



WHITE PAPER

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Tenth Anniversary Update: Annotated Local Patent Rules for the Northern District of Illinois

Ten years ago, in an effort to create greater predictability for patent litigation in the Northern District of Illinois, the District enacted Local Patent Rules (“LPR”).¹ This annotated version of the LPRs is released in honor of the 10th anniversary of the LPRs. In the 10 years since the District enacted LPRs, a substantial body of case law has been developed interpreting and applying the rules. This annotated version of the LPRs collects decisions interpreting and applying the Rules from October 1, 2009, up through September 30, 2019. After reciting each rule, we provide citations to opinions that have applied the rule, along with a relevant quote from the opinion and an explanatory heading.

We hope the annotated LPRs are a valuable resource to the judges, parties, and attorneys involved in patent litigation in the Northern District of Illinois. Of course, the LPRs and these annotations should be read in conjunction with the Northern District of Illinois Local Rules as well as any applicable rules or standing orders particular to each judge.

Although local patent rules from other jurisdictions were considered in drafting the Northern District’s LPRs, the LPRs differ from other local patent rules in several important respects.

1. On March 1, 2013, the Northern District amended the LPRs; the LPRs were further amended on October 26, 2018.

PROTECTIVE ORDER

The LPRs include a default protective order that automatically takes effect upon initiation of a lawsuit. (LPR 1.4, Appendix B.) The purpose of this default protective order is to facilitate the early disclosures required by the LPRs without any delay that may otherwise result from the parties' negotiation of a protective order. The parties may seek to modify the default protective order for good cause, but the filing of such a motion does not affect the parties' early disclosure obligations under the LPRs.

INITIAL DISCLOSURES

Fourteen days after an accused infringer files an answer or otherwise responds to the complaint, the parties must exchange initial disclosures. (LPR 2.1.) For patentees, these disclosures include documents relating to: (i) the on-sale bar; (ii) conception and reduction to practice (for pre-AIA patents); (iii) the communications with the Patent and Trademark Office for each patent-in-suit; and (iv) ownership of the patent rights.

For accused infringers, these disclosures include: (i) documents sufficient to show the operation and construction of all aspects or elements of each accused instrumentality identified with specificity in the complaint; (ii) each item of prior art of which the party is aware that allegedly anticipates or renders the patent claims obvious; and (iii) a statement of the gross sales revenue from the accused products for the shorter of a six-year period preceding the filing of the complaint, or from the date of issuance of the patent. In a departure from many other local patent rules, the Northern District of Illinois requires that the accused infringer's initial disclosures occur *before* the patentee provides its initial infringement contentions.

FACT DISCOVERY

The LPRs provide for potentially two stages of fact discovery. (LPR 1.3.) The first stage commences on the date of the initial disclosures and ends one week before the opening claim construction brief is due. Upon entry of the claim construction ruling, a party may move the court for a second stage of fact discovery if necessitated by the claim construction ruling.

INITIAL CONTENTIONS

The patentee must serve its Initial Infringement Contentions within 14 days of the initial disclosures. (LPR 2.2.) Then, within 14 days, the accused infringer must submit its Initial Non-Infringement, Invalidity, and Unenforceability Contentions. (LPR 2.3.) The Initial Non-Infringement Contentions must contain a chart responsive to the patentee's Infringement Contentions that identifies whether each claim element is present in each accused instrumentality, and, if it is not, the reason for the denial. The Initial Unenforceability Contentions must identify the acts that allegedly support and all bases for the unenforceability assertion. The October 2018 amendment limited the number of asserted claims to 25 per patent and 50 total, and added a requirement for § 101 invalidity contentions.

Similarly, within 14 days after service of the accused infringer's Initial Contentions, the patentee must serve a response to the contentions. (LPR 2.5.) The response must contain a chart that identifies whether each claim element is present in the prior art, and, if it is not, the reason for the denial. If the patentee is asserting infringement under the doctrine of equivalents, the patentee must include an initial explanation of each function, way, and result that is equivalent and why any differences are not substantial, to the extent not previously provided.

FINAL CONTENTIONS

While the LPRs provide for the exchange of Initial Contentions to enable the parties to focus on the contested issues from an early stage of litigation, the LPRs also provide for the exchange of Final Contentions after the parties have had an opportunity to engage in discovery. To that end, 19 weeks after the service of the Initial Infringement Contentions, any party asserting infringement must serve a list on all parties identifying no more than 10 claims per patent and 20 claims overall. (LPR 3.1.) Two weeks later, any party asserting patent infringement must serve its Final Infringement Contentions limited to 10 claims per patent and 20 claims overall.

The Final Unenforceability and Invalidity Contentions cannot rely on more than 25 prior art references unless ordered by the court upon a showing of good cause and absent unfair prejudice. Further, the accused infringer is limited to four prior

art grounds per claim and four non-prior art grounds per claim. Twenty-eight days after the service of Final Contentions, the patentee must serve its response to the Final Unenforceability and Invalidity Contentions, and the accused infringer must serve its response to the Final Infringement Contentions. (LPR 3.2.) The Final Contentions may be amended only with leave of court upon a showing of good cause and the absence of unfair prejudice. (LPR 3.4.)

CLAIM CONSTRUCTION

Within 14 days after service of the responsive Final Contentions, the parties must simultaneously exchange a list of the claim terms they contend should be construed along with proposed constructions for such terms. (LPR 4.1.) The parties must then meet and confer to agree upon no more than 10 claim terms to submit for construction. If the parties cannot agree on these 10 terms, each side is allocated five terms. More than 10 terms may be presented only with prior approval by the court based upon a showing of good cause.

Thirty-five days after the exchange of claim terms, the *accused infringer* files the opening claim construction brief. (LPR 4.2.) The patentee then files a response brief, and the accused infringer files the reply brief. In contrast to local patent rules in other jurisdictions, the Northern District of Illinois scheduled briefing in this sequence based on the view that there would be a more meaningful exchange of contested points if the patentee, who often argues for a “plain meaning” or no construction of disputed claim terms, did not file the opening brief. (Comment to LPR 4.2.)

In addition, attorneys should be aware that the LPRs require the parties to exchange demonstratives and exhibits to be used at the *Markman* hearing no later than three days before the hearing. (LPR 4.3.)

2013 AMENDMENTS

In March 2013, the Northern District of Illinois adopted various amendments to the LPRs. The most notable changes included a clarification to LPR 1.3 that fact discovery does not resume as a matter of right following a claim construction ruling. Instead, the party seeking additional discovery after claim

construction must submit a motion explaining why further discovery is necessitated by the claim construction ruling.

In addition to amending specific LPRs, the Northern District of Illinois amended the rules in 2013 to include Local Patent Rules for Electronically Stored Information (“ESI”). The [Northern District of Illinois Local Patent Rules for ESI](#) are based on the Seventh Circuit’s Electronic Discovery Pilot Program Principles and the Federal Circuit’s Model Order on E-Discovery (which has since been removed from the Federal Circuit’s website).

Some notable aspects of the Northern District of Illinois Local Patent Rules for ESI include LPR ESI 2.6(d)-(e), which provide that the default for email discovery is five custodians per producing party and five search terms per custodian. LPR ESI 2.6(d)-(e) also provide that the court “shall consider contested requests for up to five additional custodians per producing party and [up to five additional search terms per custodian], upon showing a distinct need based on the size, complexity, and issues of this specific case.”

The Local Patent Rules for ESI further contemplate cost shifting in the event that a requesting party seeks discovery of a large number of custodians or search terms: “Should a party serve email production requests for additional custodians [or search terms] beyond the limits agreed to by the parties or granted by the Court pursuant to this paragraph, the requesting party shall bear all reasonable costs caused by such additional discovery.” (LPR ESI 2.6(d)-(e).) Similarly, the ESI rules provide for cost shifting when the requesting party seeks documents produced in a format that is not the most convenient for the responding party: “If a party requests production in a format other than the one most convenient for the producing party, the requesting party is responsible for the incremental cost of creating its copy of requested information.” (LPR ESI 2.5(e).)

2018 AMENDMENTS

In October 2018, the Northern District of Illinois adopted various amendments to the LPRs. The most notable changes include a rewrite of LPR 3.1 Final Contentions, updates to reflect differences between pre-AIA (America Invents Act) and post-AIA patent law, and limits to the number of asserted claims and prior art references.

The 2018 amendments to the rules regarding initial disclosures and contentions seek to streamline and speed up litigation. LPR 2.1 was modified to require that the accused infringer provide a statement of the gross sales revenue from the accused products before the patent owner serves its initial infringement contentions. LPR 2.2 now limits the initial infringement contentions to 25 claims per patent and 50 claims total. Further, LPR 2.3 limits the accused infringer's initial invalidity contentions to 25 prior art references and expressly dictates that "[c]onclusory denials are not permitted" in the accused infringer's Initial Non-Infringement Contentions.

The 2018 amendments to LPR 3.1 require that the patent owner narrow its list of asserted claims in its Final Infringement Contentions to no more than 10 claims per patent and no more than 20 claims overall. The amendments also added restrictions on the number of prior art references that accused infringers can rely upon in their Final Unenforceability and Invalidity Contentions. Now, an accused infringer can rely upon no more than 25 prior art references, unless ordered otherwise by the court. The amendments further limited the Final

Unenforceability and Invalidity Contentions to four prior art grounds and four non-prior art grounds per claim; "non-prior art grounds" are defined in LPR 3.1(b) as "indefiniteness, lack of written description, lack of enablement, unenforceability, and non-statutory subject matter under 35 U.S.C. § 101."

The 2018 amendments added language clarifying the applicability of pre-AIA and post-AIA patent law. For example, LPR 2.3 sets forth separate requirements for invalidity contentions based on "pre-AIA" theories under 35 U.S.C. § 102(f) and 35 U.S.C. § 102(g). Further, LPR 2.3 and 3.1 now require a detailed statement of any grounds for contentions that a claim is invalid under 35 U.S.C. § 101, to reflect the marked increase in § 101 challenges since the LPRs were first enacted. LPR 3.5 was modified such that the parties must advise the court whether each asserted patent is eligible to be challenged at the USPTO, how it might be challenged, when the patent will or has been challenged, and any other prior litigations. Finally, the LPRs modified other dates and filing requirements regarding discovery and expert witnesses.

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PREAMBLE

These Local Patent Rules provide a standard structure for patent cases that will permit greater predictability and planning for the court and the litigants. These Rules also anticipate and address many of the procedural issues that commonly arise in patent cases. The court's intention is to eliminate the need for litigants and judges to address separately in each case procedural issues that tend to recur in the vast majority of patent cases.

The Rules require, along with a party's disclosures under Federal Rule of Civil Procedure 26(a)(1), meaningful disclosure of each party's contentions and support for allegations in the pleadings. Complaints and counterclaims in patent cases often need fact discovery to flesh out the basis for each party's contentions. The Rules require the parties to provide the particulars behind allegations of infringement, non-infringement, and invalidity at an early date. Because Federal Rule of Civil Procedure 11 requires a party to have factual and legal support for allegations in its pleadings, early disclosure of the basis for each side's allegations will impose no unfair hardship and will benefit all parties by enabling a focus on the contested issues at an early stage of the case. The Rules' supplementation of the requirements of Rule 26(a)(1) and other Federal Rules is also appropriate due to the various ways in which patent litigation differs from most other civil litigation, including its factual complexity; the routine assertion of counterclaims; the need for the court to construe, and thus for the parties to identify, disputed language in patent claims; and the variety of ways in which a patent may be infringed or invalid.

The initial disclosures required by the Rules are not intended to confine a party to the contentions it makes at the outset of the case. It is not unusual for a party in a patent case to learn additional grounds for claims of infringement, non-infringement, and invalidity as the case progresses. After a reasonable period for fact discovery, however, each party must provide a final statement of its contentions on relevant issues, which the party may thereafter amend only "upon a showing of good cause and absence of unfair prejudice, made in timely fashion following discovery of the basis for the amendment." LPR 3.4.

The Rules also provide a standardized structure for claim construction proceedings, requiring the parties to identify and exchange position statements regarding disputed claim

language before presenting disputes to the court. The Rules contemplate that claim construction will be done, in most cases, toward the end of fact discovery. The committee of lawyers and judges that drafted and proposed the Rules considered placing claim construction at both earlier and later spots in the standard schedule. The decision to place claim construction near the end of fact discovery is premised on the determination that claim construction is more likely to be a meaningful process that deals with the truly significant disputed claim terms if the parties have had sufficient time, via the discovery process, to ascertain what claim terms really matter and why and can identify (as the Rules require) which are outcome determinative. The Rules' placement of claim construction near the end of fact discovery does not preclude the parties from proposing or the court from requiring an earlier claim construction in a particular case. This may be appropriate in, for example, a case in which it is apparent at an early stage that the outcome will turn on one claim term or a small number of terms that can be identified without a significant amount of fact discovery.

Finally, the Rules provide for a standardized protective order that is deemed to be in effect upon the initiation of the lawsuit. This is done for two reasons. First, confidentiality issues abound in patent litigation. Second, early entry of a protective order is critical to enable the early initial disclosures of patent-related contentions that the Rules require. Absent a "default" protective order, the making of initial disclosures, and thus the entire schedule, would be delayed while the parties negotiated a protective order. The parties may, either at the outset of the case or later, seek a revised protective order that is more tailored to their case. Because, however, the Rules provide for automatic entry of the default protective order, the desire to negotiate a more tailored version is not a basis to delay the disclosure and discovery schedule that the Rules contemplate.

Annotations

1. Rules Require Parties to Crystallize Theories Early in the Case

"The local rules intend initial infringement contentions to provide early, fair notice of the plaintiff's theories of infringement.... Initial infringement contentions must meet a notice pleading standard which is meant to prevent 'shifting sands' gamesmanship in claim construction.... Parties must offer 'meaningful' and 'nonevasive' disclosures, not just boilerplate

language. N.D. ILL. L.P.R. 2.0 cmt.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *5 (N.D. Ill. May 9, 2017) (Kendall, J.).

“The purpose of these patent rules is to prevent a ‘shifting sands’ approach to claim construction by forcing the parties to crystallize their theories of the case early in litigation.... Specifically, the purpose of infringement contentions is to provide notice of the plaintiff’s theories of infringement early in the case because, in practice, it is difficult to obtain such information through traditional discovery means, such as interrogatories.” *Sloan Valve Co. v. Zurn Indus.*, 2012 U.S. Dist. LEXIS 176554, *6-7 (N.D. Ill. Dec. 13, 2012) (St. Eve, J.).

“The purpose of modern discovery is to assist in reaching a truthful result by eliminating what has aptly been called ‘trial by ambush.’ [] While patent cases are not exempt from this basic principle, because of their specialized and often arcane nature, the search for truth and comprehensibility is often perceived as more elusive than in other kinds of litigation. Thus, courts in this District and throughout the Nation have created Local Patent Rules to govern procedures in patent cases. These Rules were designed to reduce costs. [] These, of course, are interactive goals that require the parties to crystallize their theories of the case early in the litigation so as to prevent the ‘shifting sands’ approach to claim construction. [] Thus, under LPR 2.2–2.5, a party must ‘identify the likely issues in the case’ so that each side will be able to focus and narrow their discovery requests. Fairness and common sense dictate that disclosures must be ‘meaningful—as opposed to boilerplate—and non-evasive.’ []. The same is true of defenses. The Rules were not intended to create or tolerate clever loopholes. [] See LPR 1.6; 2.0.3.” *Wimo Labs v. Polyconcept*, 358 F. Supp.3d 761, 762-763 (N.D. Ill. Mar. 6, 2019). (Cole M.J.).

2. Expedited Claim Construction Schedule Likely to Be Rejected if It Will Not Lead to an Early Disposition

“The Preamble ... provides that the Court may consider requiring an early claim construction, particularly in a case where the outcome could depend on a single claim term or a few terms which could be identified with little discovery necessary.... In a case such as this one, with multiple defendants, and 176 asserted claims across 6 patents, to have an expedited claim construction schedule would not be prudent. It is unlikely that an expedited claim construction briefing schedule

and hearing would lead to greater efficiencies in the case; rather, it would force the parties to make claim construction arguments without adequate discovery or time to develop their arguments.... [I]t is unlikely that an expedited claim construction would lead to an early disposition of the case.” *Helperich Patent Licensing, L.L.C. v. New York Times Co.*, 2012 U.S. Dist. LEXIS 160804, *4-5 (N.D. Ill. Nov. 8, 2012) (Darrah, J.).

3. The Local Patent Rules Do Not Supplant the Pleading Standards Set Forth by the U.S. Supreme Court in *Twombly* and *Iqbal*

“It makes little sense that a plaintiff could plead infringement as to one patent claim and then proceed in the litigation with respect to every other materially different claim in the patent.... The Court emphasizes that a plaintiff need not necessarily address each asserted patent claim individually in the complaint. Where two claims are materially the same, sufficient allegations as to one claim are enough to support the other. A complaint need not adhere to rigid formalism. The point is that a plaintiff cannot adequately plead infringement of a patent claim if it fails to allege anything about a particular claim limitation.... Such a result sidesteps *Twombly* and *Iqbal*’s plausibility requirements, up-ends the notice-pleading requirements that remain in place post-*Twombly*, subjects the defendant to potentially unnecessary and unwarranted discovery costs, and wastes judicial resources by preventing Rule 12(b)(6) motions from narrowing the focus of the case to issues for which the plaintiff has shown it has a plausible chance of success. While the local rules in this district require plaintiffs to eventually identify each patent claim that the defendant allegedly infringed and identify where each element of each asserted claim is found in the Accused Products, see N.D. Ill. Local Patent R. 2.2, 3.1, [Plaintiff] does not identify any reason why these local rules would excuse it from the normal pleading requirements of Rule 8 that apply regardless of a federal case’s subject matter.... In addition, plaintiffs should have no problem pleading facts related to each asserted patent claim given their obligations under Federal Rule of Civil Procedure 11(b). In other words, [Plaintiff] should already know the basis for its allegations concerning *all* of its asserted claims.... In short, *Twombly* and *Iqbal* require plaintiffs to plead sufficient facts supporting their infringement allegations with respect to each asserted patent claim.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *10-11 n.7 (N.D. Ill. Mar. 31, 2017) (St. Eve, J.).

“There is no question that the counterclaims and affirmative defenses in question are, as [Plaintiff] describes them, ‘bare bones’ and do not satisfy the plausibility standards set forth by the Supreme Court’s opinions in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007), and *Ashcroft v. Iqbal*, 556 U.S. 662 (2009)... [T]his District’s local rules cannot supplant the standard for pleading claims (and counterclaims) required by the Federal Rules of Civil Procedure and the case law interpreting them—namely, in this context, Rule 8(a) and the plausibility standard it incorporates. Those standards do not vary based on the type of case; ‘the federal rules reject the notion that certain actions inherently carry a different pleading burden than others.’ 5 Charles Alan Wright & Arthur R. Miller, *Federal Practice and Procedure* §1221 (3d ed. 2004). [Defendants’] argument that patent cases should be excepted from application of the plausibility standard simply cannot stand in light of the Court’s confirmation in *Iqbal* that ‘*Twombly* expounded the pleading standard for all civil actions.’ 556 U.S. at 684.” *Tactical Medical Solutions v. Karl*, No. 14-cv-06035, at *1-2 (N.D. Ill. Sep. 21, 2015) (Tharp, J.).

4. Boilerplate Invalidity Affirmative Defenses Permitted Because Fleshed Out in Invalidity Contentions

“Defendant does not object to striking its first, second, eleventh, and sixteenth affirmative defenses. These are stricken with prejudice because they generally repeat defendant’s denials of the complaint’s allegations and thus are not proper affirmative defenses. The same is not true, however, of defendant’s third, fourth, fifth, and sixth affirmative defenses, all of which assert patent invalidity—an appropriate affirmative defense, see *Cornwall v. U.S. Const. Mfg., Inc.*, 800 F.2d 250 (Fed. Cir. 1986) (defense of patent invalidity is an affirmative defense)—on various statutory grounds. While it is true that these affirmative defenses are pled in boilerplate fashion, that is not unusual in patent cases, since the Local Patent Rules specifically provide for fleshing out the factual basis for invalidity defenses. Allowing these affirmative defenses to pend while the litigation pursues its course does not ‘clutter’ the pleadings unnecessarily.” *Arroweye Solutions, Inc. v. Harry & David Operations, Inc.*, No. 15-cv-11524, at *2 (N.D. Ill. Sep. 8, 2016) (Bucklo, J.).

5. Patent Owner’s Withdrawal of Asserted Patent Claims in Infringement Contentions can Divest Court of Jurisdiction Over Those Withdrawn Claims

“*Streck [Streck, Inc. v. Research & Diagnostic Sys., Inc.]*, 658 F. Supp. 2d 988 (D. Neb. 2009) illustrates that narrowing patent litigation to asserted claims pursuant to local patent rules

can appropriately limit the court’s reach over other unasserted claims in the patent, even if those claims were at issue when the plaintiff filed its original complaint. Under that principle, the fact that the original complaint in this case alleged that both patents were infringed, without specifying particular claims, does not require the conclusion that all claims in the patent remain at issue throughout the litigation. Under *Streck*, effectively withdrawing some claims by refusing to assert them is tantamount to voluntarily withdrawing a cause of action.” *Joao Control & Monitoring Sys., LLC v. Telular Corp.*, No. 14-cv-09852, at *7-8 (N.D. Ill. Mar. 28, 2017) (Pallmeyer, J.).

I. SCOPE OF RULES

LPR 1.1 Application and Construction

These Rules (“LPR”) apply to all cases filed in or transferred to this District after September 24, 2009, in which a party makes a claim of infringement, non-infringement, invalidity, or unenforceability of a utility patent. The court may modify the obligations and deadlines of the LPR based on the circumstances of any particular case. If a party files, prior to the Claim Construction Proceedings provided for in LPR Section 5, a motion that raises claim construction issues, the court may defer the motion until after the Claim Construction Proceedings.

Annotations

1. LPRs Do Not Apply to Design Patent Cases

“The Local Patent Rules do not by their terms apply to design patent cases ... and there is no reason to impose a schedule of that length and complexity in this present case.” *Colida v. Panasonic Corp.*, 2010 U.S. Dist. LEXIS 98574, *4-5 (N.D. Ill. Sept. 20, 2010) (Kennelly, J.).

2. LPRs Do Not Apply to False Marking Cases

“By their terms, the Local Patent Rules do not apply to false-marking cases.” *Zojo Solutions, Inc. v. Leviton Mfg. Co.*, 2010 U.S. Dist. LEXIS 112370, *9 (N.D. Ill. Oct. 20, 2010) (Grady, J.).

3. LPRs Do Not Apply Retroactively

“The court also rejects [Plaintiff’s] request that the court apply the Local Patent Rules retroactively to [Defendant], thereby creating ‘deadlines’ for [Defendant’s] initial and final contentions that had already come and gone by the time the Local Patent

Rules went into effect. The court agrees with [Defendant] that '[s]uch a scenario is patently ridiculous.'" *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 101008, *26 (N.D. Ill. July 19, 2012) (Holderman, C.J.).

"The Court recognizes that the local patent rules were drafted by practicing patent lawyers and experienced district court judges. The LPR provide helpful guidance regarding the types of issues which frequently arise in patent case, but the LPR do not automatically apply here. The LPR apply to cases 'filed in or transferred to [the Northern District of Illinois] after their effective date [of October 1, 2009].' [This case] was filed on June 9, 2008. Judge Hibbler entered the current protective order which does not include [Defendant's] requested language on February 24, 2009, seven months before the LPR were effective. While it is true that the Court has authority to apply all or part of the LPR to already pending cases (LPR 1.1), the Court declines to do so here where the provisions [Defendant] seeks were specifically rejected by Judge Hibbler and [Defendant] has not identified any new specific concerns or reasons for the protection it seeks." *Memorylink Corp. v. Motorola Solutions, Inc.*, 1-08-cv-03301 (N.D. Ill. July 29, 2010) (Nolan, M.J.).

4. The Court May Modify Requirements of the LPRs

"[T]he court suspends the default requirements of the Local Patent Rules while the parties conduct initial discovery focusing on damages and indirect infringement issues." *In re Innovatio IP Ventures, LLC, Patent Litigation*, No. 11-cv-09308 (N.D. Ill. Sept. 18, 2014) (Holderman, J.).

5. Summary Judgment Deferred Until After Claim Construction

"This district's local rules create a standardized procedural framework for the disposition of patent cases, and local patent rule 1.1 provides that when a party in a patent case files a motion that requires claim construction prior to the claim construction hearing dictated by the rules, the court may defer the motion until after the hearing.... [T]he court finds that [Defendant's] assertion of non-infringement requires construction of plaintiff's patent claim. The court concludes that the analysis of both claim construction and non-infringement contentions are most appropriately conducted in accordance with the rules of the district. Defendant's motion for summary judgment is accordingly denied without prejudice to its right to renew the motion following claim construction proceedings." *Lucas-Milhaupt, Inc. v. Bellman-Melcor, LLC*, No. 11-cv-07557 (N.D. Ill. Sept. 28, 2012) (Coleman, J.).

