
Northern District of Illinois Local Patent Rules

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Genesis of the Local Patent Rules

- Enacted October 1, 2009
- 4 Judge Panel
 - Chief Judge Holderman
 - Judge Zagel
 - Judge Kennelly
 - Judge St. Eve
- Panel of 7 Patent Practitioners
- Public Comment Period
- Amended February 25, 2013

Purposes of Northern District of Illinois Local Patent Rules

- Procedural uniformity
- Speed to trial
 - Time to trial for patent cases pre-rules was often 36 – 40 months
 - Goal of the rules was to reduce time to trial to 24 – 30 months.
- Align with other popular patent Districts
- Judge Kennelly published some of the committee's thoughts
 - <http://www.jmripl.com/issues/archives/9/2>

Schedule After Responsive Pleadings

Week 2	Initial Disclosures and Opening of Fact Discovery
Week 4	Initial Infringement Contentions
Week 6	Initial Non-Infringement , Unenforceability and Invalidity Contentions
Week 8	Initial Response to Invalidity Contentions
Week 25	<u>Final</u> Infringement, Unenforceability and Invalidity Contentions
Week 29	<u>Final</u> Non-infringement, Enforceability and Validity Contentions
Week 31	Exchange of Proposed Constructions
Week 32	Narrow to Ten Terms for Construction
Week 35	Close of Fact Discovery (May Be Reopened After <i>Markman</i> Ruling)

Markman Briefing Schedule

Week 36	Opening Claim Construction Brief (Accused Infringer)
Week 40	Responsive Claim Construction Brief (Patentee)
Week 42	Reply Claim Construction Brief (Accused Infringer)
Week 46	Claim Construction Hearing

Schedule After Markman Hearing

	Potential Reopening of Fact Discovery
Week 1	Begin willfulness discovery, willfulness disclosures
Week 6	Close of Fact Discovery
Week 3/9	Burden of Proof Expert Reports
Week 8/14	Rebuttal Expert Reports
Week 13/19	Completion of Expert Discovery
Week 17/23	Dispositive Motions
Week 37/43	Case Ready for Trial

- Approximately 102 weeks from service of summons to trial
 - *Northern District of Illinois Adopts Local Patent Rules, 9 J. Marshall Rev. Intell. Prop. L. 202 (Winter 2010)*

Effect of Certain Local Patent Rules on Litigation

- Challenges encountered in light of:
 - Fast Paced Discovery
 - Contentions Required
 - Reversal of the *Markman* briefing order

1. *Fast Pace Discovery:* *Initial Disclosures* (N.D. III. LPR 2.1)

- Significant document production required
- The deadline is 14 days after the last responsive pleading is filed
- A default protective order is in effect as of the initial disclosure deadline.
 - Fairly comprehensive
 - Similar to N.D Cal. default protective order
 - 2 tier confidentiality designations
 - No specific provision for Source Code

1. *Fast Pace Discovery:* *Initial Disclosures* (N.D. Ill. LPR 2.1) (cont'd)

- A party asserting a patent must disclose all documents concerning
 - any disclosures or transfers of embodiments that predate filing of the patent
 - the conception and development of each claimed invention
 - communications to and from the USPTO
 - ownership of the patent rights

1. Fast Pace Discovery: Initial Disclosures (N.D. Ill. LPR 2.1) (cont'd)

- A party opposing an infringement claim must disclose:
 - documents sufficient to show the operation and construction of all aspects of each accused instrumentality specifically identified in the complaint
 - a copy of all invalidating prior art of which the party is aware

1. Fast Pace Discovery: Effect on Litigation

- Earlier preparation:
 - Plaintiffs may want to conduct pre-filing document collection
 - Defendants must move quickly to meet the initial document production deadline of 14 days after answer
- Expenses
 - Costs ramp up sooner
 - Cannot avoid expense of fact discovery

2. Early Contentions Required: Effect on Litigation (LPR 2.1-2.4)

- Patentee: Detailed claim charts; priority dates; willful infringement basis; embodiments
- Accused Infringer: Noninfringement charts; invalidity charts, including reasons for combinations; indefiniteness; unenforceability
- Patentee: Response to Invalidity Contentions must contain reason for denying existence of element

2. *Final Contentions*

- Final burden of proof contentions 23 weeks after discovery opens
 - invalidity contentions limited to 25 prior art references
- Final Responsive contentions 4 weeks later
- Amendment to Final and Final Responsive Contentions only upon good cause and absence of unfair prejudice
 - Two weeks from Claim Construction Order to move to amend

2. Early Contentions Required: Effect on Litigation (LPR 2.1-2.4)

- Expenses
 - Costs ramp up sooner
 - Cannot avoid early expense of case evaluation of infringement, noninfringement, invalidity and unenforceability
- Earlier preparation:
 - Plaintiffs need to be prepared prior to filing
 - Defendants must move quickly to respond in two weeks after service of infringement contentions

3. Reversal of Markman Briefing Order

(LPR 4.1-4.3)

- Claim construction starts near close of fact discovery with exchange of claim terms and proposed constructions
- Parties agree on 10 terms for construction
- **Accused infringer files opening brief**
- Patentee responds and accused infringer replies
- Hearing within 4 weeks after briefing

Markman Briefing Schedule

Week 36	25 page Opening Brief (Accused Infringer) Joint Appendix
Week 40	25 page Responsive Brief (Patentee)
Week 42	15 page Reply Brief (Accused Infringer)
Week 46	Claim Construction Hearing

3. Reversal of Markman Briefing Order: Effect on Litigation

- Briefing order
 - Accused infringer gets to set the tone and explain the disputed technology with opening brief
 - Patentee cannot begin with the plain & ordinary meaning and then elaborate on reply
- Schedule – Fact Discovery “Closed”
 - Patentee can rely upon facts from discovery to shape its constructions
 - But pre-filing investigation should be enough

Additional Resources

- Review the Northern District of Illinois' Local Patent Rules at:
<http://www.ilnd.uscourts.gov/home/LocalRules.aspx>
- Read Judge Kennelly's introduction to the Local Patent Rules at:
<http://www.jmripl.com/issues/archives/9/2>
- Compare and contrast with local patent rules from across the country at: <http://www.localpatentrules.com/>