

LOCAL PATENT RULES (“LPR”) – Commentary on Proposed Changes

1) General Changes throughout the LPR

- a. Revised the LPR to reflect the Patent Act’s provisions both before (where appropriate) and after the America Invents Act (“AIA”).
 - i. Example:
 1. LPR 1-2: “These Rules apply to both pre-Leahy-Smith America Invents Act (“AIA”) patents and post-AIA patents.”
- b. Removed word “initial” from disclosure requirements.
 - i. Rationale
 1. The original goal of including “initial” throughout the LPR was to encourage attorneys to thoroughly learn their cases early in the litigation. In practice, the Committee found this phrasing had the opposite effect, where parties would provide poor disclosures under the guise of such disclosures being only “initial.”
- c. *Additional Note*: New proposed rules are currently denoted as “LPR 1-XX_”
 - i. If adopted, the Committee will renumber the rules and correct any cross-references

2) Specific Changes to the LPR

- a. **LPR 1-2: Scope & Construction**
 - i. Restructured paragraph for clarity.
- b. **LPR 1-4: General Provisions**
 - i. Converted to a “General Provisions” rule to highlight additional issues up front.
 1. Rationale:
 - a. The Committee found that Patent cases in the District of Nevada took much longer to resolve than other comparable districts. Thus, the new subsections are aimed at preventing early-litigation issues from stalling the case’s progression. For example, the rules now note that bringing a § 101 motion to dismiss at the outset of litigation—i.e., before the intrinsic evidence is examined and before the claims are construed based on that evidence—will not delay the Discovery Plan/Scheduling Order (unless otherwise ordered by the Court). To further improve efficiency, the rule also

now sets forth a procedure for appointing Special Masters.

c. **LPR 1-8: Disclosure of Non-infringement, Invalidity, and Unenforceability Contentions**

i. **1-8(f)**

1. Clarified “misuse” as falling under an unenforceability contention.

ii. **1-8(g)**

1. Added requirement to disclose petitions for review or reexamination before the U.S. Patent & Trademark Office.

a. Rationale:

i. The Committee found that a party should typically know at this stage in the litigation whether it intends to file such a petition. Disclosure thus helps move the case forward and prevent gamesmanship. Disclosure also allows the Court to better manage the docket, as the filing of such a petition frequently results in a stay of litigation.

1. *Additional Note:* The Committee was mindful of creating too stringent of a disclosure requirement, which could potentially result in an increase in motions based on a party’s failure to comply. The rule thus contains a low disclosure bar, only requiring a party to disclose the “contemplated scope” of its petition.

d. **LPR 1-10: Response to Invalidity and Unenforceability Contentions**

i. Removed the requirement for a party to file a response to a Non-Infringement contention.

1. Rationale:

a. The Committee found that responses to Non-Infringement contentions served little practical purpose, as the parties’ positions are already known at this stage in the litigation. The amendment therefore aims to reduce unnecessary burden on the parties/Court and expedite the case.

e. **LPR 1-12: Amendment to Disclosures**

- i. Changed the rule to emphasize the good cause requirement for disclosure amendments prior to the Claim Construction Order. The rule also now requires parties to obtain leave from the Court to amend during this stage. Additionally, the rule now cross-cites to “LPR 1-XXb,” which requires post-claim construction disclosure amendments.

1. Rationale:

- a. The current rule allows for parties to freely amend their disclosures without leave from the court (w/ good cause). The Committee found that parties were using this relaxed phrasing to add extra unnecessary rounds of contentions during the pre claim construction phase. The Committee also noted that the local rules in other districts have tighter restrictions on the number of times parties can amend prior to a Claim Construction Order. The amended rule therefore aims to improve efficiency and incentivize attorneys to provide more thorough disclosures.

- i. *Additional Note:* The Committee discussed adding a numerical limit to the number of amendments permitted. However, recognizing that circumstances change throughout the course of litigation, the Committee decided to instead tether amendments to a showing of good cause.

f. **LPR 1-XXa: Disclosure Requirements for Hatch-Waxman Act cases**

- i. Added disclosure requirements specific to “Hatch-Waxman” patent cases.

