the jury should follow and (2) the proper construction of particular claims in a patent. Therefore, no patent expert may testify before the jury about either subject without leave of the Court, except incidentally in connection with testimony permissible under subparagraph (a).

Commentary

Section 702.1 is intended as a safe-harbor provision to establish that so-called patent experts will be permitted to testify about specific subjects, and will not be permitted to testify to the jury about other subjects. See Markman, 116 S. Ct. at 1395-96 (construction of patent claims is an issue for the court, not the jury).
702.2 No Characterization of Expert as “Qualified” by the Court

Counsel shall not ask the Court in the presence of the jury to find a witness qualified to offer an opinion.

Commentary

Adapted essentially verbatim from paragraph 2(k) of Judge McKelvie’s Trial Management Order.

SO ORDERED:

Date ____________________________

United States District Judge

AGREED:

[ Counsel name, address, etc. ]

[ Counsel name, address, etc. ]
IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF XXX

ABC, INC.,

Plaintiff,

v.

XYZ, INC.,

Defendant

AGREED CONFIDENTIALITY / PROTECTIVE ORDER

The parties have requested entry of an order under Rule 26 of the Federal Rules of Civil Procedure (Federal Rules) to protect confidential information during discovery and trial. The Court has determined that it is appropriate to enter such an order for that purpose. It is therefore ORDERED as follows:

Introduction

1. Applicability. The confidentiality provisions of this order shall apply to all depositions, productions of documents, answers to interrogatories, responses to requests for admissions, and all other discovery taken pursuant to the Federal Rules of Civil Procedure, as well as testimony adduced at trial, matters in evidence and any other information which a disclosing party may designate as Protected in connection with this action.

2. Third parties. The terms “disclosing party” and “producing party” encompass not only

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1 This order is a working draft produced as part of a project-in-progress by the ABA Section of Intellectual Property Law, Committee 956, Special Committee on IP Litigation Forms. It has been approved by the committee but has not been approved or endorsed by any other component of the ABA. Electronic copies can be downloaded from the World Wide Web at http://www.lawnotes.com. Please direct comments to the committee chair, D. C. Toedt III, at Arnold, White & Durkee, FAX 713-787-1440, email dctoedt@arnoldwhite.com.

This draft does not purport to address all possible issues that might need to be addressed in an actual order of this kind. It is intended strictly as a reasonable starting point for discussions between counsel. See the notes at the end of this document for additional commentary.
the parties to this action but third parties who may disclose or produce information, e.g., in response to a subpoena.

Definitions

3. "Confidential" information means information in written, oral, electronic, graphic/pictorial, audiovisual, or other form, whether it be a document, information contained in a document, information revealed during a deposition, information revealed in an interrogatory answer, or otherwise:

   (a) which is designated as such by the producing party, and

   (b) which constitutes or contains a trade secret or other confidential research, development, or commercial information,

   (c) the disclosure of which information (i) is likely to have the effect of harming the competitive position of the producing party or (ii) would violate an obligation of confidentiality to a third person, including a court.

4. Examples of Confidential information. In appropriate circumstances, Confidential information might include, by way of example but not of limitation, trade secrets, processes, operations, research, technical or developmental information, know-how or apparatus, or to the production, marketing, sales, shipments, purchases, transfers, identification of customers, inventories, or amount or source of any income, profits, losses, or expenditures of the producing party.

5. "Restricted Confidential" information means information which is designated as such by the producing party and which constitutes or contains Confidential information relating to any of the following: proprietary technical data regarding current or future commercial products that
has been maintained by the disclosing party as protected trade secret information; present or future marketing plans; product profit data and projections; financial data of the parties; and technical and/or pricing information relating to new concepts or products or improved products currently in design.

6. "Confidential-Outside Counsel's Eyes Only" information means information which is designated as such by counsel for the producing party for the purpose of negotiating limited access to particularly sensitive information.

7. "Protected" information encompasses Confidential, Restricted Confidential, and Confidential-Outside Counsel's Eyes Only information.

8. "Financial" or "Technical" information means information optionally categorized as such in addition to being designated as Confidential or Restricted Confidential (for example, "Confidential-Financial"). In negotiating whether specific persons are to be given access to specific information to which they would not be otherwise entitled under this order, the parties are encouraged to specify that particular persons may see (by way of example) only such information as has been specifically categorized as, e.g., Restricted Confidential/Financial information but not any other Restricted Confidential information.

