GENERAL ORDER 11-3

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 implementation subject to a reasonable period for public notice and comment to be determined by the clerk.[1] *See* 28 U.S.C. § 2071(b).

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

(a) At the commencement of the action, counsel shall prepare and file the civil cover sheet, Form JS 44, along with the complaint. When filing a patent, trademark or copyright case, counsel is also responsible for electronically filing an AO Form 120 or 121, and submitting a copy of the applicable form to the United States Patent Office or United States Copyright Office.

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. The clerk is required to collect the filing fee authorized by federal statute before accepting a complaint for filing.

(b) Electronic Filing of Complaints. Attorneys must electronically file a civil complaint ~~within 24 hours of~~ upon opening ~~the~~ a civil case in CM/ECF. A civil case that is opened by an attorney without a complaint being filed within 24 hours is subject to being terminated by the clerk's office.

[1] New language appears in redlined and underlined text; deleted language appears in ~~strikeout~~ text; comments appear in blue text.

Comment: The language changes to section (b) specify that a complaint must be e-filed when the civil case is opened in CM/ECF.

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 criminal case, the charging documents, including the complaint, information, indictment, and any superseding indictment; petitions for revocation of probation or supervised release; affidavits in support of search and arrest warrants, pen registers, trap and trace requests, wiretaps and other documentation related to these types of applications; and other matters filed *ex parte* in connection with ongoing criminal investigations;

(B) filing from *pro se* litigants (prisoner and non-prisoner);

(C) ~~proof of service of the initial papers~~ return of the completed summons in a civil case;

(D) papers received from another court under Fed. R. Crim. P. 5(c), Fed. R. Crim. P. 20, and Fed. R. Crim. P. 40;

(E) official administrative records or transcripts of prior court or administrative proceedings from other courts or agencies that are required to be filed by law, rule or local rule;

(F) application to appear *pro hac vice*;

(G) any document pertaining to presentence investigation reports in criminal cases; and

(H) sealed civil complaints (this document should be filed on a CD-ROM disk with the clerk along with a motion to seal the case). *See* LOCAL R. CV-5(a)(7)(A).

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Comment: "Return of the completed summons" in Section (a)(1)(C) is a more accurate description of the document in question.

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(3) **Significance of Electronic Filing.**

(A) Electronic transmission of a document to the Electronic Filing System consistent with these rules, together with the transmission of a Notice of Electronic Filing from the court, constitutes filing of the document for all purposes, and constitutes entry of the document on the docket kept by the clerk. Receipt by the filing party of a Notice of Electronic Filing from the court is proof of service of the document on all counsel who are deemed to have consented to electronic service.

(B) When a document has been filed electronically, the official record is the electronic recording of the document as stored by the court, and the filing party is bound by the document as filed. A document filed electronically is

deemed filed at the "entered on" date and time stated on the Notice of Electronic Filing from the court.

(C) Service is deemed completed at the "entered on" date and time stated on the Notice of Electronic Filing from the court, except that documents filed electronically after 5:00 p.m. Central Time shall be deemed served on the following day.

Comment: The "entered on" language was added to Sections (a)(3)(B) and (a)(3)(C) to add clarity, since two dates are reflected on the Notice of Electronic Filing ("NEF"): the "filed" date, and the "entered on" date and time. The "filed" date is collected when the Filing User logs on to the CM/ECF system and starts to electronically file a document. The "entered on" date and time is collected when the Filing User completes the filing transaction in CM/ECF and sends the e-document to the court. Once the filing transaction is completed by the Filing User, the CM/ECF system instantaneously acknowledges receipt of the e-filed document by sending an NEF to the Filing User and any attorney(s) who are listed on the CM/ECF docket sheet at the time of filing.

The new language makes it clear that filing and service of an e-document occur at the "entered on" date and time on the NEF (i.e., when the document filing data entry procedure is completed by the Filing User).

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(6) **Attachments and Exhibits.** Filing Users must submit ~~separately~~ and describe each exhibit or attachment with specificity as a separate PDF document ~~in electronic form and identify each exhibit or attachment~~, unless the court permits conventional filing. *See* LOCAL RULES CV-5(a)(4) ("File Size Limitations," CV-7(b) ("Documents Supporting Motions"), and CV-56(d) ("Proper Summary Judgment Evidence"). Non-documentary exhibits to motions (e.g., CD-ROM disks) should be filed with the clerk's office with a copy to the presiding judge.

