GENERAL ORDER 06-15

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS

GENERAL ORDER AMENDING LOCAL RULES

It is hereby ORDERED that the following amendments to the local rules, having been approved by the judges of this court, are adopted for immediate implementation:[1]

1. LOCAL RULE CV-4 Complaint, Summons and Return

(a) ~~Where electronic filing is not required under Local Rule CV-5(a), The original and one copy of the complaint in a civil action must be filed with the clerk, except in patent, trademark or copyright cases, where an original and two copies of the complaint must be filed.~~ At the commencement of the action, counsel shall prepare and file the ~~a~~ civil cover sheet, ~~listing any related cases~~, Form JS 44, along with the complaint. ~~shall accompany the complaint. See Local Rule CV-42.~~ When filing a patent, trademark or copyright case, counsel is also responsible for preparing and submitting to the clerk AO Form 120, "Report on the Filing or Determination of an Action Regarding a Patent or a Trademark," or AO Form 121, "Report on the Filing or Determination of an Action Regarding a Copyright."

~~Any waiver of service of summons shall be done in accordance with Rule 4(d), Fed.R.Civ.P.~~ If service of summons is not waived, an original and two copies of the summons in a civil action must be prepared by the attorney for the plaintiff and submitted for each defendant to be served with a copy of the complaint. ~~Additional copies of the complaint and summons in a civil action may be required by the clerk for service through certain governmental agencies or on certain governmental defendants.~~ The clerk is required to collect the filing fee authorized by federal statute before accepting a complaint for filing.

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[1]New language appears in underlined text; deleted language appears in ~~strikeout~~ text.

Comment: Copies of original paper documents are no longer required by the clerk's office, as the original document is scanned upon receipt into the court's CM/ECF database. Once a document is scanned, it immediately becomes available electronically to multiple users.

The new provisions regarding patent, trademark and copyright cases makes it clear that it is counsel's responsibility to fill out and submit the specified forms to the clerk.

2. LOCAL RULE CV-5 Service and Filing of Pleadings and Other Papers

(a) Electronic Filing Required. Except as expressly provided or in exceptional circumstances preventing a Filing User from filing electronically, all documents filed with the court shall be electronically filed in compliance with the following procedures.

(1) Exemptions from Electronic Filing Requirement. The following are exempted from the requirement of electronic filing:

(A) In a civil case, the initial ~~papers~~ documents, including the complaint, the civil cover sheet, the ~~issuance and~~ service of the summons and the notice of removal; (Note: although not yet required, counsel are strongly encouraged to file case opening documents electronically and pay initial filing fees online using the court's CM/ECF system);

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(H) notice of appeal; (Note: although not yet required, counsel are strongly encouraged to file notices of appeal electronically and pay appellate filing fees online using the court's CM/ECF system);

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(7) **Sealed Documents.**

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(C) Documents requested or authorized to be filed under seal or filed ex parte shall be filed in electronic form. ~~In non-patent cases, unless otherwise directed by the clerk's office, such documents shall be submitted on a CD-ROM. In patent cases, parties shall~~ Attorneys must contact the clerk's office to obtain permission to file documents under seal or ex parte using the court's CM/ECF system. All sealed or ex parte documents filed with the court must comply with the file size and other form requirements of Local Rules CV-5(a) and CV-7. Counsel is responsible for serving documents under seal to opposing counsel, and may do so in electronic form, and for complying with Local Rule CV-5(a)(9) regarding courtesy copies of filings. When a sealed order is entered by the court, the clerk will send a sealed copy of the order only to the lead attorney for each party (see Local Rule CV-11), who is responsible for distributing the order to all other counsel of record for that party.

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(b) **Filing by Paper.** Where filing by paper is permitted, the original ~~and one copy of~~ pleadings, motions and other papers shall be filed with the clerk ~~(*but see* Local Rule CV-4(b) (two copies of summons and complaint required when serving Texas Secretary of State); Fed.R.Civ.P. 4(i) (extra copies required when serving the United States as a party); and Fed. R. Civ. P. 5(d) (discovery or disclosure materials under Fed.R.Civ.P. 26(a)(1) and (a)(2), including notices of depositions, are not filed unless by order of the court)).~~

Comments: Parenthetical notes have been added to sections (a)(1)(A) and (a)(1)(H) to encourage attorneys to use the court's capability to accept online fee payments for complaints and notices of appeal. Lawyers are strongly encouraged to file notices of appeal and complaints and accompanying documents electronically using the court's CM/ECF system. Issuance of summons was removed as an exemption to electronic filing, since the clerk's office has the ability to issue summons electronically to counsel.

