

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

***,

Case No. **-cv-*****-*** -KMM

Plaintiff,

v.

**RULE 26(f) REPORT
[TEMPLATE]
(PATENT CASES)**

***,

Defendant.

The parties/counsel identified below conferred as required by Fed. R. Civ. P. 26(f) and the Local Rules, on _____, and prepared the following report.

The initial pretrial conference required under Fed. R. Civ. P. 16 and Local Rule 16.2 is scheduled for _____, 20____, before United States Magistrate Judge Kate Menendez in Courtroom 8E of the U.S. Courthouse in Minneapolis, Minnesota.

DESCRIPTION OF THE CASE

1. Concise factual summary of plaintiff's claims:
2. Concise factual summary of defendant's claims/defenses:
3. Statement of jurisdiction (including statutory citations):
4. Summary of factual stipulations or agreements:
5. Statement of whether jury trial has been timely demanded by any party:
6. Statement as to whether all process has been served and all pleadings filed, and any current plans for any party to move to amend pleadings or add additional parties to the action:
7. If applicable, a list of all insurance carriers/indemnitors, including limits of coverage of each defendant or statement that the defendant is self-insured:

8. If the parties would like the case resolved under the Rules of Procedure for Expedited Trials of the United States District Court for the District of Minnesota, a statement of the parties' agreement to that effect:

FACT DISCOVERY

Having conferred about the unique needs of this case and mindful of the goal of efficiency, the parties recommend that the Court establish the following fact discovery deadlines and limitations:

1. The parties must make their initial disclosures under Fed. R. Civ. P. 26(a)(1) on or before _____. If the parties plan to disclose documents by a description by category and location of the documents, they will exchange copies of initial disclosure documents on or before _____. If the parties believe a date
2. The parties will discuss whether a date for the substantial completion of document discovery should be set within the fact-discovery period to facilitate the taking of depositions. If they believe it is appropriate to do so, fact discovery should be substantially completed by _____.
3. The parties will commence fact discovery procedures in time to be completed by _____.
4. The parties have discussed the scope of discovery, including relevance and proportionality, and propose that the Court limit each side's use and numbers of discovery procedures as follows:
 - a. ____ interrogatories
 - b. ____ document requests

The parties understand that objections to document requests must meet the requirements of amended Rule 34(b)(2)(B). If the responding party is producing copies of documents or copies of electronically stored information and the copies are not produced with the responses, another reasonable time must be specified in the response. If the requesting party disagrees that this is reasonable, the parties must meet and confer to agree on the timetable for production.

- c. ____ requests for admissions
- d. ____ factual depositions
- e. The parties have discussed the taking of depositions pursuant to Rule 30(b)(6) and present the following agreement:
- f. _____ other

CLAIM CONSTRUCTION HEARING

1. The parties have discussed whether there should be a limit on the number of asserted claims, and set forth any agreements or positions on the number of claims, as well as the deadline or deadlines for the patentee's selection of asserted claims:
2. Plaintiff's Claim Chart (to include any party who alleges infringement)
 - a. Plaintiff's claim chart must be served on or before _____.
 - b. Plaintiff's claim chart must provide a complete and detailed explanation of:
 - i. which claim(s) of its patent(s) it alleges are being infringed, whether literally or under the doctrine of equivalents;
 - ii. which specific products or methods of defendant it alleges literally infringe each claim;
 - iii. where each element of each claim listed in paragraph (1)(b)(i) is found in each product or method listed in paragraph (1)(b)(ii), including the basis for each contention that the element is present; and
 - iv. if plaintiff contends there is infringement of any claim(s) under the doctrine of equivalents, plaintiff must separately indicate this on its claim chart and, in addition to the information required for literal infringement, plaintiff must also explain each function, way, and result that it contends are equivalent, and why it contends that any differences are not substantial.

Plaintiff may amend its claim chart only by leave of the Court for good cause shown.

