

**Kansas and Missouri Local Rules
for Patent Cases**
presented by
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Lawyers Association of Kansas City
February 21, 2018

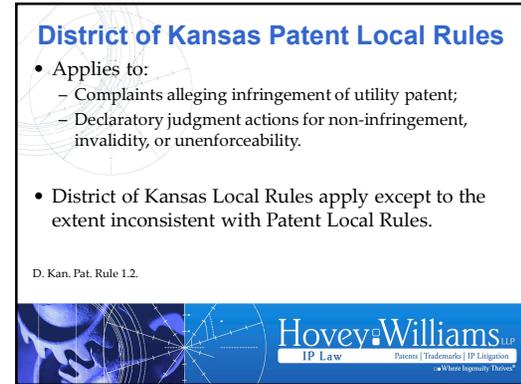
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District of Kansas Patent Local Rules

- Committee of local attorneys surveyed other jurisdiction's patent local rules.
- Draft patent local rules crafted and approved by Bench-Bar Committee and by the Court.
- Notice of Proposed Rules and Form Changes
 - Court sought comments on October 26, 2016
 - November 26, 2016 deadline
- Final rules approved and govern cases filed on or after **August 14, 2017**. D. Kan. Pat. Rule 1.4.

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District of Kansas Patent Local Rules

- Applies to:
 - Complaints alleging infringement of utility patent;
 - Declaratory judgment actions for non-infringement, invalidity, or unenforceability.
- District of Kansas Local Rules apply except to the extent inconsistent with Patent Local Rules.

D. Kan. Pat. Rule 1.2.

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Flexibility and Discretion

- Obligations and Deadlines established by Patent Local Rules may be modified based upon circumstances of the case.
 - Patents, claims, products, or parties involved
- Modifications “must, in most cases, be made at the initial case management conference, but may be made at other times upon a showing of good cause.”
- Duty to meet and confer for any requested modification.

D. Kan. Pat. Rule 1.3.



Other Proceedings

- Notify Court of other proceedings:
 - Proceedings filed within two years of each other involving same or related patent.
 - Post-grant-review proceedings involving same or related patent.
- Definition of “related patent” provided in D. Kan. Pat. Rule 2.1(a)(2).

D. Kan. Pat. Rule 2.1(a).



Additional Conference Topics

- Proposed modifications to the deadlines and disclosures contemplated by the Patent Local Rules;
- Case dispositive or settlement-driving issues;
- Proposed limits on asserted claims and prior art or time at which a decision will be made thereon;
- Timing and discovery relating to claim construction;
- How to educate Court about technology.

D. Kan. Pat. Rule 2.1(b).



Confidentiality Concerns

- Cannot withhold discovery based upon confidentiality objections absent Court order.
- If no Protective Order, Produce as “Confidential - Outside Attorneys’ Eyes Only.”
- Until PO issued, disclosure thereof limited to outside counsel of record, their employees, and necessary outside document services.
- Must be maintained as confidential and only for purposes of the litigation.

D. Kan. Pat. Rule 2.2.



Protective Order

- No later than 14 days before Rule 16 conference:
 - Submit agreed upon protective order; or
 - Submit what the parties can agree upon and for areas where disagreement persists, a concise explanation of the parties’ positions.
- As usual, the protective order should conform to the Court’s written guidelines for agreed protective orders.

D. Kan. Pat. Rule 2.3.



Discovery

- Generally, absent another legitimate objection, a party cannot object to a discovery request or decline to provide initial disclosures on the basis that the discovery is premature in light of, or conflicts with, the Patent Local Rules.
- But, a party can object to following discovery requests as premature in light of timetable provided in Patent Local Rules:
 - Requests seeking claim construction positions;
 - Requests seeking from patentee a comparison of asserted claims with accused product;
 - Requests seeking from accused infringer a comparison of asserted claims and prior art;
 - Requests seeking identification of any advice of counsel and related documents.