Section (a)(7)(C) has been changed to remove the requirement that attorneys submit sealed non-patent civil motions via CD-ROM. Under the new procedure, attorneys in all civil cases must contact the clerk's office to obtain permission to file the sealed document(s) in the CM/ECF database. This procedure was previously only available in patent cases.

The language of section (b) has been altered to eliminate the copy requirement when filing by paper. Copies of paper originals are no longer needed now that the court operates from an electronic database.

3. LOCAL RULE CV-7 Motions Practice

(a) Generally. All motions, unless made during a hearing or trial, shall be in writing, conform to the requirements of Local Rules CV-5 and CV-10, and shall be accompanied by a separate proposed order for the judge's signature. The proposed order shall be endorsed with the style and number of the cause and shall not include a date or signature block. Motions, responses, replies and proposed orders, if filed electronically, shall be submitted in "searchable PDF" format. All other documents, including attachments and exhibits should be in "searchable PDF" form wherever possible.

(1) Dispositive Motions. Dispositive motions shall not exceed thirty pages, excluding attachments, unless leave of court is first obtained. Likewise, a party opposing a dispositive motion shall limit the response to the motion to thirty pages, excluding attachments unless leave of court is first obtained. See Rule CV-56 regarding attachment to motions for summary judgment and responses thereto. Any reply brief to an opposed dispositive motion filed pursuant to section (f) of this rule shall not

exceed ten pages, ~~including~~ excluding attachments. In addition to the above limitations, unless leave of court is first obtained, the following limitations shall apply: (1) a party's summary judgment motions shall not exceed sixty pages collectively, excluding attachments; (2) a party's responses to summary judgment motions shall not exceed sixty pages collectively, excluding attachments; (3) a party's reply briefing to summary judgment motions shall not exceed twenty pages collectively excluding attachments; and (4) a party's surreply briefing to summary judgment motions shall likewise not exceed twenty pages collectively, excluding attachments.

(2) Non-dispositive Motions. Non-dispositive motions shall not exceed fifteen pages excluding attachments unless leave of court is first obtained. Likewise, a party opposing a non-dispositive motion shall limit the response to the motion to fifteen pages, excluding attachments unless leave of court is first obtained. Any reply brief to an opposed non-dispositive motion filed pursuant to section (f) of this rule shall not exceed five pages, ~~including~~ excluding attachments.

* * * * *

(j) Motions for Leave to File. With the exception of motions to exceed page limitations, motions for leave to file a document must be accompanied by the document sought to be filed. If the motion for leave to file is granted, the movant shall immediately re-file the permitted document in the court's CM/ECF database.

Comments: The amendments to sections (a)(1) and (a)(2) regarding reply briefs mirror the existing page limitation rule on motions and responses, which excludes attachments from the page limit computation.

Regarding the (a)(1) provision on summary judgment motions, in General Order 02-11 the sample scheduling order (Appendix L) was amended to add a provision limiting the number of summary judgment motions to a number set by the court at the scheduling conference. The comment to that provision stated:

> [The provision] is designed to provide the court with a mechanism that can be used on a case-by-case basis as needed to prevent counsel from circumventing Local Rule CV-7(a)(l)'s thirty-page limitation on dispositive motions by piecemealing dispositive motions by allowing the court to incorporate limits on dispositive motions in the scheduling order as appropriate after hearing the parties' positions at the scheduling conference.

The amendment to (a)(1) changes the mechanism set out in 2002 from an optional, unspecified limit on the number of summary judgment motions to a default sixty page cap on the page limits for all summary judgment motion briefing by a party. However, recognizing that this default limit may not be appropriate under the facts of a case, the intent of the rule remains that the presiding judge has discretion to incorporate limits on dispositive motion briefing "as appropriate" after gaining an understanding of the parties' positions, at the scheduling conference.

Finally, new section (j) provides additional guidance on motions for leave to file.

4. LOCAL RULE CV-10 Form of Pleadings

(a) Generally. When offered for filing, all documents shall:

(1) be endorsed with the style and number of the action;

(2) contain a caption containing the name and party designation of the party filing the document and a statement of the character of the document clearly identifying each included pleading, motion or other document (e.g., Defendant John Doe's Answer and Motion to Dismiss under Rule 12(b)(6)) [note: see Local Rule CV-38(a) for cases involving jury demands][counsel are encouraged to file pleadings, motions and other documents separately whenever possible<u>, i.e. do not include a motion and a response, or an answer and a motion in the same document</u>.];

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Comment: The additional language adds a couple of helpful illustrations of filing documents "separately whenever possible."