6. Summary Judgment Adjudicated in Conjunction with Claim Construction

"An early summary judgment motion in a patent case makes sense if there is a reasonable possibility that the case can be resolved without the expense of discovery, including expert discovery, and if it will be a simple matter to construe the claims. In this case, there appear to be few terms that will need to be construed and the Federal Circuit has defined at least two of them.... I understand that the nature of this case makes it different from the usual patent case to which we apply our local patent rules, and that the opposing sides have very different interests in the speed at which this case can be resolved. Therefore, any party that wishes to file a motion for summary judgment shall do so by December 31, 2012.... That will also be the date on which defendants' claim construction briefs shall be filed. I assume all discovery, including expert discovery shall be completed before that date." *Forest Labs, Inc. v. Indchemie Health Specialties PVT. LTD.*, No. 12-cv-01855 (N.D. Ill. June 22, 2012) (Bucklo, J.).

LPR 1.2 Initial Scheduling Conference

In their conference pursuant to Fed. R. Civ. P. 26(f), the parties must discuss and address those matters found in the form scheduling order contained in LPR Appendix "A." A completed proposed version of the scheduling order is to be presented to the court within seven days after the Rule 26(f) conference or at such other time as the court directs. Paragraphs 4(e), 7(c) and 7(d) of the form scheduling order shall be included, without alteration, in this proposed scheduling order.

Annotations

1. Proposed Scheduling Order Must Be Submitted Before Initial Scheduling Conference

"The Court strikes the status hearing ... because of the parties failure to comply with this Court's standing order regarding initial status conferences. The parties are to refer to the Court's standing order and file an initial status report and they should also refer to the Local Patent Rules." *Nalco Co. v. Ashland Inc.*, No. 13-cv-07332 (N.D. Ill. May 5, 2014) (Zee, J.).

LPR 1.3 Fact Discovery

Fact discovery shall commence upon the date for the Initial Disclosures under LPR 2.1 and shall be completed 28 days after the date for exchange of claim terms and phrases under LPR 4.1. Fact discovery may resume upon entry of a claim

construction ruling and shall end 42 days after entry of the claim construction ruling.

Comment by N.D. Illinois

The Rule states that resumption of fact discovery upon entry of a claim construction ruling “may” occur. The Rule does not provide that discovery shall automatically resume as a matter of right. It is intended that parties seeking further discovery following the claim construction ruling shall submit a motion explaining why further discovery is necessitated by the claim construction ruling.

Annotations

1. Resumption of Fact Discovery After Claim Construction Is Not a Matter of Right

“Local Patent Rule 1.3 required fact discovery to be completed by February 28, 2017. Both parties evidently operated under a misunderstanding and anticipated doing a good deal of fact discovery after the not-yet-made claim construction ruling. But Rule 1.3 is clear on its face; it requires fact discovery to be completed ‘twenty-eight (28) days after the date for exchange of claim terms and phrases under LPR 4.1.’ N.D. Ill. LPR 1.3. Rule 1.3 says that fact discovery ‘may resume’ for a brief period—6 weeks—after a ruling on claim construction, but the comment to that rule makes it crystal clear that discovery does not ‘automatically resume as a matter of right’ but rather that any party seeking further discovery after the claim construction ruling must submit a motion explaining why the court’s ruling on claim construction necessitates further discovery.” *Riddell, Inc. v. Kranos Corp.*, No. 16-cv-04496, at *7 (N.D. Ill. Mar. 12, 2017) (Kennelly, J.).

“The Court’s ... scheduling order [tracking the language of the LPRs] did not provide for automatic reopening of discovery following a claim construction ruling. Specifically, the order does not state that fact discovery ‘will resume’ or ‘shall resume’ after a claim construction ruling. Rather, the order states that ‘[f]act discovery *may resume* upon entry of a claim construction ruling and shall end forty-two (42) days after entry of the claim construction ruling.’ ... The use of the word ‘may’ was intended to communicate that reopening of fact discovery was a possibility, not an absolute certainty.” *Illinois Computer Research, LLC v. Harpo Prods., Inc.*, 2010 WL 2136665, *4 (N.D. Ill. May 26, 2010) (Kennelly, J.).

2. Parties May Agree to Conduct Fact Discovery After Claim Construction Ruling

“Fact discovery shall resume after the issuance of any claim construction ruling and shall end 42 days after issuance of a claim construction decision.” *National Steel Car Ltd. v. Freightcar America, Inc.*, 15-cv-03418 (N.D. Ill. Jul. 16, 2015) (Zagel, J.).

“It is true that Local Patent Rule 1.3 generally contemplates a motion to restart post-construction fact discovery, and generally the post-construction recovery should be related to issues (if any) that arise from the construction. But very often (at least in the Court’s experience) the parties agree early-on to that restart period, as the parties here agreed; the parties then agreed to a specific deadline of December 1, 2014, R. 238. So the absence of a formal Rule 1.3 order is not a fatal problem.” *Weber-Stephen Products, Inc. v. Sears Holding Corp.*, 13-cv-01686 (N.D. Ill. Dec. 27, 2014) (Chang, J.).

3. After Claim Construction Ruling, Discovery Is for Limited Purposes

“The LPR and the scheduling order in this case provide that fact discovery ‘may’ reopen for six weeks (forty-two days) after the court rules on claim construction. The primary purpose of this is to deal with unanticipated points that may have arisen due to the court’s claim construction ruling. This narrow focus is why the LPR and the scheduling order in this case contemplated only for a brief period to reopen fact discovery if otherwise appropriate—six weeks, a small fraction of the time allowed for fact discovery prior to the outset of the claim construction process.” *Illinois Computer Research, LLC v. Harpo Prods., Inc.*, 2010 WL 2136665, *5 (N.D. Ill. May 26, 2010) (Kennelly, J.).

“[Defendant] argues that it is ‘more efficient to seek discovery of people connected to prior art after claim construction.’ ... But that is directly contrary to the scheme set forth in the LPR and the scheduling order in this case, which required [defendant] to set out its final invalidity contentions (including identification of prior art) many weeks before claim construction.” *Illinois Computer Research, LLC v. Harpo Prods., Inc.*, 2010 WL 2136665, *11 (N.D. Ill. May 26, 2010) (Kennelly, J.).

LPR 1.4 Confidentiality

The protective order found in LPR Appendix B shall be deemed to be in effect as of the date for each party’s Initial Disclosures.

Any party may move the court to modify the Appendix B protective order for good cause. The filing of such a motion does not affect the requirement for or timing of any of the disclosures required by the LPR.

Annotations

1. “Good Cause” Requires Movant to Establish that Disclosure of Confidential Information Will Cause a Clearly Defined and Serious Injury

“[Defendant] has not met its burden to show good cause for its proposed modification of the Protective Order. ‘Good cause is established by showing that the disclosure will cause a clearly defined and serious injury.’ ... To establish good cause under Rule 26(c), the moving party must present a ‘particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.’ ... [Defendant’s] arguments are vague and speculative, and [Defendant] fails to identify a ‘clearly defined and serious injury.’ [Defendant] bases its argument on its need to protect its ‘most sensitive forward-looking secret competition information’ but does not identify any specific information that would cause it injury if disclosed.... [Defendant] both fails to provide any particular and specific demonstrations of its ‘product development information’ and does not expound on how [Defendant’s] product development information could be claimed by [Plaintiff] in a patent application.” *AmTab Mfg. Corp. v. SICO Inc.*, 2012 U.S. Dist. LEXIS 7307, *5-6 (N.D. Ill. Jan. 19, 2012) (Darrah, J.).

2. No Per Se Rule Barring Disclosure of Confidential Information to In-House Counsel

“Courts have rejected a *per se* rule barring the disclosure of confidential information to in-house counsel or other parties.... Instead, courts look to whether in-house counsel is involved in competitive decisionmaking that would create a risk of inadvertent disclosure.... [Defendant] has not cited any evidence to support the conclusion that [Plaintiff’s] in-house counsel is involved in competitive decisionmaking at [Plaintiff]. Rather, [Defendant] states generally that [Plaintiff] has six in-house patent attorneys, at least two of whom are involved in this litigation, and that [Plaintiff] appears to have hundreds of assigned patents relating to cheese food products. [Plaintiff’s] proposed modification to allow in-house counsel to review Highly Confidential information will be accepted.” *Kraft Foods Global, Inc. v. Dairilean, Inc.*, 2011 U.S. Dist. LEXIS 44279, *13 (N.D. Ill. Apr. 25, 2011) (Lefkow, J.).

3. Disclosure of Expert or Consultant Identities to Whom Confidential Information Will Be Shared Is Required

“Section 4(d) of the default LPR protective order requires that parties disclose the identity and curriculum vitae of any expert or consultant before sharing another party’s confidential information or materials with that expert. N.D. Ill. L.P.R. App. B at 6. Plaintiff proposes to eliminate this requirement.... The Court does not find good cause for Plaintiff’s proposed modification. First, Plaintiff has not identified anything unique about this case that justifies eliminating section 4(d)’s disclosure requirement.... Second, Plaintiff’s proposal would undermine the obvious purpose of section 4(d)’s disclosure requirement, which is to allow a producing party to ascertain for itself whether disclosure of its confidential information to another party’s expert may be improper and object to the disclosure if needed.... The Court therefore rejects this proposed modification.” *Lecat’s VentriloScope v. MT Tool & Mfg.*, No. 16-cv-05298, at *4-6, *11 (N.D. Ill. Jan. 20, 2017) (Castillo, C.J.).

“The default Local Patent Rule protective order provides, and Weber acknowledges, that Sears need only disclose the identity of non-testifying experts if Sears intends to give those experts Weber[’s] confidential and trade secret information. In light of the importance of protecting the confidentiality of information that is covered by the protective order, the default order has struck the right balance. One side’s own investigation of the propriety of disclosure of confidential information is insufficient to protect the other side, particularly from inadvertent failures to realize that disclosure would be inappropriate.” *Weber-Stephen Prods., LLC v. Sears Holding Corp.*, 1:13-cv-01686 (N.D. Ill. May 24, 2013) (Chang, J.).

4. Prosecution Bar Considered on Facts of Each Case

“[Defendant] has not met its burden to show good cause for its proposed modification of the Protective Order. Mavrakakis is the sole manager of [Plaintiff], but he is not one of the prosecuting attorneys in the case. James Shimota, one of the actual prosecuting attorneys, was involved in a related entity in the past but is not alleged to be a current member or manager of [Plaintiff]. [Defendant] has not shown that Mavrakakis is involved in patent prosecution or that Shimota is involved in competitive decisionmaking. [Defendant] points to a prior decision of this court that found litigation attorneys to be competitive decisionmakers when they were ‘deeply involved in a [patentee’s] business decisionmaking in the area of intellectual property’ and ‘involved in representing the client in

multiple, related infringement cases.’ However, in that case, the law firm was likely to represent the patent holder ‘in the prosecution of numerous related patents ... in the context of a fluid, developing technology.’ Here there is only one patent at issue; and this area is not a fluid, developing technology. And as previously stated, [Defendant] has not shown that the litigation attorneys are involved in business decisionmaking.” *Velocity Patent, LLC v. Audi of Am., Inc.*, 2015 WL 294849, *1 (N.D. Ill. Jan. 21, 2015) (Darrah, J.).

“It is clear that [Plaintiff’s] counsel is involved in competitive decisionmaking and participates extensively in prosecuting new patent claims and defending patent reexaminations, crafting patent applications, negotiating licenses for the patents, and litigating [Plaintiff’s] patent rights in federal court.... Because of [Plaintiff’s] counsel’s extensive responsibilities and the scope of their roles in this litigation and the reexamination proceedings before the PTO ... there is an unacceptable risk of inadvertent disclosure in this litigation.... [This], however, does not end the inquiry and is not enough to justify the issuance of a patent prosecution bar.... [E]ven if the Court finds that the risk of misuse is unacceptably high, the Court still must weigh that risk against the harm that may occur from imposition of a prosecution bar, especially the prejudice from denying the patentee access to the counsel of its choice.... The risk of competitive misuse of Defendants’ confidential information, however, is outweighed by the significant harm [Plaintiff] would suffer if [Plaintiff] were denied the counsel of its choice in both its patent prosecution and the reexaminations. [Plaintiff’s] counsel has been representing [Plaintiff] in litigation in this Court and before the PTO for years, including the multiple rounds of reexaminations filed by Defendants in this case. Defendants raised the issue of a prosecution bar almost two years ago but did not seek relief from this Court until now.... The playing field would have been more level had Defendants sought relief from the Court on this issue prior to the production of Defendants’ documents. If the Court had modified the default protective order to include a prosecution bar at that time, [Plaintiff’s] counsel could have made a more informed decision about which of [Plaintiff’s] counsel should be reviewing Defendants’ documents so as to shield some of [Plaintiff’s] attorneys from any prosecution bar that may have been entered at the time.... The Court concludes that the risk of inadvertent or competitive use of Defendants’ confidential

information by [Plaintiff’s] counsel is outweighed by the significant harm that [Plaintiff] would suffer if it were denied the full benefit of its chosen counsel, particularly at this stage in the litigation in this case and given the status of the reexaminations before the PTO.” *Helperich Patent Licensing, L.L.C. v. New York Times Co.*, 2013 U.S. Dist. LEXIS 87374, *12-18 (N.D. Ill. June 21, 2013) (Gilbert, M.J.).

“This record presents no indicia of competitive decisionmaking such as participation in a client’s pricing or product design. In order to prevail [on a motion to add a prosecution bar], [movant] must rely on specific evidence—not an inflexible rule—that supports a finding of competitive decisionmaking.” *AmTab Mfg. Corp. v. SICO Inc.*, 2012 U.S. Dist. LEXIS 7307, *11 (N.D. Ill. Jan. 19, 2012) (Darrah, J.).

“[Plaintiff] has not cited any evidence to demonstrate that [Defendant’s] outside counsel is involved in competitive decisionmaking with respect to [Defendant] or any of its other clients who might compete with [Plaintiff].... Essentially, [Plaintiff] requests a prosecution bar because [Defendant’s] litigation counsel also prosecutes patents. This type of prosecution bar was squarely rejected by the Federal Circuit in *Deutsche Bank*, 605 F.3d at 1381.... [Plaintiff’s] proposed patent prosecution bar will be stricken from the protective order.” *Kraft Foods Global, Inc. v. Dairilean, Inc.*, 2011 U.S. Dist. LEXIS 44279, 12 (N.D. Ill. Apr. 25, 2011) (Lefkow, J.).

“The Federal Circuit has discouraged a *per se* bar on in-house counsel accessing confidential information disclosed by a competitor during litigation. Likewise, attorneys who litigate patent infringement, and gain access to a competitor’s confidential information, are not automatically barred from prosecuting patents for those same clients. Instead, courts analyze ‘the particular counsel’s relationship and activities’ in the company’s competitive decision making.’ ... Defendants have failed to articulate the competitive decision making that plaintiff’s counsel is involved in that would make a patent prosecution bar necessary. Defendants state only generally that there is high risk of exposing defendants’ confidential technical information without a prosecution bar and that the plaintiff is currently prosecuting two patent applications that ‘directly relate to the patents-in-suit.’” *Intellect Wireless, Inc. v. T-Mobile USA, Inc.*, 2010 WL 1912250, *2 (N.D. Ill. May 12, 2010) (Cox, M.J.).

5. Access to Highly Confidential Information May Be Denied for Failure to Specify Scope of Information Being Disclosed

"[Defendant's] motion will be denied without prejudice to its right to file a motion requesting permission for [individual] to review specific categories of [Plaintiff's] Highly Confidential documents that may be necessary for preparing his anticipated expert testimony and report." *Kraft Foods Global, Inc. v. Dairilean, Inc.*, 2011 WL 1557881, *3 (N.D. Ill. Apr. 25, 2011) (Lefkow, J.).

6. Prohibiting Retention of Another Party's Confidential Materials After Conclusion of the Case

"Sections 4(a) and 8 of the default LPR protective order allow a party to use another party's confidential materials only 'for purposes of this litigation' and require, at the conclusion of the case, the destruction or return of all confidential materials produced in this case. N.D. Ill. L.P.R. App. B at 5, 8. Plaintiff proposes to modify sections 4(a) and 8 to permit a party to retain another party's confidential materials beyond the conclusion of the case if such materials are subject to 'a preservation duty from another pending or anticipated suit.'... The Court recognizes that Plaintiff seeks only to 'avoid being stuck between a rock and a hard place,'... in the event it is subject to a subsequently arising preservation duty that implicates confidential materials it has received in this case. However, the proposed modifications to sections 4(a) and 8 would allow a party to retain another party's confidential materials long after this case concludes with no oversight by the Court or transparency to the producing party as to what is being retained, why, or for how long. This would altogether frustrate the Court's ability to effectively enforce the protective order. If, at the conclusion of this case, a party believes it is bound by a preservation duty to retain or preserve confidential materials produced to it by another party, it can raise the issue at that time and seek appropriate relief. The Court therefore rejects this proposed modification." *Lecat's Ventriloscope v. MT Tool & Mfg.*, No. 16-cv-05298, at *3-4 (N.D. Ill. Jan. 20, 2017) (Castillo, C.J.).

7. Data from Underlying Infringement Investigation May Not Be Protected by Attorney-Client Privilege or Work Product Doctrine

"The work-product doctrine does not apply to the information underlying the documents. 'In a chemical patent, there is no way to show that these elements exist in the accused product without utilizing highly technical tests performed by experts.'... Where a party needs to have test results showing

the existence of infringing ingredients in specific amounts in the opposing party's products, the production of the test results is not only relevant, but essential to the case.... Parties cannot shelter the results under attorney-client or work-product privileges.... 'Only where the document is primarily concerned with legal assistance does it come within these privileges; technical information is otherwise discoverable.'... As such, parties' initial disclosures should be meaningful. See L.P.R. [cmt.] 2. Here, [Defendant] only seeks [Plaintiff's] underlying infringement investigation data—not attorney advice or mental impressions. Therefore, [Plaintiff] can share this data with [Defendant] without revealing confidential information. The Court need not issue an order of protection. See [] Fed. R. Civ. P. 26(c)." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *11 (N.D. Ill. Apr. 24, 2017) (Kendall, J.).

LPR 1.5 Certification of Disclosures

All disclosures made pursuant to LPR 2.2, 2.3, 2.4, 2.5, 3.1, and 3.2 must be dated and signed by counsel of record (or by the party if unrepresented by counsel) and are subject to the requirements of Federal Rules of Civil Procedure 11 and 26(g).

LPR 1.6 Admissibility of Disclosures

The disclosures provided for in LPR 2.2, 2.3, 2.4, and 2.5 are inadmissible as evidence on the merits.

Comment by N.D. Illinois

The purpose of the initial disclosures pursuant to LPR 2.2–2.5 is to identify the likely issues in the case, to enable the parties to focus and narrow their discovery requests. Permitting use of the initial disclosures as evidence on the merits would defeat this purpose. A party may make reference to the initial disclosures for any other appropriate purpose.

Annotations

1. Using Contentions Permitted

"In [Plaintiff's] motion in limine, it asks the Court to bar Defendants from disavowing their initial non-infringement contentions and certain interrogatory responses. To give context, Defendants' final non-infringement contentions contradict its earlier contentions because Defendants admitted certain claim elements were not in dispute in the initial contentions. In essence, [Plaintiff] is seeking to bar Defendants from presenting their reasons for changing their contentions

as to certain claim elements. [Plaintiff] does not explain why the Court should bar this evidence under the Federal Rules of Evidence or any other relevant evidentiary standard. Instead, [Plaintiff's] motion is an attempt at narrowing Defendants' ability to defend against [Plaintiff's] infringement claim.... As discussed in the Court's December 13, 2017 in limine ruling concerning [Plaintiff's] ability to call certain attorneys as rebuttal witnesses, the fact that Defendants changed their position is relevant to Defendants' non-infringement defense. The Court will not bar Defendants from explaining why they changed their position any more than the Court will bar [Plaintiff] from discussing Defendants' initial non-infringement contentions or proffering them as evidence. As the parties are well aware, a motion in limine 'is not a proper vehicle with which to test the sufficiency of evidence.'... For these reasons, the Court, in its discretion, grants in part and denies in part [Plaintiff's] motion in limine." *Sonix Tech. Co., Ltd. v. Publ'ns Int'l.*, No. 13-cv-02082, at *2-3 (N.D. Ill. Dec. 15, 2017) (St. Eve, J.).

"In support of jurisdiction, [Defendant's] counterclaim alleges that [Plaintiff's] original complaint and initial infringement contentions assert that [Defendant] infringed the '964 patent... [Plaintiff] argues that [Defendant] cannot rely on [Plaintiff's] initial infringement contentions because Local Patent Rule 1.6 provides that initial disclosures are not admissible 'as evidence on the merits.' The comment to the rule explains, however, that '[a] party may make reference to the initial disclosures for any other appropriate purpose.' Therefore [Defendant] may reference [Plaintiff's] initial disclosures at this preliminary stage in the proceedings." *Knowles Elecs., LLC v. Analog Devices, Inc.*, 2012 U.S. Dist. LEXIS 56135, 5, n.1 (N.D. Ill. Apr. 23, 2012) (Lefkowitz, J.).

2. Using Contentions Rejected

"Nor could [Plaintiff] reasonably rely on the positions the Defendants' took in their initial non-infringement contentions as evidence of infringement. The Local Patent Rules make clear that initial disclosures are inadmissible as evidence on the merits. LPR 1.6. Their purpose is to enable the parties to identify likely issues in the case and to enable them to focus and narrow their discovery requests. They are a vehicle through which the party that bears the burden of proof on an issue provides notice of its legal theories to the other party... In turn, the party that does not have the burden of proof on an issue provides its legal theories with respect to that issue in its responsive contentions." *Northgate Techs., Inc. v. Stryker Corp.*, No. 12-cv-07032 (N.D. Ill. Dec. 16, 2013) (Kendall, J.).

"Claim construction has not yet occurred in this case, and [Plaintiff] may thus under the court's Local Patent Rules have opportunities to amend its infringement contentions. In light of those opportunities, it is inappropriate at this point in the litigation process to use [Plaintiff's] infringement contentions to pin it down to a certain position for purposes of deciding an issue related to damages, in which infringement is not at issue." *In re Innovatio IP Ventures, LLC Patent Litig.*, 956 F. Supp. 2d 925, 941 (N.D. Ill. 2013) (Holderman, C.J.).

LPR 1.7 Relationship to Federal Rules of Civil Procedure

A party may not object to mandatory disclosures under Federal Rule of Civil Procedure 26(a) or to a discovery request on the ground that it conflicts with or is premature under the LPR, except to the following categories of requests and disclosures:

- (a) requests for a party's claim construction position;
- (b) requests to the patent claimant for a comparison of the asserted claims and the accused apparatus, device, process, method, act, or other instrumentality;
- (c) requests to an accused infringer for a comparison of the asserted claims and the prior art;
- (d) requests to an accused infringer for its non-infringement contentions; and
- (e) requests to the patent claimant for its contentions regarding the presence of claim elements in the prior art.

Federal Rule of Civil Procedure 26's requirements concerning supplementation of disclosure and discovery responses apply to all disclosures required under the LPR.

Annotations

1. Parties Have a Duty to Supplement or Correct Their Initial Disclosures

"However, the LPRs anticipate that initial disclosures and discovery responses may be supplemented. LPR1.7 adopts Federal Rule of Civil Procedure 26(e)'s requirements concerning supplementation of disclosure and discovery responses. In other words, under Rule 26(e), [plaintiff] had a duty to supplement or correct its initial disclosures and responses to [defendant]'s interrogatories in a timely manner if [plaintiff]

considered the prior disclosures or responses incomplete or incorrect... The Local Patent Rules did not eliminate that duty, but adopted it. Thus, we reject [defendant]’s request to irrevocably bind [plaintiff] to its initial disclosures and contentions.” *Oil-Dri Corp. v. Nestle Purina PetCare Co.*, No. 15-cv-01067 at *5-6 (June 26, 2018) (Schenkier, M.J.).

II. PATENT INITIAL DISCLOSURES

Comment by N.D. Illinois

LPR 2.2–2.5 supplements the initial disclosures required by Federal Rule of Civil Procedure 26(a)(1). As stated in the comment to LPR 1.6, the purpose of these provisions is to require the parties to identify the likely issues in the case, to enable them to focus and narrow their discovery requests. To accomplish this purpose, the parties’ disclosures must be meaningful—as opposed to boilerplate—and non-evasive. These provisions should be construed accordingly when applied to particular cases.

