



United States District Court
DISTRICT OF MINNESOTA

LR 16.2 INITIAL PRETRIAL CONFERENCE AND SCHEDULING ORDER

(a) When a Conference Is Required. Except in a proceeding listed in Fed. R. Civ. P. 26(a)(1)(B), the court must set an initial pretrial conference for the purpose of adopting a scheduling order.

(b) Attendance. Unless the court orders otherwise, only the attorneys and unrepresented parties need to attend the initial pretrial conference.

(c) Protective Order. At the initial pretrial conference, the court must address any unresolved issues relating to a proposed protective order submitted under LR 26.1(c).

(d) Scheduling Order.

(1) *Required Contents.* The scheduling order must include:

(A) a deadline for joining other parties;

(B) a deadline for amending the pleadings;

(C) a deadline for completing fact discovery;

(D) deadlines with respect to expert discovery, including one or more of the following:

(i) a deadline for disclosing the identity of expert witnesses;

(ii) a deadline for disclosing, in accordance with Fed. R. Civ. P. 26(a)(2)(B) or (C), the substance of each expert witness's testimony; and

(iii) a deadline for completing expert discovery;

(E) deadlines for filing and serving:

(i) nondispositive motions; and

(ii) dispositive motions;

(F) a date by which the case will be ready for trial;

(G) any modifications to the extent of discovery, such as, among other things, limits on:

- (i) the number of fact depositions each party may take;
- (ii) the number of interrogatories each party may serve;
- (iii) the number of expert witnesses each party may call at trial;
- (iv) the number of expert witnesses each party may depose; and

(H) a statement of whether the case will be tried to a jury or the bench and an estimate the trial's duration.

(2) *Permitted Contents.* In addition to matters specified in Fed. R. Civ. P. 16(b)(3)(B), the scheduling order may include procedures for handling the discovery and filing of confidential or protected documents.

(3) *Discovery Deadlines.* The discovery deadlines established under LR 16.2(d)(1)(C) and (D)(iii) are deadlines for completing discovery, not for commencing discovery. To be timely, a discovery request must be served far enough in advance of the applicable discovery deadline that the responding party's response is due before the discovery deadline.

[Adopted effective November 1, 1996, amended February 9, 2006; amended December 1, 2009; amended July 23, 2012]

2012 Advisory Committee's Note to LR 16.2

The language of LR 16.2 has been amended in accordance with the restyling process described in the 2012 Advisory Committee's Preface on Stylistic Amendments.

Matter previously found in LR 16.2(a) that related to the parties' conference under Fed. R. Civ. P. 26(f) has been relocated to LR 26.1. New LR 16.2(c) and (d)(2) have been added to specify that issues related to confidential or protected documents must be addressed at the initial pretrial conference and may be addressed in the scheduling order. New LR 16.2(d)(3) clarifies the nature of discovery deadlines.

2005 Advisory Committee's Note to LR 16.2 and Form 4 and 5

Form 4 addresses recurring issues in patent cases. Form 4 is intended to reduce motion practice and to encourage parties to narrow and focus issues for resolution by the Court, including claim construction issues. Although various provisions in Form 4 are phrased in terms of the "plaintiff" and the "defendant", in cases of counterclaims of patent infringement or for declaratory judgment, each party asserting a patent is expected to provide the information required for "plaintiff", and each party asserting a defense to patent infringement is expected to provide the information required for "defendant".

Paragraph (c) allows discovery related to a charge of willful infringement and to defenses of invalidity and unenforceability, such as the defense of inequitable conduct, without pleading of those defenses, in order to encourage parties to explore whether there is a substantial basis for such pleading before pleading them. The Court of Appeals for the Federal Circuit has commented that “the habit of charging inequitable conduct in almost every major patent case has become an absolute plague.” *Burlington Indus. v. Dayco Corp.*, 849 F.2d 1418, 1422 (Fed. Cir. 1988). The Committee considered a proposal to require leave of the Court for pleading inequitable conduct or willfulness, similar to Minn. Stat. § 549.191 (2003), but concluded that the power of the Court to dismiss such allegations under Rules 12 and 56 of the Federal Rules of Civil Procedure provides an existing tool for management of insufficient charges of inequitable conduct or willfulness.

Paragraph (e)(7) encourages the parties to agree in advance as to the discoverability of drafts of expert reports and provides that in the absence of agreement, such drafts are not discoverable. Under the Federal Rule of Civil Procedure 26, the Court has power to limit use of any discovery method by local rule if the Court determines that the burden or expense of proposed discovery outweighs its benefit. Discovery of drafts of expert reports rarely provides substantial benefits. This paragraph is intended to end motion practice as to the discoverability of drafts of expert reports.

Paragraphs (f) and (g) provide a sequence of exchanges intended to focus issues for claim construction by the Court. The parties are expected to determine the most appropriate intervals for the exchanges given the particular circumstances of a case. In general, the Court has ordered intervals of 30 to 60 days between each step in the series of exchanges. In particular cases, a different schedule may be appropriate, for example if a party intends to bring an early motion that does not depend on claim construction, such as a motion to dismiss for lack of subject matter jurisdiction.

Paragraph (h) provides for a delay of the waiver of attorney-client privilege when an opinion of counsel is offered as part of a defense to a charge of willful infringement and a provision allowing the parties to make proposals addressing other phasing or sequencing issues in discovery. The Committee considered and rejected recommending any presumptions for phased discovery or establishing schedules for phased discovery because of the variety of circumstances presented in patent cases. For example, in certain cases, prejudice could result from discovery of willfulness issues relating to attorney-client materials. On the other hand, willfulness discovery could be relevant to issues of infringement and/or equitable defenses to infringement. Depending upon the case, phasing of discovery could save discovery expense or cause an expensive duplication of discovery efforts.