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Comment: The court sometimes receives e-filed exhibits or attachments that are generically titled (e.g., Exhibit 1, Attachment 2). Also, the exhibits or attachments sometimes are not filed as separate PDF documents. To solve these difficulties, the new Section (a)(6) language requires that each exhibit or attachment be properly identified and filed as a separate PDF document.

The new sentence at the end of Section (a)(6) is designed to fix the problem that occurs when counsel submits a non-documentary exhibit to a motion (e.g., CD-ROM disk) directly to chambers without filing it with the clerk's office.

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(7) **Sealed Documents.**

(A) Unless authorized by statute or rule, a document in a civil case shall not be filed under seal unless it contains a statement by counsel following the certificate of service that certifies that (1) a motion to seal the document has been filed, or (2) the court already has granted authorization to seal the document.

(B) A motion to file document(s) under seal must be filed separately from the document(s) sought to be sealed. A motion to seal that is filed as a sealed document does not need to include the certification specified in Section (A) above. *See* LOCAL RULE CR-49(b) (additional rules regarding the filing of sealed documents in criminal cases).

(C) Documents requested or authorized to be filed under seal or *ex parte* shall be filed in electronic form. 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. Counsel is also responsible 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 who is responsible for distributing the order to all other counsel of record for that party. *See* LOCAL RULE CV-11.

(D) Unless otherwise ordered by the court, an order that rules on a sealed motion will be sealed by the clerk for seven days. During this time, a party may request that the order remain permanently sealed. If no such request is received upon expiration of the seven-day period, the order ruling on the sealed motion will be unsealed.

Comment: Sealing every order that pertains to a sealed motion is not desirable because it obscures the work of the court and impinges upon the public's access to court records. New rule CV-5(a)(7)(D) gives the parties and the court the means to identify those orders that need to remain sealed and those orders where sealing is not a concern.

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(b) **Filing by Paper.** ~~Where~~ When filing by paper is permitted, the original pleadings, motions, and other papers shall be filed with the clerk.

(1) **Filing by After-Hours Depository.** The court maintains an after-hours document ~~depositories~~ depository at the courthouse~~s~~ in ~~Beaumont, Lufkin,~~ Tyler~~, Marshall, Sherman and Texarkana~~. ~~Where filing by paper is permitted~~, Any pleadings or other documents that are marked received using the electronic time stamp contained in the depository and then placed in the box will be filed as of the time and date marked as

received to the depository.

~~(2) **Filing Papers in Proper Division.** Where filing by paper is permitted, Parties are encouraged to file pleadings, motions and other papers in the division in which the case is pending. If pleadings, motions or other papers are filed in another division, a stamped, addressed envelope for mailing to the proper division must be included.~~

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Comment: "When" is more grammatically correct in the first sentence of Section (b). The drop box deletions in Section (b)(1) conform this section to the current reality. Section (b)(2) has been deleted because e-filing by attorneys has eliminated the logistical problems caused when paper legal documents are filed in the wrong division.

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(c) **Certificates of Service.** The certificate of service required by Fed. R. Civ. P. 5(d) shall indicate the date and method of service. In civil cases involving sealed documents, counsel must indicate that the sealed document(s) was/were promptly served by means other than the CM/ECF system (e.g., e-mail, conventional mail).

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Comment: This sentence is necessary because, as currently configured, parties cannot access the electronic sealed document via the NEF that is sent to opposing counsel when the Filing User e-files a sealed document.

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3. LOCAL RULE CV-7 Motions Practice

(a) **Generally.** All motions, unless made during a hearing or trial, shall be in writing, filed as a separate document, conform to the requirements of Local Rules CV-5 and CV-10, and shall be accompanied by a proposed order in searchable and editable PDF format 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 whenever possible.

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

Case dispositive motions shall contain a statement of the issues to be decided by the court. Responses to case dispositive motions must include a response to the movant's statement of issues.

(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 or sur-reply brief to an opposed non-dispositive motion filed pursuant to Section (f) of this rule shall not exceed five pages, excluding attachments. Non-dispositive

motions include, among others, motions to transfer venue, motions for partial summary judgment, and motions for new trial pursuant to Fed. R. Civ. P. 59.

(3) **Total Page Limits for Summary Judgment Motions.** If a party files more than one summary judgment motion, the following additional limitations shall apply:

(A) a party's summary judgment motions shall not exceed sixty pages collectively, excluding attachments;

(B) a party's responses to summary judgment motions shall not exceed sixty pages collectively, excluding attachments;

(C) a party's reply briefing to summary judgment motions shall not exceed twenty pages collectively excluding attachments; and

(D) a party's sur-reply briefing to summary judgment motions shall likewise not exceed twenty pages collectively, excluding attachments.