5. LOCAL RULE CV-11 Signing of Pleadings, Motions and Other Documents

Lead Attorney.

(a) Designation. On first appearance through counsel, each party shall designate a lead attorney <u>by signature on the pleadings or otherwise.</u> ~~Signing the pleadings effects designation.~~

(b) Responsibility. The lead attorney is responsible in that action for the party. That individual attorney shall attend all court proceedings or send a fully informed attorney with authority to bind the client.

(c) Signing the Pleadings. Every document filed must be signed by the lead attorney, or by an attorney who has the permission of the lead attorney. Requests for postponement of the trial shall <u>also</u> be signed by ~~the attorney of record and~~ the party making the request.

(1) *Required Information.* Under the signature shall appear the

(A) attorney's individual name;

~~(B) designation "lead attorney;"~~

(C) state bar number;

(D) office address including zip code; and

(E) telephone <u>and facsimile</u> number<u>s</u> ~~with area code~~.

~~(F) telephone number with area code of facsimile machine, if available (see Local Rule CV-77); and~~

(~~G~~ F) e-mail address~~, if available~~.

~~(2) *Allowed Information.* The name of the law firm and name(s) of associate counsel may appear with the designation "of counsel."~~

(d) Withdrawal of Counsel. Attorneys may withdraw from a case only by motion and order under conditions imposed by the court. Change of counsel will not be cause for delay. ~~Although no delay will be countenanced because of a change in counsel, withdrawal of the lead attorney may be effected by motion and order.~~

(e) Request for Termination of Electronic Notice. If an attorney no longer desires to receive electronic notification of filings in a particular case due to settlement and/or dismissal of his/her client, the attorney may file a request for termination of electronic notice.

Comments: The language of (a) was changed to provide clarity. The language in (c) was deleted as unnecessary. The language in (c)(2) was deleted as confusing and unhelpful. Section (c)(1) (B) was deleted as inconsistent with the language of section (c).The cross-reference to fax noticing in (c)(1)(F) was deleted as no longer applicable. The changes in (d) are intended to clarify the existing rule provision.

New section (e) was added to provide guidance when an attorney settles or otherwise dismisses his/her client's case and no longer wants to receive electronic notice.

6. LOCAL RULE CV-54 Judgments; Costs

A party awarded costs by final judgment or by judgment that a presiding judge directs be entered as final under Fed.R.Civ.P. 54(b) must apply to the clerk for taxation of such costs by filing a bill of costs. Unless otherwise provided by statute or by order of the presiding judge, the bill of costs must be filed with the clerk and served on any party entitled to such service no later than 14 days after the clerk enters the judgment on the docket.

Comment: This rule is modeled after similar local rules promulgated in the other Texas federal courts, e.g., Texas Northern LR 54.1. The national rule on costs, Fed.R.Civ.P. 54(d), does not specify the time when bills of costs must be filed.

7. LOCAL RULE CV-77 District Courts and Clerks

Notice of Orders, Judgments and Other Filings ~~and Judgments~~. The clerk may serve and give notice of ~~judicial~~ orders, judgments and other filings ~~and judgments~~ by electronic mail in lieu of service and notice by conventional mail, to any person who has signed a filed pleading or document and provided an e-mail address with his/her pleadings as specified in Local Rule CV-11(c)(1)(F). Any other attorney who wishes to receive notice of judicial orders, judgments or other filings ~~and judgments~~ must file a notice of appearance of counsel with the court.

Comment: The addition of "and other filings" increases the scope of the general requirement that attorneys who do not sign filed pleadings or documents with the court need to file a notice of appearance of counsel in order to receive electronic notice from the court.

8. LOCAL RULE CV-79 Books and Records Kept by the Clerk

(~~a~~ c) Disposition of Exhibits ~~And/or Sealed Documents~~ by the Clerk. Thirty days after ~~a civil action has been finally disposed of by the appellate courts or from the date the appeal time lapsed~~ any direct appeal has been exhausted or the time for taking that appeal has lapsed, and no further action is required by the trial court, the clerk is authorized to destroy any sealed or unsealed exhibits filed therein which have not been previously claimed by the attorney of record for the party offering the same in evidence at the trial.

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(~~c~~ a) Submission ~~and Disposition of~~ Trial Exhibits.

(1) The parties shall not submit exhibits to the clerk's office prior to a hearing/trial without an order of the court. The clerk shall return to the party any physical exhibits not complying with this rule.

