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Amendments to the New Jersey Local Patent Rules: Leveling the Playing Field

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Several recent amendments to the New Jersey Local Patent Rules will serve to level the playing field between patent holders and alleged infringers. The Local Patent Rules first went into effect on January 1, 2009. They were adopted in part to provide a standard protocol and disclosure process in patent cases that would be helpful to the Court and litigants. However, almost two years after their adoption, the Local Patent Rules Committee recognized that certain amendments were needed. Below is a summary of the key changes.

Design Patents Treated Differently Than Other Patents

Prior to the amendments, design patent cases were subject to the same disclosure requirements as all other patent cases, including disclosure of asserted claims and infringement contentions, a narrative claims chart, claim construction contentions and a claim construction hearing. The amendments now exempt design patents from these requirements and obligations. The basis for the change lies with the Federal Circuit's decision in *Egyptian Goddess v. Swisa*, 543 F.3d 665 (2008), which held, in part, that a trial court should not provide a detailed description of the claimed design. *See* L. Pat. R. 3.1(c) and

(e), 3.3(c), 3.4A(c), 4.1(c), 4.2(e), 4.3(g), 4.4 and 4.5(d).

Non-Infringement Contentions and Responses to Infringement Contentions Now Required

The Local Patent Rules now require an allegedly infringing party to provide its non-infringement contentions and responses to infringement contentions. *See* L. Pat. R. 3.2A. Prior to the amendments, disclosures were only required with regard to infringement and invalidity contentions.

Responses to Invalidity Contentions Now Required

The Local Patent Rules now require responses to invalidity contentions. *See* L. Pat. R. 3.4A and 3.5. There previously was no such reciprocal obligation under the rules.

Mandatory Disclosure of Materials

The rules governing disclosure of infringement, non-infringement and invalidity contentions, and responses thereto, were amended to make clear a party is obligated to disclose all material it intends to rely upon in support of its contentions or responses. *See* L. Pat. R. 3.2(f), 3.2A(c), 3.4(c) and 3.4A(d).

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Patent Holder In Hatch-Waxman
Case Must Identify Asserted Claims

Arguably the most significant change is in the area of Hatch-Waxman actions under L. Pat. R. 3.6. Prior to the amendments, a generic defendant was obligated to disclose its invalidity and non-infringement contentions within 14 days of the Initial Conference, notwithstanding that the patent holder had not yet identified each claim of each patent that it alleges is infringed. The Patent Rules Committee concluded that:

[I]n order to help narrow the focus of a generic's invalidity contentions, the patent holder should be required to provide early disclosure of each patent and patent claim for infringement to which its infringement contentions would be limited. This eliminates speculation and added work by the generics

in formulating their non-infringement and invalidity contentions.

See Explanatory Notes for 2011 Amendments.

Mandatory Early Production of ANDA and
Production of Communications With FDA

Hatch-Waxman cases were also impacted by two other amendments. An ANDA filer must now produce its ANDA or NDA shortly after filing an answer or motion. *See* L. Pat. R. 3.6(a). Additionally, an ANDA filer is now required to advise the FDA of any motion for injunctive relief and provide the parties with relevant communications with the FDA that concern the subject matter of the litigation. *See* L. Pat. R. 3.6(j).

The amendments to the New Jersey Local Patent Rules are effective as of March 18, 2011.

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