

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF GEORGIA**

2211 U.S. COURTHOUSE  
75 TED TURNER DRIVE, SW  
ATLANTA, GEORGIA 30303-3361

404-215-1600

James N. Hatten  
District Court Executive  
and Clerk of Court

**May 30, 2017**



**PUBLIC NOTICE AND REQUEST FOR COMMENT**

The United States District Court for the Northern District of Georgia is considering revisions proposed by a member of the Bar to Rule 6 of the Patent Local Rules, CLAIM CONSTRUCTION PROCEEDINGS.

A redlined copy of the proposed revisions and a memorandum setting forth the rationale for them are available at the public counter of each divisional office of the Clerk of Court and on the Court's public website at: [www.gand.uscourts.gov](http://www.gand.uscourts.gov).

The Court is re-opening the period for receiving comments from the public and the bar on these proposed revisions.

Comments should be made in writing by June 30, 2017, to:

James N. Hatten  
District Court Executive and Clerk of Court  
Room 2217, U. S. Courthouse  
75 Ted Turner Drive, S.W.  
Atlanta, Georgia 30303-3361

# HILL, KERTSCHER & WHARTON, LLP

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To: James Hatten, District Court Executive, United States District Court for the Northern District of Georgia

From: John L. North

Date: February 23, 2017

Subject: Re: Proposed Amendment to Local Patent Rule 6.

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This memorandum is to propose revisions to Local Patent Rule 6 pertaining to Claim Construction Proceedings. The proposed amendments, with one exception, relate to the expert disclosure portion of this Rule. A mocked-up version of LPR 6, reflecting the proposed additions and deletions, is attached. While essentially just technical adjustments, the proposed revisions are intended to bring additional clarity to the Rule, thereby promoting greater efficiency in the LPR claim construction process.

The focus of claim construction is on the intrinsic evidence (i.e., patent and related file history). However, the Federal Circuit Court of Appeals has held that District Courts also may consider extrinsic evidence – including expert testimony for certain purposes. To this end, LPR 6 provides as follows: (First) LPR 6.2(b) requires that, in connection with the exchange of Preliminary Claim Constructions, any party that will rely on testimony from a percipient or expert witness must “provide a brief description of the substance of that witness’ proposed testimony.” (Second) LPR 6.3(b) requires, in connection with the filing of the Joint Claim Construction Statement (“JCCS”) that a party relying upon expert testimony must provide the identity of the witness and “a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert.” And (Third) LPR 6.4 provides for the completion of Claim Construction Discovery within fifteen days of the service and filing of the JCCS. This presently results in depositions being taken on the LPR 6.2(b) and 6.3(b) disclosures.

The proposed revisions to LPR clarify the following points regarding the disclosure of expert information in connection with the claim construction process. The proposed revisions would require the same disclosure under LPR 6.2(b) and 6.3(b). These disclosures currently are described in slightly different language. LPR 6.3(b) implies a greater level of disclosure than LPR 6.2(b). However, the language of LPR 6.3(b) could be subject to different interpretations. Instead of additional disclosure under LPR 6.3(b), the proposed revisions would add a requirement that a party relying upon expert testimony also provide a declaration of that expert testimony in connection with the LPR 6.5 opening claim construction brief. LPR 6.5 presently is silent on that point and actual practice is inconsistent. The Court might benefit from having a complete declaration submitted with the opening brief, as opposed to citations to a deposition transcript and the disclosures. The net result would be an initial disclosure sufficient to put the other side on notice of the nature of the expert testimony upon which the party intends to rely –

so the other party can decide whether it needs to engage an expert on the same point – and then the full declaration. The proposed revisions also would permit the taking of the expert depositions after the submission of the declarations and before the LPR 6.5(b) response brief is due

Finally, the proposed revisions would add the disclosure of intrinsic evidence to the LPR 6.2 exchange of evidence regarding Preliminary Claim Constructions. LPR6.2 presently is limited to the identification of extrinsic evidence. Because of the important role of intrinsic evidence in claim construction, the claim construction process would be furthered by including the identification of supporting intrinsic evidence in this first exchange.

I would be pleased to provide any additional information that might help the Court when reviewing the proposed revisions to LPR 6.

A handwritten signature in black ink, appearing to read "John L. North", is written over a horizontal line.