(2) Trial exhibits shall be properly marked, but not placed in binders. Multiple-paged documentary exhibits should be properly fastened. Additional copies of trial exhibits may be submitted in binders for the court's use.

(3) The parties shall provide letter-sized copies of pictures of any physical or oversized exhibit to the court prior to the conclusion of trial. Oversized exhibits will be returned at the conclusion of the trial or hearing. If parties desire the oversized exhibits to be sent to the appellate court, it will be their responsibility to send them.

Comment: Current section (c) deals with submission of exhibits, but should be labeled (a). Current section (a) pertains to the disposition of exhibits and should be labeled (c). The clerk's office will continue its practice of contacting attorneys prior to any destruction of exhibits. The amended language for current section (a) provides more clarity as to when exhibits can be disposed of in a civil case.

9. LOCAL RULE CR-55 Records

(b) Disposition of Exhibits by Clerk. Thirty days after ~~a criminal action has been finally disposed of by the appellate courts or from the date the appeal time lapsed~~ all direct criminal appeals and Section 2255 actions (if any) have been exhausted and/or the time for taking those appeals has lapsed, and no further action is required by the trial court, the clerk is authorized to destroy any sealed or unsealed exhibits filed therein which have not been previously claimed by the attorney of record for the party offering same in evidence at the trial. The clerk shall wait 18 months from the date the direct criminal appeal process concludes to ensure that no Section 2255 motion will be filed before destroying exhibits pursuant to this rule.

Sealed exhibits submitted in miscellaneous cases to obtain pen registers, wiretaps, etc. will be maintained in the court's vault for three (3) years. At the end of this time, the sealed exhibits will be destroyed.

Comment: The language was adjusted to provide a more precise definition of when criminal case exhibits can be disposed of. The clerk's office will continue its practice of contacting attorneys prior to any destruction of exhibits.

10. LOCAL RULE AT-2 Attorney Discipline

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(f) **Reinstatement.** Any lawyer who is suspended by this court is automatically reinstated to practice at the end of the period of suspension, provided that the bar membership fee required by Local Rule AT-1(e) has been paid. Any lawyer who is disbarred by this court may not apply for reinstatement for at least three years from the effective date of his or her disbarment. Petitions for reinstatement shall be sent to the clerk and assigned to the chief judge for a ruling. Petitions for reinstatement must include a full disclosure concerning the attorney's loss of bar membership in this court and any subsequent felony convictions or disciplinary actions that may have occurred in other federal or state courts.

Comment: The new language memorializes existing practice and is self-explanatory.

11. APPENDIX B Local Rules of Court for the Assignment of Duties to U.S. Magistrate Judges

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(E) ~~Prisoner~~ Habeas Corpus Cases Under 28 U.S.C. Sections 2241, 2254 and 2255.

All habeas corpus cases. ~~A full-time magistrate judge may perform any or all of the duties imposed upon a district judge by the rules governing proceedings in the United States District Courts~~ under Sections 2241, 2254 and Section 2255 of Title 28, United States Code, with the exception of habeas death penalty cases, are automatically referred to a U.S. magistrate judge for preliminary proceedings. ~~In so doing~~, A magistrate judge may issue any preliminary orders and conduct any necessary evidentiary hearing or other appropriate proceeding and shall submit to a district judge a report containing proposed findings of fact and recommendations for the disposition of the petition by the district judge. Any order disposing of the petition may only be made by a district judge unless the parties consent to disposition by a magistrate judge.

The parties in Section 2241 and 2254 actions may consent to trial by a magistrate judge pursuant to 28 U.S.C. Section 636(c).

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(F) Prisoner Civil Cases ~~Under 42 U.S.C. Section 1983.~~

All prisoner civil cases ~~under 42 U.S.C. Section 1983~~ are automatically referred to a magistrate judge for preliminary proceedings. A full-time magistrate judge may issue any preliminary orders and conduct any necessary evidentiary hearing or other appropriate proceeding and shall submit to a district judge a report containing proposed findings of fact and recommendations for the disposition of complaints filed by prisoners challenging the conditions of their confinement.

The parties may consent to trial by the magistrate judge pursuant to 28 U.S.C. Section 636(c).

(G) Non-Prisoner Pro Se Cases.

All non-prisoner pro se cases are automatically referred to a magistrate judge for preliminary proceedings.

The parties may consent to trial by the magistrate judge pursuant to 28 U.S.C. Section 636(c).

(~~G~~ H) Special Master References.

