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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA
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11 THE REGENTS OF THE UNIVERSITY
12 OF CALIFORNIA; and BECTON,
13 DICKINSON and COMPANY,

14 Plaintiffs,

15 v.

16 AFFYMETRIX, INC.; and LIFE
17 TECHNOLOGIES CORP.,

18 Defendants.

Case No.: 17-cv-01394-H-NLS

**(1) ORDER GRANTING JOINT
MOTION TO ADVANCE CLAIM
CONSTRUCTION SCHEDULE; AND**

[Doc. No. 75.]

**(2) AMENDED SCHEDULING
ORDER**

19 On July 10, 2017, Plaintiffs the Regents of the University of California and Becton,
20 Dickinson and Company filed a complaint for patent infringement against Defendants
21 Affymetrix, Inc. and Life Technologies Corp., alleging infringement of U.S. Patent No.
22 9,085,799, U.S. Patent No. 8,110,673, and U.S. Patent No. 8,835,113. (Doc. No. 1,
23 Compl.) On September 8, 2017, Defendants filed an answer to Plaintiffs' complaint. (Doc.
24 No. 37.)

25 On October 6, 2017, the Court issued a scheduling order. (Doc. No. 55.) On
26 November 20, 2017, the Court denied Plaintiff Becton, Dickinson's motion for a
27 preliminary injunction without prejudice. (Doc No. 69.) In the order, the Court invited the
28 parties to submit a joint proposal to advance the claim construction hearing and related

1 dates in the action. (Id. at 12.) On November 29, 2017, the parties filed a joint motion to
2 advance the claim construction schedule. (Doc. No. 75.) For good cause shown, the Court
3 grants the joint motion, and the Court issues the following amended scheduling order:¹

4 1. Prior to the filing of any discovery related motion, the parties must meet and
5 confer regarding the discovery dispute, and then provide the district judge with a summary
6 of the discovery dispute through a joint phone call or through a one-page joint filing.

7 2. **Invalidity Contentions.** On or before **December 15, 2017**, Defendants must
8 serve on all parties their “Invalidity Contentions,” which must contain the following
9 information:

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

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27 ¹ The parties should specifically note that the Court’s scheduling order sets forth disclosure
28 requirements for damages contentions that are based on the requirements set forth in the Northern
District of California Patent Local Rules 3-1(h), 3-2(f)–(j), 3-4(c)–(e), 3-8, and 3-9.

1 b. Whether each item of prior art anticipates each asserted claim or renders
2 it obvious. If obviousness is alleged, an explanation of why the prior art renders the
3 asserted claim obvious, including an identification of any combinations of prior art
4 showing obviousness;

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

9 d. Any grounds of invalidity based on indefiniteness under 35 U.S.C. §
10 112(2) of any of the asserted claims; and

11 e. Any grounds of invalidity based on lack of written description, lack of
12 enabling disclosure, or failure to describe the best mode under 35 U.S.C. § 112(1).

13 3. **Document Production Accompanying Invalidity Contentions.** With the
14 Invalidity Contentions, the party opposing a claim of patent infringement must produce or
15 make available for inspection and copying:

16 a. Source code, specifications, schematics, flow charts, artwork, formulas,
17 or other documentation sufficient to show the operation of any aspects or elements of any
18 Accused Instrumentality identified by the patent claimant in its Patent Local Rule 3.1(c)
19 chart;

20 b. A copy of each item of prior art identified pursuant to Patent Local Rule
21 3.3(a) that does not appear in the file history of the patent(s) at issue. To the extent any
22 such item is not in English, the party opposing infringement must produce an English
23 translation of the portion(s) relied upon;

24 c. All agreements that the party opposing infringement contends are
25 comparable to a license that would result from a hypothetical reasonable royalty
26 negotiation;

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1 d. Documents sufficient to show the sales, revenue, cost, and profits for
2 accused instrumentalities identified pursuant to Patent Local Rule 3.1(b) for any period of
3 alleged infringement; and

4 e. All agreements that may be used to support the party denying
5 infringement's damages case.

