

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION**

PARTY 123,

Plaintiff,

vs.

PARTY XYZ,

Defendant.

Case No.: _____

Honorable Victoria A. Roberts

Magistrate Judge _____

Attorney
FIRM
ADDRESS
ADDRESS
TELEPHONE NUMBER
Attorneys for Plaintiff

Attorney
FIRM
ADDRESS
ADDRESS
TELEPHONE NUMBER
Attorneys for Defendant

**MODEL RULE 26(f) REPORT AND PROPOSED SCHEDULING ORDER FOR
PATENT INFRINGEMENT**

Pursuant to Rule 26(f) of the Federal Rules of Civil Procedure, the parties, through counsel, jointly submit this Rule 26(f) Report and Proposed Scheduling Order:

I. RULE 26(f) CONFERENCE

The parties held a meeting on _____. The following attorneys attended:

Attorney
FIRM
ADDRESS
ADDRESS
TELEPHONE NUMBER
Attorney for Plaintiff

Attorney
FIRM
ADDRESS
ADDRESS
TELEPHONE NUMBER
Attorney for Defendant

II. SUBJECTS AND NATURE OF DISCOVERY

A. DISCOVERY BY PLAINTIFF

[Plaintiff must list topics on which it wants discovery: For example, “Plaintiff will need to conduct discovery on the issues of claim construction, patent infringement, damages, and all defenses raised by Defendant.”]

B. DISCOVERY BY DEFENDANT

[Defendant must list topics on which it wants discovery: For example, “Defendant will need to conduct discovery on infringement, validity, damages, and other defenses.”]

C. ELECTRONICALLY STORED INFORMATION (“ESI”)

[Parties must specify the scope and limits of ESI discovery, the format for production of ESI, and actions to be taken to preserve ESI, etc. *See* Fed. R. Civ. P. 26(f)(3) and 26(b)(2)(B). For example, the parties may agree to use the U.S. District Court for the Eastern District of Michigan’s Model Order Relating to the Discovery of Electronically Stored Information.

III. DISCOVERY SCHEDULE

A. FACT DISCOVERY

Fact discovery will begin on _____ and be served no later than [Typically 8-10 Months for Fact Discovery]. Discovery will be on all discoverable issues and will not be limited to claim interpretation. Discovery must include relevant opinions of counsel if Defendant intends to rely upon an opinion of counsel as a defense to a claim of willful infringement.

B. RULE 26(a)(1) INITIAL DISCLOSURES

The parties will exchange initial discovery disclosures as required by Rule 26(a)(1) by [w/in 14 days of Rule 26(f) Conference].

C. DEADLINE TO ADD PARTIES AND TO AMEND

The deadline to add parties is _____. The deadline to amend pleadings is _____.

D. DISCLOSURE OF INFRINGEMENT CONTENTIONS

The patentee must file and serve disclosures of the following information by [w/in 1 month from date of scheduling order]_____:

1. Each patent claim that is allegedly infringed by each opposing party;
2. For each asserted claim, the accused product of each opposing party of which the patentee is aware. This identification must be as specific as possible. Plaintiff must identify each accused product by name or model number, if known.
3. A chart specifically identifying where each limitation of each asserted patent claim is found within each accused product. For each limitation that is governed by 35 U.S.C. § 112 ¶ 6, the chart must include the identity of the structure(s), act(s), or material(s) in the accused product that performs the claimed function.
4. Whether each claim limitation of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the accused product.

E. DISCLOSURE OF INVALIDITY CONTENTIONS

Any party asserting invalidity or unenforceability claims/defenses must file and serve disclosures containing the following by [w/in 1 month of infringement contentions]:

- 1.** Each item of prior art that forms the basis for any allegation of invalidity by reason of anticipation under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103. For prior art that is a document, a copy of the document must be provided to the patentee's counsel or be identified by Bates Number if it was previously produced. If the prior art is not documentary in nature, it must be identified with particularity ("who, what, when, where," etc.) concerning publication date, sale date, use date, source, ownership, inventorship, conception and any other pertinent information.
- 2.** Whether each item of prior art anticipates each asserted claim or renders it obvious. If a combination of items or prior art makes a claim obvious, each such combination, and the reason why a person of ordinary skill in the art would combine such items must be identified.
- 3.** A chart identifying where specifically in each alleged item of prior art each limitation of each asserted claim is found. For each claim limitation that such party contends is governed by 35 U.S.C. § 112 ¶ 6, the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and
- 4.** For any grounds of invalidity based on 35 U.S.C. § 112 or other defenses, the party asserting the claim or defense must provide its reasons

and evidence to support claims of invalidity or unenforceability, and make specific reference to relevant portions of the patent specification and/or claims. These positions must be taken in good faith and not simply advanced as *pro forma* arguments.

F. NON-INFRINGEMENT CONTENTIONS

On or before ___[w/in 1 month of plaintiff's infringement contentions]___, a party asserting non-infringement as a defense must file and serve non-infringement contentions, which must explain the factual basis for any allegation that it does not infringe the patent-in-suit either literally or under the doctrine of equivalents, including identifying what claim limitations that it believes are not present in the accused products and why an equivalent is not present.

G. DEADLINE FOR AMENDING INFRINGEMENT, NON-INFRINGEMENT, AND INVALIDITY CONTENTIONS

Each party must amend any infringement, invalidity, or non-infringement contention in accordance with Rule 26(e) of the Federal Rules of Civil Procedure upon learning that the contention is incomplete or incorrect. The parties should timely conduct discovery so that these contentions can be updated as soon as possible. Any amendment to a party's infringement, invalidity, or non-infringement contentions, or other pleading, that is necessary due to the Court's claim interpretation ruling, must be timely made but in no event later than one month after the Court's claim construction ruling.

H. CLAIM CONSTRUCTION PROCEEDINGS

In accordance with *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384 (1996), the following procedures will be followed for resolution of claim construction issues.

1. INITIAL IDENTIFICATION OF DISPUTED CLAIM TERMS –

The parties will confer to determine what claim terms may need to be interpreted by the Court by [w/in 2 months of INVALIDITY AND NON-INFRINGEMENT CONTENTIONS].

2. PROPOSED INTERPRETATIONS – On or before [w/in 1 month of INITIAL IDENTIFICATION OF DISPUTED CLAIM TERMS], the

parties must exchange, but not file, a chart or table that lists for each disputed claim term, the party's proposed interpretation of the disputed claim term along with citations to the intrinsic and extrinsic evidence (e.g., patent, prosecution history, dictionary definitions, etc.) that supports its interpretation, along with a summary of testimony that is expected to be offered to support that interpretation.

3. FINAL IDENTIFICATION OF DISPUTED CLAIM TERMS FOR SUBMISSION TO THE COURT –

Within one week after exchanging the claim chart above, the parties must confer again about the claim terms in dispute. At this meeting, the parties must attempt to narrow and finalize the claim terms that need to be interpreted by the Court. The parties shall not submit more than 10 terms for construction unless the Court has given written permission for the construction of more terms. If, at any time, the parties determine that a claim construction hearing is not necessary, they shall notify the Court in a timely matter. The parties must

set forth separately the construction of those claim terms on which the parties agree.

4. TECHNOLOGY TUTORIAL – The Court will hold an informal conference with the attorneys on [Parties to leave blank: Case Manager will schedule approximately 2 weeks from Final Identification of Disputed Claim Terms] at _____ a.m. / p.m. At the conference, the attorneys for each side will explain the technology at issue. The conference will not be recorded. Following this tutorial, the Court may further limit the number of terms that will be interpreted at an initial *Markman* hearing.

5. PLAINTIFF’S OPENING CLAIM CONSTRUCTION BRIEF – Plaintiff(s) must file its opening claim construction brief on or before [w/in 1 month from date of technology tutorial].

6. DEFENDANT’S RESPONSE BRIEF – Defendant(s) must file its responsive claim construction brief on or before [w/in 1 month from date of principal expert report].

