



## **LOCAL PATENT RULES**

Effective: December 5, 2015

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**UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

**LOCAL PATENT RULES**

**1. SCOPE OF RULES**

**LPR 1.1      AUTHORITY**

The Local Patent Rules for the United States District Court for the Western District of Pennsylvania are promulgated as authorized by and subject to the limitations of Federal Rule of Civil Procedure 83.

**LPR 1.2      CITATION**

These are the Local Rules of Practice for Patent Cases before the United States District Court for the Western District of Pennsylvania. They should be cited as "LPR," followed by the applicable rule number and subsection.

**LPR 1.3      APPLICATION AND CONSTRUCTION**

These rules apply to all civil actions filed in or transferred to this Court that allege infringement of a utility patent in a complaint, counterclaim, cross-claim or third party claim, or that seek a declaratory judgment that a utility patent is not infringed, is invalid or is unenforceable. The Court may accelerate, extend, eliminate, or modify the obligations or deadlines set forth in these Local Patent Rules based on the circumstances of any particular case, including, without limitation, the complexity of the case or the number of patents, claims, products, or parties involved. If any motion filed prior to the Claim Construction Hearing provided for in LPR 4.4 raises claim construction issues, the Court may, for good cause shown, defer the motion until after completion of the disclosures, filings, or ruling following the Claim Construction Hearing. The Local Civil Rules of this Court shall also apply to these actions, except to the extent that they are inconsistent with these Local Patent Rules.

**LPR 1.4      EFFECTIVE DATE**

These Local Patent Rules shall take effect on December 5, 2015 and shall apply to any case filed thereafter. The parties to any other pending civil action in which the infringement, validity, or enforceability of a utility patent is an issue shall meet and confer promptly after December 5, 2015, for the purpose of determining whether any provisions in these Local Patent Rules should be made applicable

to that case. No later than seven (7) calendar days after the parties meet and confer, the parties shall file a stipulation setting forth a proposed order that relates to the application of these Local Patent Rules. Unless and until an order is entered applying these Local Patent Rules to any pending case, the Local Civil Rules and Local Patent Rules previously applicable to pending patent cases shall govern.

## **LPR 1.5      ALTERNATIVE DISPUTE RESOLUTION**

Unless the Court orders otherwise, the default form of alternative dispute resolution in any case governed by these Local Patent Rules shall be Early Neutral Evaluation, which shall occur in accordance with the timing and procedures stated in the ADR Policies and Procedures, as adopted by the Board of Judges for the United States District Court for the Western District of Pennsylvania. See, e.g., ¶ 4.4.B ADR Policies & Procedures (W.D. Pa.) (found at [http://www.pawd.uscourts.gov/Applications/pawd\\_adr/Documents/ADRPolicies.pdf](http://www.pawd.uscourts.gov/Applications/pawd_adr/Documents/ADRPolicies.pdf)) However, if all parties (1) mutually agree to employ some other form of alternative dispute resolution, such as Mediation or Arbitration, and (2) mutually agree to the timing therefor, then, unless the Court orders otherwise, the deadline for completing such Mediation or Arbitration shall be 60 calendar days after the Court's decision on claim construction.

## **2. GENERAL PROVISIONS**

### **LPR 2.1      GOVERNING PROCEDURE**

#### **(a) Planning Meeting and Report.**

When the parties confer with each other pursuant to Federal Rule of Civil Procedure 26(f), in addition to the matters covered by Federal Rule of Civil Procedure 26, the parties must discuss and address in the statement filed pursuant to Federal Rule of Civil Procedure 26(f), the following topics:

(1) Proposed modification of the deadlines provided for in these Local Patent Rules and/or set forth in the Court's Scheduling Order (see Model Scheduling Order at "Appendix LPR 2.1" for types of deadlines that might be included) and the effect of any such modification on the date and time of the Claim Construction Hearing, if any;

(2) Whether the parties believe that appointment of a special master may be helpful to the parties and the Court and if so, the joint nomination of a special master to be appointed in the case for purposes of claim construction, based upon mutual agreement of the parties;

(3) Any anticipated motions or proceedings that might affect the deadlines set by these Local Patent Rules, including motions for preliminary injunction; to add or substitute parties; to consolidate; or to stay due to any

currently known related, concurrent, or intended patent office proceedings, ITC proceedings, or court cases;

(4) Any issues that might be the proper subject of an early motion for summary judgment or partial summary judgment;

(5) The format of the Claim Construction Hearing, including whether the Court will hear live testimony at the Claim Construction Hearing, the order of presentation, and the estimated length of the hearing;

(6) Whether the parties should provide a tutorial to the Court concerning the technology at issue, including the format and timing of such tutorial;

(7) The need for and any specific procedures or limits on discovery relating to claim construction, including depositions of witnesses, including expert witnesses;

(8) Whether parties are willing to go to trial in front of a Magistrate Judge;

(9) Whether the parties request a claim construction status conference to be held after the Joint Disputed Claim Terms Chart and Prehearing Statement provided for in LPR 4.2 has been filed, and

(10) The form(s) of alternative dispute resolution (Early Neutral Evaluation, Arbitration, or Mediation) that will be utilized in the case, along with the following information:

- the joint nomination of the neutral(s) to be appointed by the Court for purposes of alternative dispute resolution, based upon mutual agreement of the parties;
- percentage of payment responsibility by each party for any fees and expenses associated with the neutral(s);
- the date(s) on which the selected form of alternative dispute resolution will occur; and
- identification of each party representative(s) who will attend the selected alternative dispute resolution session(s).

**(b) Initial Scheduling Conference.**

In addition to the items in section (a) above, each party should be prepared to discuss the technology at issue during the initial scheduling conference. This includes the general technology at issue, the patent(s) in suit, and each accused apparatus, product, device, process, method, act or other instrumentality of each opposing party that is accused of infringing (“Accused Instrumentality”). In addition to the foregoing, each party is expected to bring a sample or representation (e.g., photographs, video, specification, etc.) of each Accused

Instrumentality, if possible. Finally, each party should be prepared for a preliminary discussion on damages.

**(c) Further Scheduling Conferences.** To the extent that some or all of the matters provided for in LPR 2.1 are not resolved or decided at the Initial Scheduling Conference, the parties shall propose dates for further Scheduling Conferences at which such matters shall be addressed.

## **LPR 2.2 CONFIDENTIALITY**

### **(a) Automatic Protective Order**

All documents or information produced under these Local Patent Rules shall be governed by the terms and conditions of the Protective Order in "Appendix LPR 2.2." Such Protective Order shall be deemed automatically entered upon the filing or transfer of any civil action to which these Local Patent Rules apply pursuant to LPR 1.3, unless otherwise modified by agreement of the parties or Order of Court.

### **(b) Additional Model Language**

Appendix LPR 2.2a contains model language for additional provisions for the Protective Order. This language is provided for consideration by the Court and the parties should the circumstances warrant inclusion of such additional provisions in the Protective Order.