LPR 2.1 Initial Disclosures

The plaintiff and any defendant that files an answer or other response to the complaint shall exchange their Initial Disclosures under Federal Rule of Civil Procedure 26(a)(1) (“Initial Disclosures”) within fourteen (14) days after the defendant files its answer or other response, provided, however, if defendant asserts a counterclaim for infringement of another patent, the Initial Disclosures shall be exchanged within fourteen (14) days after the plaintiff files its answer or other response to that counterclaim. As used in this Rule, the term “document” has the same meaning as in Federal Rule of Civil Procedure 34(a):

- (a) A party asserting a claim of patent infringement shall produce or make the following available for inspection and copying along with its Initial Disclosures, to the extent they are in the party’s possession, custody or control.
 - (1) all documents concerning any disclosure, sale or transfer, or offer to sell or transfer, of any item embodying, practicing or resulting from the practice of the claimed invention prior to the date of application for the patent in suit. Production of a document pursuant to this Rule is not an admission that the document evidences or is prior art under 35 U.S.C. § 102;

- (2) with respect to patents that are not governed by the America Invents Act (“AIA”) but instead are governed by the pre-AIA patent statute: all documents concerning 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;

- (3) all communications to and from the U.S. Patent and Trademark Office for each patent in suit and for each patent or patent application on which a claim for priority is based; and

- (4) all documents concerning ownership of the patent rights by the party asserting patent infringement.

- (b) A party opposing a claim of patent infringement shall produce or make the following available for inspection and copying, along with its Initial Disclosures:

- (1) documents sufficient to show the operation and construction of all aspects or elements of each accused apparatus, product, device, component, process, method or other instrumentality identified with specificity in the pleading of the party asserting patent infringement; and

- (2) a copy of each item of prior art of which the party is aware that allegedly anticipates each asserted patent and its related claims or renders them obvious or, if a copy is unavailable, a description sufficient to identify the prior art and its relevant details; and

- (3) a statement of the gross sales revenue from the accused product(s) (a) for the six-year period preceding the filing of the complaint or, if shorter, (b) from the date of issuance of the patent that will enable the parties to estimate potential damages and engage in meaningful settlement negotiations.

With respect to LPR 2.1 (a) and (b), each producing party shall separately identify by production number which documents correspond to each category of the corresponding LPR.

Annotations

1. Initial Disclosures Must Anticipate Possibility of Adverse Claim Construction Ruling

“[Defendant] was not entitled to hold back on its Rule 26(a) (1) disclosures on the assumption that it would win across the board on its combined claim construction / summary judgment submission. Rather, [defendant] was required to disclose, at least once it had [plaintiff’s] contentions, all witnesses that would support [defendant’s] own contentions regarding infringement and validity, irrespective of who later prevailed on claim construction. In other words, [defendant] was required to anticipate the possibility of an adverse claim construction ruling.” *Illinois Computer Research, LLC v. Harpo Prods., Inc.*, 2010 WL 2136665, *8 (N.D. Ill. May 26, 2010) (Kennelly, J.).

2. Promotional Material Insufficient When Better Information Is Available

“[Defendant’s] initial disclosures (a two-page marketing brochure and short promotion video) under Local Patent Rule 2.1(b)(1) were insufficient to allow [Plaintiff] to assess potential infringement. This Court also ruled at that time that, by its own submissions, [Defendant] had clearly demonstrated that it had in its possession or control other information that would have more clearly allowed [Plaintiff] to assess infringement but failed to turn it over.” *PACTIV Corp. v. Multisorb Techs. Inc.*, 2012 WL 1831517, *6 (N.D. Ill. May 18, 2012) (Leinenweber, J.).

3. Belated Identification of Witnesses Not Permitted as a Matter of Right

“Given the structure of the LPR as incorporated in the Court’s scheduling order, any contention that [defendant] appropriately waited until past the eleventh hour to add prior art witnesses necessarily fails—absent (perhaps) unusual circumstances that [defendant] has made no effort to show. In particular, [defendant] does not identify anything about the Court’s claim construction order that was unanticipated or that somehow made pertinent either prior art not previously identified or a not-previously-applicable invalidity/unenforceability argument.” *Illinois Computer Research, LLC v. Harpo Prods., Inc.*, 2010 WL 2136665, *7 (N.D. Ill. May 26, 2010) (Kennelly, J.).

4. Limiting Venue Discovery to the Specific Accused Instrumentalities Identified in Infringement Pleadings

“In response to [Plaintiff’s] discovery motion, [Defendant] maintains that [Plaintiff’s] discovery requests are overly-broad

because it seeks discovery about unidentified third-party software and cameras that have ‘the same or equivalent functionality’ as the software and cameras specifically identified in the Complaint.... [Defendant] argues that [Plaintiff] is not entitled to venue discovery on what [Defendant] calls the ‘unidentified instrumentalities’ because evaluating whether infringing acts occurred in the Northern District of Illinois without knowing what particular products or systems are at issue ‘is not a trivial or appropriate task.’ The Court agrees based on the federal pleading requirements and the Northern District of Illinois Patent Rules requiring an opposing party to produce documents in relation to the instrumentalities ‘identified with specificity in the pleading of the party asserting patent infringement[.]’ See N.D. Ill. Local Patent Rule 2.1(b).” *RAH Color Tech., LLC v. Quad/Graphics, Inc.*, No. 17-cv-04931, at *2-3 (N.D. Ill. Oct. 19, 2017) (St. Eve, J.).

LPR 2.2 Initial Infringement Contentions

A party claiming patent infringement must serve on all parties “Initial Infringement Contentions” containing the following information within 14 days after the Initial Disclosure under LPR 2.1:

- (a) an identification of no more than 25 claims of each patent in suit that are allegedly infringed by the opposing party, but no more than 50 claims total, including for each claim the applicable statutory subsection of 35 U.S.C. § 271;
- (b) separately for each asserted claim, an identification of each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of the opposing party of which the party claiming infringement is aware. Each Accused Instrumentality 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;
- (c) 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)/112(f), 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;
- (d) identification of whether each element of each asserted claim is claimed to be present in the Accused Instrumentality

literally or under the doctrine of equivalents. For any claim under the doctrine of equivalents, the Initial Infringement Contentions must include an initial explanation of each function, way, and result that is equivalent and why any differences are not substantial;

- (e) for each claim that is alleged to have been indirectly infringed, an identification of any direct infringement and a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement. If alleged direct infringement is based on joint acts of multiple parties, the role of each such party in the direct infringement must be described;
- (f) for any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled;
- (g) identification of the basis for any allegation of willful infringement; and
- (h) if a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own or its licensee's apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted patent, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim, including whether it is marked (actually or virtually) with the patent number.

Annotations

1. Initial Infringement Contentions Held Sufficient

"[Counterclaim-Plaintiff's] motion to compel clarifications to the Infringement Contentions ... is denied. [Counterclaim-Defendant's] contentions, set forth in the chart attached to the motion to compel, are sufficient to provide concrete notice, which is the purpose of the contentions, of [Counterclaim-Defendant's] infringement theories as measured against the accused products. [Counterclaim-Plaintiff] offers only specific example[s] of an allegedly deficient contention (the clause designated as Claim 7(c)(iii)), the contentions set forth the features that comprise[] (in [Counterclaim-Defendant's] view) the signal selection module. [Counterclaim-Plaintiff] complains in its reply that the description was 'found across three different

pages' of the contentions, but they were three *consecutive* pages in the contentions chart, and consumed three pages only because the description was in chart form and there was one description as to Biamp and one as to QSC (when combined with [Counterclaim-Plaintiff's] product). No clarification is needed." *Shure Inc. v. ClearOne, Inc.*, No. 17-cv-03078, at *1 (N.D. Ill. Nov. 14, 2017) (Chang, J.).

"Both [Plaintiff's] Initial and Revised Contentions include a chart detailing Claims 4-6... The chart outlines the components of the Accused Products—namely that they employ a composition comprising a 'mixture'; including 'sodium bentonite'; 'and a granular filler material, which comprises perlite'; 'wherein sodium bentonite comprises at least 47% of the total external surface area of the mixture'; 'wherein the granular material comprises 5% [or 10% or 15%] of the total external surface area of the mixture'; 'and wherein the mixture is removably clumpable.'... For each element, [Plaintiff's] chart explains its basis for the claim that [Defendant] improperly infringes the element with its Accused Products, whether through [Defendant's] Material Safety Data Sheets, [Plaintiff's] testing, or [Defendant's] advertising stating that the mixture forms '[I]ight, tight clumps for easy scooping.'... Each element and explanation speaks to [Plaintiff's] contention that [Defendant] has infringed through the 'manufacture, use, offer for sale and the sale of the Accused Products.' In so doing, to the extent that [Plaintiff's] claim relates to how the Accused Products literally infringe, [Plaintiff] provides more than 'boilerplate' language with 'placeholders,' instead providing detail sufficient to give [Defendant] early, fair notice of the claims and their bases, especially at this stage of the litigation while discovery continues." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *12 (N.D. Ill. May 9, 2017) (Kendall, J.).

"Defendant first contends that Plaintiff's IICs [Initial Infringement Contentions] are deficient because they fail to identify where the 'auscultation device' element recited in the claims of the '141 Patent is present in the allegedly infringing S-Scope. To satisfy LPR 2.2, Plaintiff's IICs must give fair notice of where Plaintiff contends this element can be found in the S-Scope. See N.D. ILL. L.P.R. 2.2(c)... Defendant argues that the IICs 'contain no identification whatsoever as to where the 'auscultation device' can be found.'... As can be seen in [the IIC charts], the IICs repeatedly refer to and quote discussion of a 'stethoscope' on Defendant's website and in its product literature for the S-Scope. The manner in which they do this makes it clear

that Plaintiff contends that the 'stethoscope' is what satisfies the 'auscultation device' element in the claims. That is enough to satisfy LPR 2.2." *Lecat's Ventriloscope v. MT Tool & Mfg.*, No. 16-cv-05298, at *6, *9 (N.D. Ill. Feb. 6, 2017) (Castillo, C.J.).

"Defendant next argues that Plaintiff's IICs are deficient in that they fail to provide the disclosures required for Plaintiff's induced infringement claim... Defendant asserts that the IICs 'fail to specifically identify any direct infringement' and 'fail to specify the acts by defendant that result in downstream arrangement ... in the allegedly infringing combination.'... Plaintiff explicitly states that its 'theory of infringement ... is that the scope of the claims of the '141 Patent includes simulation stethoscopes.'... The Court finds that Plaintiff's IICs provide an 'identification of any direct infringement' sufficient to satisfy LPR 2.2(e). Courts in other districts with disclosure requirements similar to LPR 2.2(e) have upheld contentions relating to indirect infringement so long as the plaintiff 'discloses sufficient information to set forth its theory of infringement,' 'identifies a particular product ... that was sold to customers,' and contends that the direct infringement 'occurs when the customer uses the [product].'... It is not necessary at this stage for Plaintiff to specifically identify any end users or customers that are alleged to have directly infringed." *Lecat's Ventriloscope v. MT Tool & Mfg.*, No. 16-cv-05298, at *11-13 n.3 (N.D. Ill. Feb. 6, 2017) (Castillo, C.J.).

"[Plaintiff's] Amended Initial Infringement Contentions contain detailed charts that both identify the specific elements for each of its claims and locate where those elements can be found within each of the accused [Defendant] products. [Plaintiff's] contentions also provide sufficient detail concerning the function and structure of each means-plus-function element asserted in its claims. That is all that is necessary under the local rules and the Court declines to require anything further of [Plaintiff] at this point." *Rehco, LLC v. Spin Master, Ltd.*, 2014 U.S. Dist. LEXIS 34111, *14 (N.D. Ill. Mar. 17, 2014) (Leinenweber, J.).

2. Initial Infringement Contentions Held Insufficient

"However, [Plaintiff] hedges its claim, acknowledging that the literal claim elements may not be found to be present in any of the Accused Instrumentalities, but instead that their equivalents may be present... Since the local rules require any claim under the doctrine of equivalents to include 'an explanation of each function, way, and result that is equivalent and why

any differences are not substantial' in a party's initial contentions, N.D. ILL. L.P.R. 2.2(d), [Plaintiff's] contentions fail in this regard. To maintain its claim that [Defendant's] equivalents of the Accused [Instrumentalities] allegedly infringed, [Plaintiff] must revise its contentions in 21 days." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *13 (N.D. Ill. May 9, 2017) (Kendall, J.).

"In some instances, Plaintiff's contentions do not specifically identify the material on which they rely, for example when they refer only vaguely to 'printed information' provided at a demonstration of the S-Scope... Plaintiff should supplement its IICs to specifically identify the product literature or other materials that allegedly instruct customers to use the S-Scope in an infringing manner." *Lecat's Ventriloscope v. MT Tool & Mfg.*, No. 16-cv-05298, at *14 (N.D. Ill. Feb. 6, 2017) (Castillo, C.J.).

"[Plaintiff's] initial infringement contention on literal infringement and infringement under the doctrine of equivalents provides as follows: '[Plaintiff] presently contends that the [Defendant's] Accused Instrumentalities literally infringe the asserted claim of the '361 Patent. Nevertheless, with respect to any claim element or limitation that may be found not to be literally embodied in the Accused instrumentalities, [Plaintiff] contends in the alternative that the Accused Instrumentalities embody such claim elements or limitations under the doctrine of equivalents and that any claim element [or] limitation not found to be literally met is equivalently met because any difference between the claim element or limitation and the Accused Instrumentalities is not a substantial difference. Accordingly, [Plaintiff] contends that any asserted claim not found to be embodied literally is nevertheless embodied by the Accused Instrumentalities under the doctrine of equivalents.' [Plaintiff's] contention provides no explanation as to why this is so; nor does it explain why any differences in the accused products are not substantial. As a result, it is insufficient under LPR 2.2(d)... [Likewise, Plaintiff's] contention on direct and indirect infringement provides as follows: 'For the reasons explained with respect to the accused part that is the subject of the ESI Report, [Plaintiff] presently contends that [Defendant] sourced parts from at least [REDACTED] in a way that induced infringement of the '361 Patent.' The attached report does not mention anyone other than [Defendant] and does not describe any acts by [Defendant]. Although the contention itself references 'sourcing,' [Plaintiff] has not described

the 'way' in which [Defendant] induced infringement. For these reasons, [Plaintiff's] contentions are insufficient in their current form. [Plaintiff] is given 21 days from the date of this Order to amend its infringement contentions to include additional information consistent with the requirements of LPR 2.2." *Fatigue Fracture Technology LLC v. Navistar, Inc.*, No. 15-cv-05667 (N.D. Ill. Oct. 17, 2016) (Blakey, J.).

"[Plaintiff's] claim under the doctrine of equivalents, however, falls short of compliance with the local rules. Local Patent Rule 2.2(d) requires that '[f]or any claim under the doctrine of equivalents, the Initial Infringement Contentions must include an explanation of each function, way, and result that is equivalent and why any differences are not substantial.' [Plaintiff's] Amended Initial Infringement Contentions state that the accused [Defendant] products 'perform substantially the same function, in substantially the same way, to achieve substantially the same result,' but provide no explanation as to why this is the case or why any differences in the accused products are not substantial. [Plaintiff's] claim therefore is insufficient in its current form." *Rehco, LLC v. Spin Master, Ltd.*, 2014 U.S. Dist. LEXIS 34111, *14-15 (N.D. Ill. Mar. 17, 2014) (Leinenweber, J.).

"As a threshold matter, in its Initial Infringement Contentions, [Plaintiff] failed to assert that any element of the claim was present under the doctrine of equivalents rather than under direct infringement.... Specifically, [Plaintiff] did not 'include an explanation of each function, way and result that is equivalent and why any differences are not substantial' as required under Local Patent Rule 2.2(d)." *Smart Options, LLC v. Jump Rope, Inc.*, 2012 U.S. Dist. LEXIS 161750, *21 (N.D. Ill. Nov. 13, 2012) (St. Eve, J.).

3. Party Need Not Cite All Evidence on Which It Will Ultimately Rely

"[A] party need not identify every piece of evidence on which it will ultimately rely to show infringement in its infringement contentions. Instead, it need only identify 'where each element of each asserted claim is found within each Accused Instrumentality.' [Plaintiff's] infringement contentions might successfully perform this task with respect to non-standard-essential claims without citing any sources other than the 802.11 standard. Accordingly, [Plaintiff's] failure to cite to anything beyond portions of the 802.11 standard in its infringement contentions with respect to a particular patent claim does not limit [Plaintiff] to using only those portions of the standard to

prove its case." *In re Innovatio IP Ventures, LLC Patent Litig.*, 956 F. Supp. 2d 925, 940-41 (N.D. Ill. 2013) (Holderman, C.J.).

4. Contentions Help Define Scope of Discovery

"Defendant is correct that the stated purpose of the IICs [Initial Infringement Contentions] 'is to identify the likely issues in the case, to enable the parties to focus and narrow their discovery requests,' but that is not the same as limiting the scope of discovery to only the products listed in the IICs, or requiring the Final Infringement Contentions to be identical to the IICs.... Case law from various circuits clearly states that there is no bright-line rule limiting discovery to only those products specifically accused in a party's infringement contentions. Rather, the rule is that discovery concerning products not explicitly listed in the infringement contentions is appropriate when: (1) the infringement contentions give notice of a specific theory of infringement; and (2) the products for which a plaintiff seeks discovery operate in a manner reasonably similar to that theory.... Thus, the issue for the Court is whether the products sought in [Plaintiff's] discovery requests operate in a manner reasonably similar to the theory of infringement listed in the IICs." *Micro Enhanced Tech., Inc. v. Videx, Inc.*, No. 11-cv-05506 (June 28, 2013) (Valdez, M.J.).

5. Amendment to Add LPR 2.2(h) Contentions Regarding Practice of Invention Permitted

"Local Rule 2.2(h) requires parties to specify in their initial contentions each 'apparatus, product, device, process, method, act, or other instrumentality' for which the party wishes to preserve its right to rely on the assertion that its own such instrumentality practices the claimed invention. N.D. ILL. L.P.R. 2.2(h). No rule precludes [Plaintiff] from amending its contentions, and other courts have allowed such amendments with good cause and if timely.... Guided by these principles, the Court weighs whether [Plaintiff] appropriately revised its Initial Contentions to add the use of a purported invention.... [Plaintiff] revised its contentions promptly, only a few weeks after disclosing its Initial Contentions to [Defendant].... Fact discovery continues, such that [Defendant] has not been unduly prejudiced by this revision, and [Defendant] cites to no case law to support its assertion that [Plaintiff] was required to disclose this information in its Initial Contentions without the ability to later revise them.... Accordingly, allowing this revision constitutes an appropriate accommodation to the parties' pretrial schedule." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *9-10 (N.D. Ill. May 9, 2017) (Kendall, J.).

6. LPR 2.2(h) Has Different Disclosure Requirements Compared to LPR 2.2(c)

“The fact that Rule 2.2(c) requires the kind of chart that [Defendant] seeks in the initial contentions about why the accused products infringe but Rule 2.2(h) is silent as to any such requirement with respect to the products that the party asserting infringement alleges practice the patents in suit, persuades the Court that Rule 2.2(h) provides no support for [Defendant]’s contention that [Plaintiff] must provide a chart.” *RTC Indus. Inc., v. Fasteners for Retail, Inc.* No. 17-cv-03595, at *3 (N.D. Ill. June 18, 2019) (Schenkier, M.J.).

7. Motion to Strike Initial Infringement Contentions May Be Treated as a Motion to Compel More Detail

“Showing how rare motions to strike initial infringement contentions (IICs) are in this District, the parties have not identified, and the Court has not found, any decisions that articulate a standard for evaluating them. In other districts with patent rules that require such contentions, ‘motions to strike initial infringement content[ion]s are frequently treated as motions to compel amendment of the ... contentions.’... As this is the first time the Court is addressing the sufficiency of Plaintiffs IICs, it is appropriate to treat Defendant’s motion as seeking to compel more detail, not as seeking the severe sanction of striking the contentions altogether.” *Lecat’s VentriloScope v. MT Tool & Mfg.*, No. 16-cv-05298, at *4-5 (N.D. Ill. Feb. 6, 2017) (Castillo, C.J.).

8. Ordering Revised LPR 2.2(f) Contentions with Specific Priority Dates, Not Date Range, and Without Qualifying Language

“The Local Rules require parties’ initial infringement contentions to identify ‘for any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled...’ N.D. ILL. L.P.R. 2.2(f). While no rule bars parties in this district from amending their priority date in revised initial contentions, other districts with local rules utilizing similar language have pushed for specific dates, not ranges, early on during discovery... Yet given that no rule in this district clearly outlines whether and when claimants may provide revised initial contentions, the Court finds that, without such prior warning, striking [Plaintiff]’s revised priority date would provide a severe sanction... Instead, the Court orders [Plaintiff] to disclose Revised Contentions within 21 days of this Order that assert their final, specific priority dates for these

claims, without the use of ‘no later than’ or ‘at least as early as’ language and without leave to further amend.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *10-11 (N.D. Ill. May 9, 2017) (Kendall, J.).

9. For Inducement, Initial Infringement Contentions Must Allege Knowledge that Induced Acts Constituted Infringement

“The local rules require that a party’s initial infringement contentions specify the statutory subsection that applies to the claim at hand and that each claim alleging indirect infringement supplies [] ‘a description of the acts of the alleged indirect infringer that contribute to or are inducing that direct infringement...’ N.D. ILL. L.P.R. 2.2(a), 2.2(e). Such allegations require the claimant to allege that the defendant possessed knowledge that the induced acts constitute patent infringement... [Plaintiff]’s Complaint and Initial Contentions did not include this [induced infringement] allegation, nor specify that [Defendant] had allegedly violated any particular subsection of 35 U.S.C. § 271... However, in its [first] Revised Contentions, [Plaintiff] specifies the particular subsection implicated for this claim by indicating that the alleged infringement violates 35 U.S.C. § 271(b)... Construed as a motion to compel more detail, the Court grants [Defendant]’s motion regarding [Plaintiff]’s allegation of induced infringement ... and requires [Plaintiff] to disclose [second] Revised Contentions alleging [Defendant]’s knowledge within 21 days of this Order.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *7-8 (N.D. Ill. May 9, 2017) (Kendall, J.).

10. Only the Final Contentions Require Leave of Court to Amend

“[Plaintiff] is also mistaken about the local patent rules of this district. Local Patent Rule 3.4 provides that ‘[a] party may amend its Final Infringement Contentions or Final Non-infringement and Invalidity Contentions only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery...’ The parties have not filed Final Infringement, Non-Infringement, or Invalidity Contentions; they have only filed initial contentions. [Plaintiff] is mistakenly treating the Initial Infringement Contentions required by the scheduling order (due August 1, 2016) with final infringement, non-infringement, and invalidity contentions. Sioux’s argument is unfounded.” *Sioux City Steel Co. v. Prairie Land Millwright Serv. Inc.*, No. 16-cv-02212, at *10, n. 3 (N.D. Ill. Mar. 29, 2019) (Gottschall, J.).

11. Certain Other District's Handling of Motions to Strike Initial Infringement Contentions Considered Persuasive Authority

"Worth noting is that both the U.S. District Court for the Northern District of California's Patent Local Rules and the U.S. District Court for the Southern District of New York's Pilot Project rules for patent cases require initial infringement contentions in terms nearly identical to this District's LPR 2.2. How those Districts treat motions to strike infringement contentions is therefore persuasive authority." *Lecat's Ventriloscope v. MT Tool & Mfg.*, No. 16-cv-05298, at *5 n.1 (N.D. Ill. Feb. 6, 2017) (Castillo, C.J.).

LPR 2.3 Initial Non-Infringement, Unenforceability, and Invalidity Contentions

Each party opposing a claim of patent infringement or asserting invalidity or unenforceability shall serve upon all parties its "Initial Non-Infringement, Unenforceability and Invalidity Contentions" within 14 days after service of the Initial Infringement Contentions. Such Initial Contentions shall be as follows:

- (a) Non-Infringement Contentions shall contain a chart, responsive to the chart required by LPR 2.2(c), that separately indicates, for each identified element in each asserted claim, to the extent then known by the party opposing infringement, whether such element is present literally or under the doctrine of equivalents in each Accused Instrumentality and, if not, each reason for such denial and the relevant distinctions. Conclusory denials are not permitted.
- (b) Invalidity Contentions must contain the following information to the extent then known to the party asserting invalidity:
 - (1) an identification, with particularity, of up to 25 items of prior art per asserted patent that allegedly invalidates each asserted claim. 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. Prior art in the form of sales, offers for sale, or uses shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known

or to whom it was made known. For a patent governed by the pre-AIA amendments to the patent statute, any prior art under 35 U.S.C. §102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived, and prior art under 35 U.S.C. §102(g) (pre-AIA) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

- (2) for each item of prior art, a detailed statement of whether it allegedly anticipates or renders obvious each asserted claim. If a combination of items of prior art allegedly makes a claim obvious, the Invalidity Contentions must identify each such combination and the reasons to combine such items;
 - (3) a chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element that such party contends is governed by 35 U.S.C. § 112(6)/112(f), 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;
 - (4) a detailed statement of any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2)/112(b), enablement or written description under 35 U.S.C. § 112(1)/112(a), or any other basis; and
 - (5) a detailed statement of any grounds for contentions that a claim is invalid as non-statutory/patent ineligible under 35 U.S.C. § 101.
- (c) Unenforceability contentions shall identify the acts allegedly supporting and all bases for the assertion of unenforceability.