D. Kan. Pat. Rule 2.6.



Overview of Timeline

Event	Deadline/Setting
Submit Proposed Protective Order	[14 days before Rule 16 Conference]
Service of Disclosure of Asserted Claims and Infringement Contentions and Document Production Accompanying Disclosure	[21 days after Rule 16 Conference]
Service of Invalidity Contentions and Document Production Accompanying Invalidity Contentions	[70 days after service of Disclosure of Asserted Claims and Infringement Contentions]
Exchange of Proposed Terms for Construction	[14 days after service of Invalidity Contentions]
Exchange of Preliminary Claim Constructions and Extrinsic Evidence	[21 days after exchange of Proposed Terms for Construction]
File Joint Claim Construction Statement	[42 days after exchange of Proposed Terms for Construction]
Completion of claim construction discovery	[28 days after filing of Joint Claim Construction Statement]
Service of opening claim construction brief	[42 days after filing of Joint Claim Construction Statement]
Service of responsive claim construction brief	[28 days after service of opening brief]
Service of reply claim construction brief	[14 days after service of responsive brief]
File Final Claim Construction Chart	[7 days before claim construction hearing]
Claim Construction Hearing (court's discretion)	[to be determined]

Overview of Timeline

Event	Deadline/Setting
Claim Construction Hearing (court's discretion)	[to be determined]
Service of Amended Infringement Contentions	[28 days after filing by court of its claim construction order]
Deadline for Advice of Counsel	[42 days after filing by court of its claim construction order]
Parties submit joint proposed scheduling order for remaining deadlines in action	[42 days after filing by court of its claim construction order]
Service of Amended Invalidity Contentions	[56 days after filing by court of its claim construction order]

Form Patent Scheduling order <http://ksd.uscourts.gov/wp-content/uploads/2018/01/2017-9-7-Amended-Patent-Scheduling-Order-2.docx>

Patentee's Disclosures

21 Days after Rule 16 Scheduling Conference, patentee must provide:

- A) Infringement Contentions
- B) Document production pertinent to patent

D. Kan. Pat. Rule 3.1, 3.2.

Infringement Contentions

- All asserted claims and for each the statutory subsections of 271 asserted;
- For each claim, all accused instrumentalities of which patentee is aware;
- All patentee's practicing products if relied upon for any reason;
- Whether limitations infringed literally or under doctrine of equivalents;
- Claim charts and if Means-Plus-Function limitations, identification of associated structure or steps in accused instrumentalities;
- For any claims indirectly infringed, an identification of direct infringer and statement of the acts contributing or inducing the direct infringement;
- Priority date alleged for each asserted claim;
- Principal facts supporting willfulness infringement;
- If disagreement as to whether pre- or post-AIA application of 102, positions explained.

D. Kan. Pat. Rule 3.1.



Document Production with Contentions

- Documents sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, or any public use of, the claimed invention before the date of application for the patent in suit. (Production does not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102).
- All documents evidencing conception, reduction to practice, development of claimed invention dated before earlier of filing or alleged priority date;
- File history for each asserted patent;
- All documents evidencing ownership of the asserted patents;
- If patentee identified its own practicing products, documents sufficient to show the operation of any aspects thereof practicing the asserted patent's claims.

D. Kan. Pat. Rule 3.2.



Accused Infringer's Disclosures

70 Days after Patentee's Disclosure of Asserted Claims and Infringement Contentions, accused infringer must provide:

A) Invalidity Contentions

B) Document production

D. Kan. Pat. Rule 3.3, 3.4.



Invalidity Contentions

- Prior art relied upon for anticipation or obviousness;
- Whether the art anticipates or renders the claimed invention obviousness and, if obvious, the art combinations;
- Claim charts and if Means-Plus-Function limitations, identification of associated structure or steps in prior art;
- Identification of any other grounds of invalidity (e.g., ineligible subject matter, indefiniteness, etc.);
- If disagreement as to whether pre- or post-AIA application of 102, positions explained.