6 4. **Invalidity Contentions If No Claim of Infringement.** In all cases in which
7 a party files a complaint or other pleading seeking a declaratory judgment that a patent is
8 not infringed, is invalid, or is unenforceable, Patent Local Rules 3.1 and 3.2 will not apply
9 unless and until a party makes a claim for patent infringement. If the Defendants do not
10 assert a claim for patent infringement in answer to the complaint, no later than fourteen
11 (14) days after the Initial Case Management Conference, the party seeking a declaratory
12 judgment must serve upon each opposing party Invalidity Contentions that conform to
13 Patent Local Rule 3.3 and produce or make available for inspection and copying the
14 documents described in Patent Local Rule 3.4.

15 5. **Exchange of Preliminary Claim Construction and Extrinsic Evidence.**

16 a. On or before **January 4, 2018**, the parties will simultaneously
17 exchange a preliminary proposed construction of each claim term, phrase, or clause that
18 the parties have identified for claim construction purposes. Each Preliminary Claim
19 Construction will also, for each element that any party contends is governed by 35 U.S.C.
20 § 112(6), identify the structure(s), act(s), or material(s) described in the specification
21 corresponding to that element.

22 b. Simultaneously with exchange of the Preliminary Claim Constructions,
23 the parties must also provide a preliminary identification of extrinsic evidence, including,
24 without limitation, dictionary definitions, citations to learned treatises and prior art, and
25 testimony of percipient and expert witnesses they contend support their respective claim
26 constructions. The parties must identify each such item of extrinsic evidence by production
27 number or produce a copy of any such item not previously produced. With respect to any
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1 such witness, percipient or expert, the parties must also provide a brief description of the
2 substance of that witness's proposed testimony.

3 c. On or before **January 15, 2018**, the parties will simultaneously
4 exchange "Responsive Claim Constructions" identifying whether the responding party
5 agrees with the other party's proposed construction, or identifying an alternate construction
6 in the responding party's preliminary construction, or setting forth the responding party's
7 alternate construction.

8 d. Simultaneous with exchange of the Responsive Claim Constructions
9 pursuant to Patent Local Rule 4.1(c), the parties must also provide a preliminary
10 identification of extrinsic evidence, including without limitation, dictionary definitions,
11 citations to learned treatises and prior art, and testimony of percipient and expert witnesses
12 they contend support any responsive claim constructions. The parties must identify each
13 such item of extrinsic evidence by production number or produce a copy of any such item
14 not previously produced. With respect to any such witness, percipient or expert, the parties
15 must also provide a brief description of the substance of that witness's proposed testimony.

16 e. The parties must thereafter meet and confer for the purposes of
17 narrowing the issues and finalizing preparation of a Joint Claim Construction Chart,
18 Worksheet and Hearing Statement.

19 6. Any motion to join other parties, to amend the pleadings, or to file additional
20 pleadings must be filed on or before **January 19, 2018**.

21 7. **Joint Claim Construction Chart, Worksheet, and Hearing Statement**. On
22 or before **January 26, 2018**, the parties must complete and file a Joint Claim Construction
23 Chart, Joint Claim Construction Worksheet, and Joint Hearing Statement.

24 a. The Joint Hearing Statement must include an identification of the terms
25 whose construction will be most significant to the resolution of the case up to a maximum
26 of ten (10) terms. The parties must also identify any term among the ten (10) whose
27 construction will be case or claim dispositive. If the parties cannot agree on the ten (10)
28 most significant terms, the parties must identify ones which they do agree are most

1 significant and then they may evenly divide the remainder with each party identifying what
2 it believes are the remaining most significant terms. However, the total terms identified by
3 all parties as most significant cannot exceed ten (10). For example, in a case involving two
4 (2) parties if the parties agree upon the identification of five (5) terms as most significant,
5 each may only identify two (2) additional terms as most significant; if the parties agree
6 upon eight (8) such terms, each party may only identify only one (1) additional term as
7 most significant.