9. Exceptions to confidentiality status. Information will not be deemed Protected, and the parties shall use reasonable efforts to ensure that information is not designated as such, if the content or substance thereof:

(a) is at the time of production or disclosure, or subsequently becomes, through no wrongful act or failure to act on the part of the receiving party, generally available to the relevant public through publication or otherwise; or

(b) is already in the possession of the receiving party at the time of production; or
(c) is disclosed to the receiving party by a third party without breach of an obligation of confidence to the producing party.

10. "Other Law-Firm Attorneys" means attorneys (i.e., members in good standing of the bar of the highest court of any state or of any federal district court) who are members or employees of the law firms of the outside attorneys of record for any party but who are not themselves of record.

11. "Law-Firm Personnel" means (i) regular full- or part-time employees of the law firms of the outside attorneys of record for any party; and (ii) non-employee clerical personnel engaged by such law firms on a contract basis (e.g., data entry clerks) who have signed a document in substantially the form of Exhibit A attached hereto; to whom it is necessary that the Protected information in question be disclosed for purposes of any dispute between parties to this lawsuit.

12. "In-House Counsel" means attorneys (i.e., members in good standing of the bar of the highest court of any state or of any federal district court) who are regular full- or part-time employees of the receiving party and who are working directly on this litigation.

13. "In-House Clerical Staff" means regular clerical employees (e.g., legal assistants, secretaries, file clerks, but excluding personnel performing technology-related duties) of the receiving party who are working directly on this litigation under the direct supervision of either inside or outside counsel and to whom it is necessary that the Protected information in question be disclosed for purposes of this litigation.

14. "Outside Consultants/Experts" means persons who are not employed by the receiving party and are retained by a party or its attorneys of record in this litigation, for the purposes of assisting in preparation of this litigation for trial, such as accountants, statisticians, economists, technical consultants or other technical experts, who have signed a document in substantially the
form of Exhibit A attached hereto.

15. "Service Bureau" means a company that

(a) is independent of the parties, but a company will not be deemed non-independent solely because it does business, regularly or irregularly, with a party;

(b) is engaged by counsel of record to perform clerical-type services in connection with this litigation e.g., photocopying, imaging, computer data entry, and the like, and

(c) has executed an undertaking to be bound by the provisions of this order in substantially the form of Exhibit A attached hereto, including the specific undertaking to instruct its employees who have access to Protected information about their duty not to use or disclose such information.

16. "Other Qualified Person" means any other person (a) who is so designated (i) by order of the Court after notice and an opportunity to be heard to all affected parties, or (ii) by agreement of the producing party, and (b) who has signed a document in substantially the form of Exhibit A attached hereto.

17. Qualified Persons, as to Protected information, means the following:
Designation and Identification of Information

18. **Labeling of documents.** Information being designated as Protected that is in documentary or other tangible form shall be labeled by the producing party, prior to its production, to reflect its designation. The labeling may additionally categorize the information as Financial or Technical (e.g., Confidential-Financial or Restricted Confidential-Technical).

19. **Designation of other disclosures.** Information being designated as Protected that is not in documentary or other tangible form, or that cannot conveniently be labeled, shall be designated and/or categorized by the disclosing party in a writing provided to the receiving party at the time of production.

20. **Preliminary designation of documents being inspected.** If a producing party elects to produce documents and things for inspection, it need not label the documents and things in advance of the initial inspection. For purposes of the initial inspection, all documents within the...
produced files will be considered as having been marked "Confidential-Outside Counsel's Eyes Only." Thereafter, upon selection of specified documents for copying by the inspecting party, the producing party shall mark either the original documents or the copies or such documents as may contain protected subject matter with the appropriate confidentiality marking at the time the copies are produced to the inspecting party.

21. Designation not determinative. Designation of documents or other specified information as Protected by counsel, or receipt of documents or information so designated, shall not be considered as determinative of whether the contents of the documents or the information specified are entitled to be deemed as such.