Annotations

1. Prior Art Embodiments Must Be Specifically Identified to Avoid Potential Waiver

"Local Patent Rule 2.3 requires a party asserting invalidity to serve the other party with its invalidity contentions. This includes the identification—with particularity—of relevant prior

art. [Defendant] does not claim that it identified ECN 6102 in its invalidity contentions. Instead, it argues that the court allowed it to rely on the 'Gennady brackets' in arguing obviousness, and that the ECN 6102 bracket is one of the Gennady brackets. Therefore, [Defendant] reasons, [Plaintiff] was put on notice in the same way it would have been had [Defendant] included the ECN 6102 bracket in its invalidity contentions. What the court stated, however, was that [Defendant] may 'rely on the Gennady brackets listed as prior art in figures 1 and 2 of the '850 Patent.' Thus, the court's reference to the 'Gennady brackets' is limited to those two figures. Because [Defendant] has not offered any evidence that the ECN 6102 bracket is one of those two figures, the court will not consider it." *Peerless Indus., Inc. v. Crimson AV LLC*, 2015 WL 1275908, *4 (N.D. Ill. Mar. 17, 2015) (Lefkow, J.).

2. Exemplary Charts Do Not Provide Specificity Required by Rules

"L.P.R. 2.3 explicitly requires 'a chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found.... An 'exemplary chart' that allows [Defendant] to rely on uncited portions of prior art is contrary to the high level of specificity required by this rule, which demands identification of wherein each alleged item of prior art each claim is found." *Pactiv Corp. v. Multisorb Techs.*, 2013 WL 2384249, *3 (N.D. Ill. May 29, 2013) (Leinenweber, J.).

3. General Reference to Prior Art Is Insufficient

"[Defendant] argues that it complied with the Local Patent rules because the body of its Invalidity Contentions state that some of [Plaintiff's] patent claims are invalid based on combinations of prior art references. However, simply citing or referencing a piece of prior art, without specifying where an element of an asserted claim is found therein, is also insufficient under Rule 2.3." *Pactiv Corp. v. Multisorb Techs.*, 2013 WL 2384249, *3 (N.D. Ill. May 29, 2013) (Leinenweber, J.).

4. Party Must Provide Details in Initial Invalidity Contentions to the Extent Known, but can Supplement Later

"Critically, Local Rule 2.3 'only requires parties to provide early notice of invalidity contentions and then, subsequently, to provide more detailed invalidity contentions at set times during discovery.'... Because Local Rule 2.3 requires parties to identify 'the structure(s) ... or material(s) in each item of prior art that performs the claimed function,' [Defendant] must disclose with

clarity the external surface area, particle sizes, and particle densities of their accused product, to the extent that these measures are relevant to Patent '368, as alleged by [Plaintiff]. See L.P.R. 2.3.... The question is a matter of when. [Defendant] must provide these details to the 'extent known' within fourteen days of service, and then at other times through discovery. See L.P.R. 2.3.... [Defendant] contends that it has provided what it had to the extent known at that time of disclosure, and could have more information to give now or at another point before discovery closes. [Plaintiff] does not show otherwise, and thus fails to demonstrate that [Defendant] did not disclose with sufficient clarity the measures relevant to Patent '368 in its initial disclosures. See LPR 2.3.... Accordingly, the Court does not have reason to compel [Defendant] to provide greater clarity to [Plaintiff] pursuant to [] LPR 2.3." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 16-cv-09179, at *8-9 (N.D. Ill. Apr. 24, 2017) (Kendall, J.).

5. Initial Invalidity Contentions Found Sufficient

"[Plaintiff] asserts that [Defendant] should specifically identify which references it is relying on as anticipatory, which specific combinations of references it is relying on as rendering the patent obvious, and the specific motivation to combine for each combination of references it is relying on for its obviousness positions.... When the parties met and conferred on the issue, [Defendant] informed [Plaintiff] that it did intend to rely on all potential combinations of all references identified in its contentions and that the single motivation to combine identified in one of its charts applied equally to all such combinations.... We agree with [Defendant] that it is not required to supplement its initial invalidity contentions at this time. [When final invalidity contentions are due Defendant] is required to limit its contentions in accordance with the Local Patent Rules. At this time, however, we are not convinced that [Defendant's] invalidity contentions are in violation of the Local Patent Rules or relevant case law. There is no Local Rule that limits the number of combinations a defendant can rely on at this stage, and [Plaintiff] has not provided the Court with any case law on this issue either." *Velocity Patent LLC v. FCA US, LLC*, No. 13-cv-08419, at *1-2 (N.D. Ill. Oct. 3, 2017) (Mason, M.J.).

6. Parties May Not Be Bound by Initial Contentions

"In [Plaintiff's] motion in limine, it asks the Court to bar Defendants from disavowing their initial non-infringement contentions and certain interrogatory responses. To give context, Defendants' final

non-infringement contentions contradict its earlier contentions because Defendants admitted certain claim elements were not in dispute in the initial contentions. In essence, [Plaintiff] is seeking to bar Defendants from presenting their reasons for changing their contentions as to certain claim elements. [Plaintiff] does not explain why the Court should bar this evidence under the Federal Rules of Evidence or any other relevant evidentiary standard. Instead, [Plaintiff's] motion is an attempt at narrowing Defendants' ability to defend against [Plaintiff's] infringement claim.... As discussed in the Court's December 13, 2017 in limine ruling concerning [Plaintiff's] ability to call certain attorneys as rebuttal witnesses, the fact that Defendants changed their position is relevant to Defendants' non-infringement defense. The Court will not bar Defendants from explaining why they changed their position any more than the Court will bar [Plaintiff] from discussing Defendants' initial non-infringement contentions or proffering them as evidence. As the parties are well aware, a motion in limine 'is not a proper vehicle with which to test the sufficiency of evidence.'... For these reasons, the Court, in its discretion, grants in part and denies in part [Plaintiff's] motion in limine." *Sonix Tech. Co., Ltd. v. Publ'ns Int'l.*, No. 13-cv-02082, at *2-3 (N.D. Ill. Dec. 15, 2017) (St. Eve, J.).

"[Defendant] argues that [Plaintiff] did not disclose its invalidity theories based on the ClearOne BMA, the ClearOne XAP 800, Kellerman 2001, or Kajala in its initial invalidity contentions as required by Local Patent Rule 2.3... But [Plaintiff] did disclose Kellerman 2001... It makes sense that [Plaintiff's] invalidity contentions would evolve as discovery progressed and Shure learned more about [Defendant's] invention and legal theories. The Local Patent Rules do allow (and even expect) parties to amend and update their contentions. See Local Patent Rules 3.1.-3.2 [Plaintiff] updated its invalidity contentions accordingly, ... so there is no reason to exclude these theories for noncompliance with the Local Patent Rules." *Shure, Inc. v. ClearOne, Inc.*, No. 17-cv-03078 at *24-25, Fn. 16 (N.D. Ill. Mar. 16, 2018) (Chang J.).

LPR 2.4 Document Production Accompanying Initial Non-Infringement and Invalidity Contentions

With the Initial Non-Infringement and Invalidity Contentions under LPR 2.3, the party opposing a claim of patent infringement shall supplement its Initial Disclosures and, in particular, must produce or make available for inspection and copying:

- (a) any additional documentation showing the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its LPR 2.2 chart; and

- (b) a copy of any additional items of prior art identified pursuant to LPR 2.3 that does not appear in the file history of the patent(s) at issue.

LPR 2.5 Initial Response to Non-Infringement and Invalidity Contentions

Within 14 days after service of the Initial Non-Infringement and Invalidity Contentions under LPR 2.3, each party claiming patent infringement shall serve upon all parties its "Initial Response to Non-Infringement Invalidity Contentions."

- (a) With respect to invalidity issues, the initial response shall contain a chart, responsive to the chart required by LPR 2.3(a)-(d), that states as to each identified element in each asserted claim, to the extent then known, whether the party admits to the identity of elements in the prior art and, if not, the reason for such denial.
- (b) In response to denials of infringement, if the party asserting infringement intends to rely upon Doctrine of Equivalents, such party must include an initial explanation of each function, way, and result that is equivalent and why any differences are not substantial, to the extent not previously provided in response to LPR 2.2(d).

LPR 2.6 Disclosure Requirement in Patent Cases Initiated by Complaint for Declaratory Judgment

In a case initiated by a complaint for declaratory judgment in which a party files a pleading seeking a judgment that a patent is not infringed, is invalid, or is unenforceable, LPR 2.2 and 2.3 shall not apply unless a party makes a claim for patent infringement. If no claim of infringement is made, the party seeking a declaratory judgment must comply with LPR 2.3 and 2.4 within 28 days after the Initial Disclosures.

III. FINAL CONTENTIONS

LPR 3.1 Final Infringement, Unenforceability, and Invalidity Contentions

- (a) Final Infringement Contentions. Final infringement contentions shall be served in two stages:
 - (i) Within 19 weeks after the due date for service of Initial Infringement Contentions, each party claiming patent infringement must serve on all other parties a list

identifying no more than 10 claims per patent and no more than 20 claims overall that the party is asserting, each of which must be selected from claims identified in the Initial Infringement Contentions.

(2) Within 21 weeks after the due date for service of Initial Infringement Contentions, each party claiming patent infringement must serve on all other parties “Final Infringement Contentions” containing the information required by LPR 2.2 (a)-(h). In the Final Infringement Contentions, no Accused Instrumentality may be accused of infringing more than 10 claims per patent and 20 claims overall, selected from the claims identified in the Initial Infringement Contentions. If the Doctrine of Equivalents is being asserted, the Final Infringement Contentions must include an explanation of each function, way, and result that is equivalent and why any differences are not substantial.

(b) Final Unenforceability and Invalidity Contentions. Each party asserting invalidity or unenforceability of a patent claim shall serve on all other parties, at the same time that the Final Infringement Contentions required by LPR 3.1(a)(2) are served, “Final Unenforceability and Invalidity Contentions” containing the information required by LPR 2.3 (b) and (c). Final Invalidity Contentions may rely on more than 25 prior art references only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties. For each claim alleged to be invalid, the Final Unenforceability and Invalidity Contentions are limited to four prior art grounds per claim and four non-prior art grounds. No claim asserted to be infringed shall be subject to more than eight total grounds per claim. Each of the following shall constitute separate grounds: indefiniteness, lack of written description, lack of enablement, unenforceability, and non-statutory subject matter under 35 U.S.C. § 101. Each assertion of anticipation and each combination of references shall constitute separate grounds.

Annotations

1. Infringement Contentions Must Provide Sufficient Notice of Infringement Theories

“While it is true that infringement contentions need not establish a plaintiff’s entitlement to relief on the merits, they must

at least provide reasonable notice to the defendant why the plaintiff believes it has a reasonable chance of proving infringement.” *Visual Interactive Phone Concepts, Inc. v. U.S. Cellular Corp.*, 1:11-cv-5289 (N.D. Ill. May 26, 2015) (Bucklo, J.).

“Infringement contentions are generally considered adequate if they ‘provide fair notice of the scope of [the plaintiff’s] infringement theory.’ ... In other words, infringement contentions must ‘set[] forth particular theories of infringement with sufficient specificity to provide defendants[] with notice of infringement beyond that which is provided by the mere language of the patents themselves.” *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 101766, *25 (N.D. Ill. Jul. 23, 2012) (Holderman, C.J.).

2. Contentions Held Sufficient

“Turning to [Plaintiff’s] Final Infringement Contentions in relation to its indirect infringement allegations, [Defendant] maintains that [Plaintiff] has failed to identify the required disclosures under LPR 2.2(e)... [Plaintiff’s] Final Infringement Contention in this respect states: ‘As to each of the Asserted Claims, [Defendant] has also indirectly infringed and induced infringement pursuant to 35 U.S.C. § 271(b), by advertising, marketing and selling the Accused Instrumentalities to [Defendant] retailers (e.g., WalMart, Target, Kroger, Dollar General, Walgreens, PetSmart, etc.), for example, for resale to consumers.’ ... Recently, Chief Judge Castillo articulated that ‘[c]ourts in other districts with disclosure requirements similar to LPR 2.2(e) have upheld contentions relating to indirect infringement so long as the plaintiff ‘discloses sufficient information to set forth its theory of infringement,’ ‘identifies a particular product ... that was sold to customers,’ and contends that the direct infringement ‘occurs when the customer uses the [product].’ ... Under this reasoning, [Plaintiff] has sufficiently identified the Accused Products in its Final Infringement Contentions, the retailers involved in selling the Accused Products, and indicates that the indirect infringement occurred by advertising, marketing, and selling the Accused Products. Further, [Plaintiff] attached examples of [Defendant’s] advertisements in relation to the Accused Products to its Final Infringement Contentions disclosing additional information forming the basis for its indirect infringement allegations. As such, [Plaintiff] has satisfied the requirements under LPR 2.2(e), and therefore, the Court denies this aspect of [Defendant’s] motion to strike.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15 cv-01067, at *11-12 (N.D. Ill. Feb. 26, 2018) (St. Eve, J.).

“[Defendant contends that Plaintiff’s] Final Infringement Contentions do not provide any evidence of actual usage of the accused products. [Plaintiff] asserts that the Local Patent Rules do not require it to point to ‘specific, actual use of the product’ for method claims. Nor do the rules require the ‘reasonably capable’ analysis that [Defendant] contends [Plaintiff] must demonstrate in its Final Infringement Contentions. This Court agrees that the Local Patent Rules do not require the Final Infringement Contentions to provide evidence of actual usage of the accused products.” *Trading Techs. Int’l, Inc. v. CQG, Inc.*, 2014 WL 4477932, *4 (N.D. Ill. Sept. 10, 2014) (Coleman, J.).

“[Defendant] also disclosed Angiomax® batches as prior art in Table 5 of its Final Unenforceability and Invalidity Contentions.... In Table 5, [Defendant] stated that Angiomax® anticipated the asserted claims in the ‘727 patent.... In support of this contention, [Defendant] cited ... a document listing Angiomax® batches by number and their corresponding Asp9-bivalirudin impurity levels and manufacture release dates.... This [Plaintiff]-produced document includes batches 339257 and 515495 and lists their Asp9-bivalirudin impurity levels as below 0.6%.... Accordingly, although [Defendant] did not specifically list Angiomax® batches 339257 and 515495 in its Final Unenforceability and Invalidity Contentions, the information [Defendant] provided was sufficient to put [Plaintiff] on notice that it contended batches 339257 and 515495 anticipated certain claims in the ‘727 patent.” *Medicines Co. v. Mylan Inc.*, No. 11-cv-01285 (N.D. Ill. May 27, 2014) (St. Eve, J.).

“[Defendant] argues that [Plaintiff’s] statement alleging literal infringement does not fulfill its requirements under LPR 3.1. The Court disagrees. [Plaintiff’s] contention provides a specific description regarding how the hot gas vented from the [accused product’s] cooking enclosure mixes with the air vented from the series of apertures in the side service of the powerhead. Under LPR 3.1, this information is sufficiently specific.” *Morningware, Inc. v. Hearthware Home Prods.*, 2010 U.S. Dist. LEXIS 98927, *20-21 (N.D. Ill. Sept. 22, 2010) (St. Eve, J.).

3. Contentions Held Insufficient

“[Defendant] asserts that [Plaintiff’s] Final Infringement Contention[s] concerning its theory under the doctrine of equivalents does not provide the requisite explanation or detail under LPR 2.2(d).... In support of its doctrine of equivalents

theory of infringement, [Plaintiff’s] contention states that it finds the non-swelling opaline silica material manufactured at [Defendant’s] Maricopa plant to be ‘clay material,’ and thus infringing.... [Plaintiff] then highlights certain Accused Products that [Defendant] manufactures at its Maricopa plant—yet does not point to which specific aspects of these Accused Products are equivalent and why any differences are insubstantial.... Because [Plaintiff’s] Final Infringement Contentions (and explanations in its legal memorandum) do not sufficiently address why the purported aspects of the Accused Products are equivalent and why any differences are insubstantial, [Plaintiff] has not adequately fulfilled LPR 2.2(d) for its theory of liability under the doctrine of equivalents.... [Plaintiff’s] doctrine of equivalents contention is impermissibly vague and its arguments in support of this contention are not well-reasoned. The Court therefore grants [Defendant’s] motion in this respect and strikes [Plaintiff’s] contentions regarding the doctrine of equivalents.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *9-11 (N.D. Ill. Feb. 26, 2018) (St. Eve, J.).

“Furthermore, [Defendant] argues that [Plaintiff’s] Final Infringement Contentions are insufficient because instead of identifying where certain claimed elements can be found in the Accused Products, [Plaintiff] references and relies upon U.S. Patent No. 6,887,570 (‘the ‘570 Patent’), which is owned by [Defendant’s Related Entity]. [Defendant] specifically highlights [Plaintiff’s] reliance on the ‘570 Patent as a purported basis for 14 of the 18 limitations in its LPR 2.2(c) claim chart, asserting that [Plaintiff] is attempting to use the ‘570 Patent as a product specification for the Accused Products. Indeed, after reviewing [Plaintiff’s] LPR 2.2(c) claim chart, although [Plaintiff] identifies certain claim limitations in the Accused Products, it also relies on the ‘570 Patent in some instances. Furthermore, this is not a situation where the Accused Products are not publically or commercially available, but instead, the Accused Products are sold in the marketplace and [Defendant] provided [Plaintiff] with at least six physical samples of certain TidyCats products for testing.... Equally important, in its response brief, [Plaintiff] does not address [Defendant’s] argument that it improperly relies upon extraneous information as a substitute for the Accused Products. Under these circumstances, the Court grants [Defendant’s] motion in this respect and strikes [Plaintiff’s] reliance on the ‘570 Patent.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *12-13 (N.D. Ill. Feb. 26, 2018) (St. Eve, J.).

“Plaintiff’s use throughout its infringement contentions of constructions such as ‘and/or,’ *inter alia*, etc., and ‘including but not limited to’ leave its infringement theory far too nebulous to satisfy this requirement.” *Visual Interactive Phone Concepts, Inc. v. U.S. Cellular Corp.*, 1:11-cv-5289 (N.D. Ill. May 26, 2015) (Bucklo, J.).

“[P]laintiff’s final infringement contentions assert that the ‘central data center’ is found in defendant’s ‘interconnected computer systems/servers/devices/routers, including but not limited to the regional connectivity centers at Schaumburg and Knoxville, the local connectivity centers at New Berlin and Madison, the billing and/or connectivity center in Middleton, and the CARES and/or TOPS system.’ While it may be that the ‘central data center’ cannot be defined with reference to a precise physical location, and may indeed comprise a number of interrelated elements, it cannot be an infinitely expandable, open set of systems, devices, and facilities as plaintiff’s use of the phrases ‘including but not limited to’ suggests.” *Visual Interactive Phone Concepts, Inc. v. U.S. Cellular Corp.*, 1:11-cv-5289 (N.D. Ill. May 26, 2015) (Bucklo, J.).

“Although the contentions suggest various ways in which ‘interconnected’ components might perform certain functions, they fail to identify where specific elements required by the asserted claims may be found.” *Visual Interactive Phone Concepts, Inc. v. U.S. Cellular Corp.*, 1:11-cv-5289 (N.D. Ill. May 26, 2015) (Bucklo, J.).

“The constellation of slash symbols, *inter alia*, and ‘and/or’ expressions in this loquacious contention puts one in mind of a Choose Your Own Adventure[] with its fulsome array of possible infringement theories. Yet, despite multiple theories as to how defendant (and third parties) might transmit, receive, and store transaction information and video content, nowhere does it identify the existence or location of ‘a computer processor connected to a video storage center,’ which is required for infringement of any claim containing this element. Rather, plaintiff merely states, in a conclusory fashion, that the multitude of items identified as the ‘central data center’ ‘include computer processors that are connected to U.S. Cellular customers’ videophones.” *Visual Interactive Phone Concepts, Inc. v. U.S. Cellular Corp.*, 1:11-cv-5289 (N.D. Ill. May 26, 2015) (Bucklo, J.).

“[Plaintiff] has not provided the requisite explanation of each function, way, and result that is equivalent and why any differences are not substantial and therefore [Plaintiff] has not provided a Doctrine of Equivalents theory.... The sections of its Contentions to which [Plaintiff] refers describe only a theory of literal infringement. Rule 2.2 clearly requires more than the passing reference to infringement under the Doctrine of Equivalents.” *Trading Techs. Int’l, Inc. v. CQG, Inc.*, 2014 WL 4477932, *3 (N.D. Ill. Sept. 10, 2014) (Coleman, J.).

“[Plaintiff] fails to cite to a particular diagram or photograph or give a detailed explanation of where the fan chamber is located in the powerhead. Therefore, the Court grants [Defendant’s] motion to compel a more detailed Final Infringement Contention.” *Morningware, Inc. v. Hearthware Home Prods.*, 2010 WL 3781254, *4 (N.D. Ill. Sept. 22, 2010) (St. Eve, J.).

“[T]he Court agrees with [Defendant] that [Plaintiff] has failed to fulfill the relevant LPR for its alternative claims under the doctrine of equivalents. In its motion and memoranda, [Defendant] makes specific arguments how [Plaintiff’s] contentions fail to explain why the purported aspects of the [Defendant’s accused product] are equivalent and why any differences are insubstantial.... [Plaintiff’s] bare-boned response that it has sufficiently set forth its alternative theory under the doctrine of equivalents—without any details or explanation—does not save the day. The Court therefore strikes [Plaintiff’s] contentions concerning its alternative claims under the doctrine of equivalents.” *Morningware, Inc. v. Hearthware Home Prods.*, 2010 U.S. Dist. LEXIS 98927, *21-22 (N.D. Ill. Sept. 22, 2010) (St. Eve, J.).

“Not only is the offer of proof not evidence as a technical matter, but there is also good reason not to consider undisclosed theories and evidence. The local patent rules are not mere traps for the unwary. [Plaintiff] organized its defense of its patent around [Defendant’s] final invalidity contentions. Had [Defendant] timely disclosed these theories and the evidence supporting them, [Plaintiff] might have marshalled a different or stronger response. To consider the offer of proof is to accept [Defendant’s] idealized version of its own argument, unimpeached and uncontradicted. The court will not do so.” *Peerless Industries, Inc. v. Crimson AV, LLC*, No. 11-cv-01768, 2018 WL 6178237 at *11 (N.D. Ill. Nov. 27, 2018) (Lefkowitz, J.).

4. Final Contentions Limit Scope of Summary Judgment Motions

"[Defendant] failed to disclose its [best mode] theory in its Final Contentions.... [Defendant] cannot now add an additional invalidity contention without notice. Accordingly, the Court grants summary judgment on this aspect of the best mode defense as a matter of law." *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 165968, *70-71 (N.D. Ill. Nov. 20, 2013) (St. Eve, J.).

"[Defendant] for the first time in its summary judgment briefing raised invalidity arguments that it did not include in its initial and supplemental invalidity contentions.... That [Defendant] alleged the on-sale bar doctrine in its amended answer does not save the defense because [Defendant] had an obligation to disclose the defense in its invalidity contentions, which it failed to do.... That [Defendant] reserved the right to supplement its invalidity defenses does not excuse its failure to comply with this court's local rules, which require that a party assert all invalidity defenses in its final invalidity contentions. Nor has [Defendant] offered any explanation as to why it did not timely raise these defenses. Accordingly, [Defendant] is barred from raising invalidity defenses." *Peerless Indus., Inc. v. Crimson AV, LLC*, 2013 WL 6197096, *4 (N.D. Ill. Oct 2, 2013) (Lefkow, J.).

"To the extent that [Defendant's] argument on summary judgment exceeds the scope of its [final] invalidity contentions, the court agrees with [Plaintiff] that [Defendant] is procedurally barred from advancing a new invalidity theory at this stage of the litigation." *Fujitsu Ltd. v. Tellabs, Inc.*, 898 F. Supp. 2d 1047, 1051 (N.D. Ill. Sept. 26, 2012) (Holderman, C.J.).

5. Final Contentions Limit Scope of Expert Reports

"Like the party in [*Pactiv Corp. v. Multisorb Techs., Inc.*, No. 10-cv-00461, 2013 WL 238249 (N.D. Ill. May 29, 2013)], if [Defendant] wished to have [its expert] rely on the [reference], it should have identified that material as prior art in its L.P.R. 3.1 contentions or timely moved for leave to amend its contentions to include it. This Court will not now permit [Defendant] 'to circumvent the disclosure requirements of our Local Patent Rules by offering such materials as background' in an expert report.... Moreover, the fact that [Defendant's expert] uses the [reference] as prior art not standing alone, but in combination with other prior art, does not render his reliance on the [reference] merely background information. '[I]f a combination of items of prior art allegedly makes a claim obvious, each such

combination, and the reasons to combine such items must be identified.' Thus, in *Pactiv*, the court granted the defendant's motion to strike portions of the plaintiff's expert report where that report contained new invalidity arguments by relying on combinations and citations of prior art not disclosed previously in its invalidity contentions. Likewise, [Defendant's expert's] introduction of the [reference] as prior art in combination with other prior art introduced a new theory of invalidity that was not included in [Defendant's] L.P.R. 3.1 contentions." *Avnet, Inc. v. Motio, Inc.*, No. 12-cv-02100, 2016 WL 3365430, at *4 (N.D. Ill. June 15, 2016) (Schenkier, M.J.).

