UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

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*,

Civil No. *

Plaintiff(s)*,

v.

RULE 26(f) REPORT

*,

Defendant(s)*.

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

The initial pretrial conference in this matter is scheduled for _____, 20__, before United States Magistrate Judge Douglas L. Micko, in Courtroom 6B of the U.S. Courthouse, 316 N. Robert Street, in St. Paul, Minnesota.

DESCRIPTION OF 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 of 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. Any related litigation involving the patent or related patent in the patent family (including status);

8. Any pending public filings in the USPTO or PTAB relating to the patent(s) (including status);

9. If applicable, a list of all insurance carriers/indemnitors, including limits of coverage of each Defendant or statement that the Defendant is self-insured; and

10. 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.

DISCOVERY

Pursuant to Fed. R. Civ. P. 26(f), the parties must prepare a discovery plan that is designed to maximize the efficiency of pretrial case preparation. The parties must review and address each of the matters set forth in Fed. R. Civ. P. 26(f)(3)(A)–(F) and design a discovery plan that is appropriate and proportionate to the case. The Court expects counsel and parties to cooperate in the development and implementation of the discovery plan.

The details of the discovery plan should be set forth in this Report. The following discovery schedule and limitations are intended to guide the parties and should be useful in the ordinary case; however, the parties are encouraged to reach agreement on, and suggest to the Court, a discovery plan that takes into account the unique circumstances of the individual case. To the extent the parties cannot reach agreement on any particular item, they should set forth their separate positions in this section so that they can be discussed at the Pretrial Conference.

FACT DISCOVERY

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

1. The parties must make their initial disclosures required by Rule 26(a)(1) on or before _____.

2. Fact discovery procedures shall be commenced in time to be completed on or before _____.

3. The parties propose that the Court limit the use and number of discovery procedures as follows:

   a) No more than a total of _____ interrogatories, counted in accordance with Rule 33(a), shall be served by each side.

   b) No more than _____ document requests shall be served by each side.

The parties understand that objections to document requests must meet the requirements of Rule 34(b)(2)(B).

c) No more than _____ requests for admissions shall be served by each side.

d) No more than _____ fact depositions, including Rule 30(b)(6) depositions, shall be taken by either side.

Where appropriate, the parties are encouraged to discuss possible additional agreements concerning limitations on the number and/or length of depositions, procedures for noticing and taking Rule 30(b)(6) depositions, the arrangements that may be needed for depositions taken outside the U.S. and/or in a language other than English, and other issues that, if addressed early, could make deposition discovery more cost-effective and avoid costly and time-consuming disputes.

e) Other agreements on fact discovery:

4. Other discovery issues.

a) 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:

b) Discovery of Electronically Stored Information. The parties have discussed issues about preservation, disclosure, production, or discovery of electronically stored information, as required by Fed. R. Civ. P. 26(f), and request the Court to include the following agreement in the scheduling order: _____.

[**NOTE:** If it appears there will be significant electronic discovery, the parties should 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.]

c) 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 _____.

d) 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 or as part of a protective 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: _____.

e) 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 then limiting its response to that definition.

5. 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, that it has support, and 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.

NON-DISPOSITIVE MOTION DEADLINES

The parties propose the following deadlines for filing non-dispositive motions:

1. Except as provided in paragraph 4 below, all motions that seek to amend the pleadings or to add parties must be filed and served on or before _____.

2. All motions that seek to amend the pleadings to include punitive damages, if applicable, must be filed and served on or before _____.

3. Except as provided in paragraph 4 below, 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 two weeks following the close of fact discovery.]

4. 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 two weeks following the close of expert discovery.]