A magistrate judge may be designated by a district judge to serve as a special master in appropriate civil cases in accordance with 28 U.S.C. Section 636(b)(2) and Rule 53 of the Federal Rules of Civil Procedure. Upon the consent of the parties, a magistrate judge may be designated by a district judge to serve as a special master in any civil case, notwithstanding the limitations of Rule 53(b) of the Federal Rules of Civil Procedure.

(~~H~~ I) Review of Administrative Agency Proceedings.

1. All Social Security cases are automatically referred to a U.S.magistrate judge for for judicial review under 42 U.S.C. § 405(g) and for a reasoned report recommending disposition of the action.

2. In a suit for judicial review of a final decision of ~~an~~ any other federal administrative agency, a magistrate judge may be designated by a district judge to review the record of administrative proceedings and submit to the district judge a report and recommendation concerning (a) any defects in the agency proceedings which constitute a violation of statute or regulation or a violation of due process, (b) whether the matter should be remanded to the agency for additional factual determinations, and (c) whether the record contains substantial evidence in support of the agency decision. *See Mathews v. Weber*, 423 U.S. 261 (1975).

3. The parties may consent to trial by the magistrate judge pursuant to 28 U.S.C. Section 636(c).

(~~I~~ J) Conduct of Trials and Disposition of Civil Cases Upon Consent of the Parties - 28 U.S.C. Section 636(c).

(1) General Consent.

Upon the consent of the parties, a full-time magistrate judge may conduct any or all proceedings in a jury or non-jury civil matter which is filed in this court, including the conducting of a trial, and may order the entry of a final judgment, in accordance with 28 U.S.C. Section 636(c). In the course of conducting such proceedings upon consent of the parties, a magistrate judge may hear and determine any and all pretrial and post-trial motions which are filed by the parties, including case-dispositive motions.

(a) The clerk shall not file consent forms unless they have been signed by all the parties or their respective counsel in a case. No consent form will be made available, nor will the contents be made known to any judge, unless all parties have consented to the reference to a magistrate judge. See Fed.R.Civ.P. 73(b); 28 U.S.C. §636(c)(2).

(~~J~~ K) Other Duties.

A full-time magistrate judge is also authorized to -

(1) Conduct pretrial conferences, settlement conferences, omnibus hearings, and related pretrial proceedings in civil and criminal cases;

(2) Conduct arraignments in criminal cases assigned to a district judge and take not guilty pleas in such cases, a magistrate judge can conduct voir dire in a criminal case when assigned by a district judge and with consent of the parties;

(3) Receive grand jury returns in accordance with Rule 6(f) of the Federal Rules of Criminal Procedure;

(4) Accept waivers of indictment, pursuant to Rule 7(b) of the Federal Rules of Criminal Procedure;

(5) Accept petit jury verdicts in civil cases for a district judge;

(6) Conduct necessary preliminary proceedings leading to the potential revocation of probation;

(7) Modify, revoke, or terminate supervised release or probation of any person sentenced to a term of supervised release or probation by a magistrate judge.

(8) Conduct guilty plea proceedings in criminal felony cases with the permission of the presiding district judge and the signed consent of the defendant.

(~~8~~ 9) Conduct evidentiary hearing, when designated by a district judge, to modify, revoke, or terminate supervised release and to submit proposed findings of fact and recommendations, including, in the case of revocation, a recommended sentence. (See 18 U.S.C. Section 3401). Recommendations are to be submitted in accordance with 28 U.S.C. 636(b)(1)(B), enabling the district judge to make a de novo review.

(~~9~~ 10) Issue subpoenas, writs of habeas corpus ad testificandum or habeas corpus ad prosequendum, or other orders necessary to obtain the presence of parties, witnesses or evidence needed for court proceedings;

(~~10~~ 11) Order the exoneration or forfeiture of bonds;

(~~11~~ 12) Conduct proceedings for the collection of civil penalties of not more than $200 assessed under the Federal Boat Safety Act of 1971, in accordance with 46 U.S.C. Section 1484(d);

(~~12~~ 13) Conduct examinations of judgment debtors in accordance with Rule 69 of the

Federal Rules of Civil Procedure;

(~~13~~ 14) Conduct proceedings for initial commitment of narcotics addicts under Title III of the Narcotic Addict Rehabilitation Act;

(~~14~~ 15) Perform the functions specified in 18 U.S.C. Sections 4107, 4108 and 4109, regarding proceedings for verification of consent by offenders to transfer to or from the United States and the appointment of counsel therein;

(~~15~~ 16) Conduct extradition proceedings under 18 U.S.C. Section 3184;

(~~16~~ 17) Conduct proceedings pursuant to provisions of Section 7402(b) and 7604(a) of Title 26 U.S.C. to judicially enforce Internal Revenue Service summons;

(~~17~~ 18) Consider and rule upon applications for administrative inspection warrants and orders permitting entry upon a taxpayer's premises to effect levies in satisfaction of unpaid tax deficits;

(~~18~~ 19) Perform the duties required by ~~the Plan~~[2] Local Rule CV-26(e) on "Discovery Hotline" calls.