8 b. The Joint Claim Construction Chart must have a column listing
9 complete language of disputed claims with the disputed terms in bold type and separate
10 columns for each party's proposed construction of each disputed term. Each party's
11 proposed construction of each disputed claim term, phrase, or clause, must identify all
12 references from the specification or prosecution history that support that construction, and
13 identify any extrinsic evidence known to the party on which it intends to rely either to
14 support its proposed construction of the claim or to oppose any party's proposed
15 construction of the claim, including, but not limited to, as permitted by law, dictionary
16 definitions, citations to learned treatises and prior art, and testimony of percipient and
17 expert witnesses. For every claim with a disputed term, each party must identify with
18 specificity the impact of the proposed constructions on the merits of the case.

19 c. The parties' Joint Claim Construction Worksheet must be in the format
20 set forth in Appendix A of the Patent Local Rules and include any proposed constructions
21 to which the parties agree, as well as those in dispute. The parties must jointly submit the
22 Joint Claim Construction Worksheet to Judge Huff's e-file inbox in both Word and
23 WordPerfect format or in such other format as the Court may direct.

24 d. The Joint Hearing Statement must include:
25 1. The anticipated length of time necessary for the Claim
26 Construction Hearing;
27 2. Whether any party proposes to call one or more witnesses,
28 including experts, at the Claim Construction Hearing, the identity of each such witness,

1 and for each expert, a summary of each opinion to be offered in sufficient detail to permit
2 a meaningful deposition of that expert; and

3 3. The order of presentation at the Claim Construction Hearing.

4 e. At the Court’s discretion, within seven (7) days of the submission of
5 the Joint Claim Construction Chart, Joint Claim Construction Worksheet and Joint Hearing
6 Statement, the Court will hold a status conference with the parties, in person or by
7 telephone, to discuss scheduling, witnesses and any other matters regarding the Claim
8 Construction Hearing.

9 8. Amended and Final Infringement Contentions.²

10 a. As a matter of right, a party asserting infringement may serve Amended
11 Infringement Contentions no later than the filing of the parties’ Joint Claim Construction
12 Chart, **January 26, 2018**. Thereafter, absent undue prejudice to the opposing party, a party
13 asserting infringement may only amend its infringement contentions:

14 1. If, not later than thirty (30) days after service of the Court’s
15 Claim Construction Ruling, the party asserting infringement believes in good faith that
16 amendment is necessitated by a claim construction that differs from that proposed by such
17 party; or

18 2. upon a timely motion showing good cause.

19 b. As a matter of right, a party opposing a claim of patent infringement
20 may serve “Amended Invalidity Contentions” no later than the Completion of Claim
21 Construction Discovery, **February 9, 2018**. Thereafter, absent undue prejudice to the
22 opposing party, a party opposing infringement may only amend its invalidity contentions:

23 1. if a party claiming patent infringement has served Amended
24 Infringement Contentions, and the party opposing a claim of patent infringement believes
25 in good faith that the Amended Infringement Contentions so require;

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28 ² This rule does not relieve any party from its obligations under Federal Rule of Civil Procedure
26 to timely supplement disclosures and discovery responses.

1 2. if, not later than fifty (50) days after service of the Court’s Claim
2 Construction Ruling, the party opposing infringement believes in good faith that
3 amendment is necessitated by a claim construction that differs from that proposed by such
4 party; or

5 3. upon a timely motion showing good cause.

6 9. **Completion of Claim Construction Discovery.** On **February 9, 2018**, the
7 parties must complete all discovery, including depositions of any percipient or expert
8 witnesses, that they intend to use in the Claim Construction Hearing. Federal Rule of Civil
9 Procedure 30 applies to depositions taken pursuant to Patent Local Rule 4.3 except as to
10 experts. An expert witness identified in a party’s Joint Hearing Statement pursuant to
11 Patent Local Rule 4.2(d) may be deposed on claim construction issues. The identification
12 of an expert witness in the Joint Hearing Statement may be deemed good cause for a further
13 deposition on all substantive issues.