## **LPR 2.3 CERTIFICATION OF INITIAL DISCLOSURES**

All statements, disclosures, or charts filed or served in accordance with these Local Patent Rules must be dated and signed by counsel of record (or by the party if unrepresented by counsel). Pursuant to Rules 11 and 26(g) of the Federal Rules of Civil Procedure, counsel's signature (or the signature of the unrepresented party) 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.

## **LPR 2.4 ADMISSIBILITY OF DISCLOSURES**

Except as hereinafter provided, statements, disclosures, or charts governed by these Local Patent Rules are admissible to the extent permitted by the Federal Rules of Evidence or Civil Procedure. However, the statements or disclosures provided for in LPR 4.1 and 4.2 are not admissible for any purpose other than in connection with motions seeking an extension or modification of the time periods within which actions contemplated by these Local Patent Rules must be taken, or concerning the scope, length, or substance of the Claim Construction proceedings set forth in LPR 4.3 and 4.4.

## **LPR 2.5 RELATIONSHIP TO FEDERAL RULES OF CIVIL PROCEDURE**

### **(a) Objections on Grounds of Prematurity**

Except as provided in this paragraph or as otherwise ordered, it shall not be a legitimate ground for objecting to an opposing party's discovery request (e.g., interrogatory, document request, request for admission, deposition question) or declining to provide information otherwise required to be disclosed pursuant to Federal Rule of Civil Procedure 26(a)(1) that the discovery request or disclosure requirement is premature in light of or otherwise conflicts with, these Local Patent Rules. A party may object, however, to the following categories of discovery requests (or decline to provide information in its initial disclosures under Federal Rule of Civil Procedure 26(a)(1)) on the ground that they are premature in light of the timetable provided in the Local Patent Rules:

- (1) Requests seeking to elicit a party's claim construction position. **See LPR 4.1-4.3;**
- (2) Requests seeking to elicit from the patent claimant a comparison of the asserted claims and the accused apparatus, device, process, method, act, or other instrumentality. **See LPR 3.2-3.3;**
- (3) Requests seeking to elicit from an accused infringer a comparison of the asserted claims and the prior art. **See LPR 3.4-3.5; and**
- (4) Requests seeking to elicit the identification of any advice of counsel, and related documents. **See LPR 3.9.**

Where a party properly objects to a discovery request (or declines to provide information in its initial disclosures under Federal Rule of Civil Procedure 26(a)(1)) as set forth above, that party shall provide the requested information on the date on which it is required to provide the requested information to an opposing party under these Local Patent Rules, unless there exists another legitimate ground for objection.

The parties are reminded that the obligations under Federal Rule of Civil Procedure 26(e) to supplement disclosure and discovery responses shall apply to all Patent Initial Disclosures and all other discovery responses associated with these Local Patent Rules.

### **3. PATENT INITIAL DISCLOSURES**

#### **LPR 3.1 INITIAL DISCLOSURES**

Not later than fourteen (14) days after the Initial Scheduling Conference, the parties shall exchange the initial disclosures required by Federal Rule of Civil Procedure 26(a)(1) ("Initial Disclosures") and shall exchange the documents specified below, subject to the terms of the Protective Order as set forth in LPR 2.2.

With the Initial Disclosures of the party asserting a claim of patent infringement, such party shall produce or make available for inspection and copying, among other items:

All Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreement, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell or other manner of transfer, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102;

All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or a priority date otherwise identified for the patent in suit, whichever is earlier;

All documents evidencing communications to and from the U.S. Patent Office for each patent in suit and for each patent on which a claim for priority is based; and

All documents evidencing ownership of the patent rights by the party asserting patent infringement.

The producing party shall separately identify by production number which documents correspond to each category.

With the Initial Disclosures of the party opposing a claim of patent infringement, such party shall produce or make available for inspection and copying, among other items:

Source code, specifications, schematics, flow charts, artwork, formulas, drawings and/or other documentation, including sales literature, sufficient to show the operation of any aspects or elements of each accused apparatus, product, device, process, method or other accused instrumentality identified with specificity in the pleading of the party asserting patent infringement; and

A copy of each item of prior art, of which the opposing party is aware, that allegedly anticipates each asserted patent and its related claims or renders them obvious.

## **LPR 3.2 DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS**

### **(a) Timing**



Not later than thirty (30) calendar days after the Initial Scheduling Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Infringement Contentions."

**(b) Asserted Claims and Infringement Contentions**

Separately for each opposing party, the "Disclosure of Asserted Claims and Infringement Contentions" shall contain the following information:

(1) Each claim of each patent in suit that is allegedly infringed by each opposing party, including for each claim the applicable statutory subsection of 35 U.S.C. § 271;

(2) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party claiming infringement is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(3) A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(6) [or 35 U.S.C. § 112(f) for patents having an effective date after March 16, 2013], a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(4) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality, and if present under the doctrine of equivalents, the asserting party shall also explain each function, way, and result that it contends are equivalent, and why it contends that any differences are not substantial;

(5) For each claim which is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer(s) that contribute to or that are inducing direct infringement;

(6) To the extent any alleged direct infringement is based on the joint acts of multiple parties, an identification of each such party and a description of the relevant role of each such party;

(7) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;

(8) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus,

product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim and;

(9) If a party claiming patent infringement alleges willful infringement, the bases for such allegation.

(10) Nothing in this provision shall be construed to modify any party's pleading obligations under the Federal Rules of Civil Procedure.

### **LPR 3.3 DOCUMENT PRODUCTION ACCOMPANYING DISCLOSURE**

With the "Disclosure of Asserted Claims and Infringement Contentions," the party claiming patent infringement shall supplement its Initial Disclosures, if applicable, based upon the Initial Disclosures of the opposing party.

### **LPR 3.4 NON-INFRINGEMENT AND/OR INVALIDITY CONTENTIONS**

#### **(a) Timing**

Not later than fourteen (14) calendar days after service upon it of the "Disclosure of Asserted Claims and Infringement Contentions," each party asserting non-infringement and/or invalidity of a patent, shall serve upon all parties its "Non-Infringement and/or Invalidity Contentions."

#### **(b) Non-Infringement Contentions**

Non-Infringement Contentions shall contain a chart, responsive to the chart required by LPR 3.2, that states as to each identified element in each asserted claim, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality, and, if denied, the specific reasons for such denial.

#### **(c) Invalidity Contentions**

Invalidity Contentions must contain the following information:

(1) The identity of each item of prior art that allegedly anticipates each asserted 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.

(2) With respect to prior art that anticipates any asserted claim, the facts, documents, witnesses, entities and times that establish that an asserted claim was, before the applicable priority date, patented, described in a printed publication, known, on sale, in public use, otherwise available to the public, derived from another, or is otherwise invalid according to the applicable provisions of § 102.