22. Challenges to confidentiality designations. A party shall not be obligated to challenge the propriety of a designation of information as Protected at the time made, and failure to do so shall not preclude a subsequent challenge thereto. If any party to the action disagrees at any stage of the proceedings with such a designation, that party shall provide to the producing party written notice of its disagreement. The parties shall first try to dispose of such dispute in good faith on an informal basis. (The parties are strongly encouraged to agree on, e.g., “declassification” or “downgrading” of redacted copies of particular documents or to agree that certain specified persons may be given access to particular Protected information.) If the dispute cannot be resolved, the party challenging the designation may request appropriate relief from the Court. The burden of proving that the information has been properly designated as Protected is on the party making such designation.

23. Designation of deposition testimony. The following procedures shall be followed if Protected information of a producing party is discussed or disclosed in a deposition:

(a) The producing party shall have the right to exclude from attendance at the dep-
osition, during such time as the Protected information is to be discussed or disclosed, any person other than the deponent, the court reporter, and Qualified Persons.

(b) The Protected information shall be designated as Confidential, Restricted Confidential, or Confidential-Outside Counsel's Eyes Only at the request of counsel for the producing party (or, if the producing party is not a party to the action and is not represented at the deposition, at the request of counsel for the party disclosing the information or questioning the witness about it).

(c) If a request under subparagraph (b) is made on the record during the deposition, the reporter shall indicate on the cover page of the transcript that the transcript contains Confidential, Restricted Confidential, or Confidential-Outside Counsel's Eyes Only information and additionally shall list the pages and line numbers of the transcript on which the information in question is contained.

(d) Alternatively, a request under subparagraph (b) may be made in writing within ten (10) days after the requesting counsel receives a copy of the transcript of the deposition. The request shall contain a list of the numbers of the pages and lines of the transcript that are to be designated as containing Confidential, Restricted Confidential, or Confidential-Outside Counsel's Eyes Only information, and specific designations for each item or group of items on the list. The list shall be set forth on one or more separate pieces of paper, the first one of which shall bear the caption of the action and identifying information about the deposition. The requesting counsel shall insert the list before the cover page of the transcript and shall mail or FAX copies of the list to counsel for all parties so that it may be affixed to the face of the transcript and each copy thereof.

2 Note that under Fed. R. Civ. P. 6(a), time periods of less than 11 days are business days.
Access to Information

24. Access to Protected information disclosed to a receiving party shall be limited to Qualified Persons except with the prior written agreement of the producing party.

25. The following procedure shall be followed for any disclosure of information as to which prior notice to the producing party is required under paragraph 17:

(a) Counsel for the receiving party shall (i) notify counsel to the producing party in writing of its intention to make such disclosure ten (10) days before the intended disclosure; (ii) specify the identity and the current employment of the individual(s) to whom the proposed disclosure will be made, including a curriculum vitae of such person; (iii) identify the particular information proposed to be disclosed; and (iv) specify the reasons why the proposed disclosure is believed to be necessary.

(b) If the producing party makes a written objection within the ten-day period and the objection is not resolved between counsel within five (5) days thereafter, the party seeking disclosure shall not disclose the information but shall have the right to bring the dispute before the Court for its resolution.

(c) If the dispute over the proposed disclosure is submitted to the Court by motion, the party seeking disclosure of the information shall have the burden of persuasion.

26. Disclosure in certain circumstances. Nothing in this Order shall preclude any party to the lawsuit or their attorneys from:

(a) showing a document designated as Protected to an individual who either prepared or reviewed the document prior to the filing of this action, or is shown by the document to have received the document, or

(b) disclosing or using, in any manner or for any purpose, any information or docu-
uments from the party's own files which the party itself has designated as Protected.

27. Restrictions on use. Disclosure of information designated as Protected shall be solely for the purposes of resolving disputes between the parties; information so disclosed shall not be used for any other purpose. The persons receiving the information in question are ENJOINED from disclosing it to any other person except in conformance with this order.

28. 18a. Future representation by counsel. It is not the intent of the parties, nor of the Court, that an attorney or law firm that acquires knowledge of (or is given access to) Protected information pursuant to this order should thereby be disqualified from other representations adverse to the producing party solely because of such knowledge (or access).

Other Provisions

29. Filing under seal. No document containing Protected information shall be filed with this Court unless it is in a sealed, opaque container or envelope including on the outside thereof the case heading of this litigation and a notification that the contents are subject to a protective order and the container is not to be opened except upon further order of this Court or by stipulation of counsel for all parties. The Clerk of this Court is directed to maintain under seal all documents and transcripts of deposition testimony designated as Protected that is so filed in this litigation.