3. Defendant's Claim Chart (to include any party accused of infringement)
 - a. Defendant's claim chart must be served on or before _____.
 - b. Defendant's claim chart must indicate with specificity which elements on plaintiff's claim chart it admits are present in its accused device or process, and which it contends are absent, including in detail the basis for its contention that the element is absent. And, as to the doctrine of equivalents, defendant must indicate on its chart its contentions concerning any differences in function, way, and result, and why any differences are substantial.

Defendant may amend its claim chart only by leave of Court for good cause shown.

4. Form of Claim Charts. As part of their Rule 26(f) meeting, the parties must meet and confer about the form and specificity of their claim charts, and must include as part of this Rule 26(f) Report any agreements regarding the form and specificity of their claim charts, and any disputes on which they would like the Court's assistance:
5. Exchange of Claim Terms and Proposed Constructions
 - a. On or before _____, the parties must simultaneously exchange a list of claim terms, phrases, or clauses that each party contends should be construed by the Court.
 - b. Following the exchange of the list of claim terms, phrases, or clauses, but before _____, the parties must meet and confer for the purpose of finalizing a list of claim terms, phrases or clauses, narrowing or resolving differences, and facilitating the ultimate preparation of a joint claim construction statement, and determining whether to request a pre-claim construction conference.
 - c. During the meet and confer process, the parties must exchange their preliminary proposed construction of each claim term, phrase, or clause which the parties collectively have identified for claim

construction purposes and will make this exchange on or before _____.

- d. When exchanging their preliminary claim constructions, the parties must provide a preliminary identification of extrinsic evidence, including without limitation: dictionary definitions, citations to learned treatises and prior art, and testimony of percipient or expert witnesses that they contend support their respective claim constructions.
 - i. The parties must identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced.
 - ii. With respect to any such witness, percipient, or expert, the parties must also provide a brief description of the substance of that witness' proposed testimony.
6. Joint Patent Case Status Report. Following the meet and confer process outlined in paragraph (5)(b)-(d), above, but no later than _____, the parties must file a joint patent case status report. The joint patent case status report must address the following:
- a. Whether the parties request a claim construction hearing to determine claim interpretation. If the parties disagree about whether a claim construction hearing should be held, the parties must state their respective positions and reasoning; and
 - b. Whether the parties request a pre-claim construction conference with the Court and if so, whether they request that the pre-claim construction conference occur before or after the joint claim construction statement is filed.
 - i. If the parties request that the pre-claim construction conference occur before the joint claim construction statement is filed, the parties must state why an early conference is necessary.

- ii. If the parties disagree about whether a pre-claim construction conference should be held, the parties must provide their respective positions and reasoning.
- iii. If the parties request a pre-claim construction conference, the parties must submit a summary of the claim construction issues the parties wish to discuss at the conference.

7. Joint Claim Construction Statement

- a. A joint claim construction statement must be filed with the joint patent case status report, unless the joint patent case status report requests that the pre-claim construction conference occur before the joint claim construction statement is filed.

If the Court does not respond to the request to schedule a pre-claim construction conference within 30 days after the joint patent case status report is filed, the parties must file a joint claim construction statement.

- b. The joint claim construction statement must contain the following information:
 - i. the construction of the claim terms, phrases, or clauses on which the parties agree;
 - ii. each party's proposed construction of each disputed claim term, phrase, or clause together with an identification of all references from the specification of prosecution history to support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either in support of its proposed construction of the claim or to oppose any other party's proposed construction;
 - iii. whether any party proposes to call one or more witnesses, including any experts, at the claim construction hearing; the identity of each witness; and for each expert, a summary of the opinion to be offered in sufficient detail to permit a meaningful deposition of that expert; and

- iv. whether the parties believe that a technology tutorial would be helpful for the Court and, if so, the proposed timing and format of the tutorial.
8. Claim Construction Hearing Order. If the Court schedules a claim construction hearing, the Court will issue an order before the hearing, addressing:
- a. the date and time for the claim construction hearing;
 - b. whether it will receive extrinsic evidence, and if so, the particular evidence it will receive;
 - c. whether the extrinsic evidence in the form of testimony must be the affidavits already filed or in the form of live testimony from the affiants; and
 - d. a briefing schedule.