"[W]e disagree with [Defendant] that [its expert] should be allowed to rely on the [reference] because [Defendant's other expert] and plaintiffs' expert discussed the [reference] in their reports, and it was known in the industry. The Local Patent Rules are clear: if the [reference] was known to [Defendant], then [Defendant] was required to have disclosed the [reference] under L.P.R. 3.1 and 2.3(b), or to have sought leave to amend its invalidity contentions to include it. The fact that the defense expert ... discussed it in his report and plaintiff's expert then did so in a rebuttal report does not excuse [Defendant] of its threshold failure to comply with the Local Patent Rules. To the contrary, this highlights the vice in the approach [Defendant] advocates. One of the purposes of final invalidity contentions is to give notice to plaintiffs of the defendant's contentions, and the bases for them, prior to expert discovery, because 'there is much for a plaintiff to do. Witnesses may have to review the document(s), and rebuttal evidence may have to be sought out and examined.' ... It would turn the local rule on its head to allow a defendant to withhold prior art references from its invalidity contentions, only to spring them on the plaintiff in the defense expert report." *Avnet, Inc. v. Motio, Inc.*, No. 12-cv-02100, 2016 WL 3365430, at *5 (N.D. Ill. June 15, 2016) (Schenkier, M.J.).

"Defendants argue in two footnotes that this argument should be procedurally barred because it did not first appear in Plaintiffs' Final Infringement Contentions. In particular, Defendants submit that Plaintiffs should have amended their Final Infringement Contentions rather than introduce the argument for the first time in their expert reports. The Court is not persuaded. Not only do Defendants fail to cite a local rule or case law, but their argument ignores the goals of the local patent rules. The local patent rules were enacted to 'prevent a shifting sands approach to claim construction by forcing the parties to crystallize their theories of the case early in litigation'

and to 'provide notice of the plaintiff's theories of infringement early in the case because, in practice, it is difficult to obtain such information through traditional discovery means, such as interrogatories.' []Plaintiffs' Final Infringement Contentions included a detailed description of the Accused Structure and a photograph with red marks drawing attention to the toggle, making clear that the toggle played an important role in the infringement claim. The arguments in Plaintiffs' subsequent expert reports and motions are consistent with this suggestion. The Final Infringement Contentions therefore gave Defendants fair notice of Plaintiffs' theory of infringement, satisfying the purpose of the local patent rules. The absence of the particular words 'pivot lever' in the Contentions is to be expected; the Court did not use those words in its claim construction opinion until over one year later. Requiring an amendment in these circumstances would only prolong the litigation, increasing the costs to both parties and needlessly wasting judicial resources. Accordingly, the Court finds that Plaintiffs' argument is not procedurally barred." *The Black & Decker Corp. v. Positec USA Inc.*, 11-cv-5426 (N.D. Ill. Mar. 31, 2015) (Dow, J.).

"[Plaintiff] lists in its supplemental infringement contentions commands/events in certain accused products that are 'manual' per the construction of 'static' for the dependent claims and supplemented the claim charts for its dependent claims. However, [Plaintiff] fails to identify a manual re-centering command for each of the independent claims. [Plaintiff] now asserts that the re-centering/centering instructions in certain dependent claims are identical in scope to the independent claims' manual re-centering command. Therefore, [Plaintiff] has not complied with L.P.R. 2.2 (c) and its experts may not present opinions regarding the presence of manual re-centering commands for each of the independent claims." *Trading Techs. Int'l, Inc. v. CQG, Inc.*, 2014 WL 4477932, *3 (N.D. Ill. Sept. 10, 2014) (Coleman, J.).

"[Defendant] contends that [Plaintiff] failed to claim infringement or willful infringement in [Plaintiff's] Final Infringement Contentions based on [Defendant] having copied various features and functionalities in [Plaintiff's] products, but both [Plaintiff's] experts claim to have reviewed documents produced by [Defendant] that demonstrate copying by [Defendant].... [Defendant's] motion is granted as to copying. Nowhere in [Plaintiff's] infringement contentions does there appear to be an infringement theory based on copying."

Trading Techs. Int'l, Inc. v. CQG, Inc., 2014 WL 4477932, *3 (N.D. Ill. Sept. 10, 2014) (Coleman, J.).

"[Defendant] does not dispute that [its written description defense] is not expressly included in its Final Invalidity Contentions.... As stated in *Pactiv Corp. v. Multisorb Techs.*: 'To allow an expert to go beyond [Final Invalidity Contentions] would render them useless and ignore the specificity requirements of the Local Patent Rule 2.3.' ... Accordingly, this Court finds that [Defendant] has waived [its written description defense]." *Trading Techs. Int'l, Inc. v. CQG Inc.*, 1-05-cv-04811 (N.D. Ill. May 14, 2014) (Coleman, J.).

"[Plaintiff] contends that the [Defendant's expert report] discloses new prior art references.... [Defendant's] first argument, that these references only provided context and were included 'as complementary to understanding the invalidity references' is unpersuasive. If these new materials are not prior art, not necessary references, and not something that their expert relied upon, then there is truly no reason for them to be in the Report. If, however, these materials are prior art, then they should have been disclosed over a year ago with the Invalidity Contentions pursuant to Local Patent Rule 3.1. [Plaintiff] points out several cases that rejected similar attempts to offer previously undisclosed materials as 'background on the art' or 'state of the art,' and this Court agrees that parties should not be able to circumvent the disclosure requirements of our Local Patent Rules by offering such materials as background. Similarly, [Defendant's] argument that [Defendant's expert's] inclusion of these new materials is acceptable because some of them were referred to in the patents-in-suit is also unsuccessful. Again, if the materials are not prior art and not necessary to [Defendant's expert's] opinions, there is no reason to include them. If they are new prior art, they were required to be disclosed previously by our Local Patent Rules. It would be improper to allow an expert to rely on undisclosed prior art merely because it was cited in an asserted patent." *Pactiv Corp. v. Multisorb Techs.*, 2013 U.S. Dist. LEXIS 75585, *6-7 (N.D. Ill. May 29, 2013) (Leinenweber, J.).

"[Defendants'] experts are limited to the [Final] Invalidity Contentions it served.... To allow an expert to go beyond those would render them useless and ignore the specificity requirements of the Local Patent Rule 2.3 [incorporated by LPR 3.1]." *Pactiv Corp. v. Multisorb Techs.*, 2013 U.S. Dist. LEXIS 75585, *10 (N.D. Ill. May 29, 2013) (Leinenweber, J.).

“As this court has previously noted, ‘local rules are meant to prevent a shifting sands approach to claim construction by forcing the parties to crystallize their theories of the case early in litigation’... [Plaintiff] had a duty to be ‘as specific as possible’ when identifying the ‘Accused Instrumentality,’ and to include in its infringement contentions ‘specifically where each element of each asserted claim is found within each Accused Instrumentality’... Although [Plaintiff] now asserts its intention to accuse all [products with certain modules] and all modules ‘conceptually identical’ to the [identified] module ... this intention is not clear from the [] Infringement Contentions’ vague allusions.... If [Plaintiff] intended to rely on the inclusion of [certain] modules in the [Defendant’s product] for purposes of proving infringement, it should have explicitly said so. As drafted, the [] Infringement Contentions do not put [Defendant] on notice of [Plaintiff’s] intent to rely on the inclusion of [certain modules] in the [Defendant’s product] for purposes of proving infringement. Because the [] Infringement Contentions do not assert infringement of the [] Patent by [certain] modules, [Defendant’s] Renewed Motion [to Strike] is granted with respect to those portions of the Infringement Report that rely on an analysis of these modules for purposes of infringement.” *Fujitsu Ltd. v. Tellabs, Inc.*, 1-09-cv-04530 (N.D. Ill. May 24, 2013) (Holderman, C.J.).

“Expert infringement reports may not introduce theories not previously set forth in infringement contentions.” *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 101766, *26 (N.D. Ill. Jul. 23, 2012) (Holderman, C.J.).

6. Court Has Discretion to Consider Theories Not Set Forth in Final Contentions

“Plaintiff’s Final Infringement Contentions did not explain how the [accused product] infringes claim 4 under the doctrine of equivalents, but because both parties have addressed the issue on this [summary judgment] motion, the court does so, as well.” *Thermapure, Inc. v. RxHeat, LLC*, 2014 U.S. Dist. LEXIS 43024, *45-46 n.12 (N.D. Ill. Mar. 31, 2014) (Pallmeyer, J.).

“As an initial matter, [Plaintiff] correctly notes that [Defendant’s] response raises a defense that it failed to disclose in its Amended Final Invalidity and Unenforceability Contentions... [Plaintiff] argues that the Court should therefore preclude [Defendant] from raising it at this stage... [Defendant] did, however, assert this argument in [its expert’s] corresponding

Invalidity Report.... Further, [Plaintiff] was clearly on notice of [Defendant’s] argument because [Plaintiff] addressed the merits of [Defendant’s expert’s] written description invalidity opinion in its memorandum in support of its motion for summary judgment.... Therefore, the Court will not preclude [Defendant] from raising this defense.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 165968, *78-79 (N.D. Ill. Nov. 20, 2013) (St. Eve, J.).

“[Defendant] timely asserted obviousness as a defense in its invalidity contentions; however, it added additional supporting prior art ... after the court-imposed deadline for disclosing final invalidity contentions... Because [Defendant] disclosed the prior art, albeit after the deadline, [Plaintiff] was aware of [Defendant’s] bases for asserting obviousness, thus reducing any resulting prejudice. Accordingly, the court will allow it to rely on this prior art for purposes of arguing obviousness.” *Peerless Indus., Inc. v. Crimson AV, LLC*, No. 11-cv-01768 (N.D. Ill. Oct. 2, 2013) (Lefkow, J.).

7. Allowing More Than 4 Non-Prior Art Grounds in Final Invalidity Contentions Despite the Limit Imposed by the LPRs

“The Court grants Extension of the Local Patent Rule 3.1(b) Limits and allows Defendant to file 5 non-prior art grounds.” *Trading Techs. Int’l, Inc. v. BGC Partners, Inc.*, No. 10-cv-00715 (N.D. Ill. May 13, 2019) (Kendall, J.).

8. Final Invalidity Contentions Limited to 25 Prior Art References Except for Good Cause and Absence of Unfair Prejudice

“Local Patent Rule 3.1 was crafted by experienced patent counsel from various segments of patent law practice. Local Patent Rule 3.1 was approved by the judges of this court unanimously after public comment and was designed to focus the issues surrounding contentions of invalidity on a reasonable number of discernible identified prior art references. In most cases, culling the potential prior art references on the issue of patent invalidity to a representative 25 is reasonable. Typically, if parties asserting patent invalidity cannot persuasively present their best 25 prior art references to meet their burden on that issue, allowing them 30, 40 or 50 references will not improve their position but will merely burden the record to no useful end. Of course, in the proper case, appropriate additional references will be allowed, but this is not that case.” *CoStar Realty Info., Inc. v. CIVIX-DDI, LLC*, No. 12-cv-04968 (N.D. Ill. Aug. 8, 2013) (Holderman, C.J.).

“The Federal Circuit has recognized that district judges have case management authority to trim cases down to manageable size in an attempt to prevent jury (and judge) confusion and to reduce the drain on resources. All the courts that have been presented with challenges to Local Patent Rules have found that they are essentially a series of case management orders that fall within the court’s broad discretionary powers to limit the number of claims and defenses in patent cases, wisely recognizing that a plethora of claims or defenses ultimately does little more than confuse the fact finder. [] The cases have regularly sustained the court’s authority to limit the number of prior art references. [] That is precisely what Local Rule 3.1(b) has done in limiting Final Invalidation Contentions to no more than 25 prior art references except by permission of the court.... It was to prevent certain common abuses that the Local Patent Rules approved proposed amendments to LPR 3.1(b). [] For each claim alleged in *Oil-Dri Corp. Of America* to be invalid, Judge Kennelly ordered that no more than eight prior art grounds per claim and no more than four non-prior art grounds per claim would be allowed. []. Each combination of references was to count as a separate ground against the overall limits, thus requiring the defendant ‘to significantly pare down and focus its invalidity and unenforceability contentions.’” *Wimo Labs v. Polyconcept*, 358 F. Supp.3d 761, 765-66 (N.D. Ill. Mar. 6, 2019) (Cole M.J.).

9. The Limit to 25 Prior Art References does not Limit the Proof Offered In Support of a Specific Theory

“The language of LPR 3.1 is clear and reflects the Rule’s purpose. While LPR 3.1 seeks to streamline patent litigation by, in part, limiting the number of grounds on which a claim of invalidity may be based, it does not purport to dictate or limit the proof that may be offered in support of a specific example of a claim based on a permissible ground ...Under the Local Patent Rule, grounds are limited; proof of discrete and separate instances are not. All that is required is that the specific instance be based on a permissible ground. Limitations that do not exist should not be grafted onto a statute or rule. The plaintiff’s reading of LPR 3.1 makes ‘language a trap rather than a mode of communication.’ ... Of course, the question of whether or how the case should be further streamlined is a matter for the informed discretion of Judge Lee. But the reality is that each of the 37 instances referred to by the defendants do not constitute 37 separate grounds. The plaintiff is correct in contending that ‘any one of them [if proven] could independently be relied upon in an attempt to invalidate the

claims of [the] patents.’ ... That is the purpose of proof. But, that does not mean that under LPR 3.1 each is a separate ground and thus violative of the numerical limitations imposed on the number of grounds that may be advanced under the Rule... No one can dispute that Local patent Rule 3.1(b) limits Final Unenforceability and Invalidation Contentions to four prior art grounds per claim and four non-prior art grounds. But, as defendants point out and plaintiff cannot dispute, defendants cite only three separate non-prior art grounds: indefiniteness, lack of enablement, and lack of written description. Then, for each claim at issue, they cite the term and the particular reason why it is believed they have the better of the validity argument. These are, as plaintiff asserts, ‘separate and distinct invalidity arguments...’ ... They are not, however, separate grounds. The Rule, itself, clearly defines what constitutes a non-prior art ground: indefiniteness, lack of written description, lack of enablement...’ Local Patent Rule 3.1(b). And that numerical limitation has not been violated.” *Wimo Labs v. Polyconcept*, 358 F. Supp.3d 761, 766-67 (N.D. Ill. Mar. 6, 2019) (Cole M.J.).

10. LPR 3.1 Does Not Limit the Number of Claim Terms a Party Might Claim Are Indefinite or Not Enabling

“Thus, the defendants’ argument as to why the term ‘shaft’ is claimed to be indefinite—‘lacks objective boundaries and fails to inform those of ordinary skill in the art, with reasonable certainty’—is clearly not a separate ground. It is merely a claimed example of alleged indefiniteness, which is a ground. The Rule doesn’t limit the former, only the latter. It doesn’t limit the number of terms that a defendant might claim are indefinite or not enabling. Accordingly, pointing to six or seven terms in a patent that are claimed to be indefinite or not enabling does not violate the Local Patent Rule. If one supposes a patent riddled with indefinite terms, it would not make sense—and it would certainly not be fair—to, at this stage, limit the defendant to choosing just one term out of that entire patent. And LPR 3.1 does not pretend to do so.” *Wimo Labs v. Polyconcept*, 358 F. Supp.3d 761, 767 (N.D. Ill. Mar. 6, 2019) (Cole M.J.).

11. Multiple Documents Describing Prior Art System Count as Single Reference

“[T]he Court concludes that it is appropriate to construe the term ‘prior art reference’ within LPR 3.1 as including, in addition to a prior art instrumentality, the associated references necessary to describe that instrumentality.” *GeoTag Inc. v. Classified Ventures, LLC*, No. 13-cv-00295 (N.D. Ill. Feb. 13, 2014) (Tharp, J.).

12. Production of Documents Does Not Replace Obligation to Disclose Prior Art References in Contentions

“The fact that [Defendant] produced these five pages along with thousands of other pages of documents does not mitigate [the] prejudice [of not disclosing these documents in their L.P.R. 3.1 disclosures]. On this issue, [Defendant] again circumvented the Local Patent Rules, and [Defendant] has not presented any reason for failing to disclose these documents in its L.P.R. 3.1 contentions or to seek to amend its contentions to include them. ‘If these new materials are not prior art, not necessary references, and not something that their expert relied upon, then there is truly no reason for them to be in the Report.’ If, however, these documents were prior art, necessary references, or something that [Defendant’s expert] relied upon, then they should have been disclosed in [Defendant’s] invalidity contentions.” *Avnet, Inc. v. Motio, Inc.*, No. 12-cv-2100, 2016 WL 3365430, at *6 (N.D. Ill. June 15, 2016) (Schenkier, M.J.) (quoting *Pactiv Corp. v. Multisorb Techs., Inc.*, No. 10-cv-00461, 2013 WL2384249 (N.D. Ill. May 29, 2013)).

13. Parties Are Allowed and Expected to Amend and Update Their Initial Contentions

“[Defendant] argues that [Plaintiff] did not disclose its invalidity theories based on the ClearOne BMA, the ClearOne XAP 800, Kellerman 2001, or Kajala in its initial invalidity contentions as required by Local Patent Rule 2.3... But [Plaintiff] did disclose Kellerman 2001... It makes sense that [Plaintiff’s] invalidity contentions would evolve as discovery progressed and [Plaintiff] learned more about [Defendant’s] invention and legal theories. The Local Patent Rules do allow (and even expect) parties to amend and update their contentions. See Local Patent Rules 3.1.-3.2 [Plaintiff] updated its invalidity contentions accordingly, ... so there is no reason to exclude these theories for noncompliance with the Local Patent Rules.” *Shure, Inc. v. ClearOne, Inc.*, No. 17-cv-3078 at *24-25, n. 16 (N.D. Ill. Mar. 16, 2018) (Chang J.).

14. Permitting Amendment of Final Unenforceability and Invalidity Contentions

“Upon review of Defendants proposed amended final unenforceability and invalidity contentions ..., the Court GRANTS Defendants motion for leave to amend.... The Court finds good cause for the amendments because they do not present new

theories; they merely add information to support Defendants invalidity and unenforceability defenses. Because much of the added information recently came to light from Dr. Lecats deposition or from Plaintiff itself, the Court further finds that Plaintiff would not be unduly prejudiced by the amendments. The Court is not persuaded that the timing of Dr. Lecats deposition shows a lack of diligence; just as Plaintiff deposed Defendants principals late in the discovery period to ensure that Defendants story would not change after the depositions, ... a defendant could quite reasonably elect to depose the named inventor at a late stage in order to ensure it has first obtained all relevant documents.” *Lecat’s VentriloScope v. MT Tool & Mfg.*, No. 16-cv-05298 (N.D. Ill. Aug. 1, 2018) (Castillo, C.J.).

15. Final Contentions Must Include an Explanation for Doctrine of Equivalents

“That Plaintiff [] was not aware of Defendant[]’s position on the Maricopa clay until October 5, 2017 does not change the Court’s ruling that Plaintiff’s Final Infringement Contentions in support of its doctrine of equivalents theory of infringement did not comply with Northern District of Illinois Local Patent Rule 2.2(d) because the contentions did not include ‘an explanation of each function, way, and result that is equivalent and why any differences are not substantial[.]’ Therefore, the Court, in its discretion, denies Plaintiff’s motion to reconsider this interlocutory order.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067 (N.D. Ill. May 7, 2018) (St. Eve, J.).

16. Claim Construction Arguments Cannot be Inconsistent with Final Invalidity Contentions

“Local Patent Rule 2.3(b)(4) states that ‘invalidity contentions must contain a detailed statement of any grounds of invalidity based on indefiniteness’ (emphasis added). The purpose of these rules surrounding final invalidity contentions is to put the plaintiff on notice as to the anticipated arguments and the support for them. There is no question that Defendants’ position presented in their opening claim construction brief is materially different from their prior, disclosed ‘redundant’ argument. Section B of Defendants’ opening claim construction brief argues that the claim term is contradictory and therefore indefinite. This argument is itself contradictory to the position stated in Defendants’ final invalidity contentions and also is

nowhere to be found in the same. Defendants' attempt to swap out invalidity contentions is improper and violates Local Patent Rules 3.1 and 2.3(b)(4).” *Trading Techs. Int'l, Inc. v. BGC Partners, Inc.*, No. 10-cv-00715 *4 (N.D. Ill. Aug. 15, 2019) (Kendall, J.).

17. Motion to Strike Final Infringement Contentions May Be Treated as a Motion to Compel More Detail

“[Defendant] first argues that [Plaintiff’s] direct infringement contentions embodied in [Plaintiff’s] chart detailing the dependent and independent claims of the ‘019 Patent as required by LPR 2.2(c) are ‘devoid’ of the required disclosures. [Defendant] specifically argues that [Plaintiff’s] reliance on its testing of the Accused Instrumentalities does not provide sufficient details for the limitation ‘predetermined mean particle size,’ also known as predetermined MPS. In response, [Plaintiff] explains that determining whether the claim limitation ‘predetermined MPS’ is embodied in the Accused Products involves expert chemical testing and that it has provided [Defendant] with such testing results and data as an exhibit to its Final Infringement Contentions.... In any event, [Defendant] asks the Court strike certain Final Infringement Contentions because [Plaintiff] does not explain where the claim limitation ‘predetermined MPS’ is found in the Accused Instrumentalities.... [I]nstead of striking these Final Infringement Contentions, the better course of action is to treat this aspect of [Defendant’s] motion to strike as a motion to compel amendment to the infringement contentions.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *6-7 (N.D. Ill. Feb. 26, 2018) (St. Eve, J.).

18. Patent Owner Must Identify Specific Date(s) It Intends to Rely on to Show Reduction to Practice and Conception of Asserted Patent Claims, So Defendant Has Necessary Information to Provide Final Invalidity Contentions

“The Local Patent Rules ‘are meant to prevent a ‘shifting sands’ approach to claim construction by forcing the parties to ‘crystallize their theories of the case early in litigation.’ [P]laintiff’s theory is that its patent was conceived of and reduced to practice before the patent filing date. [Defendant] has a right to know the dates underlying this theory so that it can respond. Indeed in its final contentions, [Defendant] will be limited in the number of prior art references it can use. See LPR 3.1. And amendment to final contentions is allowed ‘only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties.’ LPR 3.4.” *Beckman Coulter, Inc. v. Sysmex Am., Inc.*, No. 18-cv-06563, 2019 WL 1875356 at *2 (N.D. Ill. Apr. 26, 2019) (Rowland M.J.).

19. Motion to Strike Final Invalidity Contentions is Not the Proper Vehicle For Resolving a Dispute About Whether a Cited Reference Qualifies as Prior Art

“[Plaintiff]’s third argument is that a particular prior art reference cited in [Defendant]’s final contentions—a published U.S. patent application by an inventor named Mehta— does not qualify as prior art because it postdates the ‘513 patent’s March 27, 2009 priority date. [Defendant]’s response is that [Plaintiff] has not established that the ‘513 patent is entitled to that priority date, which is derived from an earlier patent application. The short answer is that this dispute goes to the merits of [Defendant]’s final contentions and thus is not an appropriate matter for a motion to strike. It should be litigated, if appropriate, as part of a motion for summary judgment. The Court declines to rule on the merits of this issue.” *GemShares LLC v. Arthur Joseph Lipton et al.*, No 17-cv-6221 *2-3 (N.D. Ill. Dec. 28, 2018) (Kennelly, J.).

LPR 3.2 Final Non-Infringement, Enforceability, and Validity Contentions

Not later than 28 days after the due date for Final Infringement Contentions under LPR 3.1:

- (a) Each party asserting non-infringement of a patent claim shall serve on all other parties “Final Non-infringement Contentions” containing the information called for in LPR 2.3(a).
- (b) Each party asserting patent infringement shall serve “Final Enforceability and Validity Contentions” in response to any “Final Unenforceability and Invalidity Contentions.”

Annotations

1. Final Contentions Limit Scope of Summary Judgment Motions

“[Defendant] never previously disclosed this ‘flexible bushing’ [non-infringement] argument. For the first time in its summary judgment brief, [Defendant] argues that its bushing is flexible and, thus, does not have a horizontal axis of plunger travel. [Defendant] never disclosed this non-infringement theory in its final contentions, never previously disclosed that its bushing was too flexible to allow a ‘horizontal axis of plunger travel,’ and never raised this theory in any of its expert reports. [Plaintiff] did not have notice of this non-infringement argument. Further, [Defendant] failed to seek leave to amend its

final non-infringement contentions to include this theory. It is now too late to do so.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 165968, *37 (N.D. Ill. Nov. 20, 2013) (St. Eve, J.).