John L. North

Hill, Kertscher, and Wharton

## **LPR 6: CLAIM CONSTRUCTION PROCEEDINGS**

### **LPR 6.1. EXCHANGE OF PROPOSED TERMS**

(a) Not later than ninety (90) days after filing of the Joint Preliminary Report and Discovery Plan, each party shall simultaneously exchange a list of claim terms, phrases, or clauses which that party contends should be construed by the Court, and identify any claim element which that party contends should be governed by 35 U.S.C. § 112(6).

(b) The parties shall thereafter meet and confer for the purposes of finalizing this list, narrowing or resolving differences.

### **LPR 6.2. EXCHANGE OF PRELIMINARY CONSTRUCTIONS**

(a) Not later than twenty (20) days after the exchange of Proposed Terms, for Construction, the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which any party has identified for claim construction purposes. Each such Preliminary Claim Construction shall also, for each element which any party contends is governed by 35 U.S.C. § 112(6), identify the structure(s), act(s), or material(s) in the specification corresponding to that element.

(b) At the same time the parties exchange their respective Preliminary Claim Constructions they shall each also provide a preliminary identification of intrinsic and extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses intended to support the respective claim constructions. The parties shall identify each such item of extrinsic evidence by production number or produce a copy of any such item not previously produced. With respect to any such witness, percipient or expert, the parties shall also provide a brief description of the substance of that witness' proposed testimony. No other Rule 26 report or disclosure shall be required for testimony directed solely towards claim construction.

(c) The parties shall thereafter meet and confer for the purposes of narrowing the issues and finalizing preparation of a Joint Claim Construction Statement.

### **LPR 6.3. JOINT CLAIM CONSTRUCTION STATEMENT**

(a) Not later than one hundred and thirty (130) days after the filing of the Joint Preliminary Report and Discovery Plan, the parties shall complete and file a Joint Claim Construction Statement,

(b) The Joint Claim Construction Statement shall contain the following information:

(1) The construction of those claim terms, phrases, or clauses on which the parties agree;

(2) Each party's proposed construction of each disputed claim term, phrase, or clause, together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its proposed construction of the claim or to oppose any other party's proposed construction of the claim;

(3) The anticipated length of time necessary for the Claim Construction Hearing;

(4) Whether any party proposes to call one or more witnesses, including experts, at the Claim Construction Hearing, the identity of each such witness; and the information previously exchanged under LPR 6.2(b) regarding the expected substance of the testimony, and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert. No other Rule 26 report or disclosure shall be required for testimony directed solely towards claim construction.

#### **LPR 6.4. COMPLETION OF CLAIM CONSTRUCTION DISCOVERY**

(a) No later than fifteen (15) days after service and filing of the Joint Claim Construction Statement, the parties shall complete all discovery relating to claim construction, including any depositions with respect to claim construction of any witnesses, including experts, identified in the Joint Claim Construction Statement. Notwithstanding the foregoing, to the extent a party submits an expert or a lay person declaration in connection with their opening brief, see LPR 6.5(a) *infra*, such party shall make the declarant available to be deposed regarding the declaration no later than ten (10) days before the responsive brief is due.

(b) Discovery from an individual on claim construction issues shall not prevent a prior or subsequent deposition of the same individual on other issues.

#### **LPR 6.5. CLAIM CONSTRUCTION BRIEFS**

(a) Not later than thirty (30) days after serving and filing the Joint Claim Construction Statement, each party shall serve and file an opening brief and any evidence supporting its claim construction. Such evidence shall include a declaration by any lay or expert witness upon whose testimony there is reliance.

(b) Not later than twenty (20) days after service upon it of an opening brief, each party shall serve and file its responsive brief and supporting evidence.

#### **LPR 6.6. CLAIM CONSTRUCTION HEARING**

Subject to the convenience of the Court's calendar, the Court shall conduct a Claim Construction Hearing to the extent the Court believe a hearing is necessary for construction of the claims at issue.

### **LPR 6.7. DISCOVERY AFTER CLAIM CONSTRUCTION**

If at the time the Court issues its claim construction ruling, there are fewer than thirty (30) days left for discovery pursuant to the discovery track to which the case was assigned pursuant to the Local Rules, the parties shall have an additional forty-five (45) days in which to take discovery after the Court files and serves its claim construction ruling.