Paragraph (h)(1) is intended to address discovery controversies that frequently arise when there is a claim of willful infringement and a denial based upon reliance on advice of counsel. Motion practice often follows requests for discovery, including motions to compel discovery or motions to stay discovery and bifurcate trial. Paragraph (h)(1) encourages the parties to agree on the time table for discovery regarding the waiver of any applicable attorney-client privilege on topics relevant to willfulness or articulate proposals regarding such discovery in advance of the initial pretrial conference. The parties are not required to propose that the Court phase discovery regarding the waiver of any applicable attorney-client privilege on topics relevant to willfulness. This provision provides a format for the parties to meet and confer on this subject and either present joint or individual proposals to be considered by the Court.

The general provision set forth in paragraph (h)(2) is intended to encourage the parties to identify other areas of agreement or dispute regarding discovery phasing early so these matters can be addressed at the initial pretrial conference. Optional responses to paragraph (h)(2) include no proposals, joint proposals, or individual proposals regarding the phasing or sequencing of discovery. The inclusion of paragraph (h)(2) should not be interpreted to mean phased discovery is favored in patent cases. Whether discovery on topics that are the subject of discovery are phased depends upon the Court’s discretion in adopting a pretrial schedule. Whether phased discovery is proposed or adopted also does not create a presumption regarding the bifurcation of any issues for trial.

Paragraph (h)(3) addresses protective orders and proposes, but does not require, Form 5 as a template for such orders. The Committee concluded that repeated negotiation of such orders wastes the parties' resources and delays the beginning of discovery. The parties are accordingly required to raise issues relating to any protective order, including issues relating to what persons may have access to documents designated for protection under the order, at the initial pretrial conference, and the Court is to endeavor to resolve such issues in connection with the conference.

Form 5 is meant to focus attention on the issues that are typically contested in negotiating protective orders rather than resolve those issues. This Form is thus presented as one that might serve as a template for protective orders even though in any individual case, parties may by agreement or by motion depart from the template.

Paragraph (n) provides for the use of a tutorial describing the technology and matters in issue for the benefit of the Court. A technology tutorial is not mandatory. Rather, the parties are free to decide whether a technology tutorial would be helpful to educate the Court regarding the technology at issue. A mandatory technology tutorial would unnecessarily increase the cost of and needlessly complicate patent suits involving relatively simple, easily understandable technologies.

If the parties believe that it would be helpful to the Court to have a tutorial, it is not required that the tutorial be in the form of a video tape. Should the parties determine that a format other than video tape be more appropriate, such as a DVD or a computerized presentation, they may suggest the format at the initial pretrial conference. For any such format selected, the parties must confirm the Court's technical ability to access the information contained in the tutorial. The parties may further choose to present the tutorials in person.

The purpose of the technology tutorial is to educate the Court. As such, the scheduling of the tutorial should preferably be early in the litigation, and most preferably before the exchange of claim construction briefs. However, the scheduling of the tutorial may vary based on the complexity of the case and the amount at stake in the litigation. In some cases, the parties may suggest that the tutorial be due mid-discovery to allow its use in connection with any possible summary judgment motions or claim construction hearing. In cases that are likely to settle early on, the parties may suggest the deadline for the tutorial be set late in the litigation in hopes of avoiding its cost altogether.

Whether or not the parties agree to use a technology tutorial, the Court may request that the parties have their experts appear to explain the technology. However, expert legal testimony (as opposed to technical testimony) on such substantive issues as invalidity (by anticipation, obviousness, on-sale bar, etc.) and claim construction and infringement are not intended to be part of the tutorial.

Paragraph (o) provides for the use of the patent procedure tutorial. The purpose of the patent procedure tutorial is to educate the jury about the patent process. The Federal Judicial Center distributes this 18-minute video, entitled "An Introduction to the Patent System". This video provides jurors with an overview of patent rights in the United States, patent office procedure, and the contents of a patent.

A decision by one or all the parties not to show a patent procedure tutorial as set forth in Paragraph (o) does not preclude a Court from showing the patent procedure tutorial on its own initiative.

1996 Advisory Committee's Note to LR 16.2

LR 16.2 incorporates the requirement of the CJRA Plan that an early scheduling conference be held as soon as practicable. The Rule defines this as an Initial Pre-Trial Conference and requires that one be scheduled in every case, except those in categories that the Court, by Local Rule 16.8, has determined to be inappropriate for such a conference. The Rule 26(f) Report form 3 and the recitation of what a pre-trial schedule shall contain is designed to create some uniformity among the judicial officers of the Court with respect to the content of pre-trial schedules.

LR 16.2 contemplates that the pre-trial schedule will set a single date by which all discovery shall be completed and by which all non-dispositive pre-trial motions shall be filed and served. The Advisory Committee considered and rejected a suggestion that the Rule 16 pre-trial schedule set different dates for the termination of discovery and for the hearing of non-dispositive motions, in order to create a period, following the close of discovery, for hearing non-dispositive motions. The Committee rejected the suggestion because it would be inconsistent with LR 37.1, which requires that motions involving discovery disputes shall be served and filed prior to the discovery termination date established pursuant to Rule 16. This provision of LR 37.1 was designed to address the practical problem of how to timely resolve discovery disputes which arise near the close of the discovery period.

Under LR 37.1, by counting backward from the discovery deadline, counsel can plan to serve their discovery requests in such a way that, in the event the response is inadequate, they will still have time to make a motion before the termination of discovery. Because the motion, to be timely, needs only to be filed and served, the inability to get a hearing date before the close of discovery will not prejudice any party.