2. Final Contentions May Not Limit Scope of Evidence Presented at Trial for Certain Purposes

“[Plaintiff] argues ... that [Defendant’s] Notice of Prior Art under 35 U.S.C. § 282 ... should be excluded at trial because it is in violation of Local Patent Rule 3.4. [Plaintiff] alleges that the cited prior art references will be used by [Defendant] to support its invalidity defenses at trial. However, [Defendant] contends that the references are unrelated to invalidity contentions. Rather, the references will be used for the limited purpose of showing the ‘state of the art’ as required by 35 U.S.C. § 282(c)... In addition, the record reflects that [the expert] disclosed such prior art references through his expert report. [Defendant’s] late disclosure of these references is not unfairly prejudicial to [Plaintiff] given their limited purpose at trial.” *PSN Ill., LLC v. Abbott Labs.*, 2012 U.S. Dist. LEXIS 155637, *13-14 (N.D. Ill. Oct. 31, 2012) (Der-Yeghiayan, J.).

3. Final Contentions May Include Theories Not Set Forth in Initial Contentions

“The Court overrules [Plaintiff]’s argument that [Defendant] should be barred from including invalidity defenses (including combinations of prior art) that it did not assert in its initial contentions. Accepting this argument would essentially turn the Local Patent Rules on their head. The drafters of the Rules chose not to require a single-stage set of contentions that would be binding throughout the litigation. Rather, the Rules adopt an approach that requires very early initial, non-binding contentions, followed later in the suit by final, binding contentions. The purpose of the initial contentions is not to lock the parties into particular positions but rather to enable them to focus discovery and preparation on the issues that are likely to be significant as the case progresses. See LPR 1.6, Committee Comment. Had the drafters of the Rules intended the initial contentions to be binding or to, in effect, estop the parties from taking different or contrary positions later, they would not have required the disclosures at such an early stage of the case. In this regard, the Court notes that although the Rules require a showing of good cause and the absence of unfair prejudice to amend final contentions, see LPR 3.4, they contain no similar requirement that would effectively bind a party to its initial contentions.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *2 (N.D. Ill. Jun. 9, 2018) (Kennelly, J.).

LPR 3.3 Document Production Accompanying Final Invalidity Contentions

With the Final Invalidity Contentions, the party asserting invalidity of any patent claim shall produce or make available for inspection and copying: a copy or sample of all prior art identified pursuant to LPR 3.1(b), to the extent not previously produced, that does not appear in the file history of the patent(s) at issue. If any such item is not in English, an English translation of the portion(s) relied upon shall be produced. The translated portion of the non-English prior art shall be sufficient to place in context the particular matter upon which the party relies.

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

LPR 3.4 Amendment of Final Contentions

A party may amend its Final Infringement Contentions; Final Non-infringement, Unenforceability and Invalidity Contentions; or Final Contentions in Response to any Unenforceability and Invalidity Contentions only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery of the basis for the amendment. An example of a circumstance that may support a finding of good cause, absent undue prejudice to the non-moving party, includes a claim construction by the Court different from that proposed by the party seeking amendment. A motion to amend final contentions due to a claim construction ruling shall be filed, with proposed amendment(s), within 14 days of the entry of such ruling.

The duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.

Annotations

1. Moving Party Must Establish Both Good Cause and Absence of Unfair Prejudice

“[Movant] has the burden of demonstrating both good cause and lack of prejudice.” *R-Boc Representatives, Inc. v. Minemyer*, 2014 WL 4412311, *4 (N.D. Ill. Sept. 5, 2014) (Cole, M.J.).

“The court notes that according to the plain language of Local Patent Rule 3.4, which provides that a party may amend its final infringement contentions only upon a ‘showing of good cause and absence of unfair prejudice to opposing parties’ [Plaintiff’s] failure to establish good cause warrants denial

without consideration of any prejudice to [Defendant].” *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 38740, *35 (N.D. Ill. Mar. 21, 2012) (Holderman, C.J.).

2. Good Cause Determination Is Within Discretion of Court

“Determining whether a party has satisfied the good cause requirement is within the discretion of the court.” *Thermapure, Inc. v. Giertsen Co.*, 2012 U.S. Dist. LEXIS 175612, *5-6 (N.D. Ill. Dec. 11, 2012) (Lefkow, J.).

3. Amendment Permitted to Respond to Corresponding Amended Contentions by Opposing Party

“[T]he Court grants [Defendant’s] Motion for Leave to Amend its Non-infringement, Invalidity/Unenforceability Contentions to the extent that those amendments are necessary to respond to the permissible amendments to Amended Final Infringement Contentions.” *Sloan Valve Co. v. Zurn Indus.*, 2012 U.S. Dist. LEXIS 176554, *14 (N.D. Ill. Dec. 13, 2012) (St. Eve, J.).

4. Amendment That Did Not Change Infringement Theory Rejected

“Because the purpose of infringement contentions is to provide notice of the plaintiff’s theories of infringement early in the case, and [Plaintiff] is not, by its own concession, seeking to change its theory, this proposed amendment to its contentions is unnecessary.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 22739, *9 (N.D. Ill. Feb. 20, 2013) (St. Eve, J.).

5. Amendment Including Extra Data Supporting Infringement Theory Rejected

“[T]he proposed additions are evidence that will be used by [Plaintiff] at trial to prove its previously disclosed theories of infringement. Although the Court does not currently address the issue of whether such data will be admissible at trial, the Court agrees that there is no cause at this stage to amend the contentions in order to include extra data to support the theories included in these contentions.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 22739, *12-13 (N.D. Ill. Feb. 20, 2013) (St. Eve, J.).

6. Willingness to Provide Additional Details May Constitute Good Cause

“[Plaintiff] maintains that before [Defendant] filed the present motion, [Plaintiff] had indicated its willingness to amend its final contentions and provide additional details, but [Defendant] nevertheless filed the present motion.... The Court considers this good cause for allowing [Plaintiff] to amend its final contentions ... and concludes that [Defendant] will not be

prejudiced in allowing [Plaintiff] to do so.” *Morningware, Inc. v. Hearthware Home Prods.*, 2010 U.S. Dist. LEXIS 98927, *22 (N.D. Ill. Sept. 22, 2010) (St. Eve, J.).

7. Good Cause Shown Where Expert Did Not Disclose Opinion Until Deposition

“Because [Plaintiff’s expert’s] opinion and understanding of the ‘visually negligible’ term was not elucidated until his deposition, Defendants’ response is timely and they have shown ‘good cause’ for leave to amend their invalidity contentions in this manner.” *Sonix Tech. Co. v. Publications Int’l, Ltd.*, 13-cv-2082 (N.D. Ill. Aug. 10, 2015) (St. Eve, J.).

8. Good Cause Requires Diligence

“To demonstrate good cause to amend invalidity or infringement contentions, a party must demonstrate that it acted diligently and that the accused infringer would suffer no unfair prejudice if the moving party were permitted to amend... ‘In showing diligence, the relevant inquiry is not when the party learned about the information, but when it could have made the discovery’.... Furthermore, ‘good cause requires more than a showing that new information has been revealed in discovery.’” *Peerless Indus. v. Crimson AV, LLC*, 2013 WL 6197096, *5 (N.D. Ill. Nov. 27, 2013) (Lefkow, J.).

“In determining whether amendments of final infringement contentions are appropriate, the two factors that govern are whether (1) the party seeking the amendment acted with diligence and (2) the accused infringer would suffer prejudice.... The party seeking to amend its final infringement contentions has the burden of establishing that it acted diligently and that the accused infringer will suffer no unfair prejudice....” *Thermapure, Inc. v. Giertsen Co.*, 2012 U.S. Dist. LEXIS 175612, *5-6 (N.D. Ill. Dec. 11, 2012) (Lefkow, J.).

“Local Patent Rule 3.4 states that a party may amend its final contentions ‘only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery of the basis for the amendment.’ N.D. Ill. LPR 3.4. [Plaintiff]’s motion does not satisfy any of the rule’s requirements. First, the motion was not made promptly upon discovery of the basis for the amendment. [Plaintiff] does not address this requirement in its motion, but it appears that it discovered the basis for the amendment back in February 2018, when it received certain clay samples from [Defendant]. Yet it did not file the present motion for nine months, despite knowing as of Judge St. Eve’s February 26,

2018 ruling that it had no ‘live’ doctrine of equivalents infringement contentions.... Second, [Plaintiff] says that it made its doctrine of equivalents contentions known to [Defendant] via e-mails sent to its attorney in early March 2018. It seems to take the position that this was good enough. But the rule says that final contentions may be amended ‘only by order of the Court.’ [Plaintiff] may not end-run this requirement by relying on disclosures made on the if-come (‘[s]hould the Court allow it,’ ...) without so much as an attempt to seek court permission.... Third, [Plaintiff] has not shown good cause; indeed, it has barely attempted to do so. Both its motion and its reply focus on its contention that [Defendant] was aware of its position due to the March 2018 e-mails. That confuses notice with good cause. The closest [Plaintiff] comes to arguing good cause is a seeming contention that Judge St. Eve’s February 2018 ruling was wrong.... If that is what [Plaintiff] is contending, the argument lacks merit. Judge St. Eve denied a motion to reconsider, and [Plaintiff] did not even attempt to seek amendment after that. The earlier rulings are the law of the case, and now is far too late to seek reconsideration.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *2-3 (N.D. Ill. Dec. 21, 2018) (Kennelly, J.).

9. Cases Holding Party Acted Diligently in Amending Contentions

“[T]he Court will credit [Defendant’s] representation that it did not become aware of the process [Defendant’s subsidiary] used in 1980s until January 2013 and finds that [Defendant] acted diligently in pursuing the amendment [three months later].” *Oleksy v. General Elec. Co.*, 2013 U.S. Dist. LEXIS 107638, *13 (N.D. Ill. July 31, 2013) (Kendall, J.).

“[Plaintiff] seeks to amend its final infringement contentions to include [certain Defendant products] as accused instrumentalities.... [I]n discovery requests and in [Defendant’s] deposition, [Plaintiff] inquired into these topics; however, it did not receive a forthright response regarding [Defendant’s] use of these [products]. After learning about [Defendant’s product] use in November 2012, [Plaintiff] timely filed a motion seeking leave to amend its final infringement contentions with this new information. The court concludes that [Plaintiff] acted with the requisite diligence to satisfy Local Patent Rule 3.4’s good cause requirement.” *Thermasure, Inc. v. Giertsen Co.*, 2012 WL 6196912, *3 (N.D. Ill. Dec. 11, 2012) (Lefkow, J.).

10. Cases Rejecting Amendment of Contentions for Lack of Diligence

“[Defendant] argues that because fact discovery was still open at the time it engaged in the third-party discovery and because [Defendant] promptly filed this motion upon discovering the pertinent information, it has satisfied the good cause requirement. The Final Invalidation Contentions are the not the *raison d’être* of fact discovery. The Second Revised Discovery Plan contemplated that discovery would continue after the parties served their final contentions; there are purposes of discovery that extend beyond the final contentions. Furthermore, there will be another round of fact discovery after the Court issues its claims construction ruling. By [Defendant’s] logic, anything it uncovers during those periods, no matter how readily it could have been discovered before it served [its] Final Invalidation Contentions, is a sufficient basis for amending its Final Invalidation Contentions. This is not correct. The question is whether [Defendant] should have discovered this information sooner. Because in the present case [Defendant] could have and should have, it has failed to satisfy the good cause requirement of Local Patent Rule 3.4 and the Court denies its motion for leave to amend.” *Kolcraft Enters., Inc. v. Artsana USA, Inc.*, No. 13-cv-04863, at *2 (N.D. Ill. Sept. 20, 2017) (Ellis, J.).

“Defendant’s motion to amend final invalidity contentions ... is denied. No good cause has been shown as to why the proposed Fisher-Price and Kids II amendments were not presented much earlier: Defendant knew of the references long ago, and although the asserted patent Claims have changed over the course of the litigation, Claims 20 and 28 31 have been at issue well after Defendant knew of the references. Also, fact discovery closed on 10/14/2016 (for Claims 28–31) and 12/31/2016 for Claim 20, and again well before that time Defendant should have engaged in discovery in *this* case in order to develop (and allow Plaintiff to rebut, in *this* case) these references. So the motion is denied.” *Kolcraft Enters., Inc. v. Chicco USA, Inc.*, 1-09-cv-03339, at *1 (N.D. Ill. July 9, 2017) (Chang, J.).

“[Plaintiff] has not demonstrated good cause to amend its final infringement contentions because its actions demonstrate a lack of diligence. As noted above, [defendant’s] initial non-infringement contentions dated September 7, 2012 provided that ‘[defendant] does not perform, nor does it instruct others

to perform, the step of removing a lamp from a motor vehicle.’ Similarly, [defendant’s] interrogatory responses dated October 5, 2012 provided that ‘[t]he first step of [defendant’s] refinishing process involves the delivery of candidate head lamps to [defendant’s] facility from either [defendant’s] salvage yards or from third party salvage companies.’ Thus, [plaintiff] had notice of [defendant’s] position in the fall of 2012 and, while [defendant] elaborated on its argument in its final non-infringement contentions, [plaintiff] cannot now argue that [defendant’s] final non-infringement contentions represent a material change in [defendant’s] position. Indeed, [plaintiff] acknowledged [defendant’s] position in its final infringement contentions. (See dkt. 103-4 Exh. 5 at 5 ([Plaintiff] understands that in some instances [defendant] may not perform the step of removing the lamp from the motor vehicle.’))” *Clearlamp LLC v. LKQ Corp.*, No. 12-cv-02533 (N.D. Ill. Jul. 2, 2015) (Lefkow, J.).

“These ‘undisturbed’ principles on which [Defendant] is basing its new invalidity contentions were as available to [Defendant] when it made its final invalidity contentions ... and when it submitted its expert report ... as they are [now].... This is a waiver of an argument regarding indefiniteness in any sense, and the fact that [Defendant’s] indefiniteness contention is based on case law that was readily available to counsel at the time he came up with his definition for the claim term certainly scuttles any contention that there was good cause.” *R-Boc Representatives, Inc. v. Minemyer*, 2014 WL 4412311, *5 (N.D. Ill. Sept. 5, 2014) (Cole, M.J.).

“[T]he local patent rules require the plaintiff to file its final infringement contentions after the close of fact discovery, but before claim construction and expert discovery. Here, [Plaintiff] seeks to amend its final infringement contentions after claim construction, after the close of expert discovery, and after the Court’s ruling on the parties’ motions for summary judgment. The Court’s summary judgment opinion on certain affirmative defenses in this case is not the type of information that is highly relevant to final infringement contentions and certainly does not meet the good cause standard that Local Patent Rule 3.4 requires. Rather, [Plaintiff’s] proposed amendments give credence to [Defendant’s] argument that [Plaintiff’s] true intent is to inform the jury of the Court’s adverse rulings on certain of [Defendant’s] affirmative defenses. This is not a proper use of final infringement contentions.” *Sloan Valve Co. v. Zurn Indus.*, 2014 U.S. Dist. LEXIS 1208, *11-12 (N.D. Ill. Jan. 7, 2014) (St. Eve, J.).

“[Plaintiff] did not assert indirect infringement in its final infringement contentions.... [Plaintiff] filed its motion for leave to amend its infringement contentions less than three weeks [after Defendants served their final non-infringement contentions].... [Plaintiff] has not shown that good cause to amend its final infringement contentions exists. This Court has not yet construed the claims and [Plaintiff] does not claim that discovery revealed any new information that warrants an amendment. Rather, [Plaintiff] claims that the positions the Defendants have taken in response to [Plaintiff’s] final infringement contentions necessitate an amendment by [Plaintiff]. But the facts have not changed.... [Plaintiff] has the burden of proof with respect to infringement and had to provide notice of its legal theories in view of the information revealed through discovery.... There is no new information that requires an amendment. The only thing that has changed is the Defendants’ legal theory. In other words ... all that has changed is how the Defendants’ view the facts in the context of [Plaintiff’s] allegations. This does not establish good cause.” *Northgate Techs., Inc. v. Stryker Corp.*, No. 12-cv-07032 (N.D. Ill. Dec. 16, 2013) (Kendall, J.).

“[Defendant] has not established good cause to amend its invalidity contentions because its actions demonstrate a lack of diligence in pursuing these defenses.... [Defendant] argues that it could not have filed this motion any sooner because it lacked necessary information due to [Plaintiff’s] admonishable discovery tactics.... But [Defendant] does not explain why it was able to include the unnamed inventor and on-sale bar doctrine contentions in its April summary judgment motion but was unable to request leave to properly add those contentions. Even if it received confirmation of this through discovery during the summer and fall (and is still awaiting confirmation through discovery that [Plaintiff] has not yet turned over), that is no excuse. ‘[T]heories of [invalidity] do not need to be confirmed before [invalidity] contentions may be amended.’” *Peerless Indus. v. Crimson AV, LLC*, 2013 WL 6197096, *6 (N.D. Ill. Nov. 27, 2013) (Lefkow, J.).

“[Defendant] seeks to ... amend[] its non-infringement contentions ... [Defendant] has not shown good cause to amend this contention because its proposed amendment improperly re-argues issues the court treated during claim construction.... Because [Defendant] is attempting to re-argue an issue at play in the claim construction process, it could and should have included this amended contention earlier. [Defendant]

thus has failed to demonstrate good cause or diligence, and the court need not delve into whether [Plaintiff] would suffer prejudice if [Defendant] were allowed to amend this contention.” *Avnet, Inc. v. Motio, Inc.*, No. 12-cv-02100 (N.D. Ill. Nov. 27, 2013) (Lefkow, J.).

“[Defendant] has not shown the good cause necessary to amend this contention. While the proposed amended contention incorporates the court’s claim construction ruling ... [Defendant] has not demonstrated why this addition is necessary. The unamended iteration of its non-infringement contention encapsulates this idea... It is thus unnecessary to update this contention as [Defendant] proposes, and [Defendant] provides the court with no good cause to find to the contrary.” *Avnet, Inc. v. Motio, Inc.*, No. 12-cv-02100 (N.D. Ill. Nov. 27, 2013) (Lefkow, J.).

“[Defendant] did not raise the issue of seeking leave to amend its Invalidity and Unenforceability Contentions until July 25, 2013 (nearly four months [after discovering its basis]) and only did so in response to [Plaintiff’s] motion for summary judgment. Further, [Defendant’s] January 2012 Invalidity and Unenforceability Contentions included §§ 102 and/or 103 invalidity contentions as to all of the asserted claims... [Defendant] removed these contentions from its January 2013 invalidity and unenforceability contentions, which it filed after the *Markman* hearing... Even if it had shown good cause to amend its contentions, [Defendant] has not shown that it sought leave to add these invalidity contentions ‘promptly upon discovery of the basis for the amendment.’ This lack of diligence and delay by [Defendant] undermines any good cause it could have to warrant amendment, which it also has not shown.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 165968, *59-60 (N.D. Ill. Nov. 20, 2013) (St. Eve, J.).

“[I]n addition to failing to show good cause for this amendment, [Plaintiff] has not shown that it sought leave add this amendment ‘promptly upon discovery of the basis for the amendment.’ Indeed, the Court issued its claim construction ruling September 13, 2012 and [Plaintiff] did not file the present motion until January 28, 2013... [Plaintiff] had access to this data and had analyzed it prior to October 9, 2012, yet did not seek leave to include these contentions until January 28, 2013... This lack of diligence and repeated delay by [Plaintiff] undermines any good cause it could have to warrant amendment.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 22739, *10-11 (N.D. Ill. Feb. 20, 2013) (St. Eve, J.).

“[Plaintiff], however, was delinquent in seeking to amend its contentions to reflect this information... Despite having obtained this information in the fall, [Plaintiff] offers no explanation in its motion for the three month delay in seeking to amend its contentions in this manner ... the parties appeared before the Court and filed multiple documents with the Court, yet failed to bring this issue to the Court until months later. Moreover, the parties are currently in the middle of expert discovery, having already exchanged initial expert reports. The Court will not reward such delay by [Plaintiff], particularly when [Plaintiff] has not offered any justification for its actions.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 22739, *14-15 (N.D. Ill. Feb. 20, 2013) (St. Eve, J.).

“The relevant inquiry is not when [Plaintiff] learned about the information, but when it could have made the discovery... [Plaintiff] could have subpoenaed [Defendant’s] affiliates before fact discovery closed (as it had done in 2011) requesting this type of information, but it never did so. [Plaintiff] failed to act with the required diligence to show good cause under Local Patent Rule 3.4 that would allow amendment.” *Thermasure, Inc. v. Giertsen Co.*, 2012 WL 6196912, *2 (N.D. Ill. Dec. 11, 2012) (Lefkow, J.).

“[Plaintiff] relies heavily on the fact that much of the source code cited in its proposed amended infringement contentions is recently produced. But good cause requires more than a showing that new information has been revealed in discovery... It requires the party to show that it acted with reasonable diligence in asserting the new infringement theory... [Plaintiff] has not met its burden to show good cause. Notably, [Defendant] designated [witnesses] in late 2009 to testify regarding the operation of [Defendant’s] products as they relate to the [asserted] patent. But [Plaintiff] did not set dates to depose these witnesses until late January, as the fact discovery deadline approached... Further, while [Plaintiff] complains of the confusing and incomplete nature of [Defendant’s] source code production, it did not raise those issues with this court until now. [Plaintiff] simply has not shown diligence either in pursuing its [new infringement] theory or updating its infringement contentions.” *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 38740, *32-33 (N.D. Ill. Mar. 21, 2012) (Holderman, C.J.).

“[B]y its own admission, [Plaintiff] identified many of [Defendant’s] ‘new’ products as potentially infringing in 2009

and 2010.... [Plaintiff] points to recent deposition testimony that it argues 'confirm[ed]' the bases for infringement ... but ... theories of infringement do not need to be confirmed before infringement contentions may be amended. Additionally, the court agrees with [Defendant] that it would be prejudiced by having to analyze and defend itself with respect to these additional products at this late stage of the case. Because [Plaintiff] has not explained how these proposed amendments were made promptly upon discovery of their bases or shown an absence of unfair prejudice to [Defendant], the motion to amend is denied as to the new products." *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 38740, *41-42 (N.D. Ill. March 21, 2012) (Holderman, C.J.).

"[Plaintiff] waited ... nearly two years ... to seek leave to make these amendments.... [Plaintiff's] delay in seeking leave to make these amendments is unjustified.... To suggest that [Plaintiff's] counsel was so busy with the other issues in this case that it required almost two years to prepare a motion for leave to file the amended complaint and amended infringement contentions is unfounded." *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2011 U.S. Dist. LEXIS 112672, *10-11 (N.D. Ill. Sept. 29, 2011) (Holderman, C.J.).

"[Defendant] also argues that the Court erred by applying Local Patent Rule 3.4's good cause standard in barring the tardily-disclosed [reference] and the [device.] But the Federal Circuit has explained that the use of local patent rules falls within a district court's 'broad power to control its docket and enforce its order.' [Defendant] failed to show good cause for its late amendments to its invalidity contentions, and this Court permissibly barred the prior art. [Defendant]'s assertion that this excluded prior art would have been relevant to the case does not change the fact of its proscriptively tardy disclosure." *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 315 F. Supp. 3d 977, 1006 (N.D. Ill. 2018), *aff'd in part, vacated in part, rev'd in part sub nom. Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, No. 2018-2103, 2019 WL 3938278 (Fed. Cir. Aug. 21, 2019).

11. Non-Movant Receiving Notice or Discovery from Movant Does Not Excuse Delay in Seeking Amendment

"[T]he fact that [Plaintiff] provided discovery on these theories does not demonstrate compliance with the Local Patent

Rules." *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 38740, *n.9 (N.D. Ill. Mar. 21, 2012) (Holderman, C.J.).

"[Plaintiff's] contention that [Defendant's] will not be prejudiced because [Defendant] has had notice of these potential amendments [for nearly two years] is not well-taken. [Plaintiff] dedicates a substantial portion of its arguments to this court outlining when [Defendant] received notice of these potential amendments.... [Plaintiff], however, never took the requisite step of seeking the court's leave to amend the ... Infringement Contentions. That [Defendant] had notice that [Plaintiff] ultimately could seek to make these amendments and include new infringement theories does not excuse [Plaintiff's] delay nor does it ameliorate the prejudice to [Defendant], particularly whereas here, [Plaintiff's] extensive and ever-continuing delay in pursuing these theories raised a substantial likelihood that [Plaintiff's] request for leave to amend would be denied." *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2011 U.S. Dist. LEXIS 112672, *12-13 (N.D. Ill. Sept. 29, 2011) (Holderman, C.J.).

"Third, [Plaintiff] has not shown good cause; indeed, it has barely attempted to do so. Both its motion and its reply focus on its contention that [Defendant] was aware of its position due to the March 2018 e-mails. That confuses notice with good cause. The closest [Plaintiff] comes to arguing good cause is a seeming contention that Judge St. Eve's February 2018 ruling was wrong.... If that is what [Plaintiff] is contending, the argument lacks merit. Judge St. Eve denied a motion to reconsider, and [Plaintiff] did not even attempt to seek amendment after that. The earlier rulings are the law of the case, and now is far too late to seek reconsideration". *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *3 (N.D. Ill. Dec. 21, 2018) (Kennelly, J.).