1. Rationale:

- a. The Committee found that Hatch-Waxman cases contain common elements that pose different disclosure/procedural requirements than general patent cases. This rule does not aim to create new obligations for parties but rather codify the already-existing structure that Hatch-Waxman cases tend to follow. The Committee noted that other districts have adopted similar local rules specific to this type of case.

- g. **LPR 1-15: Joint Claim Construction & Prehearing Statement**
 - i. Added two new subsections aimed at improving the time between filing and resolving patent cases. Notably, the parties now must provide suggested dates for a Claim Construction Hearing. These dates must be within 60 days of the deadline for claim construction briefing.
 - 1. Rationale:
 - a. One of the primary issues identified by the Committee is the length of time between filing a patent case and trial in the District of Nevada (42.1 months).
 - i. *Comparison to Other Districts:*
 - 1. E.D. Va.(12.4 months), S.D. Fla. (17.9 months), E.D. Tex (19.0 months), W.D. Wash. (19.4 months), E.D. La. (20.4 months), W.D. Tex. (20.4 months), W.D. Wis. (20.5 months), S.D. Tex. (20.8 months), E.D. Pa. (21.1 months), N.D. Ohio (21.4 months), and C.D. Cal. (21.5 months).
 - b. The Committee found that by having the parties submit availability within a fixed temporal range (60 days), the Court would be in a better position to timely move the case forward.
 - i. *Additional Note:* The Committee was mindful of increasing the burden on the Court. Thus, the rule does not place any affirmative obligation on the Court to hold a hearing by a certain date. The Court may request additional availability outside the 60-day range if necessary.
- h. **LPR 1-16: Claim Construction Briefing**
 - i. Added subsection requiring a showing of good cause to deviate from the Joint Claim Construction and Prehearing Statement.
 - 1. Rationale:
 - a. The Committee aimed to emphasize the importance of the Joint Claim Construction and Prehearing Statement and incentivize the parties to put more effort into the process.

- i. **LPR 1-17: Claim Construction Hearing & Order**
 - i. Reworded the rule to emphasize the Court’s role in moving the case forward within a certain timeframe.
 - 1. Rationale:
 - a. The Committee emphasized reducing the median time between filing a case and trial in the District of Nevada (*see* explanation under section “g” above).
 - i. *Additional Note*: The Committee aimed to highlight an ideal timeline for the Court to follow but was mindful not to add strict obligations on the Court.
- j. **LPR 1-XXb: Post Claim Construction Amendment of Contentions**
 - i. Added rule requiring parties to amend disclosures post claim construction in order to reduce claims and prior art references asserted.
 - 1. Rationale:
 - a. The Committee found that cases could be streamlined by requiring parties to re-evaluate claims and prior art assertions at this stage in the litigation.
- k. **LPR 1-XXc: Opinion of Counsel Defenses**
 - i. Added rule requiring parties to disclose information regarding any opinion of counsel defenses following issuance of the Claim Construction Order.
 - 1. Rationale:
 - a. The Committee found that parties should know by this stage in the litigation whether they intend to rely on an opinion of counsel defense and disclosure will improve efficiency and prevent gamesmanship.
- l. **LPR 1-19: Mandatory Settlement Conferences for Patent Cases**
 - i. Removed subsection requiring a pre claim construction settlement conference.
 - 1. Rationale:
 - a. The Committee found that a settlement conference at this early stage in the litigation served little practical purpose and created unnecessary work for both the parties and the Court.

- m. **LPR 1-20: Stay of Federal Court Proceedings**
 - i. Added word “review” to the types of proceedings before the U.S. Patent & Trademark Office.

- n. **LPR 1-21: Good Faith Participation**
 - i. Amended rule to include reference to new obligations set forth in LPR-1XXb.

- o. **LPR 1-22: Use of Court Appointed Masters**
 - i. Removed rule because the Special Masters provision is now included upfront under LPR 1-4’s “General Provisions.”

- p. **LPR 1-23: Form of Discovery Plan & Scheduling Order**
 - i. Amended the Sample Discovery Plan/Scheduling Order to reflect terminology and date changes throughout the amended LPR.