(4) **Motions to Reconsider.** Motions to reconsider must specifically state the action and the docket sheet document number to be reconsidered in the title of the motion (e.g., "Motion to Reconsider Denial of Motion for Partial Summary Judgment (dkt # x))."

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Comment: New Subsection (4) has been added to require additional clarity in the titling of motions to reconsider.

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(h) **"Meet and Confer" Requirement.** The "meet and confer" motions practice requirement imposed by this rule has two components, a substantive and a procedural component.

The substantive component requires, at a minimum, a personal conference, by telephone or in person, between an attorney for the movant and an attorney for the non-movant. In any discovery related motion, the substantive component requires, at a minimum, a personal conference, by telephone or in person, between the lead ~~trial counsel~~ attorney and any local counsel for the movant and the lead ~~trial counsel~~ attorney and any local counsel for the non-movant.

In the personal conference, the participants must give each other the opportunity to express his or her views concerning the disputes. The participants must also compare views and have a discussion in an attempt to resolve their differing views before coming to court. Such discussion requires a sincere effort in which the participants present the merits of their respective positions and meaningfully assess the relative strengths of each position.

In discovery-related matters, the discussion shall consider, among other things: (1) whether and to what extent the requested material would be admissible in a trial or is reasonably calculated to lead to the discovery of admissible evidence; (2) the burden and costs imposed on the responding party; (3) the possibility of cost-shifting or sharing; and (4) the expectations of the court in ensuring that parties fully cooperate in discovery of relevant information.

Except as otherwise provided by this rule, a request for court intervention is not appropriate until the participants have met and conferred, in good faith, and concluded, in good faith, that the discussions have conclusively ended in an impasse, leaving an open issue for the court to resolve. Good faith requires honesty in one's purpose to discuss meaningfully the dispute, freedom from intention to defraud or abuse the discovery process, and faithfulness to one's obligation to secure information without court intervention. Correspondence, e-mails, and facsimile transmissions do not constitute compliance with the substantive component and are not evidence of good faith. Such materials, however, may be used to show bad faith of the author.

An unreasonable failure to meet and confer violates Local Rule AT-3 and is grounds for disciplinary action. A party may file an opposed motion without the required conference only when the nonmovant has acted in bad faith by failing to meet and confer.

The procedural requirement of the "meet and confer" rule is one of certification. It appears in Section (i) of this rule, entitled "Certificates of Conference."

Comment: "Lead attorney" is defined in Local Rule CV-11. "Lead trial attorney" is changed to "lead attorney" to add consistency in the use of this defined term throughout the local rules.

(i) **Certificates of Conference.** Except as specified below, all motions must be accompanied by a "certificate of conference" at the end of the motion following the certificate of service. The certificate must state: (1) that counsel has complied with the meet and confer requirement in Local Rule CV-7(h); and (2) whether the motion is opposed or unopposed. Opposed motions shall include a statement in the certificate of conference, signed by the movant's attorney, that the personal conference or conferences required by this rule have been conducted or were attempted, the date and manner of such conference(s) or attempts, the names of the participants in the conference(s), an explanation of why no agreement could be reached, and a statement that discussions have conclusively ended in an impasse, leaving an open issue for the court to resolve. In discovery-related motions, the certificate of conference shall be signed by the lead ~~trial counsel~~ attorney and any local counsel. In situations involving an unreasonable failure to meet and confer, the movant shall set forth in the certificate of conference the facts believed to constitute bad faith.

Neither the "meet and confer" nor the certificate~~s~~ of conference requirements are applicable to *pro se* litigants (prisoner or non-prisoner) or to the following motions:

(1) to dismiss;
(2) for judgment on the pleadings;
(3) for summary judgment, including motions for partial summary judgment;
(4) for judgment as a matter of law;
(5) for judgment of acquittal in a criminal case;
(6) to suppress evidence in criminal cases;
(7) for new trial;
(8) any motion captioned as "joint," "agreed, " or "unopposed;"

(9) issuance of letters rogatory;

(10) objections to report and recommendations of magistrate judges or special masters;

(11) for reconsideration; and

(12) for sanctions under Fed. R. Civ. P. 11, provided the requirements of Fed. R. Civ. P. 11(c)(2) have been met.

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Comment: Use of the defined term "lead attorney" is substituted. The court believes it unnecessary for counsel to routinely confer on motions for partial summary judgment, objections to reports and recommendations, motions for reconsideration, and motions for Rule 11 sanctions.