PROTECTIVE ORDER

If either party believes a protective order is necessary, the parties shall jointly submit a proposed protective order, identifying any terms on which the parties disagree so they can be discussed in connection with the pretrial conference. [**NOTE:** The Court has recently revised its suggested protective order form and the parties are encouraged to consult that form in preparing a proposed protective order for entry by the Court (***http://www.mnd.uscourts.gov/local_rules/forms/Stipulation-for-Protective-Order-Form.pdf*** or ***http://www.mnd.uscourts.gov/local_rules/forms/Stipulation-for-Protective-Order-Form.docx***).] No protective order may include language purporting to obligate the Court or the office of the Clerk of Court to destroy or return confidential documents to the

parties after the conclusion of the case. The parties are also reminded that their Stipulation for Protective Order must be filed in CM/ECF and a Word version of the document must be e-mailed to Magistrate Judge Micko's chambers.

The absence of a protective order entered by the Court will not be a basis for withholding discovery or disclosures. If any document or information responsive to discovery served in this case is deemed confidential by the producing party and the parties are waiting for the Court to enter a protective order, the document shall be marked "Confidential" or with some other Confidential designation (such as "Confidential - Outside Attorneys Eyes Only") by the producing party and disclosure of the Confidential document or information shall be limited to each party's outside attorney(s) of record and the employees of such outside attorney(s). After the Court enters a protective order, such documents and information shall be treated in accordance with the protective order.

DISCOVERY RELATING TO INFRINGEMENT

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, and the deadline or deadlines for the patentee's selection of asserted claims: _____.

2. Plaintiff's (which includes any party who alleges infringement) Infringement Claim Chart.

    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 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.

Plaintiff may amend its claim chart only by 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 and leave of Court must be sought no later than _____ **days** after the new information is made available.

3. Defendant's (which includes any party accused of infringement) Responsive Non-infringement Claim Chart.

   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:

DISCOVERY RELATING TO VALIDITY AND PRIOR ART

1. Defendant's (which includes any party accused of infringement) 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, or another statutory provision.

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

2. Plaintiff's (which includes any party who alleges infringement) 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 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 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) 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's proposed testimony.

2. Joint Patent Case Status Report.

   Following the meet and confer process outlined in paragraph (e)(3)(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.

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 the pre-claim construction conference occur before the joint claim construction statement is filed.

(ii) 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.

a) Content of the joint claim construction statement. 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.

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 _____.

   f) Expert discovery, including depositions, shall be completed on or before _____. Each party may take one deposition per expert.

   g) Other agreements on expert discovery.

DISPOSITIVE MOTION DEADLINES

1. The parties **do / do not** believe that all fact and expert discovery must be completed before dispositive motions are filed.

2. 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.

3. 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 must conduct a meaningful discussion about possible settlement before the initial pretrial conference, including a written demand by the Plaintiff(s) and a written response by each Defendant. The parties must also discuss whether private mediation or an early settlement conference with the Court (or another form of alternative dispute resolution) would be productive and, if so, when it should occur and what discovery, if any, would be necessary to conduct before such a conference.

   The results of that discussion, including any proposals or recommendations, are as follows: _____.

2. Each party will email to Magistrate Judge Micko's chambers, no later than **one (1) week before** the pretrial conference, a confidential letter of no more than three (3) pages, setting forth what settlement discussions have taken place, whether the party believes an early settlement conference would be productive, what discovery each party believes is necessary before an early settlement conference can take place and any additional, confidential information about the party's interest in settlement or possible settlement proposals as may be of assistance to Magistrate Judge Micko in planning or furthering early settlement efforts. [**NOTE:** This confidential letter should not advance arguments or positions on issues that may come before Magistrate Judge Micko for ruling.]

3. The Court will discuss this topic with the parties at the pretrial conference and will set a date for an early settlement conference or for a status conference to determine when the case will be ready for a productive settlement conference.

TRIAL

1. Trial by Magistrate Judge:

   The parties **have / have not** agreed to consent to jurisdiction by the Magistrate Judge pursuant to Title 28, United States Code, Section 636(c). (If the parties agree, the consent form, signed by both parties, should be filed with the Clerk of Court.) 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.

2. The parties agree that this case will be ready for trial on _____.

   The anticipated length of the **bench / jury** trial is ____ days.

DATE: _____ _____

Plaintiff's Counsel
License #
Address
Phone #
E-mail

DATE: _____ _____

Defendant's Counsel
License #
Address
Phone #
E-mail