(~~19~~ 20) Conduct "Alternative Dispute Resolution" proceedings when assigned by a district judge.

(~~20~~ 21) Review civil in rem forfeiture suits filed by the United States, and if conditions for an action in rem appear to exist, enter orders so stating and authorizing warrants of arrest in rem and other appropriate initial orders.

(~~21~~ 22) Perform any additional duty as is not inconsistent with the Constitution and laws

[2] The Eastern District of Texas "Civil Justice Expense and Delay Reduction Plan".

of the United States.

A part-time magistrate judge may perform items (6) through (12).

Comment. The revisions to existing sections E, F and H and new section G of Appendix B are designed to memorialize pre-existent delegations of authority to magistrate judges contained in General Orders 05-4 (Section 1983 prisoner), 05-5 (habeas corpus), 05-6 (Social Security) and 05-7 (prisoner pro se). These delegations of authority are best recorded as local rules rather than as general orders. The above-mentioned general orders will be dismissed as moot upon promulgation of these changes.

The last addition to section (E) does not include Section 2255 motions because 5th Circuit law precludes dispositive action on a Section 2255 motion by a magistrate judge, even with consent of the parties. This distinction is noted in General Order 05-10, which authorizes magistrate judges to preside by consent only in Section 2241 and 2254 actions.

The new language in section (F) memorializes General Order 05-04, which automatically refers prisoner civil cases. They include not only suits against state and municipal agents under Section 1983, but also Bivens suits against federal agents and suits under the state and federal tort claims acts.

New section (G) memorializes the existing practice of automatically referring all non-prisoner pro se civil suits to magistrate judges.

New subsection (I)(1) tracks the language of General Order 05-06. The additional language in subsection (I)(2) covers the rare occasion where the court reviews other types of agency action.

The addition of new subsection (K)(8) memorializes the existing practice that magistrate judges may conduct felony guilty plea proceedings with the permission of the presiding district judge and the written consent of the defendant..

12. APPENDIX H Court-Annexed Mediation Plan

(f) MEDIATION REPORT. Within five (5) days following the conclusion of the mediation conference, the mediator shall ~~submit~~ electronically file the mediation report with the court using the CM/ECF filing system. ~~to the presiding judge indicating whether all required parties were present~~. The report shall ~~also~~ indicate whether all required parties were present, whether the case settled, was continued with the consent of the parties, or whether the mediator declared an impasse. ~~The presiding judge will file the mediation report with the clerk of court.~~

Comment: This amendment streamlines the former process, which required the mediator to submit a paper report to the presiding judge, who would then forward the report to the clerk for filing. Under the new procedure, the electronic report is immediately filed in the case by the mediator, and is instantaneously available to the court and the litigants.

13. APPENDIX M Patent Rules

As amended May 1, 2006

APPENDIX M

PATENT RULES

1. SCOPE OF RULES

3. PATENT INITIAL DISCLOSURES

3-1. Disclosure of Asserted Claims and ~~Preliminary~~ Infringement Contentions.

Not later than 10 days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and ~~Preliminary~~ Infringement Contentions." Separately for each opposing party, the "Disclosure of Asserted Claims and ~~Preliminary~~ Infringement Contentions" shall contain the following information:

(a) Each claim of each patent in suit that is allegedly infringed by each opposing party;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(c) A chart identifying specifically where each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;

(e) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

(f) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

3-2. Document Production Accompanying Disclosure.

With the "Disclosure of Asserted Claims and ~~Preliminary~~ Infringement Contentions," the party claiming patent infringement must produce to each opposing party or make available for inspection and copying:

(a) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102;

(b) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to P. R. 3-1(e), whichever is earlier; and

(c) A copy of the file history for each patent in suit.

The producing party shall separately identify by production number which documents correspond to each category.

3-3. Preliminary Invalidity Contentions.

