

**UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA**

[Plaintiff],

Civ. No. [] (-DJF)

Plaintiffs,

v.

[Defendant],

**RULE 26(f) REPORT
TEMPLATE (PATENT)**

Defendant.

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

The initial pretrial conference required under Fed. R. Civ. P. 16 and LR 16.2 is scheduled for _____, 20____, before United States Magistrate Judge Dulce J. Foster by Zoom.

(a) Rule 7.1 Disclosures.

The parties must comply with Rule 7.1, if applicable:

(1) For plaintiff: Rule 7.1 [does/does not] apply.

(2) For defendant: Rule 7.1 [does/does not] apply.

(b) 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) Description of any related litigation involving the patent or related patent in the patent family, including status:

(6) Any pending public filings in the USPTO or PTAB relating to the patent(s) (including status):

(7) A jury trial [has/has not] been demanded by [plaintiffs/defendants/all parties].

(8) The parties [agree/do not agree] to resolve the matter under the Rules of Procedure for Expedited Trials of the United States District Court, District of Minnesota, if applicable.

(c) Pleadings.

The status of pleadings is as follows: [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.]

(d) Fact Discovery.

[The parties should discuss their proposed plan using this form but may modify the form as appropriate to the needs of the case. To the extent that the parties cannot reach agreement on any particular item about scheduling or discovery, they should set forth their separate positions in their Rule 26(f) Report for discussion at the pretrial conference.]

The parties recommend that the Court establish the following fact discovery deadlines and limitations:

- (1) Deadline for initial disclosures under Fed. R. Civ. P. 26(a)(1): _____.
- (2) Deadline for the exchange of documents identified by each party's Rule 26(a)(1) initial disclosures: _____.
- (3) Interim deadline [if any] for the substantial completion of document production [to facilitate the scheduling and taking of depositions]: _____.
- (4) Deadline for service of deposition notices or subpoenas under Fed. R. Civ. P. 30(b)(6) _____
_____. Any notice of 30(b)(6) deposition must be served at least _____
days before the scheduled deposition date.
- (5) Deadline for the close of all fact discovery [the parties must commence fact discovery in time to be completed by the following deadline]: _____.
- (6) The parties have discussed the scope of discovery, including relevance and proportionality, and propose that the Court limit the use and numbers of discovery procedures [per party/per side] as follows:
 - (A) _____ interrogatories;
 - (B) _____ document requests;
 - (C) _____ requests for admissions;
 - (D) _____ fact depositions (including Fed. R. Civ. P. 30(b)(6) depositions);
 - (E) _____ other [please specify].
- (7) The parties [do/do not] anticipate that fact depositions will include depositions under Fed. R. Civ. P. 30(b)(6). The parties propose the following deadline for the service of deposition notices and subpoenas under Rule 30(b)(6): _____. The parties agree that any

such notice or subpoena should be served at least _____ days before the scheduled deposition date.

(e) Expert Discovery.

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

(A) The plaintiff anticipates calling _____ [number] experts in the fields of:
_____.

(B) The defendant anticipates calling _____ [number] experts in the fields of:
_____.

(2) The parties propose that the Court establish the following plan for expert discovery:

(A) Initial experts.

(i) The identity of any expert who may testify at trial regarding issues on which a party has the burden of persuasion, or in a party's primary case (irrespective of burden), must be disclosed on or before _____.

(ii) The initial expert written report completed in accordance with Fed. R. Civ. P. 26(a)(2)(B) must be served on or before _____.

(B) Rebuttal experts.

(i) Rebuttal expert reports shall be limited in scope to the topics addressed in initial expert reports. The identity of any experts who may testify in rebuttal to any initial expert must be disclosed on or before _____.

(ii) Any rebuttal expert's written report completed in accordance with Fed. R. Civ. P. 26(a)(2)(B) must be served on or before _____.

(3) All expert discovery must be completed by _____.

(f) Other Discovery Issues.

(1) Discovery of Electronically Stored Information (ESI).¹

The parties have discussed the scope of ESI discovery, including relevance and proportionality, and any issues about preserving ESI. The parties have also discussed the form or forms in which ESI should be produced. They inform the Court of the following agreements or issues:

The parties will further meet and confer by _____ [date] to discuss their plan or formal protocol for ESI discovery. They agree to present any disputes regarding an ESI discovery plan and protocol to the Court by _____ [date].

(2) Protective Order.