(3) With respect to a combination of items of prior art that allegedly make a claim obvious, each such combination, and the reasons a person of ordinary skill in the art would combine such items.

(4) A chart identifying where specifically in each alleged item of prior art each element of each challenged claim is found, including for each element that such party contends is governed by 35 U.S.C. § 112(6) [or 35 U.S.C. § 112(f) for patents having an effective date after March 16, 2013], a description of the claimed function of that element and the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function.

(5) A detailed explanation of any grounds of invalidity of any of the asserted claims based on ineligible subject matter under 35 U.S.C. § 101, indefiniteness under 35 U.S.C. § 112, or enablement or written description under 35 U.S.C. § 112.

### **LPR 3.5 DOCUMENT PRODUCTION ACCOMPANYING INVALIDITY CONTENTIONS**

With the "Non-infringement and/or Invalidity Contentions," the party asserting non-infringement and/or invalidity of a patent shall supplement its Initial Disclosures and, in particular, must produce or make available for inspection and copying:

Any additional documentation showing the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its LPR 3.2 chart; and

A copy of any additional items of prior art identified pursuant to LPR 3.4 that does not appear in the file history of the patent(s) at issue.

The party asserting non-infringement and/or invalidity of a patent shall also produce summary sales and/or use information reflecting the quantity of the Accused Instrumentality sold and/or used in the United States and the revenues from those sales and/or uses, to the extent known.

### **LPR 3.6 GOOD FAITH DAMAGES ESTIMATE**

Not later than fourteen (14) calendar days after production of the summary sales and use information set forth in LPR 3.5, the party asserting patent infringement shall serve upon the party asserting non-infringement a good faith estimate of its expected damages, including a summary description of the method used to arrive at that estimate. If such damages estimate is based upon a reasonable royalty, the party asserting patent infringement shall also produce any and all license agreements concerning each patent in suit and any related patent.

### **LPR 3.7 DISCLOSURE REQUIREMENT IN PATENT CASES INITIATED BY DECLARATORY JUDGMENT**

**(a) Non-infringement and/or Invalidity Contentions If No Claim of Infringement**

In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable, LPR 3.2 and 3.3 shall not apply unless and until a claim for patent infringement is made by a party. If the defendant does not assert a claim for patent infringement in its answer to the complaint, no later than thirty (30) calendar days after the Initial Scheduling Conference, the party seeking a declaratory judgment must serve upon each opposing party its Non-infringement and/or Invalidity Contentions that conform to LPR 3.4 and produce or make available for inspection and copying the documentation described in LPR 3.5.

**(b) Application of Rules When No Specified Triggering Event**

If the filings or actions in a case do not trigger the application of these Local Patent Rules under the terms set forth herein, the parties shall, as soon as such circumstances become known, meet and confer for the purpose of agreeing on the application of these Local Patent Rules to the case.

**(c) Inapplicability of Rule**

This LPR 3.7 shall not apply to cases in which a request for a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable is filed in response to a complaint for infringement of the same patent.

**LPR 3.8 AMENDMENT TO CONTENTIONS**

**(a) Leave Not Required**

Not later than twenty-one (21) days after entry of a Claim Construction Order, a party claiming patent infringement may amend, modify or supplement its Infringement Contentions without leave of Court if the Court adopts a claim construction different from that proposed by the party claiming patent infringement and that party believes, in good faith, that the claim construction necessitates the proposed amendment, modification or supplement. Not later than thirty-five (35) days after entry of a Claim Construction Order, a party opposing a claim of patent infringement may amend, modify or supplement its Invalidity and/or Non-Infringement Contentions without leave of Court if (1) a party claiming patent infringement amends, modifies or supplements its Infringement Contentions pursuant to this Rule or (2) the Court adopts a claim construction different from that proposed by the party opposing patent infringement and that party believes, in good faith, that the claim construction necessitates the proposed amendment, modification, or supplement.

**(b) Leave Required**

Except otherwise provided in LPR 3.8(a), any amendment, modification, or supplement of any Infringement or Non-Infringement and/or Invalidity Contentions may be made only by order of the Court or Court-approved stipulation of the parties. Leave may be granted if the motion is made in a timely fashion, for good cause, and without purpose of delay or undue prejudice to the non-moving party. Non-exhaustive examples of circumstances that may support a finding of good cause can include: information newly discovered, through due diligence, regarding an accused product or prior art; information discovered or

provided by a party's consultant or expert after a party's contentions have been served; a new product launches; amendments to the complaint or counterclaim adding or removing one or more asserted patents; and information learned from or positions taken in the claim construction proceedings or in the exchange of contentions pursuant to LPR 3.2-3.7.

### **LPR 3.9      **ADVICE OF COUNSEL****

#### **(a)      **Timing****

Not later than 60 days prior to the close of fact discovery, as set forth in the Court's Scheduling Order, any party relying upon advice of counsel as part of a patent-related claim or defense for any reason shall:

(1)      Produce or make available for inspection and copying any written advice and documents related thereto for which the attorney-client and work product protection have been waived;

(2)      Provide a written summary of any oral advice and produce or make available for inspection and copying that summary and documents related thereto for which the attorney-client and work product protection have been waived; and

(3)      Serve a privilege log identifying any other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the advice which the party is withholding on the grounds of attorney-client privilege or work product protection.

#### **(b)      **Depositions****

After such information becomes discoverable, an opposing party shall be entitled to take the deposition of any attorneys rendering the advice relied upon and any persons who received such advice, including but not limited to any person who claims to have relied upon such advice, subject to any limitations otherwise imposed by these Rules, the Federal Rules of Civil Procedure, or the Court's Scheduling Order, and prior to the close of fact discovery, unless otherwise ordered by the Court.

#### **(c)      **Failure to Comply****

A party who does not comply with the requirements of this Rule shall not be permitted to rely upon advice of counsel for any purpose absent a stipulation of all parties, with approval by the Court, or otherwise by order of the Court.

## **4. CLAIM CONSTRUCTION PROCEEDINGS**

#### **LPR 4.1**

### **EXCHANGE OF PROPOSED CLAIM TERMS AND PHRASES FOR CONSTRUCTION**

#### **(a) Exchange of Proposed Claim Terms and Phrases**

Not later than fourteen (14) days after: (i) service of the Non-infringement and/or Invalidity Contentions pursuant to LPR 3.4; or (ii) an agreement of the parties to expedite claim construction following the Initial Scheduling Conference pursuant to LPR 2.1, each party shall simultaneously exchange a list of claim terms and phrases which that party contends should be construed by the Court, and identify any claim element which that party contends should be governed by 35 U.S.C. § 112(6) (pre-AIA) or 35 U.S.C. § 112(f) (AIA).