Not later than 45 days after service upon it of the "Disclosure of Asserted Claims and ~~Preliminary~~ Infringement Contentions," each party opposing a claim of patent infringement, shall serve on all parties its "~~Preliminary~~ Invalidity Contentions" which must contain the following information:

(a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);

(b) Whether each item of prior art anticipates each asserted claim or renders it obvious. If a combination of items of prior art makes a claim obvious, each such combination, and the motivation to combine such items, must be identified;

(c) A chart identifying where specifically in each alleged item of prior art each element of each asserted claim is found, including for each element that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function; and

(d) Any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(2) or enablement or written description under 35 U.S.C. § 112(1) of any of the asserted claims.

3-4. Document Production Accompanying ~~Preliminary~~ Invalidity Contentions.

With the "~~Preliminary~~ Invalidity Contentions," the party opposing a claim of patent infringement must produce or make available for inspection and copying:

(a) Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its P. R. 3-1(c) chart; and

(b) A copy of each item of prior art identified pursuant to P. R. 3-3(a) which does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon must be produced.

3-5. Disclosure Requirement in Patent Cases for Declaratory Judgment.

(a) Invalidity Contentions If No Claim of Infringement. In all cases in which a party files a complaint or other pleading seeking a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable, P. R. 3-1 and 3-2 shall not apply unless and until a claim for patent infringement is made by a party. If the defendant does not assert a claim for patent infringement in its answer to the complaint, no later than 10 days after the defendant serves its answer, or 10 days after the Initial Case Management Conference, whichever is later, the party seeking a declaratory judgment must serve upon each opposing party its ~~Preliminary~~ Invalidity Contentions that conform to P. R. 3-3 and produce or make available for inspection and copying the documents described in P. R. 3-4. The parties shall meet and confer within 10 days of the service of the ~~Preliminary~~ Invalidity Contentions for the purpose of determining the date on which the plaintiff will file its Final Invalidity Contentions which shall be no later than 50 days after service by the Court of its Claim Construction Ruling.

(b) Applications of Rules When No Specified Triggering Event. If the filings or actions in a case do not trigger the application of these Patent Rules under the terms set forth herein, the parties shall, as soon as such circumstances become known, meet and confer for the purpose of agreeing on the application of these Patent Rules to the case.

(c) Inapplicability of Rule. This P. R. 3-5 shall not apply to cases in which a request for a declaratory judgment that a patent is not infringed, is invalid, or is unenforceable is filed in response to a complaint for infringement of the same patent.

3-6. ~~Final~~ Amending Contentions.

(a) Leave not required.

Each party's "~~Preliminary~~ Infringement Contentions" and "~~Preliminary~~ Invalidity Contentions" shall be deemed to be that party's final contentions, except as set forth below.

(~~a~~ 1) If a party claiming patent infringement believes in good faith that the Court's Claim Construction Ruling so requires, not later than 30 days after service by the Court of its Claim

Construction Ruling, that party may serve "~~Final~~ Amended Infringement Contentions" without leave of court that amend its "~~Preliminary~~ Infringement Contentions" with respect to the information required by Patent R. 3-1(c) and (d).

(~~b~~ 2) Not later than 50 days after service by the Court of its Claim Construction Ruling, each party opposing a claim of patent infringement may serve "~~Final~~ Amended Invalidity Contentions" without leave of court that amend its "~~Preliminary~~ Invalidity Contentions" with respect to the information required by P. R. 3-3 if:

(~~1~~ A) a party claiming patent infringement has served "~~Final~~ Infringement Contentions" pursuant to P. R. 3-6(a),

(~~2~~ B) the party opposing a claim of patent infringement believes in good faith that the Court's Claim Construction Ruling so requires.

~~3-7. Amendment to Contentions.~~ (b) Leave required.

Amendment or ~~modification~~ supplementation of ~~the Preliminary or Final~~ any Infringement Contentions or ~~the Preliminary or Final~~ Invalidity Contentions, other than as expressly permitted in P. R. 3-6(a), may be made only by order of the Court, which shall be entered only upon a showing of good cause.

~~3-8.~~ 3.7 Willfulness.

By the date set forth in the Docket Control Order, each party opposing a claim of patent infringement that will rely on an opinion of counsel as part of a defense to a claim of willful infringement shall:

(a) Produce or make available for inspection and copying the opinion(s) and any other documents relating to the opinion(s) as to which that party agrees the attorney-client or work product protection has been waived; and

(b) Serve a privilege log identifying any other documents, except those authored by counsel acting solely as trial counsel, relating to the subject matter of the opinion(s) which the party is withholding on the grounds of attorney-client privilege or work product protection.

