

Intellectual Property Alert: United States District Court for the District of Massachusetts Adopts New Patent Rule

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Last November, the United States District Court for the District of Massachusetts adopted a new local patent rule after a public comment period. The new rule, *Local Rule 16.6*, provides special scheduling and procedures for litigants in a patent case. Why the new rule? To provide both patentees and accused infringers a more even-handed litigation process. Other districts such as the Northern District of California are sought after by many litigants in patent infringement cases because they are seen as operating more efficiently, having rules that streamline the litigation process. Still, some have argued that while these venues provide structure, their local rules are too stringent. The District of Massachusetts wanted to provide more uniformity and predictability to the sometimes unwieldy patent litigation process by providing a guideline for discovery and contention positions. Local Rule 16.6 is meant to supplement Local Rule 16.1 by highlighting certain aspects of cases particular to patent law, such as infringement and invalidity contentions and Markman hearings.

The Court's new rule provides that the patentee and the accused infringer shall consider and address in a joint statement certain issues, such as:

- deadlines for infringement and invalidity contentions,
- whether claim construction will be resolved at a live hearing or based upon briefs, and
- policies for preservation of electronically stored information.

The joint statement is to be submitted at the scheduling conference pursuant to Local Rule 16.1 and, following the conference, a specially tailored scheduling order will be issued.

While the new rule sets guidelines for the scheduling process and provides issues that must be addressed during case management, there is no iron-clad timeline that parties must follow. Along with the rule, its appendix sets forth a sample scheduling order. This appendix merely provides suggestions as to how to schedule the timing of contentions and when claim constructions should be disclosed. As such, parties ultimately should have a schedule that is particular to their case. The following timetable illustrates how some of the scheduling and procedural issues may be addressed:

Within 30 days of the required case management conference, the patentee must serve and file preliminary disclosure of the claims allegedly infringed and identify the accused products or methods that allegedly infringe those claims.

Within 60 days after service of the preliminary disclosure, the accused infringer must serve and file preliminary invalidity and noninfringement contentions, identifying prior art that allegedly makes the identified claims invalid as anticipated or obvious.

Within 120 days after preliminary disclosures, parties must simultaneously exchange and file preliminary claim construction briefs listing the terms to be construed and proposed constructions. No later than ten days following the exchange shall reply briefs be exchanged.

Parties must file a joint claim construction and prehearing statement that identifies both agreed and disputed terms. The joint statement shall indicate the estimated length of time necessary for the claim construction hearing and whether tutorials will be presented; a joint claim construction chart shall be included as well. The claim terms to be construed should be prioritized in order of importance, and it is suggested that no more than ten terms per patent be identified to be construed.

After the claim construction hearing, the parties may amend their preliminary disclosures, noting whether their contentions are withdrawn. If the fact discovery period has expired before a ruling on claim construction, the court may grant additional time for discovery limited to issues of infringement, invalidity, or unenforceability dependent on the claim construction. If extensive expert discovery already has been conducted before a claim construction ruling, the court may grant additional time for supplemental expert discovery, also limited to issues of infringement, invalidity, or unenforceability dependent on the claim construction.

Many local patent litigators hope that with the adoption of Local Rule 16.6, Massachusetts will be as attractive a venue as the Northern District of California, by being as efficient. By requiring the parties to establish a defined schedule for laying-out infringement, noninfringement, and invalidity contentions, as well as limiting claim terms to be construed, Local Rule 16.6 appears to place an emphasis on the need for predictability, but also provides the court with the power of discretion.

Local Rule 16.6 offers useful tables that patentees and accused infringers may use in their required filings.

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