#### **(b) Exchange of Proposed Constructions**

Not later than fourteen (14) days after the exchange of the "Proposed Claim Terms and Phrases for Construction" pursuant to LPR 4.1(a), the parties shall simultaneously exchange a preliminary proposed construction of each claim term or phrase which the parties collectively have identified for claim construction purposes. Each such preliminary claim construction shall also, for each element which any party contends is governed by 35 U.S.C. § 112(6) (pre-AIA) or 35 U.S.C. § 112(f) (AIA), identify the structure(s), act(s), or material(s) corresponding to that element.

#### **LPR 4.2**

### **PREPARATION AND FILING OF JOINT DISPUTED CLAIM TERMS CHART AND PREHEARING STATEMENT**

#### **(a) Meet and Confer**

Not later than seven (7) days after the exchange set forth in LPR 4.1(b), the parties shall meet and confer to identify claim terms and phrases that are in dispute, and claim terms and phrases that are not in dispute, and shall prepare and file a Joint Disputed Claim Terms Chart listing claim terms and phrases and corresponding intrinsic evidence for each disputed claim term and phrase, asserted by each party. Reasonable efforts shall be made by the parties to limit the terms in dispute by narrowing or resolving any differences between the respective constructions. The Joint Disputed Claim Terms Chart shall be in the format shown in "Appendix LPR 4.2." Each party shall also file with the Joint Disputed Claim Terms Chart an appendix containing a copy of each exhibit of intrinsic evidence cited by the party in the Joint Disputed Claim Terms Chart.

#### **(b) Prehearing Statement**

At the same time, the parties shall jointly file a Prehearing Statement that contains the following information:

(1) The construction of those claim terms and phrases on which the parties agree;

(2) The anticipated length of time necessary for the Claim Construction Hearing; and

(3) Whether any party proposes to call one or more witnesses at the Claim Construction Hearing, the identity of each such witness, and for each such witness, a copy of his or her CV (if available) and a brief summary of his or her anticipated testimony.

### **LPR 4.3 CLAIM CONSTRUCTION BRIEFING AND EXTRINSIC EVIDENCE**

#### **(a) Opening Submission**

Not later than thirty (30) calendar days after filing of the Joint Disputed Claim Terms Chart pursuant to LPR 4.2, the Plaintiff (including the Plaintiff alleging non-infringement in a declaratory judgment action), shall serve and file an Opening Claim Construction Brief including a proposed construction of each claim term and phrase which the parties collectively have identified as being in dispute. Notwithstanding the above, the parties may stipulate that the Defendant (including the Defendant alleging infringement in a declaratory judgment action) will serve and file the Opening Claim Construction Brief. Such Opening Claim Construction Brief shall also, for each element which the party contends is governed by 35 U.S.C. § 112(6) (pre-AIA) or 35 U.S.C. § 112(f) (AIA), describe the claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element. For purposes of this rule, if there is no claim of patent infringement present in the complaint as originally filed, then the party first alleging infringement or non-infringement of the subject patent shall serve and file the Opening Claim Construction Brief.

At the same time the party serves its Opening Claim Construction Brief, that party shall serve and file an identification of extrinsic evidence, including testimony of lay and expert witnesses the party contends supports its claim construction. The party shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, lay or expert, the party shall also serve and file an affidavit signed by the witness that sets forth the substance of that witness' proposed testimony sufficient for the opposing party to conduct meaningful examination of the witness(es) and promptly make the witness available for deposition concerning the proposed testimony.

#### **(b) Responsive Submission**

Not later than twenty-one (21) days after service of the Opening Claim Construction Brief, the opposing party shall serve and file a Response to Opening Claim Construction Brief including the party's proposed construction of each claim term and phrase which the parties collectively have identified as being in dispute. Such Response shall also, for each element which the opposing party contends is governed by 35 U.S.C. § 112(6) (pre-AIA) or 35 U.S.C. § 112(f) (AIA), describe the claimed function of that element and identify the structure(s), act(s), or material(s) corresponding to that element. Such Response shall further include a concise statement not to exceed five (5) pages as to whether the party objects to the opening party's offer of extrinsic evidence.

At the same time the opposing party serves its Response, that party shall serve and file an identification of extrinsic evidence, including testimony of lay and expert witnesses the party contends supports its claim construction. The party

shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, lay or expert, the party shall also serve and file an affidavit signed by the witness that sets forth the substance of that witness' proposed testimony sufficient for the opposing party to conduct meaningful examination of the witness(es) and promptly make the witness available for deposition concerning the proposed testimony.

**(c) Reply Submission**

Not later than fourteen (14) days after service of the Response, the opening party may serve and file a Reply directly rebutting the opposing party's Response. Such Reply shall further include a concise statement not to exceed five (5) pages as to whether the party objects to the opposing party's offer of extrinsic evidence. In the event the opposing party identifies a lay or expert witness whose testimony will support its claim construction, the date for the filing of a Reply Claim Construction Brief shall be extended by seven (7) calendar days.

**(d) Surreply Submission**

In the event that the party bearing the burden of proof on the issue of infringement is the party filing the Response, that party may file a Surreply directly rebutting the opposing party's Reply without leave of Court. Such Surreply shall be filed no later than fourteen (14) days after the service of the Reply and shall not exceed five (5) pages.

**(e) Status Conference**

Prior to the Claim Construction Hearing, the Court may schedule a status conference or issue an order stating whether it will receive extrinsic evidence and, if so, the particular evidence that it will exclude and that it will receive, and any other matter the Court deems appropriate concerning the conduct of the hearing. Should the Court not conduct a conference or issue an order in advance of the Claim Construction Hearing, such matters will be addressed, as necessary, at the Hearing.

**LPR 4.4 CLAIM CONSTRUCTION HEARING**

Subject to the convenience of the Court's calendar, promptly following submission of the Reply specified in LPR 4.3(c) [or the Surreply specified in LPR 4.3(d) if applicable], the Court shall conduct a Claim Construction Hearing.

**LPR 4.5 SPECIAL MASTER REPORT AND RECOMMENDATION ON CLAIM CONSTRUCTION**

If a Special Master for the purpose of claim construction is appointed, the Special Master shall be empowered to hold hearings and receive and report evidence on the issue of claim construction.

Unless otherwise ordered by the Court, within thirty (30) calendar days following the hearing on the issue of claim construction, the Special Master shall submit to



the Court a report and recommendation on the issue of claim construction. Either party may file objections to -- or a motion to adopt or modify -- the Special Master's report and recommendation, no later than fourteen (14) days from the time the Special Master's report and recommendations are submitted. A party may file a response to such objection or motion within fourteen (14) days of the initial filing of such objection or motion.

The compensation to be paid to the Special Master shall be fixed and determined by the Court pursuant to Federal Rule of Civil Procedure 53(a). Unless otherwise ordered by the Court, the parties shall equally split the costs and fees for services rendered by the Special Master.

## **5. EXPERT WITNESSES**

### **LPR 5.1 DISCLOSURE OF EXPERTS AND EXPERT REPORTS**

For issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule.

