

PROPOSED UPDATES TO S.D.TEX. LOCAL PATENT RULES

DECEMBER 15, 2021

2 OVERVIEW

- Background of Project
- Overview of Proposed Rules Changes
 - Local Patent Rules
 - Patent Case Scheduling Order Template
 - Protective Order Template
 - Order Setting Scheduling Conference and Discovery Order Template
- Questions/Feedback
- Deadline for Comments – ~~December 31, 2021~~ extended to January 14, 2022

3 BACKGROUND OF PROJECT

- Current version of Local Patent Rules from 2008
- In 2019, cross-section of IP practitioners met over the course of several months to discuss potential amendments to Local Patent Rules
- Current rules balanced, but out-of-date; templates also out-of-date
- Reviewed AIPLA Model Local Rules and local rules/procedures from other courts, E.D. Tex., N.D. Tex., W.D. Tex. (Waco Division), N.D. Cal.
- Proposed changes intended to incorporate changes to patent laws created by America Invents Acts (AIA) and changes to Federal Rules of Civil Procedure and current practices

4 LOCAL PATENT RULES

- Primary changes intended to bring Local Patent Rules in line with AIA, including addressing whether pre- or post-AIA law applies, addressing post-AIA prior art requirements, and updates to post-AIA references to Section 112.
- Certain requirements added to incorporate more specific identification for contentions
 - E.g., for infringement under the doctrine of equivalents and for indirect infringement
 - E.g., for invalidity contentions, adds section 101 eligibility challenges
- See chart for more details

5 PATENT CASE SCHEDULING ORDER TEMPLATE

- Streamlines/simplifies current Scheduling Order Template
- Overall timeframe/structure remains the same
- Case- and judge-dependent entries have been removed, e.g. pre-trial order requirements and submission of names of special masters
- Adds in separate fact and expert discovery deadlines
- Removes 2005 dates in current template and simplifies references for deadlines
- Removes “other requirements” at end of current template
- Clarifies deadline for privilege logs

6 PROTECTIVE ORDER TEMPLATE

- Updates current template, e.g., omits reference to old rules
- Adds “It is hereby Ordered” language at beginning of Order
- Adds subsections (e) and (f) to Section 6(C) on who may have access to “Highly Confidential Information.”
- Deletes option to deliver sealed documents with the Court under Section 8.
- Adds last sentence to Section 10 (Conclusion of Litigation)

7 ORDER SETTING SCHEDULING CONFERENCE AND DISCOVERY ORDER TEMPLATE

- Streamlines/simplifies current template
- Provides proposed baseline for discovery, but may be tailored for needs of a case
- Includes required disclosures at outset of case, but subject to Fed. R. Civ. P. 26(b)(1) and based on documents that are reasonably accessible, and requires a good faith computation of damages and production of documents/materials on which the computation is based.
- Changes timeframes for required disclosures from 45 days to 6 weeks.
- Omits requirement to file notices with the Court

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8 ORDER SETTING SCHEDULING CONFERENCE AND DISCOVERY ORDER TEMPLATE

- Omits current section on testifying experts, which is otherwise governed by Federal Rules
- Simplifies “Discovery Limitations” paragraph and relies on Federal Rules and other modifications agreed to by the parties
- Omits Pretrial Order requirements and paragraph on Signatures
- Clarifies that Protective Order template applies in absence of other order
- Omits other requirements such as E-Filing and Hearing Notebooks

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QUESTIONS/FEEDBACK



10 COMMENTS DEADLINE – ~~DECEMBER 31, 2021~~ JANUARY 14, 2022

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