DISCOVERY RELATING TO VALIDITY AND PRIOR ART

1. Defendant's Prior Art Chart and Invalidity Statement (to include any party accused of infringement)
- a. Within ____ days of receiving plaintiff's claim chart / By _____, defendant must serve a prior art chart and statement, listing all prior art on which it relies and a complete and detailed explanation of its allegations with respect to:
 - i. which claim(s) alleged to be infringed are invalid;
 - ii. which specific prior art, if any, invalidates each claim; and
 - iii. where in such prior art each element of the allegedly invalid claims may be found.
 - b. Defendant must also include a statement regarding whether a basis for invalidity other than prior art is alleged, specifying what the basis is and whether such allegation is based upon 35 U.S.C. §§ 101, 102, 103, and 112, or another statutory provision.

- c. Defendant may amend its prior art chart and statement only by leave of the Court for good cause shown.
2. Plaintiff's Prior Art Chart and Invalidity Statement (to include any party who alleges infringement)
 - a. Within ____ days of its receipt of defendant's prior art chart and invalidity statement / By _____, plaintiff must serve a prior art chart and statement, responding specifically to each allegation of invalidity set out in defendant's prior art chart and statement, including its position on why the prior art or other statutory reference does not invalidate the asserted patent claims.
 - b. Plaintiff may amend its prior art chart and statement only by leave of the Court for good cause shown.
3. Form of Prior Art Charts and Statements. As part of their Rule 26(f) meeting, the parties must meet and confer about the form of their prior art charts and statements. The parties must include as part of this Rule 26(f) Report any agreements regarding the form and specificity of their prior art charts and statements, and any disputes on which they would like the Court's assistance. A prior art chart and statement may be, but are not required to be, submitted in the form of an expert report. If a prior art chart and statement is submitted in the form of an expert report, the deadlines for the exchange of the prior art charts govern and are not extended by any different expert discovery deadlines.

TUTORIAL DESCRIBING THE TECHNOLOGY IN ISSUE

The parties [do/do not] believe that a joint tutorial regarding the technology and/or products/processes in issue would be helpful for the Court, and propose the following regarding the timing and format of the tutorial:

EXPERT DISCOVERY

The parties anticipate that they [will/will not] require expert witnesses at the time of trial.

1. The plaintiff anticipates calling _____ [number] experts in the fields of:
_____.

2. The defendant anticipates calling _____ [number] experts in the fields of: _____.
3. Disclosure of the identities of expert witnesses under Rule 26(a)(2)(A) and the full disclosures required by Rule 26(a)(2)(B) (accompanied by the written report prepared and signed by the expert witness) and the full disclosures required by Rule 26(a)(2)(C), shall be made as follows:
 - a. On or before _____, each party shall identify to the opposing party each expert whom it may use at trial to present evidence under Fed. R. Evid. 702, 703, or 705 concerning the issues on which that party has the burden of proof.
 - b. On or before _____, each party shall provide expert reports prepared in accordance with Fed. R. Civ. P. 26(a)(2)(B), and the full disclosures required by Rule 26(a)(2)(C), concerning issues on which the disclosing party has the burden of proof.
 - c. On or before _____, each party shall identify to the opposing party each expert whom it may use at trial to present evidence under Fed. R. Evid. 702, 703, or 705 on issues on which the disclosing party does not have the burden of proof.
 - d. On or before _____, each party shall provide expert reports prepared in accordance with Fed. R. Civ. P. 26(a)(2)(B), and the full disclosures required by Rule 26(a)(2)(C), concerning issues on which the disclosing party does not have the burden of proof.
 - e. Rebuttal identities and disclosures (if any) shall be provided on or before _____.
4. Expert discovery, including depositions, shall be completed on or before _____. Each party may take one deposition per expert.
5. Other agreements on expert discovery:

OTHER DISCOVERY ISSUES

1. The parties have met and discussed whether any discovery should be conducted in phases to reduce expenses or make discovery more effective and present the following joint/ individual proposals:
2. Decision on Waiver and Discovery of Privileged Documents. Defendant may postpone the waiver of any applicable attorney-client privilege on topics relevant to claims of willful infringement, if any, until _____, provided that all relevant privileged documents are produced no later than _____. All additional discovery regarding the waiver will take place after _____ and must be completed by _____.
3. Protective Order. The parties have discussed whether they believe that a protective order is necessary to govern discovery and jointly submit a [proposed protective order/report identifying areas of disagreement]. The parties are encouraged, but not required, to use Form 5 to the Local Rules as a starting point for the proposed Protective Order.
4. Discovery of Electronically Stored Information. The parties have discussed issues about disclosure or discovery of electronically stored information as required by Fed. R. Civ. P. 26(f), including but not limited to preservation, scope of discovery, and the form or forms in which it should be produced, and inform the Court of the following agreements or issues:

If it appears there will be significant electronic discovery, the parties are strongly encouraged to agree upon and attach to this Report an Electronically Stored Information (“ESI”) Protocol, identifying any differences in position between the parties that should be addressed at the Pretrial Conference. The Court refers counsel to *Discussion of Electronic Discovery at Rule 26(f) Conferences: A Guide for Practitioners*, developed by the Federal Practice Committee, to help attorneys and parties prepare for a meaningful discussion of electronic discovery issues early in the litigation. The Guide is available on the Court’s website under the Court Forms tab, in the “Pretrial, Discovery, and Trial Forms” section. In addition, the Court has endorsed the Sedona Conference Cooperation Proclamation and

expects the parties to be guided by its precepts. A copy is attached and may also be found at <https://thesedonaconference.org/download-pub/3802>.

5. Claims of Privilege or Protection. The parties have discussed issues about claims of privilege and of protection as attorney work-product or trial preparation materials, as required by Fed. R. Civ. P. 26(f), including whether the parties agree to a procedure to assert these claims after production, or have reached any other agreements under Fed. R. Evid. 502, and [do/do not] request the Court to include the following agreement in the scheduling order:

The parties agree to follow the procedure set forth in Fed. R. Civ. P. 26(b)(5)(B) regarding information produced in discovery that is subject to a claim of privilege or protection as trial-preparation material. Pursuant to Fed. R. Evid. 502, the inadvertent production of any documents in this proceeding shall not constitute a waiver of any privilege or protection applicable to those documents in any this or any other federal or state proceeding.

If the parties do not agree to the foregoing language, and/or have reached other or additional agreements concerning the process for handling privileged or work product information that is produced in discovery and wish them to be incorporated into the Pretrial Scheduling Order, those agreements should be set forth here: _____.

6. The parties:
 - agree that a party should be required to request an informal conference with the Court before filing a discovery motion;
 - agree that a party should not be required to request an informal conference with the Court before filing a discovery motion;
 - or do not agree whether a party should be required to request an informal conference with the Court before filing a discovery motion.
7. In responding to discovery requests, each party must construe broadly terms of art used in the patent field (e.g., “prior art”, “best mode”, “on sale”), and read them as requesting discovery relating to the issue as

opposed to a particular definition of the term used. Compliance with this provision is not satisfied by the respondent including a specific definition of the term of art in its response, and limiting its response to that definition.