No later than thirty (30) calendar days after (1) the normal close of discovery pursuant to the Court's case management order, or (2) the Court's ruling on claim construction, whichever is later, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which each bears the burden of proof.

No later than thirty (30) calendar days after the first round of disclosures, each party shall make its initial expert witness disclosures required by Rule 26 on the issues on which the opposing party bears the burden of proof.

Unless otherwise ordered by the Court, no later than fourteen (14) days after the second round of disclosures, each party shall make any rebuttal expert witness disclosures permitted by Rule 26.

### **LPR 5.2 DEPOSITIONS OF EXPERTS**

Depositions of expert witnesses disclosed under this Rule, if any, shall commence within seven (7) calendar days after rebuttal reports are served and shall be completed within thirty (30) calendar days after commencement of the deposition period.

**APPENDIX LPR 2.1**

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Plaintiff v. Defendant. ) Civil Action No.

**MODEL SCHEDULING ORDER FOR USE IN PATENT CASES**

AND NOW, this \_\_\_\_\_ day of \_\_\_\_\_, 20\_\_\_\_,

IT IS ORDERED that this action is placed under the Local Patent Rules of this Court for pretrial proceedings and all provisions of these Rules will be strictly enforced.

IT IS FURTHER ORDERED that counsel shall confer with their clients prior to all scheduling, status, or pretrial conferences to obtain authority to participate in settlement negotiations which may be conducted or ordered by the Court.

IT IS FURTHER ORDERED that compliance with provisions of Local Rule 16 and the Local Patent Rules shall be completed as follows:

- (1) The parties shall move to amend the pleadings or add new parties by \_\_\_\_\_;
- (2) The party claiming patent infringement must serve on all parties a Disclosure of Asserted Claims and Infringement Contentions by \_\_\_\_\_; [30 calendar days after the Initial Scheduling Conference; LPR 3.2]
- (3) The party claiming non-infringement and/or invalidity must serve on all parties a Disclosure of Non-infringement and/or Invalidity Contentions by \_\_\_\_\_; [14 days after service of Disclosure of Asserted Claims and Infringement Contentions; LPR 3.4]
- (4) Each party will simultaneously exchange Proposed Claim Terms and Phrases for Construction by \_\_\_\_\_; [14 days after service of the Non-infringement and/or Invalidity Contention; LPR 4.1(a)]
  - (4a) Each party will simultaneously exchange a preliminary proposed construction of each term or phrase by \_\_\_\_\_; [not later than 14 days after the exchange of proposed claim terms and phrases; LPR 4.1(b)]
- (5) The parties shall meet and confer by \_\_\_\_\_ to identify claim terms and phrases that are in dispute, and claim terms and phrases that are not

in dispute and prepare and file a Joint Disputed Claim Terms Chart and Prehearing Statement. Each party shall also file with the Joint Disputed Claim Terms Chart and Prehearing Statement an appendix containing a copy of each item of intrinsic evidence cited by the party in the Joint Disputed Claim Terms Chart; *[Not later than 7 days after the exchange of preliminary constructions; LPR 4.2]*

(6) It is hereby Ordered that \_\_\_\_\_ is appointed Special Master pursuant to Federal Rule of Civil Procedure 53 to serve in accordance with the LPRs in this action;

(7) The parties have agreed to submit this case to \_\_\_\_\_ *[Early Neutral Evaluation, Mediation, or Arbitration]*. As such, it is hereby Ordered that \_\_\_\_\_ is/are appointed as the *[Early Neutral Evaluator, Mediator, or Arbitrator]* to serve in accordance with the ADR Policies and Procedures in this action;

(8) The above-mentioned alternative dispute resolution shall take place on \_\_\_\_\_ and on such other dates as the parties may agree; *[if Mediation is selected, then the deadline shall be 60 calendar days after the Court's decision on claim construction, unless the Court rules otherwise; LPR 2.1]*

(9) Plaintiff shall file and serve an Opening Claim Construction Brief and an identification of extrinsic evidence by \_\_\_\_\_; *[30 calendar days after filing of the joint disputed claim terms chart; LPR 4.3]*

(10) The Opposing Party shall file and serve a response to the Opening Claims Construction Brief, an identification of extrinsic evidence and any objections to extrinsic evidence by \_\_\_\_\_; *[21 days after service of the opening claim construction brief; LPR 4.3]*

(11) The opening party may serve and file a Reply directly rebutting the opposing party's Response, and any objections to extrinsic evidence by \_\_\_\_\_; *[14 days after opposing party's response is served (or 21 days if the opposing party's response includes testimony from a lay or expert witness); LPR 4.3]*

(12) If the Opposing Party bears the burden of proof on infringement, it may file a Surreply directly rebutting the opening party's Reply by \_\_\_\_\_; *[14 days after opening party's Reply is served; LPR 4.3]*

(13) The Court will conduct a hearing on the issue of Claim Construction on \_\_\_\_\_;

(14) The Report and Recommendation of the Special Master on the issue of claim construction shall be due on \_\_\_\_\_; *[Unless otherwise ordered by the Court, 30 calendar days after the hearing on claim construction; LPR 4.5]*

(15) The parties shall complete fact discovery by 60 days after the Court issues a ruling on claim construction, and all interrogatories, depositions, requests for admissions, and requests for production shall be served within sufficient time to allow responses to be completed prior to the close of discovery;

(16) Each party shall make its initial expert witness disclosures, as required under Rule 26, on the issues on which each bears the burden of proof by \_\_\_\_\_, [30 calendar days after the normal close of discovery pursuant to the Court's case management order, or the court's ruling on claim construction, whichever is later; LPR 5.1]

(17) Each party shall make its initial expert witness disclosures, as required under Rule 26, on the issues on which the opposing party bears the burden of proof by \_\_\_\_\_; [30 calendar days after the first round of expert disclosures; LPR 5.1]

(18) Rebuttal expert witness disclosures are to be made by \_\_\_\_\_; [14 days after second round of expert disclosures; LPR 5.1]

(19) Expert Depositions, if any, shall begin by \_\_\_\_\_; [within 7 calendar days after service of the rebuttal expert reports] and be completed by \_\_\_\_\_; [30 calendar days after commencement of deposition period; LPR5.2]

(20) Motions for summary judgment with evidentiary material and accompanying brief, if appropriate, shall be filed by \_\_\_\_\_, and responses to such motions shall be filed within \_\_\_\_\_ calendar days thereafter. Reply and surreply briefs shall not be filed unless approved/requested by the Court;

(21) Plaintiff's pretrial narrative statement shall comply with Rule 16.1.C.1, and be filed by \_\_\_\_\_;

(22) Defendant's pretrial narrative statement shall comply with Rule 16.1.C.2, and be filed by \_\_\_\_\_;

(23) The parties shall not amend or supplement their pretrial narrative statements without leave of Court;

(24) All parties shall file an indication whether or not they are willing to proceed to trial in front of a Magistrate Judge by \_\_\_\_\_;

(25) The Court shall conduct a pretrial conference on \_\_\_\_\_ 20\_\_\_\_\_, at \_\_\_\_\_ (time) Room \_\_\_\_\_ U.S. Post Office & Courthouse, Seventh Avenue and Grant Street, Pittsburgh, Pennsylvania, and all trial counsel must attend; and

(26) The trial shall commence on \_\_\_\_\_, 20\_\_\_\_\_, at \_\_\_\_\_ (time), Courtroom No. \_\_\_\_\_.