4. LOCAL RULE CV-10 Form of Pleadings

(a) **Generally.** When offered for filing, all documents, excluding preexisting documentary exhibits and attachments, shall:

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

(2) have 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 it (e.g., Defendant John Doe's Answer; Defendant John Doe's Motion to Dismiss under Rule 12(b)(6)); (*ee* LOCAL RULE CV-38(a) (cases involving jury demands); *see also* LOCAL RULE CV-7(a) (each motion must be filed as a separate document);

(3) be signed by the ~~attorney in charge~~ lead attorney or with his or her permission;

(4) when filed by paper, be plainly written, typed, or printed, double-spaced, on 8 1/2 inch by 11 inch white paper; and

(5) be double spaced and in a font no smaller than 12 point type.

Comment: The defined term "lead attorney" has been substituted for "attorney in charge," which has been phased out of the rules.

5. **LOCAL RULE CV-56 Summary Judgment**

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(d) **Proper summary judgment evidence.** As used within this rule, "proper summary judgment evidence" means excerpted copies of pleadings, depositions, documents, electronically stored information, answers to interrogatories, admissions, affidavits or declarations, stipulations (including those made for purposes of the motion only), and other admissible evidence cited in the motion for summary judgment or the response thereto. The phrase "appropriate citations" means that any excerpted evidentiary materials that are attached to the motion or the response should be referred to by page and, if possible, by line. Counsel are strongly encouraged to highlight or underline the cited portion of any attached evidentiary materials, unless the citation encompasses the entire page. The page preceding and following a highlighted page may be submitted if necessary to place the highlighted material in its proper context. Only relevant, cited-to excerpts of evidentiary materials should be attached to the motion or the response.

Comment: The definition of "proper summary judgment evidence" has been amended consistent with the listing of proper summary judgment materials in new Fed. R. Civ. P. 56(c)(1)(a).

6. **LOCAL RULE CV-62 Stay of Proceedings to Enforce a Judgment**

(a) **Supersedeas Bond.** Unless otherwise ordered by the presiding judge, a supersedeas bond staying execution of a money judgment shall be in the amount of the judgment, plus 20% of that amount to cover interest and any award of damages for delay, plus $250.00 to cover costs. The parties may waive the requirement of a supersedeas bond by stipulation.

The bond shall: (1) confirm that the insurance company is on the Treasury Department's list of certified bond companies, unless the court orders otherwise (a link to this list may be

found on the court's website); and (2) confirm the underwriting limitation.

(b) **Power of Attorney.** If the insurance company is not incorporated and licensed in the State of Texas, a power of attorney must be filed. It is the responsibility of the filing attorney to confirm that the information on the power of attorney and bond is correct. The agent for the power of attorney shall reside in the Eastern District of Texas, unless the court orders otherwise.

Comment: More specific requirements regarding the filing of supersedeas bonds have been added. The new Section (b) resident agent provision was added to conform the local rule with 31 U.S.C. § 9306, which states:

Surety corporations acting outside area of incorporation and place of principal office.

(a) A surety corporation may provide a surety bond under section 9304 of this title in a judicial district outside the State, the District of Columbia, or a territory or possession of the United States under whose laws it was incorporated and in which its principal office is located only if the corporation has a resident agent for service of process for that district. The resident agent—

(1) may be an official of the State, the District of Columbia, the territory or possession in which the court sits who is authorized or appointed under the law of the State, District, territory or possession to receive service of process on the corporation; or

(2) may be an individual who resides in the jurisdiction of the district court for the district in which a surety bond is to be provided and who is appointed by the corporation as provided in subsection (b).

(b) If the surety corporation meets the requirement of subsection (a) by appointing an

individual under subsection (a)(2), the surety corporation shall file a certified copy of the power of attorney with the clerk of the district court for the district in which a surety bond is to be given at each place the court sits. A copy of the power of attorney may be used as evidence in a civil action under section 9307 of this title.

(c)

(1) If a resident agent is removed, resigns, dies, or becomes disabled, the surety corporation shall appoint another agent as described in this section.

(2) Until an appointment is made under paragraph (1) of this subsection or during an absence of an agent from the district in which the surety bond is given, service of process may be made on the clerk of the court in which a civil action against the corporation is brought. The official serving process on the clerk of the court—

(A) immediately shall mail a copy of the process to the corporation; and

(B) shall state in the officials return that the official served the process on the clerk of the court.