A party opposing a claim of patent infringement who does not comply with the requirements of this P. R. 3-8 shall not be permitted to rely on an opinion of counsel as part of a defense to willful infringement absent a stipulation of all parties or by order of the Court, which shall be entered only upon a showing of good cause.

4. CLAIM CONSTRUCTION PROCEEDINGS

4-1. Exchange of Proposed Terms and Claim Elements for Construction.

(a) Not later than 10 days after service of the "~~Preliminary~~ Invalidity Contentions" pursuant to P. R. 3-3, 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, and facilitating the ultimate preparation of a Joint Claim Construction and Prehearing Statement.

4-2. Exchange of Preliminary Claim Constructions and Extrinsic Evidence.

(a) Not later than 20 days after the exchange of "Proposed Terms and Claim Elements for Construction" pursuant to P. R. 4-1, the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which the parties collectively have 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) 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 extrinsic evidence, including without limitation, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses they contend support their 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.

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

4-3. Joint Claim Construction and Prehearing Statement.

Not later than 60 days after service of the "~~Preliminary~~ Invalidity Contentions," the parties shall complete and file a Joint Claim Construction and Prehearing Statement, which shall contain the following information:

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

(b) 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, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses;

(c) The anticipated length of time necessary for the claim construction hearing;

(d) Whether any party proposes to call one or more witnesses, including experts, at the claim construction hearing, the identity of each such witness, and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert; and

(e) A list of any other issues which might appropriately be taken up at a prehearing conference prior to the claim construction hearing, and proposed dates, if not previously set, for any such prehearing conference.

4-4. Completion of Claim Construction Discovery.

Not later than 30 days after service and filing of the Joint Claim Construction and Prehearing 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 and Prehearing Statement.

4-5. Claim Construction Briefs.

(a) Not later than 45 days after serving and filing the Joint Claim Construction and Prehearing Statement, the party claiming patent infringement shall serve and file an opening brief and any evidence supporting its claim construction.

(b) Not later than 14 days after service upon it of an opening brief, each opposing party shall serve and file its responsive brief and supporting evidence.

(c) Not later than 7 days after service upon it of a responsive brief, the party claiming patent infringement shall serve and file any reply brief and any evidence directly rebutting the supporting evidence contained in an opposing party's response.

(d) At least 10 days before the Claim Construction Hearing held pursuant to P.R. 4-6, the parties shall jointly submit a claim construction chart on computer disk in WordPerfect format or in such other format as the court may direct.

(1) Said chart shall have a column listing complete language of disputed claims with disputed terms in bold type and separate columns for each party's proposed construction of each disputed term. The chart shall also include a fourth column entitled "Court's Construction" and otherwise left blank. Additionally, the chart shall also direct the court's attention to the patent and claim number(s) where the disputed term(s) appear(s).

(2) The parties may also include constructions for claim terms to which they have agreed. If the parties choose to include agreed constructions, each party's proposed construction columns shall state "[AGREED]" and the agreed construction shall be inserted in the "Court's Construction" column.

(3) The purpose of this claim construction chart is to assist the court and the parties in tracking and resolving disputed terms. Accordingly, aside from the requirements set forth in this rule, the parties are afforded substantial latitude in the chart's format so that they may fashion a chart that most clearly and efficiently outlines the disputed terms and proposed constructions. Appendices to the court's prior published and unpublished claim construction opinions may provide helpful guidelines for parties fashioning claim construction charts.

(e) Unless otherwise ordered by the court, the page limitations governing dispositive motions pursuant to Local Rule CV-7(a) shall apply to claim construction briefing.

4-6. Claim Construction Hearing.

Subject to the convenience of the court's calendar, two weeks following submission of the reply brief specified in P.R. 4-5(c), the court shall conduct a Claim Construction Hearing, to the extent the parties or the court believe a hearing is necessary for construction of the claims at issue.

Comments: The word "preliminary" has been removed from all references to "infringement contentions" and "invalidity contentions" as unnecessary in light of P.R. 3-6 and 3-7, which state contentions are final, unless amendment is permitted. No substantive change is intended by this revision. P.R. 3-6 and 3-7 are consolidated into one rule which deals with all the methods of amending infringement and invalidity contentions. Again, no substantive change is intended by this revision.

New section P.R. 4-5(e) provides a default page limitation - that of dispositive motions - for claim construction briefing, unless otherwise ordered by the court.

Signed this 27 day of October, 2006.

FOR THE COURT:

THAD HEARTFIELD
Chief Judge