\_\_\_\_\_  
United States District Judge

cc: All Counsel of Record

## APPENDIX LPR 2.2

### IN THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Plaintiff v. Defendant. ) Civil Action No.

#### **PROTECTIVE ORDER**

Pursuant to Rule 26(c) of the Federal Rules of Civil Procedure, the following Protective Order has been entered by Court.

#### **Proceedings and Information Governed.**

1. This Order and any amendments or modifications hereto ("Protective Order") shall govern any document, information, or other thing furnished by any party, to any other party, and includes non-parties who receive a subpoena in connection with this action. The information protected includes, but is not limited to, answers to interrogatories, answers to requests for admission, responses to requests for production of documents, deposition transcripts and videotapes, deposition exhibits, and other writings or things produced, given, or filed in this action that are designated by a party as "Confidential Information," "Confidential Attorney Eyes Only Information," or "Highly Confidential – Source Code Information" (collectively, "Protected Information") in accordance with the terms of this Order, as well as to any copies, excerpts, abstracts, analyses, summaries, descriptions, or other forms of recorded information containing, reflecting, or disclosing such information.

#### **Designation and Maintenance of Information.**

2. For purposes of this Protective Order:

(a) The "Confidential Information" designation shall mean that the document is comprised of trade secrets or commercial information which is not publicly known and is of technical or commercial advantage to its possessor, in accordance with Federal Rule of Civil Procedure 26(c)(7), or other information required by law or agreement to be kept confidential.

(b) The "Confidential Attorney Eyes Only Information" designation shall mean that the document is comprised of Confidential Information that the producing party deems especially sensitive, which may include, but is not limited to, confidential research and development, financial, technical, marketing, any other sensitive trade secret

information, or information capable of being utilized for the preparation or prosecution of a patent application dealing with such subject matter.

(c) The “Highly Confidential – Source Code Information” designation shall mean extremely sensitive “Confidential Information” representing computer code and associated comments and revision histories, formulas, engineering specifications, or schematics that define or otherwise describe in detail the algorithms or structure of software or hardware designs, disclosure of which to another party or non-party would create a substantial risk of serious harm that could not be avoided by less restrictive means.

(d) Protected Information does not include, and this Protective Order shall not apply to, information that is already in the knowledge or possession of the party to whom disclosure is made unless that party is already bound by agreement not to disclose such information, or information that has been disclosed to the public or third persons in a manner making such information no longer confidential.

3. Protected Information may be designated in the following manner.

(a) Documents and things produced during the course of this litigation within the scope of paragraph 2(a) above, may be designated by the producing party as containing Confidential Information by placing on each page and each thing a legend substantially as follows:

**CONFIDENTIAL INFORMATION  
SUBJECT TO PROTECTIVE ORDER**

(b) Documents and things produced during the course of this litigation within the scope of paragraph 2(b) above may be designated by the producing party as containing Confidential Attorney Eyes Only Information by placing on each page and each thing a legend substantially as follows:

**CONFIDENTIAL ATTORNEY EYES ONLY INFORMATION  
SUBJECT TO PROTECTIVE ORDER**

(c) Documents and things produced during the course of this litigation within the scope of paragraph 2(c) above may be designated by the producing party as containing Highly Confidential – Source Code Information by placing on each page and each thing a legend substantially as follows:

**HIGHLY CONFIDENTIAL – SOURCE CODE INFORMATION  
SUBJECT TO PROTECTIVE ORDER**

(d) A party may designate information disclosed at a deposition as Protected Information by requesting the reporter to so designate the transcript or any portion thereof at the time of the deposition. If no such designation is made at the time of the deposition, any party shall have fourteen (14) calendar days after the date of the deposition to designate, in writing to the other parties and to the court reporter, whether the transcript is to be designated as Protected Information. If no such designation is made at the deposition or within such fourteen (14) calendar day period (during which

period, the transcript shall be treated as Confidential Attorneys Eyes Only Information, unless the disclosing party consents to less confidential treatment of the information), the entire deposition will be considered devoid of Protected Information. Each party and the court reporter shall attach a copy of any final and timely written designation notice to the transcript and each copy thereof in its possession, custody or control, and the portions designated in such notice shall thereafter be treated in accordance with this Protective Order.

(e) It is the responsibility of counsel for each party to maintain materials containing Protected Information in a secure manner and appropriately identified so as to allow access to such information only to such persons and under such terms as is permitted under this Protective Order.

#### **Inadvertent Failure to Designate.**

4. The inadvertent failure to designate or withhold any information as confidential or privileged will not be deemed to waive a later claim as to its confidential or privileged nature, or to stop the producing party from designating such information as confidential at a later date in writing and with particularity. The information shall be treated by the receiving party as confidential from the time the receiving party is notified in writing of the change in the designation.

#### **Challenge to Designations.**

5. A receiving party may challenge a producing party's designation at any time. Any receiving party disagreeing with a designation may request in writing that the producing party change the designation. The producing party shall then have fourteen (14) days after receipt of a challenge notice to advise the receiving party whether or not it will change the designation. If the parties are unable to reach agreement after the expiration of this fourteen (14) day time frame, and after the conference required under Local Rule 37.1, the receiving party may at any time thereafter seek a Court Order to alter the confidential status of the designated information. Until any dispute under this paragraph is ruled upon by the Court, the designation shall remain in full force and effect and the information shall continue to be accorded the confidential treatment required by this Protective Order.

#### **Disclosure and Use of Confidential Information.**

6. Information designated as Confidential Information or Protected Information may only be used for purposes of preparation, trial and appeal of this action. Protected Information may not be used under any circumstances for prosecuting any patent application, for patent licensing or for any other purpose. The provisions of LCvR 16.1.D, relating to the inadvertent disclosure of privileged information, shall apply in all cases governed by this Protective Order.

7. Subject to paragraph 9 below, Confidential Information may be disclosed by the receiving party only to the following individuals provided that such individuals are informed of the terms of this Protective Order: (a) two (2) employees of the receiving party who are required in good faith to provide assistance in the conduct of this litigation, including any settlement discussions, and who are identified as such in writing to counsel for the designating party in advance of the disclosure; (b) two (2) in-house counsel who are identified by the receiving party; (c) outside counsel for the receiving party; (d) supporting personnel employed by (b) and (c), such as paralegals, legal secretaries, data entry clerks and legal clerks; (e) experts or

consultants; (f) any persons requested by counsel to furnish services such as photocopying, document coding, image scanning, mock trial, jury profiling, translation services, court reporting services, demonstrative exhibit preparation, or the creation of any computer database from documents; and (g) the Court and its personnel.