14 10. **Damages Contentions.** On **February 16, 2018**, each party asserting
15 infringement shall:

16 a. Identify each of the category(-ies) of damages it is seeking for the
17 asserted infringement, as well as its theories of recovery, factual support for those theories,
18 and computations of damages within each category, including:

- 19 1. lost profits;
- 20 2. price erosion;
- 21 3. convoied or collateral sales;
- 22 4. reasonable royalty; and
- 23 5. any other form of damages.

24 b. To the extent a party contends it is unable to provide a fulsome response
25 to the disclosures required by this rule, it shall identify the information it requires.

26 11. **Responsive Damages Contentions.** On **March 9, 2018**, each party denying
27 infringement shall identify specifically how and why it disagrees with those contentions.
28 This should include the party’s affirmative position on each issue. To the extent a party

1 contends it is unable to provide a fulsome response to the disclosures required by this rule,
2 it shall identify the information it requires.

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4 12. **Claim Construction Briefs.**

5 a. On **February 23, 2018**, the parties will simultaneously file and serve
6 opening briefs and any evidence supporting their claim constructions.

7 b. On **March 9, 2018**, the parties will simultaneously file and serve briefs
8 responsive to the opposing party's opening brief and any evidence directly rebutting the
9 supporting evidence contained in the opposing party's opening brief.

10 13. **Claim Construction Hearing.** On **Friday, March 23, 2018, at 10:00 a.m.**,
11 the Honorable Marilyn L. Huff will conduct a Claim Construction Hearing in San Diego,
12 California.

13 14. **Advice of Counsel.** Not later than thirty (30) days after the filing of the Claim
14 Construction Order, each party relying upon advice of counsel as part of a patent related
15 claim or defense for any reason must:

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

19 b. Provide a written summary of any oral advice and produce or make
20 available for inspection and copying that summary and documents related thereto for which
21 the attorney-client and work product protection have been waived; and

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

26 A party who does not comply with the requirements of Patent Local Rule 3.7 will
27 not be permitted to rely on advice of counsel for any purpose, absent a stipulation of all
28 parties or by order of the court, which will be entered only upon showing of good cause.

1 15. The initial date for the substantial completion of document discovery
2 including electronically stored information (“ESI”) is **April 27, 2018**. See Patent L.R.
3 2.1(a)(1).

4 16. All fact discovery must be completed on or before **June 29, 2018**.
5 “Completed” means that all discovery under Rules 30 through 36 of the Federal Rules of
6 Civil Procedure must be initiated a sufficient period of time in advance of the cut-off date
7 so that it can be completed by the cut-off date, taking into account the times for services,
8 notice, and response as set forth in the Federal Rules of Civil Procedure.

9 17. On or before **April 27, 2018**, all parties must exchange with all other parties
10 a list of all expert witnesses expected to be called at trial. The list must include the name,
11 address, and telephone number of the expert and a brief statement identifying the subject
12 areas as to which the expert is expected to testify. The list must also include the normal
13 rates the expert charges for deposition and trial testimony. The list must include non-
14 retained testifying experts. On or before **May 11, 2018**, any party may supplement its
15 designation in response to any other party’s designation so long as that party has not
16 previously retained an expert to testify on that subject.

17 18. Each expert witness designated by a party must prepare a written report to be
18 provided to all other parties no later than **May 25, 2018**, containing the information
19 required by Federal Rule of Civil Procedure 26(a)(2)(A) and (B). Except as provided in
20 paragraph 16 below, any party that fails to make these disclosures must not, absent
21 substantial justification, be permitted to use evidence or testimony not disclosed at any
22 hearing or at the time of trial. In addition, the Court may impose sanctions as permitted by
23 Federal Rule of Civil Procedure 37.

24 19. Any party, through any expert designated, must, in accordance with Federal
25 Rule of Civil Procedure 26(a)(2)(D) and 26(e)(2), supplement any of its expert reports
26 regarding evidence intended solely to contradict or rebut evidence on the same subject
27 matter identified in an expert report submitted by another party. Any such rebuttal reports
28 are due on or before **June 8, 2018**.

