

NOTICE TO THE BAR
PROPOSED AMENDMENTS
TO THE

DISTRICT OF NEW JERSEY LOCAL CIVIL RULES

The United States District Court for the District of New Jersey announces that the following proposed amendments to the Local Patent Rules are posted for public comment as required by 28 U.S.C. § 2071(b) at <http://www.njd.uscourts.gov>. All interested parties may also view the Explanatory Notes for the 2016 Amendments as well as the Majority and Minority Reports of the Local Patent Rules Advisory Committee on the Court's web site under "What's New."

Amendments are proposed to the following Local Patent Rules:

L.Pat.R. 2.1(a)(6) – Initial scheduling conference topics in patent cases;

L.Pat.R. 2.2 – Shortening time to submit Discovery Confidentiality Order after initial conference in patent cases;

L.Pat.R. 3.3(d) – Pertaining to invalidity contentions and responses thereto;

L.Pat.R. 3.6(c) and (e) – Enlarging the time in Hatch-Waxman cases within which a party must produce non-infringement and invalidity contentions;

L.Pat.R. 4.1 and 4.2 – For claim construction, parties would be required to explain the meaning of "plain and ordinary" when that is assigned to each claim term.

L. Civ. R. 9.3 -- LOCAL PATENT RULES

2. GENERAL PROVISIONS

2.1. Governing Procedure.

(a) **Initial Scheduling Conference.** When the parties confer pursuant to Fed. R. Civ. P. 26(f), the parties shall discuss and address in the Discovery Plan submitted pursuant to Fed. R. Civ. P. 26(f) and L. Civ. R. 26.1(b)(2) the topics set forth in those rules and the following topics:

(1) Proposed modification of the obligations or deadlines set forth in these Local Patent Rules to ensure that they are suitable for the circumstances of the particular case (see L. Pat. R. 1.3);

(2) The scope and timing of any claim construction discovery including disclosure of and discovery from any expert witness permitted by the court;

(3) The format of the Claim Construction Hearing, including whether the Court will hear live testimony, the order of presentation, and the estimated length of the hearing;

(4) How the parties intend to educate the Court on the patent(s) at issue;

(5) The need for any discovery confidentiality order and a schedule for presenting certification(s) required by L. Civ. R. 5.3(b)(2);

and

(6) The availability and timing of production of invention records (including inventor laboratory notebooks and analytical test results);

The availability and timing of production of ANDA product research and development documents;

The availability and timing of production of ANDA product samples;

The date of conception and the date of reduction to practice for each patent asserted in the action;

Each inventor's availability for deposition in the matter;

Availability of foreign witnesses for deposition and foreign documents;

Whether there is a 30-month stay and if so, when it ends;

A date for substantial completion of document production and a method for determining compliance;

Any other issues or matters that a party believes are time sensitive.

2.2. Confidentiality.

Discovery cannot be withheld or delayed on the basis of confidentiality absent Court order. Pending entry of a discovery confidentiality order, discovery and disclosures deemed confidential by a party shall be produced to the adverse party for outside counsel's Attorney's Eyes Only, solely for purposes of the pending case and shall not be disclosed to the client or any other person.

Within ~~30~~ 14 days after the initial Scheduling Conference, (a) the parties shall present a consent discovery confidentiality order, supported by a sufficient certification (or statement complying with 28 U.S.C. § 1746) under L. Civ. R. 5.3(b)(2), or (b) in the absence of consent, a party shall, supported by a sufficient certification, apply for entry of a discovery confidentiality order under L. Civ. R. 5.3(b)(5) and L. Civ. R. 37.1(a)(1). The Court will decide those issues and enter the appropriate order, or the Court may enter the District's approved Discovery Confidentiality Order as set forth in Appendix S to these Rules if appropriate, in whole or in part.

With respect to all issues of discovery confidentiality, the parties shall comply with all terms of L. Civ. R. 5.3.

3. PATENT DISCLOSURES

3.3. Invalidity Contentions.

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(d) Any grounds of invalidity based on 35 U.S.C. § 101, indefiniteness under 35 U.S.C. §~~112(2)~~ 112(b) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims including a detailed explanation of the bases for the asserted grounds.

3.4A Responses to Invalidity Contentions.

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(d) For each asserted grounds of invalidity under L.Pat.R.3.3(d), a detailed explanation of how the asserted claim complies with 35 U.S.C. §112; and

(e) ~~(d)~~The production or the making available for inspection and copying of any document or thing that the party intends to rely on in support of its Responses herein.

3.6. Disclosure Requirements for Patent Cases Arising Under 21 U.S.C. § 355 (commonly referred to as “the Hatch-Waxman Act”).

The following applies to all patents subject to a Paragraph IV certification in cases arising under 21 U.S.C. § 355 (commonly referred to as “the Hatch-Waxman Act”). This rule takes precedence over any conflicting provisions in L. Pat. R. 3.1 to 3.5 for all cases arising under 21 U.S.C. § 355.

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(c) Not more than ~~14~~ 30 days after the initial Scheduling Conference, each party opposing an assertion of patent infringement shall provide to each party asserting patent infringement the written basis for its “Invalidity Contentions,” for any patents referred to in the opposing party's Paragraph IV Certification, which shall contain all disclosures required by L. Pat. R. 3.3.

(d) Any “Invalidity Contentions” disclosed under L. Pat. R. 3.6(c), shall be accompanied by the production of documents required under L. Pat. R. 3.4(b) and (c).

(e) Not more than ~~14~~ 30 days after the initial Scheduling Conference, each party opposing an assertion of patent infringement shall provide to each party asserting patent infringement the written basis for its “Non-Infringement Contentions,” for any patents referred to in the opposing party's Paragraph IV Certification which shall include a claim chart identifying each claim at issue in the case and each limitation of each claim at issue. The claim chart shall specifically identify for each claim which claim limitation(s) is/(are) literally absent from each opposing party's allegedly infringing Abbreviated New Drug Application or New Drug Application.

4. CLAIM CONSTRUCTION PROCEEDINGS

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4.2. Exchange of Preliminary Claim Constructions and Extrinsic Evidence.

(a) Not later than 21 days after the exchange of the lists pursuant to L. Pat. R. 4.1, the parties shall simultaneously exchange preliminary proposed constructions of each term identified by any party for claim construction, including constructions for each term for which “plain and ordinary” meaning is asserted. Each such “Preliminary Claim Construction” shall also, for each term which any party contends is governed by 35 U.S.C. § 112(6), identify the structure(s), act(s), or material(s) corresponding to that term's function.

Any comments must be received by the Clerk of the Court by November 1, 2016.
Comments should be addressed to:

William T. Walsh, Clerk of Court
United States District Court
Martin Luther King Jr. Federal Bldg. & U.S. Courthouse
50 Walnut St.
Newark, NJ 07101

or by e-mail to: localrules@njd.uscourts.gov

For the Court
Jerome B. Simandle
Chief Judge