

**MINORITY REPORT OF THE  
LOCAL PATENT RULES ADVISORY COMMITTEE**

May 25, 2016

Preliminary Statement

As requested by Judge Chesler, we have revised the May 23, 2016 Minority Report to set forth the critical issue of dispute over the proposed amendments to Local Patent Rule 2.1(a).

Proposed Amendments to Local Patent Rule 2.1(a)

The Committee is not unanimous on the inclusion of the following subsection in proposed Rule 2.1(a)(6):

**Whether the Judge in his/her discretion consistent with L. Pat. R. 1.3, should consider issuing a Scheduling Order that contains two dates for amendments under L. Pat. R. 3.7 and for adding parties, the first date of which shall be without the need for leave of Court, and second date for which amendments would be permitted only upon application to the Court under customary procedures;\***

**\* Inclusion of this item for discussion does not indicate any endorsement by the Committee of this procedure.**

*First*, this proposal *requires* parties to discuss two dates for amending contentions – one without leave of court – and makes that discussion part of the Joint Discovery Plan. However, Local Patent Rule 3.7, which is a hallmark of this District’s Local Patent Rules, governs the timing and substantive requirements for amending contentions under the rules. To have the parties be “required” by this new rule to discuss and negotiate these “double dates” (one without good cause) is (1) inconsistent with the express language of Local Patent Rule 3.7 and (2) inconsistent with the Committee’s virtually unanimous vote rejecting this concept (*see* Proposed Amendments to Rules 2.2 and 3.6).

*Second*, although the proposal cites to the discretion reflected in Local Patent Rule 1.3, nothing in the *current* rules prevents courts from exercising that discretion at any time. *See* L. Pat. R. 1.3 (Court may modify obligations set forth in Local Patent Rules based on circumstances of any case). In short, the proposed paragraph seeks to fix a problem that does not exist and may create additional problems. As the Rules stand now, without this unnecessary amendment, the parties may still reach agreement on specific procedures relevant to the needs of their case, and the Magistrate Judge may use his or her discretion in approving any such agreement. Requiring the parties to discuss two dates for amending contentions – one without good cause – may give rise to unnecessary disputes and protract the litigation. The Local Patent Rules should not become a vehicle for rigorous micromanagement by attempting to dictate every topic that the parties must discuss, especially a topic such as amending contentions, which the Rules already address fully.

**Third**, the Committee reached a compromise position to amend Local Patent Rules 3.6(c) and (e) to provide additional time for defendants in Hatch-Waxman cases to serve their Non-Infringement and Invalidity Contentions (*see* Proposed Amendment to Rule 3.6 (allowing 30 days, instead of 14 for defendants in Hatch-Waxman cases to serve their contentions)). This compromise was reached after the Committee rejected a proposal to amend the Local Patent Rules to provide a date for amending contentions without leave of court. This proposed subparagraph would undermine the purpose of that compromise and is contrary to the Committee's consensus that Local Patent Rule 3.7 should not be modified.

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In short, the proposed amendment to Rule 2.1(a) would create greater uncertainty and could protract the process. We believe the Local Patent Rules have been working well and see no reason to add the disputed subparagraph at this time.

With respect to the proposed revisions to Local Patent Rules 2.2 and 3.6, we believe the language in the Report of the Local Patent Rules Advisory Committee should be revised to reflect the official Committee Minutes and the November 13, 2015 Subcommittee Report and have provided the proposed alternative language in the May 23, 2016 version of the Minority Report.

Respectfully submitted,  
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