8. Subject to paragraph 9 below, Confidential Attorney Eyes Only Information may be disclosed by the receiving party only to the following individuals provided that such individuals are informed of the terms of this Protective Order: (a) two (2) in-house counsel who are identified by the receiving party; (b) outside counsel for the receiving party; (c) supporting personnel employed by (a) and (b), such as paralegals, legal secretaries, data entry clerks and legal clerks; (d) experts or consultants; (e) any persons requested by counsel to furnish services such as photocopying, document coding, image scanning, mock trial, jury profiling, translation services, court reporting services, demonstrative exhibit preparation, or the creation of any computer database from documents; and (f) the Court and its personnel.

9. Further, prior to disclosing Confidential Information or Confidential Attorney Eyes Only Information to a receiving party's proposed expert, consultant or employees, the receiving party shall provide to the producing party a signed Confidentiality Agreement in the form attached as Exhibit A, the resume or curriculum vitae of the proposed expert or consultant, the expert or consultant's business affiliation, and any current and past consulting relationships in the industry. The producing party shall thereafter have fourteen (14) days from receipt of the Confidentiality Agreement to object to any proposed individual. Such objection must be made for good cause and in writing, stating with particularity the reasons for objection. Failure to object within fourteen (14) days shall constitute approval. If the parties are unable to resolve any objection, the receiving party may apply to the Court to resolve the matter. There shall be no disclosure to any proposed individual during the fourteen (14) day objection period, unless that period is waived by the producing party, or if any objection is made, until the parties have resolved the objection or the Court has ruled upon any resultant motion.

10. Counsel shall be responsible for the adherence by third-party vendors to the terms and conditions of this Protective Order. Counsel may fulfill this obligation by obtaining a signed Confidentiality Agreement in the form attached as Exhibit B.

11. Confidential Information or Confidential Attorney Eyes Only Information may be disclosed to a person, not already allowed access to such information under this Protective Order, if:

(a) the information was previously received or authored by the person or was authored or received by a director, officer, employee, or agent of the company for which the person is testifying as a Rule 30(b)(6) designee;

(b) the designating party is the person or is a party for whom the person is a director, officer, employee, consultant or agent; or

(c) counsel for the party designating the material agrees that the material may be disclosed to the person.

In the event of disclosure under this paragraph, only the reporter, the person, his or her counsel, the Court and its personnel, and persons to whom disclosure may be made, and who



are bound by the Protective Order, may be present during the disclosure or discussion of the Protected Information. Disclosure of material pursuant to this paragraph shall not constitute a waiver of the confidential status of the material so disclosed.

**Disclosure and Use of Highly Confidential—Source Code Information.**

12. To the extent production of source code becomes necessary in this case, a producing party may designate source code as Highly Confidential—Source Code Information if it comprises or includes confidential, proprietary, or trade secret source code.

13. The parties agreed to cooperate in good faith so as to protect the producing party's source code while not unreasonably hindering the receiving party's ability to efficiently and effectively conduct the prosecution or defense of this action.

14. Protected Information designated as Highly Confidential—Source Code shall be subject to all of the protections afforded to Confidential Attorney Eyes Only Information and may be disclosed only to the authorized individuals to whom Confidential Attorney Eyes Only Information may be disclosed, as set forth in paragraph 8, with the exception of the two in-house counsel specified in paragraph 8(a). Disclosure of this information to the individuals identified in paragraph 8(e) may only be made if the disclosure is reasonably necessary for this litigation and the individuals have signed the Confidentiality Agreement in the form attached as Exhibit B.

15. Any source code produced in discovery shall be made available for inspection, in a format allowing it to be reasonably reviewed and searched, during normal business hours (8:00 a.m. to 6:00 p.m. on open business days) or at other mutually agreeable times, at an office of the producing party's counsel or another mutually agreed upon location. The source code shall be made available for inspection on a secured computer in a secured room without internet access or network access to other computers, and the receiving party shall not copy, remove, or otherwise transfer any portion of the source code onto any recordable media or recordable device. The producing party shall provide the receiving party with information explaining how to start, log on to, and operate the computer(s) in order to access the source code. The producing party may visually monitor the activities of the receiving party's representatives during any source code review, but only to ensure that there is no unauthorized recording, copying, or transmission of the source code.

16. The receiving party may request paper copies of limited portions of source code that are reasonably necessary for the preparation of court filings, pleadings, expert reports, or other papers, or for deposition or trial, but shall not request paper copies for the purposes of reviewing the source code other than electronically as set forth in paragraph 15 in the first instance. The producing party shall provide all such source code in paper form including bates numbers and the label specified in paragraph 3(c). The producing party may challenge the amount of source code requested in hard copy form pursuant to the dispute resolution procedure and timeframes set forth in paragraph 5 whereby the producing party is the "receiving party" and the receiving party is the "producing party" for purposes of the dispute resolution provisions of that paragraph.

17. The receiving party shall maintain a record of any individual who has inspected any portion of the source code in electronic or paper form. The receiving party shall maintain all paper copies of any printed portions of the source code in a secured, locked area under the supervision and control of an individual authorized to be in possession of the information. The receiving party may also temporarily keep paper copies of any printed portions of the source

code at (a) the Court for any proceedings where the use of the source code may be relevant; (b) the site of any depositions where the use of the source code may be relevant; and (c) any intermediate location reasonably necessary to transport the copies (e.g., at a hotel prior to a Court proceeding or deposition) as long as the receiving party takes reasonable steps to secure the copies.

18. Highly Confidential—Source Code Information may only be transported by the receiving party at the direction of a person authorized to be in possession of the information by hand carry, Federal Express, or other similar reliable courier. Highly Confidential—Source Code Information may not be transported or transmitted electronically over a network of any kind, including a LAN, intranet, or the internet, except as required by the Court pursuant to paragraph 19 below.

19. The receiving party shall not create any electronic or other images of the paper copies and shall not convert any of the information contained in the paper copies into any electronic format without the producing party's permission, except as is necessary to create documents that, pursuant to the Court's rules, procedures, or orders, must be filed or served electronically. The receiving party shall only make additional paper copies if such additional copies are (1) necessary to prepare court filings, pleadings, or other papers (including a testifying expert's expert report), (2) necessary for deposition, or (3) otherwise necessary for the preparation of its case. Any paper copies used during a deposition shall be retrieved by the producing party at the end of each day and must not be given to or left with a court reporter or any other unauthorized individual.