D. Kan. Pat. Rule 3.3.



Document Production with Contentions

- Prior art that is not in file history of asserted patents.
 - English translation of portions of foreign art relied upon
- Documents sufficient to identify operation of any structures of accused instrumentalities identified in patentee's disclosure of infringement contentions claim chart.

D. Kan. Pat. Rule 3.4.



Amending Contentions – As of Right

- Once following filing of claim construction order:
 - 28 days after filing: Patentee may amend certain portions of its contentions
 - Claim charts, identification of direct for indirect infringement allegations, literal vs. equivalents.
 - No adding accused instrumentalities as of right.
 - 56 days after filing: Accused infringer may amend invalidity contentions if:
 - Patentee amended its contentions; or
 - Accused infringer believes in good faith amendment necessary because of claim construction order.

D. Kan. Pat. Rule 3.5(a).



Amending Contentions – Discretionary

- In all other cases, amendment of contentions only by order of Court upon timely showing of good cause.
- Absent undue prejudice, examples of good cause include:
 - Recent discovery of prior art despite earlier diligent search.
 - Recent discovery of non-public information about accused instrumentality discovered after earlier diligent efforts before service of infringement contentions.
- Duty to supplement discovery does not excuse need to obtain leave to amend contentions.

D. Kan. Pat. Rule 3.5(b).



Advice of Counsel

- 42 days after Court files claim construction order.
- Any party relying on advice of counsel must provide:
 - Written advice or written summary of oral advice and documents relating thereto for which attorney/client and work product protection is being waived.
 - A privilege log identifying any other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the advice that the party is withholding on the grounds of attorney-client privilege or work product protection.
- Can't rely on advice of counsel if not now disclosed.

D. Kan. Pat. Rule 3.6.



Claim Construction – Initial Exchange

- Exchange identification of terms for construction and identification of means-plus-function within 14 days after invalidity contentions served.
- Meet and confer to narrow disputes and limit number of terms presented and identify the 10 terms most significant to resolving parties' dispute.

D. Kan. Pat. Rule 4.1.



Preliminary Claim Constructions

- Within 21 days after initial exchange identifying terms for construction, parties simultaneously exchange Preliminary Claim Constructions.
- Identify structure/steps for means-plus-function terms.
- Identify intrinsic and extrinsic evidence relied upon to support construction.
- Affidavits containing proposed testimony of witnesses
 - If expert, provide: complete statement of opinions and basis; facts and data considered; any exhibits to be used to summarize/support .
- Meet and confer again.

D. Kan. Pat. Rule 4.2.



Joint Claim Construction Statement

- Within 42 days after initial exchange, parties file Joint Claim Construction Statement:
 - Agreed constructions;
 - Each parties' proposed constructions and associated evidence;
 - Identification of the 10 significant terms;
 - Of those 10, identify dispositive terms;
 - Anticipated length of time for argument;
 - Proposed format for hearing, including calling of witnesses.
- Claim construction discovery closes 28 days later.

D. Kan. Pat. Rules 4.3, 4.4.



Claim Construction Briefing

- Within 42 days after filing JCCS, accused infringer files its principal claim construction brief.
- 28 days later, patentee files its principal claim construction brief.
- 14 days later, accused infringer serves its reply.

- 7 days before *Markman* hearing, parties file "Final Claim Construction Chart."
- Generally, *Markman* hearing held 28 days after reply brief.

D. Kan. Pat. Rules 4.5, 4.6.



Remaining Case Deadlines

- Within 42 days after Court files claim construction order, the parties submit a joint e-mail to magistrate's chambers a proposed scheduling order for remaining deadlines in the case.

D. Kan. Pat. Rule 4.7.



Western District of Missouri

- Committee formed and on October 17, 2017 held first meeting for drafting Patent Local Rules for the Western District of Missouri.
- Issues relating to Kansas City attorneys practicing in both districts frequently.
- Account for W.D. Mo.'s Mediation and Assessment Program ("MAP").
- Notice and comment forthcoming.



Any Questions?

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Thank You!

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