12. Expert Declaration May Help Establish Reasonableness of Delay in Seeking Amendment

"[Plaintiff] does assert that until it received source code files recently produced by [Defendant], it could not have understood the theory of infringement it now advances.... In its voluminous filings, however, [Plaintiff] has not included an affidavit from one its experts explaining what information it needed to articulate [its new infringement theory] and when that information became available." *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 38740, *31-32 (N.D. Ill. Mar. 21, 2012) (Holderman, C.J.).

13. Amendment Held Not Unduly Prejudicial

“[T]he Court must determine whether [Plaintiff] would be unduly prejudiced by the three-month delay between the date the Final Invalidation Contentions were due and the time [Defendant] sought leave to amend those contentions.... [Plaintiff] contends that he would be prejudiced because documents relating to the [Defendant's subsidiary's] process could have been destroyed because [Defendant's subsidiary] only holds records for seven years and did not receive a litigation hold notice until January 2013. However, the risk of document destruction from the ordinary course of business would exist regardless of whether [Defendant] asserted this defense in December 2012 or March 2013. Therefore, [Defendant's] delay does not prejudice [Plaintiff] on this ground.... The Court also does not find the discovery time and costs that are associated with the [Defendant's subsidiary] defense are overly prejudicial to [Plaintiff].... discovery on the [Defendant's subsidiary's] process would likely have to be performed regardless of whether or not this prior use affirmative defense is allowed. Moreover ... there is still time before the fact discovery cut-off to take the necessary discovery on this issue.” *Oleksy v. General Elec. Co.*, 2013 U.S. Dist. LEXIS 107638, *14-15 (N.D. Ill. July 31, 2013) (Kendall, J.).

14. Amendment Rejected as Unduly Prejudicial

“[Plaintiff] has not carried its burden to show that [Defendant] would not be unfairly prejudiced by the introduction of a new theory of infringement.... In regard to prejudice to [Defendant], the court finds that interjecting a completely new theory of infringement at this stage of the case, when it has been pending for more than four years and is on the verge of trial, would prejudice [Defendant] ... introducing additional [Defendant's] products and infringement theories into the litigation at this late stage, after [Defendant] has committed to its claim construction positions, would be highly prejudicial.” *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2012 U.S. Dist. LEXIS 38740, *35 (N.D. Ill. Mar. 21, 2012) (Holderman, C. J.).

“[T]he court also finds that [Defendant] would be severely prejudiced by allowing [Plaintiff] to now pursue these infringement theories at this late date. The parties have been actively engaged in discovery, including document production and depositions. The identification of new accused products that previously were not at issue in this case creates the very likely possibility that [Defendant] will have to once again perform extensive (and costly) searches and reviews of electronically stored information and re-depose witnesses, all of which could

have been handled more cost-effectively by [Plaintiff's] counsel adding the new infringement theories had been added to this action when the case was transferred to this court in 2009 as opposed to nearly two years later.... Introducing additional [Defendant] products and infringement theories into the litigation at this late stage, after [Defendant] has committed to its claim construction positions, would be highly prejudicial.” *Fujitsu Ltd. v. Tellabs Operations, Inc.*, 2011 U.S. Dist. LEXIS 112672, *11-12 (N.D. Ill. Sept. 29, 2011) (Holderman, C.J.).

“The rule also requires the absence of unfair prejudice to the opposing party ([Defendant]). [Plaintiff] cites evidence suggesting that [Defendant] was assuming that the doctrine of equivalents theory was in the case. But that misses the point. [Defendant] was entitled to rely on Judge St. Eve's rulings. The prejudice that it would experience were the Court to permit the amendment is clear: it would have to conduct further depositions of [Plaintiff's] experts; it would have to obtain and conduct testing of clay samples; and it would have to supplement its own expert disclosures. [Plaintiff] responds that this can be done quickly (actually it likely would take about six weeks of hard work, all told), but allowing a post-discovery amendment simply because a fix is available is tantamount to saying that court-imposed discovery and disclosure deadlines are meaningless. And even were one to conclude that [Defendant] would not be unfairly prejudiced, the Local Patent Rules do not permit a party to amend its final infringement contentions so long as the other party is not unfairly prejudiced; good cause and timeliness are also required. As the Court has concluded, [Plaintiff] has met neither of those requirements.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *3-4 (N.D. Ill. Dec. 21, 2018) (Kennelly, J.).

15. Delay Itself May Constitute Prejudice

“[T]he public has a significant and transcendent interest in the speedy and efficient resolution of disputes and that delay alone can impair the public interest in the prompt resolution of disputes.... There comes a point where delay, itself, is prejudicial.... We are at that point now, if we haven't already been before.” *R-Boc Representatives, Inc. v. Minemyer*, 2014 WL 4412311, *5 (N.D. Ill. Sept. 5, 2014) (Cole, M.J.).

16. Amendment Allowed Only to Extent Permitted by Court

“[Plaintiff's] Motion to Amend Its Final Infringement Contentions explicitly stated a single basis for its request: ‘that the Court enter an order permitting [Plaintiff] to amend its Final

Infringement Contentions against [Defendant] to specifically recite [Plaintiff's] claim for provisional damages relating to [Defendant's] pre-issuance activities.' ... [Plaintiff's] motion was silent as to requesting leave to amend its contentions on the basis of the Court's ... claim construction order or any other basis outside of the clear request under Section 154(d). Furthermore, the Court limited the extent to which [Plaintiff] could amend its Final Infringement Contentions to recite claims for provisional damages. Yet, [Plaintiff's] Amended Final Infringement Contentions ... explicitly state that its amended contentions 'have been updated in view of the court's claim construction decision'.... The Court, however, did not grant [Plaintiff] permission to amend based on the claim construction ruling. [Plaintiff's] attempts to circumvent the Court's October 2, 2012 Order are improper. As such, the Court strikes these amendments." *Sloan Valve Co. v. Zurn Indus.*, 2012 U.S. Dist. LEXIS 176554, *9 (N.D. Ill. Dec. 13, 2012) (St. Eve, J.).

17. Only the Final Contentions Require Leave of Court to Amend

"[Plaintiff] is also mistaken about the local patent rules of this district. Local Patent Rule 3.4 provides that '[a] party may amend its Final Infringement Contentions or Final Non-infringement and Invalidity Contentions only by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery....' The parties have not filed Final Infringement, Non-Infringement, or Invalidity Contentions; they have only filed initial contentions. [Plaintiff] is mistakenly treating the Initial Infringement Contentions required by the scheduling order (due August 1, 2016) with final infringement, non-infringement, and invalidity contentions. [Plaintiff's] argument is unfounded." *Sioux City Steel Co. v. Prairie Land Millwright Serv. Inc.*, Case No. 16-cv-02212, at *10, n. 3 (N.D. Ill. Mar. 29, 2019) (Gottschall, J.).

18. Patentee Cannot Add Additional Claims in its Final Infringement Contentions

"This caselaw, and a commonsense application of the federal pleading requirements, make clear that [Plaintiff] cannot add additional patent claims to this case by asserting them, for the first time, in final infringement contentions. The action [Plaintiff] proposes alters the scope of this litigation and would vitiate the purpose of the initial contentions required by the Local Patent Rules. It is on this basis, and without consideration of the pending petitions for Inter Partes Review, that this Court

concludes that [Plaintiff's] Final Infringement Contentions concerning the newly asserted patent claims are procedurally improper and therefore must be stricken." *RTC Indus. Inc., v. Fasteners for Retail, Inc.* Case No. 17-cv-03595, at *3 (N.D. Ill. May 7, 2018) (Coleman J.).

19. LPR 3.4 Is Consistent With Federal Rules of Civil Procedure

"[Defendant] argues that local patent rules should not trump Federal Rule of Civil Procedure 26(e). In particular, [Defendant] takes issue with Local Patent Rule 3.4, providing that a party wishing to amend its invalidity contentions may only do so 'by order of the Court upon a showing of good cause and absence of unfair prejudice to opposing parties, made promptly upon discovery of the basis for the amendment.' The rule expressly provides that a party's 'duty to supplement discovery responses does not excuse the need to obtain leave of court to amend contentions.' Federal Rule of Civil Procedure 26(e) provides that a party has a continuing obligation to supplement disclosures and responses if the party learns that a disclosure or response is incomplete or incorrect.... [Defendant's] argument fails.... [T]he Federal Circuit recently affirmed a decision denying leave to amend infringement contentions based on a local rule resembling Local Patent Rule 3.4." *Peerless Indus. v. Crimson AV, LLC*, 2013 U.S. Dist. LEXIS 168684, *22-24 (N.D. Ill. Nov. 27, 2013) (Lefkow, J.).

LPR 3.5 Relationship to USPTO Proceedings and Prior Litigation

- (a) In the parties' Rule 26(f) Report, the parties shall advise the court with respect to each patent in suit (1) whether the patent is eligible to be challenged at the USPTO by each defendant, (2) what form such a challenge may take (inter parties review, post grant review, covered business method review, ex parte reexamination, etc.), (3) the earliest and latest date such a challenge is permitted to be made for each defendant, (4) whether the patent has been the subject of prior USPTO reviews and, if so, the status of the same, and (5) any other prior litigation history of the patent and the status of the same.
- (b) Absent exceptional circumstances, no party may file a motion to stay the lawsuit pending any proceeding in the U.S. Patent and Trademark Office after the due date for service of that party's Final Contentions pursuant to LPR 3.2.

Annotations

1. Granting Stay During Early Stages of Case

“Plaintiff argues that ‘a significant amount of work has already occurred in this case,’ noting that the parties have served initial contentions and responses and have produced certain documents pursuant to the Local Patent Rules... Plaintiff does not dispute, however, that the parties have not answered interrogatories, taken depositions, filed substantive motions, briefed claim-construction issues, or requested a trial date. Accordingly, ‘the litigation is in its infancy,’ which militates in favor of granting a stay.” *JAB Distrib., LLC v. London Luxury, LLC*, 2010 WL 1882010, *4 (N.D. Ill. May 11, 2010) (St. Eve, J.).

LPR 3.6 Discovery Concerning Opinions of Counsel

- (a) The substance of a claim of reliance on advice of counsel offered in defense to a charge of willful infringement, and other information within the scope of a waiver of the attorney-client privilege based upon disclosure of such advice, is not subject to discovery until seven days after the court’s claim construction ruling.
- (b) On the day advice of counsel information becomes discoverable under LPR 3.6(a), a party claiming reliance on advice of counsel shall disclose to all other parties the following:
- (1) All written opinions of counsel upon which the party will rely;
 - (2) All information provided to the attorney in connection with the advice;
 - (3) All written attorney work product developed in preparing the opinion that the attorney disclosed to the client; and
 - (4) Identification of the date, sender and recipient of all written and oral communications with the attorney or law firm concerning the subject matter of the advice by counsel.
- (c) After advice of counsel information becomes discoverable under LPR 3.6(a), a party claiming willful infringement may take the deposition of any attorneys preparing or

rendering the advice relied upon and any persons who received or claims to have relied upon such advice.

- (d) This Rule does not address whether materials other than those listed in LPR 3.6(b)(1-4) are subject to discovery or within the scope of any waiver of the attorney client privilege.
- (e) In a case where advice of counsel is considered relevant to a patent-related claim or defense, fact discovery relating to advice of counsel shall not commence until seven days after entry of a claim construction ruling, notwithstanding LPR 1.3, and shall end 42 days after entry of the claim construction ruling.

Annotations

1. LPR 3.6 Limited to Opinions of Counsel

“Plaintiff requests documents reviewed by [Witness] prior to his deposition to refresh his recollection.... [Witness] admits that he reviewed notes from two December meetings; from a telephone call ... and from an April 2009 meeting to refresh his recollection for the testimony.... Defendants argue that these documents are not discoverable under the Local Patent Rule 3.6(a) ‘until thirty-five (35) days prior to the close of the period of fact discovery that, under LPR 1.3, follows the court’s claim construction ruling’.... This argument, however, is unpersuasive as the Local Patent Rule 3.6(a) narrowly refers to Opinions of Counsel and is not applicable in this instance.” *Schultz v. iGPS Inc.*, No. 10-cv-00071 (N.D. Ill. Nov. 3, 2010) (Valdez, M.J.).

2. LPR 3.6 Does Not Prevent Patent Owner From Seeking Discovery of Information Other than Opinions of Counsel That Relate to Willful Infringement

“We conclude with some observations about Local Patent Rule 3.6, which addresses discovery concerning ‘opinions of counsel.’ We do so in light of [Defendant]’s contention that it is premature to allow [Plaintiff] to obtain the Rule 30(b)(6) testimony it seeks unless and until [Defendant] elects to waive the attorney-client privilege and rely on the advice of counsel to defend against any potential charge of willful infringement.... To defend against a charge of willful patent infringement, an accused infringer may argue that it relied upon an opinion from counsel that it did not infringe the patent at issue or that the patent is invalid.... Invoking this defense, however, waives

the attorney-client privilege over 'all other communications relating to the same subject matter.' ... Under Local Patent Rule 3.6, discovery into '[t]he substance of a claim of reliance on advice of counsel ... and other information within the scope of a waiver of the attorney client privilege based upon disclosure of such advice' is not permitted until seven days after the court's claim construction ruling. LPR 3.6(a); see also LPR 3.6(e) (delaying fact discovery relating to advice of counsel until seven days after a claim construction ruling). If the accused infringer decides to rely upon an 'opinion of counsel' defense, it must affirmatively disclose the following information seven days after the claim construction ruling: (1) '[a]ll written opinions of counsel upon which the party will rely; (2) [a]ll information provided to the attorney in connection with the advice; (3) [a]ll written attorney work product developed in preparing the opinion that the attorney disclosed to the client; and (4) [i]dentification of the date, sender and recipient of all written and oral communications with the attorney or law firm concerning the subject matter of the advice by counsel.' LPR 3.6(b).... Local Patent Rule 3.6 recognizes that relying upon an 'opinion of counsel' defense is not a decision to be made lightly; invoking the defense waives the privilege not only for the opinion(s) at issue but also for other communications regarding the same subject matter. As such, it makes sense to allow an accused infringer to hold off on making this decision until later in the litigation, *i.e.*, after fact discovery has been completed or substantially completed and after the claim construction ruling. This gives the accused infringer the ability to consider both the discovery received and the claim construction ruling before it must determine whether to take the weighty step of waiving its attorney-client privilege.... At the same time, Local Patent Rule 3.6 does not preclude all discovery into issues related to willful infringement. The rule specifically does not address the discoverability of 'materials other than those listed in LPR 3.6(b)(1-4),' which all specifically relate to the written opinions upon which an accused infringer ultimately relies for its 'opinion of counsel' defense. LPR 3.6(d). Thus, Local Patent Rule 3.6 does not prevent a patent owner from seeking other information that may help it determine whether it can assert willful infringement in the first place, such as the facts and circumstances surrounding the accused infringer's knowledge of a patent. Indeed, deferring when an accused infringer must decide whether to waive the privilege and rely on advice of counsel presumes that other discovery will have occurred that informs this important decision. Thus, the fact that [Defendant]

is not yet required to decide whether to waive the privilege and rely upon an 'opinion of counsel' defense ... is true, but irrelevant here, and it does not empower [Defendant] to withhold other, non-privileged information that relates to willful infringement." *Baxter Intl., Inc., v. Becton, Dickinson and Co.*, Case No. 17-cv-07576, 2019 WL 3408813 at *8-9 (N.D. Ill. July 26, 2019) (Schenkier M.J.).

IV. CLAIM CONSTRUCTION PROCEEDINGS

LPR 4.1 Exchange of Proposed Claim Terms to Be Construed Along with Proposed Constructions

- (a) Within 14 days after service of the Final Contentions pursuant to LPR 3.2, each party shall serve a list of (i) the claim terms and phrases the party contends the Court should construe; (ii) the party's proposed constructions; (iii) identification of any claim element that the party contends is governed by 35 U.S.C. § 112(6); and (iv) the party's description of the function of that element, and the structure(s), act(s), or material(s) corresponding to that element, identified by column and line number with respect to the asserted patent(s).
- (b) Within seven days after the exchange of claim terms and phrases, the parties must meet and confer and agree upon no more than 10 terms or phrases to submit for construction by the court. No more than 10 terms or phrases may be presented to the Court for construction absent prior leave of court upon a showing of good cause. The assertion of multiple non-related patents shall, in an appropriate case, constitute good cause. If the parties are unable to agree upon ten terms, then five shall be allocated to all plaintiffs and five to all defendants. For each term to be presented to the Court, the parties must certify whether it is outcome-determinative.

Comment by N.D. Illinois

In some cases, the parties may dispute the construction of more than ten terms. But because construction of outcome-determinative or otherwise significant claim terms may lead to settlement or entry of summary judgment, in the majority of cases the need to construe other claim terms of lesser importance may be obviated. The limitation to ten claim terms to be presented for construction is intended to require the parties to focus upon outcome-determinative or otherwise significant disputes.

Annotations

1. Claim Construction Set Near Close of Fact Discovery to Focus on Significant Claim Terms

"[Claim construction] is a question of law, to be decided by the trial court, 'toward the end of fact discovery' (under this jurisdiction's Local Patent Rules)." *Weber-Stephen Prods. LLC v. Sears Holding Corp.*, 2014 WL 5333364, *9 (N.D. Ill. Oct. 20, 2014) (Chang, J.).

"The decision to place the claim construction process toward the end of fact discovery (in both the LPR and the scheduling order in this case) was premised upon the belief that this would result in focusing the issues so that the claim construction process would involve claim terms whose construction is determinative or otherwise significant, rather than unimportant claim terms." *Illinois Computer Research, LLC v. Harpo Prods., Inc.*, 2010 WL 2136665, *5 (N.D. Ill. May 26, 2010) (Kennelly, J.).

2. Cases Rejecting Belated Proposed Claim Constructions

"To the extent that [Plaintiff] did not propose its own construction, then [Plaintiff] opted to have that term construed according to its plain and ordinary meaning as understood by a person of ordinary skill in the art. [Plaintiff's] decision constrains [Plaintiff] somewhat in that it cannot propose a claim construction different from what a person of ordinary skill in the art would understand that claim term to mean. In other words, [Plaintiff] can present evidence and arguments showing that a person of ordinary skill in the art would understand a claim term to have a particular meaning. But [Plaintiff] cannot propose a previously undisclosed claim construction that extends beyond the plain and ordinary meaning of the term as understood by a person of ordinary skill in the art. That would violate the spirit of the Local Patent Rules, which contemplate early and meaningful disclosure." *Scholle Corp. v. Rapak LLC*, 2014 WL 3687734, *5 (N.D. Ill. July 24, 2014) (Kendall, J.).

"The parties failed to coordinate the exchange [of proposed claim constructions], and as a result [Plaintiff] has not offered a construction for nine of the defendants' proposed terms. [Plaintiff] states that 'while [it has] no present intent to offer counter-constructions, nothing in the Scheduling Order, the Local Patent Rules, or relevant precedent dictates that [it] could not do so if the circumstances so warrant.' I will not permit [Plaintiff] to offer last-minute constructions for these

terms. It is free to argue that each term is clear and doesn't require an interpretation, but if it wants a construction it must disclose its proposed construction [within two business days]." *Brandeis Univ. v. East Side Ovens, Inc.*, No. 12-cv-01508 (N.D. Ill. June 28, 2012) (Posner, J.).

3. Cases Permitting Belated Proposed Claim Constructions

"First, [Plaintiff] notes that [Defendant] did not disclose this proposed limitation during the claim construction exchange process as required under Local Patent Rule 4.1 and implies that [Defendant] has waived this argument.... The Federal Circuit grants district courts broad discretion in the enforcement of local patent rules. *Allvoice Devs. US, LLC v. Microsoft Corp.*, 612 F. App'x 1009, 1014 (Fed. Cir. 2015). The Court finds that [Defendant] has not waived the ability to argue this limitation." *Riddell, Inc. v. Kranos Corp.*, No. 16-cv-04496, at *10-11 (N.D. Ill. May 24, 2017) (Kennelly, J.).

"[Plaintiff's] disagreement with [Defendant's] proposed construction of this term provided sufficient notice to [Defendant] that [Plaintiff] believed that some of the retaining ring could be above the top surface of the body. Therefore, there is no reason to strike [Plaintiff's] proposed construction. Because [Plaintiff] either proposes the plain and ordinary meaning as understood by a person of ordinary skill in the art or responds to [Defendant's] proposed constructions for each of the claim terms at issue, this Court denies [Defendant's] motion to strike [Plaintiff's] proposed constructions." *Scholle Corp. v. Rapak LLC*, 2014 WL 3687734, *6 (N.D. Ill. July 24, 2014) (Kendall, J.).

"[O]nly [Defendant] proposed constructions of terms.... [Plaintiff] contended that no constructions were necessary and that the terms should simply be given their plain and ordinary meaning. [Plaintiff] reiterated this position during the meeting between the parties contemplated by LPR 4.1(b).... In its [claim construction] response brief, [Plaintiff] maintains its position that the Court should not construe any terms. However, in its arguments against [Defendant's] proposed constructions, [Plaintiff] also set forward proposed alternatives to [Defendant's] constructions.... [G]iven that [Plaintiff] maintains its contention that the Court should not construe any terms in this case, the Court feels that the alternatives set forth by [Plaintiff] in its response brief are more properly characterized as part of its argument against [Defendant's] constructions, rather than as newly proposed constructions.... In fact, many

of [Plaintiff's] proposed alternatives simplify [Defendant's] language so much that it seems clear that [Plaintiff's] aim in submitting them was actually to bolster its argument that constructions are not necessary in this case. The Court is concerned that perhaps [Plaintiff] could have made more of an effort during their conference with [Defendant] to come to some agreement regarding language that [Defendant] could cut from their proposed constructions. Nonetheless, the Court will not strike [Plaintiff's] arguments simply because they propose some middle ground between the constructions proposed by [Defendant] and [Plaintiff's] desire to go without constructions. LPR 4.1 mandates that [Plaintiff] set forth its proposal, which it did, not that it explicitly set forth all edits of [Defendant's] constructions that it would find more agreeable. While the Court sympathizes with [Defendant's] position that it is somewhat surprised by [Plaintiff's] proposals, the company's concern about prejudice is tempered by the fact that it may respond to [Plaintiff's] arguments in its reply brief." *Memorylink Corp. v. Motorola, Inc.*, 2011 U.S. Dist. LEXIS 80137, *2-4 (N.D. Ill. July 18, 2011) (Hibbler, J.).

4. Cases Permitting Construction of More Than 10 Claim Terms

"As for the additional terms [Defendant] identifies—which are not means-plus-function terms—the Court finds that constructions potentially may substantially advance the litigation. The ten-term limit is not inflexible, particularly where claim construction is outcome determinative or of particular importance. The Court notes, however, that if it becomes apparent that construction of a term is unnecessary or not of particular importance, it may decline to construe the term." *Baxter Int'l, Inc. v. Carefusion Corp.*, No. 15-cv-09986, at *2 (N.D. Ill. May 17, 2017) (St. Eve, J.).

"A total of sixteen (16) claim terms and phrases may be presented to the Court for construction. Of the sixteen (16) claim terms and phrases that may be presented to the Court for construction, [Plaintiff] may present eight (8) claim terms and phrases and [Defendant] may present eight (8) claim terms and phrases." *Dunnhumby USA, LLC v. emnos USA Corp.*, No. 13-cv-00399 (N.D. Ill. Sept. 30, 2014) (St. Eve, J.).

"[Plaintiff] also complains that the defendants have violated local patent rule 4.1(b) by proposing more than ten terms for construction. But the thirteen terms proposed between the parties are a manageable set, and I will construe all of them at

the *Markman* hearing." *Brandeis Univ. v. East Side Ovens, Inc.*, No. 12-cv-01508 (N.D. Ill. June 28, 2012) (Posner, J.).

5. Parties Must Certify Whether Claim Terms Are Outcome-Determinative

"[Defendant] has not certified whether any of the claim terms it intends to submit for construction are outcome-determinative. The Local Patent Rules require this certification to make the parties focus on significant disputes... Despite [Defendant's] failure to follow the Local Patent Rules... this Court will consider all of [Defendant's] proposals. The primary reason this Court will do so is to avoid further delay." *Scholle Corp. v. Rapak LLC*, 2014 WL 3687734, *2 (N.D. Ill. July 24, 2014) (Kendall, J.).

6. LPR 4.1 is Intended to Encourage the Parties to Focus on Outcome-Determinative Claim Terms

"Under Northern District of Illinois Local Patent Rule 4.1, a party must certify to the Court that the term is 'outcome-determinative' in seeking a construction of the claim. But this policy is intended to 'encourag[e] the parties to focus upon outcome-determinative or otherwise significant claim construction disputes,' not to require courts to shear off terms from the process of claim construction." *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, 2018 WL 4216627 at *2 (N.D. Ill. Sept. 5, 2018) (Kennelly J.).