30. Use of information in court proceedings. Any receiving party that knows that it intends to present Protected information of another party in oral form at trial, or during any pre- or post-trial hearing, shall first notify the Court and the producing party a reasonable amount of time in advance. Because of the policy favoring public attendance at judicial proceedings, the parties are strongly encouraged to agree on procedures that will minimize the presentation of
Protected information in open court. In appropriate circumstances such procedures might include, e.g., submission of written testimony under seal, presentation of "declassified" summaries of Protected information, and the like. The Court does not here determine which if any such procedures might be suitable in particular situations. Absent a stipulation of all parties, the fact that information has been designated as Protected shall not be admissible during the trial of this action, nor shall the jury be advised of such designation.

31. Disposition of documents, etc., after final termination.

(a) Except as set forth below, within 60 days of final termination of this action, the attorneys of record for each receiving party shall return to each producing party or its attorneys of record, at the expense of the producing party, all documents (and copies thereof) and all materials (and any copies thereof) which have been furnished to it by the producing party and which have been identified as Protected information pursuant to this order. At the option of the producing party, such documents received by the receiving party may be destroyed in lieu of being returned to the producing party.

(b) Notwithstanding subparagraph (a), the attorneys of record for a party may retain indefinitely, in "secure storage" (defined below), a reasonable number of archival copies of Protected information. Such Protected information may not be used or disclosed except (i) as permitted by this order, (ii) by agreement of the producing party in question, or (iii) by further order of this Court. The archival copies may be in hard-copy, electronic, magnetic, optical-disk, or other form, or any combination thereof. By way of example and not of limitation, outside counsel may maintain, e.g., a set of production documents; a set of pleadings, briefs, and similar court papers; a set of trial exhibits; a copy of the record on appeal; a reasonable number of backup tapes containing Protected information in electronic form that had been maintained on
law firm computer networks (i.e., counsel need not specifically purge their firms' routine backup
tapes of Protected information as long as the backup tapes are kept in secure storage); and the
like.

(c) For purposes of subparagraph (b), "secure storage" for archival copies of Protected information does not include storage that is routinely physically accessible from a local-area network, wide-area network, or the Internet.

32. No waiver of right or obligation to object to production. Nothing contained in this order shall be construed as a waiver by any party of its right to object to the subject matter of any request for production of documents in this action, nor as a waiver by any other party of the first party's obligation to make proper response to discovery requests. The entry of this order shall not be construed as an agreement by any party to produce any documents or to supply any information and shall not constitute an admission that any such documents which may exist are relevant or material in any way to the issues raised in the pending action or admissible in such action, nor as a waiver of any privilege with respect thereto.

33. Third parties. In the event that a party seeks discovery from a non-party to this action, the non-party may invoke the terms of this order in writing to all parties to the action with respect to any Protected information to be provided to the requesting party by the non-party.

34. Continuing jurisdiction. This order shall survive the final conclusion of the action, and this Court retains jurisdiction of the parties hereto, and of any person who executes a copy of Exhibit A, indefinitely as to any dispute between any of them regarding improper use of information disclosed pursuant to this order.

35. Requests for additional protection. This order shall be without prejudice to the right of the parties to request additional protection under Rule 26(c), Fed.R.Civ.P., for discovery
requests made hereafter by any party.

Date__________________________

United States District Judge

[Include signature blocks for counsel here]
NOTES

Note 1: In-house counsel access. The extent to which in-house counsel should be permitted to have access to confidential information is sometimes a sensitive issue. See, e.g., Brown Bag Software v. Symatec Corp., 960 F.2d 1465 (9th Cir. 1992) (holding that the proper review of protective orders barring in-house counsel's access to confidential information requires the court to examine factually all of the risks and safeguards surrounding inadvertent disclosure); U.S. Steel Corp. v. United States, 730 F.2d 1465 (Fed. Cir. 1984) (finding that in-house counsel should be denied access to confidential information in certain circumstances); A. Hirsh, Inc. v. United States, 657 F. Supp. 1297 (Ct. Int'l Trade 1987) (in-house attorney denied access to confidential information, viz. non-public portion of administrative record submitted to or produced by International Trade Administration and International Trade Commission, where attorney was an officer of a small family business).