#### **Non-Party Information.**

20. The existence of this Protective Order shall be disclosed to any person producing documents, tangible things or testimony in this action who may reasonably be expected to desire confidential treatment for such documents, tangible things or testimony. Any such person may designate documents, tangible things, or testimony confidential pursuant to this Protective Order.

#### **Filing Documents With the Court.**

21. In the event that any party wishes to submit Protected Information to the Court, such party shall follow the procedures prescribed by the Court, including obtaining leave of Court prior to filing any documents under seal.

#### **No Prejudice.**

22. Producing or receiving confidential information, or otherwise complying with the terms of this Protective Order, shall not (a) operate as an admission by any party that any particular Protected Information contains or reflects trade secrets or any other type of confidential or proprietary information; (b) prejudice the rights of a party to object to the production of information or material that the party does not consider to be within the scope of discovery; (c) prejudice the rights of a party to seek a determination by the Court that particular materials be produced; (d) prejudice the rights of a party to apply to the Court for further protective orders; or (e) prevent the parties from agreeing in writing to alter or waive the provisions or protections provided for herein with respect to any particular information or material.

### **Conclusion of Litigation.**

23. Within sixty (60) calendar days after final judgment in this action, including the exhaustion of all appeals, or within sixty (60) calendar days after dismissal pursuant to a settlement agreement, each party or other person subject to the terms of this Protective Order shall be under an obligation to destroy or return to the producing party all materials and documents containing Protected Information, and to certify to the producing party such destruction or return. However, outside counsel for any party shall be entitled to retain all court papers, trial transcripts, exhibits, and attorney work provided that any such materials are maintained and protected in accordance with the terms of this Protective Order.

### **Other Proceedings.**

24. By entering this Order and limiting the disclosure of information in this case, the Court does not intend to preclude another court from finding that information may be relevant and subject to disclosure in another case. Any person or parties subject to this Protective Order that may be subject to a motion to disclose another party's information designated as Protected Information pursuant to this Protective Order, shall promptly notify that party of the motion so that it may have an opportunity to appear and be heard on whether that information should be disclosed.

### **Remedies.**

25. It is Ordered by the Court that this Protective Order will be enforced by the sanctions set forth in Rule 37(b) of the Federal Rules of Civil Procedure and such other sanctions as may be available to the Court, including the power to hold parties or other violators of this Protective Order in contempt. All other remedies available to any person(s) injured by a violation of this Protective Order are fully reserved.

26. Any party may petition the Court for good cause shown, in the event such party desires relief from a term or condition of this Order.

Exhibit A

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Plaintiff v. Defendant. ) Civil Action No.

**CONFIDENTIALITY AGREEMENT FOR EXPERT,  
CONSULTANT OR EMPLOYEES OF ANY PARTY**

I hereby affirm that:

Information, including documents and things, designated as "Protected Information," as defined in the Protective Order entered in the above-captioned action (hereinafter "Protective Order"), is being provided to me pursuant to the terms and restrictions of the Protective Order.

I have been given a copy of and have read the Protective Order.

I am familiar with the terms of the Protective Order and I agree to comply with and to be bound by such terms.

I submit to the jurisdiction of this Court for enforcement of the Protective Order.

I agree not to use any Protected Information disclosed to me pursuant to the Protective Order except for purposes of the above-captioned litigation and not to disclose any such information to persons other than those specifically authorized by said Protective Order, without the express written consent of the party who designated such information as confidential or by order of this Court. I also agree to notify any stenographic, clerical, or technical personnel who are required to assist me of the terms of this Protective Order and of its binding effect on them and me.

I understand that I am to retain all documents or materials designated as or containing Protected Information in a secure manner, and that all such documents and materials are to remain in my personal custody until the completion of my assigned duties in this matter, whereupon all such documents and materials, including all copies thereof, and any writings prepared by me containing any Protected Information are to be returned to counsel who provided me with such documents and materials.

Exhibit B

IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Plaintiff v. Defendant. ) Civil Action No.

**CONFIDENTIALITY AGREEMENT FOR THIRD-PARTY VENDORS**

I hereby affirm that:

Information, including documents and things, designated as "Protected Information," as defined in the Protective Order entered in the above-captioned action (hereinafter "Protective Order"), is being provided to me pursuant to the terms and restrictions of the Protective Order.

I have been given a copy of and have read the Protective Order.

I am familiar with the terms of the Protective Order and I agree to comply with and to be bound by such terms.

I submit to the jurisdiction of this Court for enforcement of the Protective Order.

I agree not to use any Protected Information disclosed to me pursuant to the Protective Order except for purposes of the above-captioned litigation and not to disclose any such information to persons other than those specifically authorized by said Protective Order, without the express written consent of the party who designated such information as confidential or by order of this Court.

## APPENDIX LPR 2.2a

### Prosecution Bar

Absent written consent from the producing party, any individual (including in-house counsel and outside counsel) who reviews Confidential Attorney Eyes Only Information relating to the producing party's technical or scientific information (as opposed to financial, marketing, or other types of information not related to the technical subject matter of the patents in suit) ("Technical Confidential Attorney Eyes Only Information") or Highly Confidential—Source Code Information shall not be involved in the prosecution of patents or patent applications relating to [\_\_\_\_\_(insert subject matter)\_\_\_\_\_], including without limitation the patents asserted in this action and any patent or application claiming priority to or otherwise related to the patents asserted in this action, before any foreign or domestic agency, including the United States Patent and Trademark Office. For purposes of this paragraph, "prosecution" includes directly or indirectly drafting, amending, advising, or otherwise affecting the scope or maintenance of patent claims. To avoid any doubt, "prosecution" as used in this paragraph does not include representing a party challenging a patent before a domestic or foreign agency (including, but not limited to, a reissue protest, ex parte reexamination, inter partes reexamination, or other similar proceeding). This Prosecution Bar shall begin when the Technical Confidential Attorney Eyes Only Information or Highly Confidential—Source Code Information is first reviewed by the affected individual and shall end [\_\_\_ months/years] after final termination of this action, including appeals.

Documents and things produced during the course of this litigation that contain Technical Confidential Attorneys Eyes Only Information should be designated by the producing party as containing Technical Confidential Attorneys Eyes Only Information by placing on each page and each thing a legend substantially as follows:

**TECHNICAL CONFIDENTIAL ATTORNEYS EYES ONLY INFORMATION  
SUBJECT TO PROTECTIVE ORDER AND PROSECUTION BAR**

## APPENDIX LPR 4.2

JOINT DISPUTED CLAIM TERMS CHART\*\*Plaintiff v. Defendant, Civ. Action No. 00-000-XXX

Disputed Claim Term	Plaintiff Proposed Construction	Plaintiff Citation To Intrinsic Evidence	Defendant Proposed Construction	Defendant Citation To Intrinsic Evidence
1. "Term 1"				
2. "Term 2"				
3. "Term 3"				
4. "Term 4"				

\*\* This chart shall not contain legal argument.