LPR 4.2 Claim Construction Briefs

(a) Opening Claim Construction Brief. Within 35 days after the exchange of terms set forth in LPR 4.1(a), the parties opposing infringement shall file their Opening Claim Construction Brief, which may not exceed 25 pages absent prior leave of court. The brief shall identify any intrinsic evidence with citation to the Joint Appendix under LPR 4.2(b) and shall separately identify any extrinsic evidence the party contends supports its proposed claim construction. If a party offers the testimony of a witness to support its claim construction, it must include with its brief a sworn declaration by the witness setting forth the substance of the witness' proposed testimony, and promptly make the witness available for deposition (if the witness is under the control of the party) concerning the proposed testimony.

(b) Joint Appendix. On the date for filing the Opening Claim Construction Brief, the parties shall file a Joint Appendix containing the patent(s) in dispute and the prosecution history for each patent. The prosecution history must be

paginated, and all parties must cite to the Joint Appendix when referencing the materials it contains. Any party may file a separate appendix to its claim construction brief containing other supporting materials.

- (c) **Responsive Claim Construction Brief.** Within 28 days after filing of the Opening Claim Construction brief, the parties claiming infringement shall file their Responsive Claim Construction Brief, which may not exceed 25 pages absent prior leave of Court. The brief shall identify any intrinsic evidence with citation to the Joint Appendix under LPR 4.2(b) and shall separately identify any extrinsic evidence the party contends supports its proposed claim construction. If a party offers the testimony of a witness to support its claim construction, it must include with its brief a sworn declaration by the witness setting forth the substance of the witness's proposed testimony and promptly make the witness available for deposition (if the witness is under the control of the party) concerning the proposed testimony. If such a deposition occurs, the date for the filing of a Reply Claim Construction brief shall be extended by seven calendar days. The brief shall also describe all objections to any extrinsic evidence identified in the Opening Claim Construction Brief.
- (d) **Reply Claim Construction Brief.** Within 14 days after filing of the Responsive Claim Construction Brief, the parties opposing infringement shall file their Reply Claim Construction Brief, which may not exceed 15 pages absent prior leave of Court. The brief shall describe all objections to any extrinsic evidence identified in the Opening Claim Construction Brief.
- (e) The presence of multiple alleged infringers with different products or processes shall, in an appropriate case, constitute good cause for allowing additional pages in the Opening, Responsive, or Reply Claim Construction Briefs or for allowing separate briefing as to different alleged infringers.
- (f) **Joint Claim Construction Chart.** Within seven days after the date for filing of the Reply Claim Construction Brief, the parties shall file (1) a joint claim construction chart that sets forth each claim term and phrase addressed in the claim construction briefs; each party's proposed construction, and (2) a joint status report containing the parties'

proposals for the nature and form of the claim construction hearing pursuant to LPR 4.3.

Comment by N.D. Illinois

The committee opted for consecutive claim construction briefs rather than simultaneous briefs, concluding that consecutive briefing is more likely to promote a meaningful exchange regarding the contested points. For the same reason, the committee opted to have the alleged infringer file the opening claim construction brief. Patent holders are more likely to argue for a "plain meaning" construction or for non-construction of disputed terms; alleged infringers tend to be less likely to do so.

The Rules provide for three briefs (opening, response, and reply), not four, due to the likelihood of a claim construction hearing or argument. The Court's determination not to hold a hearing or argument may constitute a basis to permit a sur-reply brief by the patent holder. A judge may choose not to require or permit a reply brief.

Annotations

1. Prosecution History for Each Asserted Patent Must Be Part of Joint Appendix

"Pursuant to Local Patent Rule 4.2(b), the parties were to submit a Joint Appendix containing the patents in dispute and the prosecution history for each patent. N.D. Ill. LPR 4.2(b). The Joint Appendix submitted in this case was deficient as it failed to provide the complete prosecution history." *Albecker v. Contour Prods., Inc.*, 2010 WL 1839803, *1 n.1 (N.D. Ill. May 3, 2010) (Castillo, J.).

2. Good Cause for Exceeding Page Limit Not Shown Despite Multiple Accused Infringers with Different Products

"Defendants' joint motion for relief under Local Patent Rule 4.2(e) ... is denied for failure to show good cause." *Activision TV, Inc. v. Richardson Elecs., Ltd.*, No. 10-cv-03483 (N.D. Ill. Nov. 9, 2010) (Conlon, J.).

3. "Plain and Ordinary Meaning" Insufficient to Satisfy LPR 4.2(f)

"Plaintiff has failed to comply with Local Patent Rule 4.2(f), which requires the parties within seven days after the filing of the reply claim construction brief to file 'a joint claim construction chart that sets forth each claim term and phrase

addressed in the claim construction briefs [and] each party's proposed construction' of those terms and phrases.... Plaintiff lists '[Plaintiff's] Proposed Construction' of each disputed term as simply 'Plain and ordinary meaning' without explaining what he contends the 'plain and ordinary meaning' of each disputed term is.... Plaintiff must amend his entries to the Joint Claim Construction Chart to comply with Local Patent Rule 4.2(f).” *Bobel v. Maxlite, Inc.*, No. 12-cv-05346 (N.D. Ill. Dec. 23, 2013) (St. Eve., J.).

4. Expert Declaration Submitted with Opening Claim Construction Brief is Timely Under LPR 4.2

“In addition, the [Expert] Declaration was submitted at the same time and in support of [Defendant]’s opening construction brief. This procedure complies with the Local Patent Rules, specifically Rule 4.2(a), which requires the opening brief ‘separately identify any extrinsic evidence the party contends supports its proposed claim construction’ and for witness testimony, the party ‘must include with its brief a sworn declaration by the witness setting forth the substance of the witness’ proposed testimony.’ N.D. Ill. L.P.R. 4.2.” *Baxter Intl., Inc., v. CareFusion Corp.*, No. 15-cv-09986 at *2-3 (N.D. Ill. Oct. 29, 2018) (Kendall J.).

LPR 4.3 Claim Construction Hearing

Unless the Court orders otherwise, a claim construction oral argument or hearing may be held within 28 days after filing of the Reply Claim Construction Brief. Either before or after the filing of claim construction briefs, the Court shall issue an order describing the schedule and procedures for a claim construction hearing. Any exhibits, including demonstrative exhibits, to be used at a claim construction hearing must be exchanged no later than three days before the hearing.

Annotations

1. Order Setting Procedure for Claim Construction Hearing

“During the hearing, the court anticipates hearing Plaintiffs’ construction of each claim term first, followed by Defendants’ construction, with an opportunity for rebuttal, and allowing parties to cross-examine witnesses. Parties should inform the court if they agree to a different procedure. Parties are to exchange exhibits and demonstratives to be used at the hearing [three days before], in accordance with LPR 4.3.” *Schultz v. iGPS*, No. 10-cv-00071 (N.D. Ill. Oct. 3, 2012) (Gottschall, J.).

V. EXPERT WITNESSES

LPR 5.1 Disclosure of Experts and Expert Reports

Unless the Court orders otherwise,

- (a) for issues other than claim construction to which expert testimony shall be directed, expert witness disclosures and depositions shall be governed by this Rule;
- (b) within 28 days after the claim construction ruling or the close of discovery after the claim construction ruling, whichever is later, each party shall make its initial expert witness disclosures required by Federal Rule of Civil Procedure 26 on issues for which it bears the burden of proof;
- (c) within 28 days after the date for initial expert reports, each party shall make its rebuttal expert witness disclosures required by Federal Rule of Civil Procedure 26 on the issues for which the opposing party bears the burden of proof.

Annotations

1. LPRs Defer Expert Discovery Until After Claim Construction so Expert Reports are Not Submitted in the Blind

“One reason why the Rules defer expert discovery until after claim construction is to enable the parties to focus expert opinions regarding infringement and invalidity on the construction of the claims adopted by the Court rather than making these disclosures in the blind or semi-blind.” *Oil-Dri Corp. of Am. v. Nestle Purina Petcare Co.*, No. 15-cv-01067, at *3 (N.D. Ill. Jun. 9, 2018) (Kennelly, J.).

2. Untimely Disclosure of Expert Report Held “Substantially Justified”

“Even assuming that [Defendant’s] disclosure of its commercial success expert report was untimely, such failure was ‘substantially justified.’ ... [Plaintiff] did not disclose its expert’s opinions on this issue until March 21, 2013, following the Court’s deadline for initial and rebuttal expert reports.... Moreover, any prejudice to [Plaintiff] from the timing of the disclosure is curable.... Furthermore, the record does not show any evidence of bad faith by [Defendant].... [Defendant] also served the expert report by the reply expert report deadline.... Accordingly,

in light of the procedural history of this case, any failure by [Defendant] to timely serve the report was ‘substantially justified.’” *Medicines Co. v. Mylan, Inc.*, 2013 U.S. Dist. LEXIS 73597, *9-11 (N.D. Ill. May 24, 2013) (St. Eve, J.).

3. Failure to Disclose Expert Not Justified

“To provide expert testimony, defendants were required to disclose [their managing director as a witness] under Rule 26(a)(2)(A) and Local Patent Rule 5.1. The disclosure, then, was due on October 22, 2013. Under Rule 37(c)(1) failure to identify a witness as required by Rule 26(a) results in an automatic and mandatory sanction prohibiting the party who failed to make such disclosure from using that witness to supply evidence, unless the offending party establishes that the violation was justified or harmless.... [Defendant] offers no justification for its failure other than its untenable argument that the declaration is lay-witness testimony.... Although [the managing director] may have some lay testimony concerning the development, design, [manufacture] and features of an actual embodiment of the invention on which he worked or of accused products, he may not compare the claims of the patent to prior art or give an opinion that the patent is anticipated, obvious, or fails to disclose the best mode.” *Peerless Indus., Inc. v. Crimson AV LLC*, No. 11-cv-1768, at *7-8 (N.D. Ill. Apr. 28, 2016) (Lefkow, J.).

4. LPR 5.1 Provides For Initial and Rebuttal Expert Reports, Not Reply Reports

“[T]he deadlines and sequence set forth in Rule 26(a)(2)(D) apply only ‘[a]bsent a stipulation or a court order.’ LPR 5.1 provides a different set of deadlines, and applies to all patent cases by General Order, thus superseding the structure set forth in Rule 26(a)(2)(D). And LPR 5.1 provides for exactly two types of reports: (1) initial expert disclosures on issues for which the disclosing party bears the burden of proof, and (2) rebuttal expert disclosures on issues for which the opposing party bears the burden of proof. LPR 5.1(b)-(c). No reply reports are permitted. Although Plaintiff protests that this ‘binary stricture’ is unfair, he offers no reason to deviate from the explicit sequence set forth in the Local Patent Rules.” *Berkheimer v. Hewlett-Packard Co.* No. 12-cv-09023 at *3-4 (July 1, 2019) (Lee J.).

LPR 5.2 Depositions of Experts

Depositions of expert witnesses shall be completed within 28 days after exchange of expert rebuttal disclosures.

LPR 5.3 Presumption Against Supplementation of Reports

Amendments or supplementation to expert reports after the deadlines provided herein are presumptively prejudicial and shall not be allowed absent prior leave of court upon a showing of good cause that the amendment or supplementation could not reasonably have been made earlier and that the opposing party is not unfairly prejudiced.

Annotations

1. General Rule for Supplementing Expert Report

“[U]nder LPR 5.3, a party seeking to supplement its expert report ‘after the deadlines provided herein’ have passed must overcome the presumption against supplementation by showing: (1) good cause that the amendment or supplementation could not reasonably have been made earlier, and (2) that the opposing party is not unfairly prejudiced by the supplementation.” *Berkheimer v. Hewlett-Packard Co.*, No. 12-cv-09023, 2016 WL 3030170, at *2 (N.D. Ill. May 25, 2016) (Gilbert, M.J.).

2. Presumption Against Supplementation Is Particularly Strong in Patent Cases

“[Plaintiff] provided [Defendant] with the Supplemental [Expert] Report a mere ten days before [Defendant’s] rebuttal expert disclosures were due. [Plaintiff] failed to seek leave of Court to issue the supplemental report as mandated under Local Patent Rule 5.3.... The presumption against supplementation of expert reports at the eleventh hour is particularly important in patent cases where expert discovery is expensive and often integral to the success of the claims. It is unfair to expect an opposing party to change course well into expert discovery because of one party’s failure to comply with the Rules.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 155730, *6 (N.D. Ill. Mar. 25, 2013) (St. Eve, J.).

“[U]nder LPR 5.3, amendment of the initial expert report is presumptively prejudicial once the initial disclosure deadline passes, and the same is true for amendment of rebuttal reports once that deadline elapses. ... Certainly, under this view, amendment of initial expert disclosures once the rebuttal deadline has passed is also presumptively prejudicial. And contrary to Plaintiff’s argument, reading LPR 5.3 in this manner does not render the phrase ‘the deadlines provided herein’

superfluous or meaningless. Rather, it actually strengthens the deadlines contained in LPR 5.1. If amendments were broadly permitted at any time up until the conclusion of expert depositions, there would be no reason to follow the deadlines for expert disclosures in the first place, and parties could end up 'amending' their expert reports back and forth ad infinitum." *Berkheimer v. Hewlett-Packard Co.* No. 12-cv-09023 at *3-4 (July 1, 2019) (Lee J.).

3. No Good Cause When Supplementation Is Due to Party's Own Fault

"Significantly, none of the amendments to [Plaintiff's] Supplemental Report are based on any delays by [Defendant's] counsel or expert witnesses. Instead, the amendments are based on the actions or faults of [Plaintiff's] own expert witnesses.... [Defendant], however, should not bear the prejudice of [Plaintiff's] failure to discover that its own expert witnesses did not agree on certain factors." *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 155730, *6-7 (N.D. Ill. Mar. 25, 2013) (St. Eve, J.).

4. Supplementation Denied Due to Undue Prejudice

"The only thing that patent litigants can rely on to discern their opponent's arguments is the opposing party's disclosure of expert reports and contentions. Indeed, this district's local patent rules, along with Rule 26, exist precisely to encourage such disclosures at an early stage of the litigation. [Defendant] had no reason to believe that just because [Plaintiff] asserted a particular argument with respect to the '689 and '411 Patents, that [Plaintiff] would assert the same argument with respect to the '346 Patent. Indeed, [the expert's] disclosures of his caged material theory with respect to the '689 and '411 Patents in the summer of 2012 makes it all the more inexplicable and inexcusable that he failed to disclose the same theory with respect to the '346 Patent until March 22, 2013. Accordingly, the court will strike [the] supplemental expert report of March 22, 2013 on the basis that (1) there is prejudice to [Defendant] that (2) it reasonably cannot be expected to cure within the time left before trial (3) without disruption of the trial, and (4) the court finds that [Plaintiff] acted in bad faith when it failed to disclose [expert's] opinion in his March 22, 2013 report as to the '346 Patent at a substantially earlier date, such as when [expert] reported that opinion as to the '689 and '411 Patents." *McDavid, Inc. v. Nike USA, Inc.*, 2013 U.S. Dist. LEXIS 57752, *10-11 (N.D. Ill. Apr. 23, 2013) (Holderman, C.J.).

"[Defendant] has submitted affidavits from two of its experts ... who had completed initial drafts of their rebuttal reports before [Plaintiff] served [Defendant] with the Supplemental Report. They have submitted uncontested affidavits that [Defendant] would incur an approximate additional \$30,000 to \$40,000 in expert fees in order for [Defendant's experts] to review and analyze the Supplemental Report and 5000 additional documents and revise their rebuttal reports.... Furthermore, [Defendant's] attorneys have estimated that [Defendant] will incur at least \$23,000 in additional legal fees to address the supplemental reports, including preparation time to re-depose the experts.... This uncontested evidence establishes the unfair prejudice [Defendant] will suffer from the supplemental report." *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 155730, *7-8 (N.D. Ill. Mar. 25, 2013) (St. Eve, J.).

5. Supplementation to Address Arguments in Opposing Party's Reply Report Not Permitted

"[A] 'supplemental' report is not contemplated by the Local Patent Rules. The time for [Plaintiff's expert] to set out her opinions was in her previously served report. Rule 26(a)(2)(B)(i) says that a retained expert's report should include 'a complete statement of all opinions the witness will express and the basis and reasons for them.' Expert reports are not first drafts. The Rule does not say that an expert's report should contain her best stab at an opinion that then can be supplemented, corrected, changed or augmented with new, alternative opinions after she has had a chance to think about it more and review the opposing expert's report. The new analysis contained in [Plaintiff's expert's] 'supplemental' report results in materially lower damages chargeable to HP than did the analysis in her original report. If [Plaintiff's expert] thought it was appropriate to do that analysis, it should have been included in her original report." *Berkheimer v. Hewlett-Packard Co.*, No. 12-cv-09023, 2016 WL 3030170, at *4 (N.D. Ill. May 25, 2016) (Gilbert, M.J.).

"The Court will not permit [Defendant] to supplement [Defendant expert's] report to address [Plaintiff expert's] arguments in his Reply Report. Because the [relevant] arguments in [Plaintiff expert's] Reply Report are responsive to [Defendant expert's] rebuttal report as noted above, [Defendant] does not have the right to supplement [Defendant Expert's] report to address them." *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 85897, *11 (N.D. Ill. June 19, 2013) (St. Eve, J.).

6. Expert Declaration Stricken as Improper Supplementation

“Although [Plaintiff] did not file a motion for leave to supplement [its expert’s] opinions and reports in this case, the analysis under Local Patent Rule 5.3 is relevant to the issues before the Court. In addition to the fact that [Plaintiff] did not seek leave of Court to submit the [expert] Declaration, its admission at this stage, as discussed above, unfairly prejudices Defendants and provides them no recourse to respond. Furthermore, although Defendants first disclosed [their] Declaration—to which the [Plaintiff’s expert] Declaration responds—during summary judgment, the Court does not find that the [Plaintiff’s expert] Declaration ‘could not reasonably have been made earlier[.]’ See LPR 5.3 (requiring a showing of good cause that the amendment or supplementation could not reasonably have been made earlier). The essence of the information disclosed in the [Defendants’] Declaration is the information regarding the function of the Accused Products—information that [Plaintiff] knew belonged to [a third party], yet failed to independently pursue during discovery. The primary rationale for excluding untimely expert opinions is to avoid an unfair ‘ambush’ in which a party advances new theories or evidence to which its opponent has insufficient time to formulate a response. See *Salgado v. Gen. Motors Corp.*, 150 F.3d 735, 742 (7th Cir. 1998); see also *Finley v. Marathon Oil Co.*, 75 F.3d 1225, 1230–31 (7th Cir. 1996) (experts’ new charts ‘disclosed only a few days before the start of the trial would have placed on [the opponent] a heavy burden of meeting the new evidence at trial with its own experts’ analysis’). Accordingly, the Court grants Defendants’ motion to strike the [Plaintiff’s expert] Declaration and does not consider it for the purposes of summary judgment.” *Sonix Tech. Co., Ltd. v. Publications Int’l, Ltd.*, No. 13-cv-02082, at *5-6 (N.D. Ill. Dec. 8, 2015) (St. Eve, J.).

“[I]n response to the motion to strike now under consideration, [Defendant] submitted a declaration by [expert].... The Local Patent Rules prohibit amendment or supplementing expert reports without leave of court. LPR 5.3. Therefore, this Court will disregard the [expert’s] declaration.” *Trading Techs. Int’l, Inc. v. CQG Inc.*, 1-05-cv-04811 (N.D. Ill. May 16, 2014) (Coleman, J.).

7. Supplementation Permitted

“[Defendant] objects to [Plaintiff expert’s] reliance on a license agreement between [Plaintiff] and [third party] to support his reasonable royalty opinion.... That agreement became available after [Plaintiff expert’s] last expert report. [Plaintiff expert’s] comments on it are an appropriate supplementation of his

earlier reports. [Defendant] argues that [Plaintiff expert’s] new opinion nevertheless relies on a new methodology that [Plaintiff expert] did not use to analyze previous license agreements. The court believes that [Plaintiff expert’s] use of a new methodology is insufficient to justify striking the opinion, however. It may be the case that the [] license has unique features requiring [Plaintiff expert’s] new methodology for an accurate assessment. That question can be tested on cross examination by [Defendant’s] counsel at trial, and, if there is no such justification, may well undermine [Plaintiff expert’s] credibility before the jury. Any prejudice to [Defendant] is therefore limited. Consequently, the court declines to strike [Plaintiff expert’s] reliance on the [] agreement.” *McDavid, Inc. v. Nike USA, Inc.*, 2013 WL 1749805, *5 (N.D. Ill. Apr. 23, 2013) (Holderman, C.J.).

“[Defendant] moves to strike certain evidence in [Plaintiff expert’s] supplemental report ‘that was available years ago at the time of his original reports,’ such as e-mails and deposition testimony.... None of these individual pieces of evidence amount to an entirely new theory that will require [Defendant] to devote significant time or resources to prepare a response. Moreover, much of the new evidence originated from [Defendant], so [Defendant] has been aware of that evidence for a sufficient amount of time. In that circumstance, the court declines to strike the new evidence [Plaintiff’s expert] has included in his supplemental report.” *McDavid, Inc. v. Nike USA, Inc.*, 2013 WL 1749805, *5 (N.D. Ill. Apr. 23, 2013) (Holderman, C.J.).

“The unfair prejudice ... does not extend to the removal of the references to [Plaintiff’s expert A’s] expert report [from Plaintiff expert B’s report] and the replaced citations to a [Plaintiff] employee. Neither [of Defendant’s experts] reference additional work or analysis necessitated from these changes. In addition, [Defendant] had the opportunity to depose [Plaintiff’s expert B] regarding the removal of the [Plaintiff’s expert A] references. As such, the Court will not strike this aspect of the Supplemental [Plaintiff’s expert B] Report.” *Sloan Valve Co. v. Zurn Indus.*, 2013 U.S. Dist. LEXIS 155730, *8 (N.D. Ill. Mar. 25, 2013) (St. Eve, J.).

“[Defendant] objects to the admission of [Plaintiff’s Expert]’s supplemental report on the separate but related ground that the supplement violated Local Patent Rule 5.3, which requires a showing of ‘good cause that the amendment or supplementation could not reasonably have been made earlier.’ ... ‘Local patent rules are essentially a series of case management

orders that fall within a district court's broad power to control its docket and enforce its order.' ... The Court has broad discretion to enforce the Local Patent Rules.... As a result, and because the admission of the supplemental report was proper under the Federal Rules of Civil Procedure, the Court upholds its prior decision." *Kolcraft Enterprises, Inc., v. Chicco USA, Inc.*, No. 09-cv-03339, *35 n.9 (N.D. Ill. Sept. 6, 2019) (Chang, J.).

8. Supplementation Must Be Timely

"The Court also does not agree with [Plaintiff] that supplementation of [Plaintiff's expert's] report is timely because it was not served 'after the deadlines provided herein' have passed within the meaning of LPR 5.3. [Plaintiff] argues that the 'deadlines' have not passed because the time for the parties' experts to be deposed has not yet lapsed. But the time for the parties to serve their expert reports has passed. Even if [Plaintiff] is correct that the 'deadlines' referenced in LPR 5.3 may refer both to the deadlines for service of expert reports and for expert depositions in LPR 5.1 and 5.2, that does not mean that a party is free to supplement an expert report as long as the time for taking his expert's deposition has not yet passed. It cannot be that a party can move to extend the date by which experts must be deposed, as occurred in this case, and then have free rein to serve supplemental expert reports whenever he wants to do so without consequence as long as his expert has not yet been deposed. The additional or 'alternative' opinion that [Plaintiff] wants [Plaintiff's expert] to offer now does not really correct or complete her earlier report as much as change it in response to the criticism leveled by [Defendant's] expert. Allowing [Plaintiff] to do that at this late date effectively would reset the clock on expert disclosures in a way that is not in keeping with LPR 5.3." *Berkheimer v. Hewlett-Packard Co.*, No. 12-cv09023, 2016 WL 3030170, at *4 (N.D. Ill. May 25, 2016) (Gilbert, M.J.).

VI. DISPOSITIVE MOTIONS

LPR 6.1 Final Day for Filing Dispositive Motions

All dispositive motions shall be filed within 28 days after the scheduled date for the end of expert discovery.

Comment by N.D. Illinois

This Rule does not preclude a party from moving for summary judgment at an earlier stage of the case if circumstances warrant. It is up to the trial judge to determine whether to consider an "early" summary judgment motion. See also LPR 1.1 (judge may defer a motion raising claim construction issues until after claim construction hearing is held).

Annotations

1. Court May Consider Early Summary Judgment Motions

"The parties have agreed to litigate the defense summary judgment motion concerning lack of written description before launching into full discovery; based on the discussion in court, the Court accepts that deviation from the Local Patent Rule schedule. The parties represented that only very limited discovery would be necessary to litigate the summary judgment motion." *Advanced Audio Devices, LLC v. Amazon.com, Inc.*, No. 13-cv-07585 (N.D. Ill. Mar. 31, 2014) (Chang, J.).

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