MOTIONS DEADLINES

1. Except as otherwise provided in this section, all non-dispositive motions and supporting documents, including those that relate to fact discovery, shall be filed and served on or before _____. [NOTE: Absent unusual circumstances, this date should be no more than one month following the close of fact discovery.]
2. Except as provided in Paragraphs 3 and 4 of this section, all motions that seek to amend the pleadings or to add parties must be filed and served on or before _____.
3. Discovery will be permitted with respect to claims of willful infringement and defenses of patent invalidity or unenforceability not pleaded by a party, where the evidence needed to support these claims or defenses is in whole or in part in the hands of another party. Once a party has provided the necessary discovery, the opposing party may seek leave of Court to add claims or defenses for which it alleges, consistent with Fed. R. Civ. P. 11, it has support. Such support must be explained in the motion seeking leave. Leave will be liberally given where prima facie support is present, provided that the party has been diligent in seeking the necessary discovery and that it seeks leave as soon as reasonably possible following the opposing party providing the necessary discovery.
4. All motions that seek to amend the pleadings to include punitive damages, if applicable, must be filed and served on or before _____.
5. All non-dispositive motions and supporting documents that relate to expert discovery shall be filed and served on or before _____. [NOTE: Absent unusual circumstances, this date should be no more than one month following the close of expert discovery.]
6. Dispositive Motions
 - a. The parties [do/do not] believe that all fact and expert discovery must be completed before dispositive motions are filed.

- b. The parties [do/do not] believe that early dispositive motions (i.e., before the completion of all fact and expert discovery) on one or more issues could be of material assistance in resolving the case.
- c. The parties recommend that all dispositive motions be filed and served (and heard or scheduled, depending on District Judge assigned) on or before _____.

SETTLEMENT

- 1. The parties meaningfully discussed settlement [before/at] the Rule 26(f) meet-and-confer and each party has contemporaneously e-mailed a confidential letter setting forth what settlement discussions have taken place and whether the party believes an early settlement conference would be productive, as provided in Magistrate Judge Menendez’s Notice of Pretrial Conference.
- 2. The parties propose that a Court-mediated settlement conference be scheduled to take place on or before _____.
- 3. The parties have discussed whether alternative dispute resolution (other than a Court-mediated settlement conference) could be helpful to the resolution of this case and recommend the following:

TRIAL

- 1. The parties agree that the case will be ready for trial on or after _____.
- 2. The anticipated length of the [bench/jury] trial is _____ trial days.
- 3. Consent to Trial by Magistrate Judge. The parties [have/have not] agreed to consent to jurisdiction by the Magistrate Judge pursuant to 28 U.S.C. § 636(c). (If the parties agree, the consent form, signed by both parties, should be filed with the Clerk of Court.) Please note that if the parties consent to magistrate judge jurisdiction, all proceedings, including trial by jury, if any, will be before the magistrate judge assigned to the case.

4. The parties [agree/do not agree] the video “An Introduction to the Patent System,” distributed by the Federal Judicial Center, should be shown to the jurors in connection with its preliminary jury instructions.

Date: _____

Plaintiff’s Counsel
License #
Address
Phone #

Date: _____

Defendant’s Counsel
License #
Address
Phone #

ATTACHMENT A
Schedule

Event	Deadline
Initial disclosures	
Rule 30(b)(6) depositions concerning document custodian issues	
Infringement contentions by plaintiff	
Motions to amend/join (without cause)	
Non-infringement response by defendant	
Invalidity contentions by defendant	
Responsive invalidity contentions by plaintiff	
Exchange of contested terms	
Identification of <i>Markman</i> experts	
Exchange of preliminary proposed constructions and extrinsic evidence	
Meet and confer to narrow claim construction disputes	
Joint claim construction statement	
Parties file and serve opening claim construction briefs and supporting documents	
Parties file and serve responsive claim construction brief and supporting documents	
Court hearing on claim constructions (on or after)	
Deadline for waiver of privilege and production of documents by defendant on willfulness	

Event	Deadline
Close of fact discovery	
Non-dispositive motions for fact discovery	
Identification of experts	
Opening expert reports	
Identification of rebuttal experts	
Rebuttal expert reports, including plaintiff's reports concerning secondary considerations	
Defendant's reports addressing secondary considerations	
Close of expert discovery	
Non-dispositive motions for expert discovery	
Summary judgment/ <i>Daubert</i> motions	
Trial	