The parties agree that a protective order [is/is not] necessary to govern discovery. If a protective order is requested by any party, the parties will jointly submit either a proposed protective order or a report identifying areas of disagreement on or before _____. No protective order may purport to authorize filing documents under seal except as permitted under LR 5.6. No protective order may include language purporting to obligate the Court to destroy or return confidential documents to the parties after the conclusion of the case.

[The parties are encouraged, though not required, to use the Court's Form Protective Order as a template: <https://www.mnd.uscourts.gov/forms/stipulation-protective-order>.]

¹ Counsel should review and consider "Discussion of Electronic Discovery at Rule 26(f) Conferences: A Guide for Practitioners," <http://www.mnd.uscourts.gov>, and discuss whether a formal ESI plan or protocol is appropriate. If so, the parties should: (1) consider whether their plan should be submitted to the Court as a proposed order; (2) exchange lists of the types of ESI each party will seek in discovery, including custodial ESI (e.g., email) and non-custodial ESI (e.g., centralized databases); (3) discuss where ESI is stored, including storage on the party's premises, data stored by a party using third party providers (e.g., the "cloud"), storage on devices used by a party (or its employees) including laptops, smart phones or other personal devices; (4) discuss whether email or other electronic communications will be sought and identify what ESI discovery tools or techniques will be applied; (5) discuss the preservation and production of metadata, if appropriate; and (6) discuss the other topics relating to ESI discovery set forth in the Federal Rules of Civil Procedure. A plan or protocol should be clear on how the plan or protocol will operate during the course of fact discovery to satisfy a party's obligation to respond to a first and subsequent sets of document requests.

- (3) Claims of Privilege or Protection.
- a. 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 _____.
 - b. As required by Fed. R. Civ. P. 26(f)(3)(D), the parties have discussed procedures for asserting that information is protected by a privilege or the work-product doctrine, including procedures for asserting these claims after production (so-called “claw-back” procedures), and whether to request an order from the Court under Fed. R. Evid. 502(d). The parties [have reached an agreement as follows: _____/have not reached an agreement and will jointly submit a report identifying any areas of disagreement on or before _____.]
- (4) Attorney’s Fees. The parties [do/do not] anticipate that a claim for attorney’s fees will be litigated in this case. The parties [have reached an agreement regarding the manner in which attorney time will be documented as follows: _____/agree that an order regarding the manner in which attorney time will be documented is not needed/will meet and confer regarding the manner in which attorney time will be documented and present any disputes to the Court on or before _____.]
- (5) Other Protocols or Agreements. The parties have discussed the need for other protocols or agreements in this case (e.g., any protocol regarding the discovery of computer source code) and [agree to the following: _____/ will jointly submit a report regarding _____, identifying any areas of disagreement, on or before _____/do not believe an order regarding any other protocols or agreements is needed at this time].
- (6) Discovery Scope.
- a. In responding to discovery requests, each party must construe broadly the 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 used in its response, and then limiting its response to that definition.
 - b. Discovery will be permitted with respect to claims of willful infringement and defenses of patent invalidity or unenforceability not pleaded by a party, when 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, that it has support, and such support must be described in the motion seeking leave. Leave will be liberally given when

prima facie support is presented, provided that the movant has been diligent in seeking the necessary discovery and that it seeks leave as soon as reasonably possible following receipt of the necessary discovery.

DISCOVERY RELATING TO INFRINGEMENT

1. The parties have discussed whether there should be a limit on the number of asserted claims and the deadline for the patentee’s selection of asserted claims and agree as follows: _____.

2. Plaintiff’s² Infringement Claim Chart
 - a) Plaintiff’s claim chart must be served on or before _____. Plaintiff may amend its claim chart only with leave of the Court for good cause shown. For example, absent undue prejudice to the non-moving party, good cause could include Plaintiff’s discovery of new information that was only made available to Plaintiff through discovery. This example of good cause assumes Plaintiff was diligent in pursuing such discovery. Amendments to the chart may only address the newly-discovered information.

 - 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 specifically 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.

² For purposes of this Rule 26(f) Report, “Plaintiff” includes any party who alleges infringement.

3. Defendant's³ Responsive Non-Infringement Claim Chart
 - a) Defendant's claim chart must be served on or before _____. Defendant may amend its claim chart only by leave of Court for good cause shown, except that Defendant may file an Amended Responsive Claim Chart in response to any amendment of Plaintiff's Claim Chart within _____ **days of service** of Plaintiff's Amended Claim Chart without leave of Court.
 - 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.