7. DRAFT OF PLAINTIFF’S REPLY BRIEF – To the extent that Plaintiff intends to file a reply brief on claim construction issues, Plaintiff(s) must serve, but not file, a good-faith draft of its intended reply brief on opposing counsel [w/in 14 days of the Defendant’s response brief]. Within this time period, Plaintiff must also prepare and serve a draft four-column claim interpretation chart in the form of Exhibit A.

8. MEET AND CONFER – Within [two weeks] from service of the DRAFT OF PLAINTIFF’S REPLY BRIEF, or the time that service would have been due if Plaintiff does not file a reply brief, counsel for parties must meet to discuss the parties’ legal theories and proposed claim interpretations in an effort to narrow the disputes and arguments that the Court must resolve.

9. FILING OF FINAL VERSION OF REPLY BRIEF AND CLAIM CHART – Within [one week] of the MEET AND CONFER, Plaintiff must file and serve on opposing counsel, the final versions of its reply brief and the claim chart in the form of Exhibit A. Plaintiff must set forth in its reply brief any previous claim interpretation disputes that the parties resolved in the MEET AND CONFER. Plaintiff must also submit an editable copy of the final version of the claim chart to the Court via email as a proposed order through the Court’s electronic filing system.

10. CLAIM CONSTRUCTION HEARING – The Court will conduct a claim interpretation hearing on [Parties to leave blank: Case Manager will schedule approximately ~ 2 months from reply brief deadline].

I. EXPERT DISCOVERY

1. On issues where parties bears the burden of proof, they must serve expert reports as required by Rule 26(a)(2), by [w/in 1 month of *Markman* decision]; on issues where a party does not bear the burden of proof,

rebuttal expert reports are due by [w/in 1 month of principal expert reports].¹

2. All expert discovery must begin so that it is completed [w/in 1-2 months of the rebuttal expert reports].

J. MOTIONS

1. Dispositive motions must be filed on or before [1-2 months after the deadline for expert discovery].

2. Motions in limine must be filed on or before [Parties to leave blank: Case manager will enter Judge's normal preference].

K. WITNESS LISTS AND EXHIBITS

1. The parties must exchange preliminary witness lists on or before _____; final witness lists shall be exchanged on or before _____.

2. The parties must exchange preliminary exhibit lists on or before _____; final exhibit lists must be exchanged on or before _____.

L. PRETRIAL

1. The Parties must file proposed preliminary and final jury instructions on or before [Parties to leave blank: Case manager will enter Judge's normal preference, usually at least 3 weeks before the final pretrial conference].

¹ The parties may agree to delay expert reports on damages if a delay will not delay the trial date.

2. The parties must file a Joint Final Pretrial Order pursuant to Local Rule 16.2 on or before [Parties to leave blank: Case manager will enter Judge's normal preference].

3. A Final Pretrial Conference will be held pursuant to Local Rule 16.1 on [Parties to leave blank: Case manager will enter Judge's normal preference]. At the conference, the Court will discuss the number of claims that the Court will present to a jury.

M. TRIAL

Trial will begin on [To be set by Case Manager approximately 6 months after deadline for dispositive motions or 3 months after opinion resolving dispositive motions]. The trial of the liability portion of the case will normally be bifurcated from the damages portion. If the jury finds liability, the Court will resume the trial on damages before the same jury. The liability and damages portions of the trial will only be separated by a short period of time, likely around a week, depending on the availability of the jurors and the Court's schedule.

SO ORDERED

Dated: _____

The Honorable Victoria A. Roberts
United States District Court Judge

Attorney (Bar Number)
FIRM
ADDRESS
ADDRESS

Attorney (Bar Number)
FIRM
ADDRESS
ADDRESS

TELEPHONE NUMBER

Attorneys for Plaintiff

Date: _____

TELEPHONE NUMBER

Attorney for Defendant

Date: _____

EXHIBIT A

CLAIM INTERPRETATION CHART

| Disputed Claim Term | Plaintiff's Proposed Construction | Defendant's Proposed Construction | Court's Construction |
|---------------------|-----------------------------------|-----------------------------------|----------------------|
| 1. "Term 1" | | | |
| 2. "Term 2" | | | |
| 3. "Term 3" | | | |
| 4. "Term 4" | | | |