(3) A judgment or order of a court entered or made after service of process under this section is as valid as if the corporation were served in the judicial district of the court.

7. LOCAL RULE CV-83 Rules by District Courts; Judge's Directives

(a) **Docket Calls.** Traditional docket calls are abolished. Each judge shall endeavor to set early and firm trial dates which will eliminate the need for multiple-case docket calls.

(b) **Transferred or Remanded Cases.** Absent an order of the court to the contrary, no sooner than the twentieth day following an order of the court transferring the case to another district court or remanding it to the appropriate state court, the clerk shall transmit the case file to the directed court. Where a case has been remanded to state court, the clerk shall mail: (1) a certified copy of the court's order and docket sheet directing such action, and (2) ~~the original of~~ all pleadings and other documents on file in the case. Where a case has been transferred to another federal district court, the electronic case file shall be transferred to the directed court. If a timely motion or reconsideration of the order of transfer or remand has been filed, the clerk shall delay mailing or transferring the file until the court has ruled on the motion for reconsideration.

Comment: These minor changes conform Section (b) to existing practice.

8. LOCAL RULE CR-47 Motions

(a) **In General.** The district courts enter standing orders governing the filing of certain motions. This rule supplements such orders; however, the case-specific order controls if there is a discrepancy between the two.

(b) **Form and Content of a Motion.** All motions and responses to 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 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. Dispositive motions– those which could, if granted, result in the dismissal of an indictment or counts therein or the exclusion of evidence–shall contain a statement of the issues to be decided by the court. Responses to dispositive motions must include a response to the movant's statement of issues. All 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

whenever possible.

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Comment: The new language was added to make it clear that the procedural rules regarding the filing of criminal motions also applied to the filing of responses to motions.

(3) **Certificates of Conference.** Except as specified below, all motions must be accompanied by a "certificate of conference." It should be placed at the end of the motion following the certificate of service. The certificate must state: (1) that counsel has conferred with opposing counsel in a good faith attempt to resolve the matter without court intervention; and (2) whether the motion is opposed or unopposed. Certificates of conference are not required of *pro se* litigants (prisoner or non-prisoner) or for the following motions:

(A) motions to dismiss:
(B) motions *in limine*;
(C) motions for judgment of acquittal;
(D) motions to suppress;
(E) motions for new trial;
(F) any motion captioned as "joint," "agreed, " or "unopposed;"
(G) any motion permitted to be filed *ex parte*;
(H) objections to report and recommendations of magistrate judges; and
(I) for reconsideration.

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Comment: The court believes there is no utility in routinely conferring on objections to report and recommendations and motions for reconsideration in criminal cases.

(c) **Timing of a Motion.**

(1) **Responses.** A party opposing a motion has fourteen ~~calendar~~ days from the date the motion was served in which to serve and file a response and any supporting documents, after which the court will consider the submitted motion for decision. Three days shall be added to the prescribed time period pursuant to Fed. R. Crim. P. 45(c). Any party may separately move for an order of the court lengthening or shortening the period within which a response may be filed.

Comment: The word "calendar" was struck from Section (c) since the national rules on time computation already specify that calendar days are to be used in time computation. The use of the word "calendar" here is redundant and unnecessary.

9. LOCAL RULE CR-49 Service and Filing

(a) **Generally.** All pleadings and papers submitted in criminal cases must conform to the filing, service, and format requirements contained in Local Rules CV-5, CV-10, and CV-11.

(1) **Defendant Number.** In multi-defendant cases, each defendant receives a "defendant number." The numbers are assigned in the order in which defendants are listed on the complaint or indictment. When filing documents with the court, parties shall identify by name and number each defendant to whom the document being filed applies.

(2) **Sealed Indictments.** In multi-defendant cases involving one or more sealed indictments, the government should, at the time the sealed indictment is filed, provide the clerk with appropriately redacted copies of the indictment for each defendant. The goal of this procedure is to protect the confidential aspect of the sealed indictment with regard to any defendants not yet arrested.

(b) **Filing of Sealed Documents in Criminal Cases.** Documents in criminal cases that are filed under seal pursuant to general order[2] or rule of this court shall be filed under seal without need for a motion to seal or a certification by counsel. Other types of documents in criminal cases may not be filed under seal unless counsel certifies that: (1) a motion for leave to seal the document in question has been filed; or (2) the court has already granted authorization to seal. All sealed documents in criminal cases, except for indictments, shall be filed with the clerk's office in CD-ROM format. *See* LOCAL RULE CV-5(a)(7) (filing sealed documents in civil cases).