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: _____. The parties will present any disputes regarding the form of claim charts to the Court assistance on or before _____.

DISCOVERY RELATING TO VALIDITY AND PRIOR ART

1. Defendant's Prior Art Chart and Invalidity Statement
 - a) Within _____ days of receiving Plaintiff's claim chart, 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 specifically in such prior art each element of each allegedly invalid claim 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,

³ For purposes of this Rule 26(f) Report, "Defendant" includes any party who is accused of infringement.

or another statutory provision.

Defendant may amend its prior art chart and statement only by leave of Court for good cause shown.

2. Plaintiff's Responsive Prior Art Chart and Invalidity Statement

- a) Within _____ days of its receipt of Defendant's Prior Art Chart and invalidity statement, Plaintiff must serve a Responsive 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, except that Plaintiff may file an Amended Prior Art Chart and Statement in response to any amendment of Defendant's Prior Art Chart and Statement within _____ **days of service** of Defendant's Prior Art Chart and Statement without leave of Court.

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: _____
_____. The parties will present any disputes regarding the form of claim charts to the Court assistance on or before _____.

Prior art charts and statements may be, but are not required to be, submitted in the form of expert reports. If a prior art chart and statement is submitted in the form of an expert report, the deadlines in paragraph (f) govern and are not extended by any different expert discovery deadlines.

CLAIM CONSTRUCTION EXCHANGES

1. 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) The parties must exchange their preliminary proposed construction of each claim term, phrase or clause that the parties collectively have identified for claim construction purposes and will make this exchange on or before _____.
- c) The parties must provide a preliminary identification of extrinsic evidence supporting their claim constructions on or before _____. Such

extrinsic evidence includes, without limitation: dictionary definitions, citations to learned treatises and prior art, and testimony of percipient or expert witnesses.

- (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's proposed testimony.
- d) Following the claim construction exchanges outlined above, on or 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.

2. Joint Patent Case Status Report.

Following the meet and confer process outlined 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.

3. Joint Claim Construction Statement.
 - a) Filing the joint claim construction statement.
 - (i) The joint claim construction statement must be filed with the joint patent case status report, unless the joint patent case status report requests that a pre-claim construction conference occur before the joint claim construction statement is filed.
 - (ii) If the Court has not responded to the parties' request to schedule a pre-claim construction conference, the parties must file a joint claim construction statement within 30 days after the joint patent case status report is filed.
 - 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.
4. 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.

PROPOSED MOTION SCHEDULE

The parties propose the following deadlines for filing motions:

- (1) Motions seeking to join other parties must be filed and served by _____.
- (2) Motions seeking to amend the pleadings must be filed and served by _____.
- (3) Except as provided in subparagraph (4) below, all other non-dispositive motions, including those relating to fact discovery, must be filed and served by _____. [Absent unusual circumstances, this date should be no more than two weeks following the close of fact discovery.]
- (4) Non-dispositive motions relating to expert discovery shall be filed and served by _____. [Absent unusual circumstances, this date should be no more than two weeks following the close of expert discovery.]
- (5) All dispositive motions must be filed and served (and heard or scheduled, depending on the District Judge assigned) by _____.

TRIAL

- (1) Trial by Magistrate Judge: The parties [have/have not] agreed to consent to jurisdiction by the Magistrate Judge under 28 U.S.C. § 636(c). [If the parties have agreed to consent, file the consent with the Rule 26(f) Report.]
- (2) The parties agree that the case will be ready for trial on or after _____.
- (3) The anticipated length of the [bench/jury] trial is _____ days.

INSURANCE CARRIERS/INDEMNITORS

[List all insurance carriers/indemnitors, including limits of coverage of each defendant or a statement that the defendant is self-insured.]

SETTLEMENT

- (1) The parties will discuss settlement before the initial pretrial conference, by the plaintiff making a written demand for settlement and each defendant making a written response/offer to the plaintiff's demand.

(2) The parties propose that a settlement conference be scheduled to take place before _____.

(3) The parties have discussed whether alternative dispute resolution will be helpful to the resolution of this case and recommend the following: _____.

DATE: _____

Plaintiff's Counsel
License #
Address
Phone #

DATE: _____

Defendant's Counsel
License #
Address
Phone #