Some courts have said that in evaluating whether in-house counsel should have access, a court should balance the risk of inadvertent disclosure of trade secrets to competitors against the risk of impairing the process of litigation by denying access. Brown Bag, 960 F.2d at 1470. One factor in determining the risk of inadvertent disclosure of trade secrets is whether in-house counsel is involved in "competitive decision-making" that is, "advising on decisions about pricing or design made in light of similar or corresponding information about a competitor." Id.

A party's concern about permitting its opponent's in-house counsel to access its confidential information would be heightened where the in-house counsel was also a family member of certain corporate officers. [The foregoing discussion was adapted,
largely verbatim, from *Thomas & Betts Corp. v. Panduit Corp.*, 1997 WL 603880 at *12 (N.D. Ill. 1997).] See also, e.g., *Compaq Computer Corp. v. Packard Bell Electronics, Inc.*, 163 F.R.D. 329, 340 (N.D. Cal. 1995) (ordering that subpoenaed third-party information was not to be disclosed to receiving party's outside counsel); *In re Independent Service Organizations Antitrust Litigation*, 162 F.R.D. 355, 356 (D. Kan. 1995) (granting supplemental protective order to preclude Xerox in-house counsel from access to information in question); *Bayer AG and Miles, Inc. v. Barr Laboratories, Inc.*, 162 F.R.D. 456 (S.D.N.Y. 1995) (holding that party had not shown "good cause" for modifying stipulated protective order to permit in-house counsel to attend expert depositions, but declining to suggest what the result would be if the parties had not stipulated to the protective order); *In re Independent Service Organizations Antitrust Litigation*, 1995 WL 151739 at *2 (D. Kan. 1995) (granting motion to modify protective order to allow Xerox in-house counsel to have access to highly-confidential information; cautioning in-house counsel to comply strictly with the terms of the protective order and ethical obligations).

Note 2: *Inadvertent production.* Counsel should consider what the effect will be if a party inadvertently produces a document containing Protected information without marking or labeling it as such. *Some possible ways of handling such a situation:*

- The information may be freely disclosed and used by the receiving party; or
- The information may be freely disclosed and used until the receiving party
  
  [becomes aware of the error] [is notified of the error by the producing party]
  
  [forms a reasonable belief that the information was disclosed in error], after
which it shall be treated as if it had been timely designated.
IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF XXX

ABC, INC.,

Plaintiff,

v.

XYZ, INC.,

Defendant

UNDEARTAKING PURSUANT TO

AGREED CONFIDENTIALITY / PROTECTIVE ORDER

1. I, the person named below, declare that the following information is true:

   a. Name:

   b. Address:

   c. Employer name and address:

   d. Title:

   e. Occupation / job description:

   f. Other work, if any (e.g., consulting):

   g. Past or present relationship to plaintiff(s) or defendant(s), if any:
h. I am executing this Undertaking on behalf of (check all that are applicable):

   ___ my self    ___ my employer

i. Is employer is a Service Bureau (see paragraph 15 of the Protective Order)?

   ___ Yes    ___ No

2. I have received a copy of the Agreed Confidentiality / Protective Order (the "Protective Order") in this action.

3. I have carefully read and understand the provisions of the Protective Order. I agree to be bound by it, and specifically agree I will not use or disclose to anyone any of the contents of any Protected information received under the protection of the Protective Order in violation thereof.

4. I understand that I am to retain all copies of any of the materials that I receive which have been designated as Confidential, Restricted Confidential, or Confidential-Outside Counsel Only confidential information in a container, cabinet, drawer, room or other safe place in a matter consistent with the Protective Order and that all copies are to remain in my custody until I have completed my assigned or legal duties. I will return all confidential documents and things which come into my possession, or which I have prepared relating to such documents and things, to counsel for the party by whom I am retained. I acknowledge that such return or the subsequent destruction of such materials shall not relieve me from any of the continuing obligations imposed upon me by the Protective Order.

5. If I am executing this Undertaking on behalf of my employer as indicated above, I agree on its behalf that it too will be bound by the provisions of the Protective Order and that it too will abide by the requirements set out in paragraphs 3 and 4 of this Undertaking.

6. If my employer is a Service Bureau as indicated above, I further agree on its behalf that it will instruct all its employees who have access to Protected information under the Protective Order about their duty to comply with the requirements set out in
paragraphs 3 and 4 of this Undertaking.

EXECUTED UNDER PENALTY OF PERJURY on __________, 19___, at

_____________________, in the State of __________.

_____________________

(SIGNATURE)