Comment: The additional language acknowledges the fact that sealed indictments are not e-filed in this court.

10. LOCAL PATENT RULE 3-7 ~~Willfulness~~ Opinion of Counsel Defenses

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.

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[2] Existing general orders that fall into this category are General Order 93-3 ("General Order on Sealed Indictments") and General Order 93-4 ("General Order on Sealed Criminal Matters").

A party opposing a claim of patent infringement who does not comply with the requirements of this P.R. 3-7 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.

Comments: This change to P.R. 3-7 is intended to enlarge disclosure requirements to any defense to a claim of patent infringement that relies on an opinion of counsel, not simply willfulness. This includes defenses to claims of indirect infringement that depend on an accused infringer's state of mind.

11. LOCAL PATENT RULE 3-8 Disclosure Requirements for Patent Cases Arising Under 21 U.S.C. § 355 (Hatch-Waxman Act)

The following provision applies to all patents subject to a Paragraph IV certification in cases arising under 21 U.S.C. § 355 (commonly referred to as "the Hatch-Waxman Act"). This provision takes precedence over any conflicting provisions in P.R. 3-1 to 3-5 for all cases arising under 21 U.S.C. § 355.

(a) At or before the Initial Case Management Conference, the Defendant(s) shall produce to Plaintiff(s) the entire Abbreviated New Drug Application or New Drug Application that is the basis of the case in question.

(b) Not more than fourteen days after the Initial Case Management Conference, the Defendant(s) shall provide to Plaintiff(s) the written basis for their "Invalidity Contentions" for any patents referred to in Defendant(s) Paragraph IV Certification. This written basis shall contain all disclosures required by P.R. 3-3 and shall be accompanied by the production of documents required by P.R. 3-4.

(c) Not more than fourteen days after the Initial Case Management Conference, the Defendant(s) shall provide to Plaintiff(s) the written basis for any defense of non-infringement for any

patent referred to in Defendant(s) Paragraph IV Certification. This written basis shall include a claim chart identifying each claim at issue in the case and each limitation of each claim at issue. The claim chart shall specifically identify for each claim those claim limitation(s) that are literally absent from the Defendant(s) allegedly infringing Abbreviated New Drug Application or New Drug Application. The written basis for any defense of non-infringement shall also be accompanied by the production of any document or thing that the Defendant(s) intend to rely upon in defense of any infringement allegations by Plaintiff(s).

(d) Not more than forty-five days after the disclosure of the written basis for any defense of non-infringement as required by P.R. 3-8(c), Plaintiff(s) shall provide Defendant(s) with a "Disclosure of Asserted Claims and Infringement Contentions," for all patents referred to in Defendant(s) Paragraph IV Certification, which shall contain all disclosures required by P.R. 3-1 and shall be accompanied by the production of documents required by P.R. 3-2.

Comment: New Patent Rule 3-8 was added to deal with the unique procedural posture presented in Hatch-Waxman Act cases between brand-name and generic drug companies. In these cases, the generic drug company wishing to obtain FDA approval for a generic drug usually submits an Abbreviated New Drug Application ("ANDA") to the FDA that relies in large part on the brand companies New Drug Application that has been previously granted FDA approval. If the generic company wishes to seek approval to market its generic drug before expiration of the patents on the brand drug, the generic company must notify the brand company in writing (referred to as a "Paragraph IV Certification"). The Paragraph IV Certification is required to contain a detailed statement why the generic company believes the patents in question are not infringed, invalid, or unenforceable. Once a brand company receives a Paragraph IV letter, the Hatch-Waxman Act provides forty-five days for the company to make an assessment of the generic company' s claims and file suit. Because ANDA filings are confidential, the Paragraph IV letter is most commonly the only knowledge that the pioneer company has of the ANDA. During the forty-five-day period, the generic company is not obligated to provide anything to the brand company in relation to the ANDA, beyond the Paragraph IV letter. Accordingly, the brand company plaintiff is not in the same position as the traditional patent infringement plaintiff.

To account for this difference, parties often engage in early motion practice to reverse the order of disclosures found under the Patent Rules. This new proposed rule, modeled on the District of New Jersey's Patent Rule 3.6, removes the necessity for motion practice to reverse the order of disclosures and adds meaningful structure to the to the preliminary contention stage of Hatch-Waxman cases not currently provided by the Patent Rules, without requiring court intervention in each case.

Signed this 15 day of March, 2011.

FOR THE COURT:

DAVID FOLSOM
Chief Judge