1 20. All expert discovery must be completed on or before **June 29, 2018**.
2 “Completed” means that all discovery under Rules 30 through 36 of the Federal Rules of
3 Civil Procedure must be initiated a sufficient period of time in advance of the cut-off date
4 so that it can be completed by the cut-off date, taking into account the times for services,
5 notice, and response as set forth in the Federal Rules of Civil Procedure.

6 21. All motions, including motions addressing Daubert issues, but excluding
7 earlier motions to amend or join parties and later motions in limine, must be filed on or
8 before **July 27, 2018**. Any oppositions must be filed on or before **August 10, 2018**. Any
9 replies must be filed on or before **August 17, 2018**. The Court schedules a motion hearing
10 for **Friday, August 31, 2018, at 10:30 a.m.** The Court reserves the right to vacate the
11 hearing and submit the motions on the filings pursuant to Civil Local Rule 7.1(d)(1). The
12 Court reminds the parties that they do not need to wait until the last minute to file their
13 motions. For any motion filed more than two weeks before the motion-filing cut-off date,
14 the moving party must contact chambers to schedule a hearing.

15 All briefing in this action must comply with Civil Local Rule 7.1(h). Briefs or
16 memoranda in support of or in opposition to all motions noticed for the same motion day
17 must not exceed a total of twenty-five (25) pages in length, per party, for all such motions
18 without leave of the judge who will hear the motion. No reply memorandum will exceed
19 ten (10) pages without leave of the judge.

20 22. The parties must conduct a settlement conference in accordance with Patent
21 Local Rule 2.1(c). The parties must contact the magistrate judge assigned to this case to
22 arrange a date for the settlement conference.

23 23. The parties must file and submit to the Court’s e-file inbox a juror
24 questionnaire, including a question regarding time-screening for trial, on or before **August**
25 **17, 2018**.

26 24. Counsel must file their Memoranda of Contentions of Fact and Law in
27 compliance with Civil Local Rule 16.1(f)(2) on or before **September 14, 2018**.

28 25. Counsel must comply with the pretrial disclosure requirements of Federal

1 Rule of Civil Procedure 26(a)(3) on or before **September 14, 2018**. Failure to comply with
2 these disclosure requirements could result in evidence preclusion or other sanctions under
3 Federal Rule of Civil Procedure 37.

4 26. Counsel must meet together and take the action required by Civil Local Rule
5 16.1(f)(4) on or before **September 21, 2018**. At this meeting, counsel must discuss and
6 attempt to enter into stipulations and agreements resulting in simplification of the triable
7 issues. Counsel must exchange copies and/or display all exhibits other than those to be
8 used for impeachment. The exhibits must be prepared in accordance with Civil Local Rule
9 16.1(f)(4)(c). Counsel will note any objections they have to any other party's Pretrial
10 Disclosures under Federal Rule of Civil Procedure 26(a)(3). Counsel will cooperate in the
11 preparation of the proposed pretrial conference order.

12 27. Counsel for Plaintiffs will be responsible for preparing the proposed pretrial
13 order in accordance with Civil Local Rule 16.1(f)(6)(a). On or before **September 28, 2018**,
14 Plaintiffs' counsel must provide opposing counsel with the proposed pretrial order for
15 review and approval. Opposing counsel must communicate promptly with Plaintiffs'
16 attorney concerning any objections to form or content of the pretrial order, and both parties
17 must attempt promptly to resolve their differences, if any, concerning the order.

18 28. The Proposed Final Pretrial Conference Order, including objections to any
19 other party's Federal Rule of Civil Procedure 26(a)(3) Pretrial Disclosures, must be served
20 and e-mailed to the District Judge's e-file inbox on or before **October 5, 2018**, in
21 accordance with Civil Local Rule 16.1(f)(6).

22 29. The final pretrial conference and hearing on motions in limine will be held
23 before the Honorable Marilyn L. Huff on **Friday, October 12, 2018, at 10:30 a.m.** All
24 motions in limine must be filed on or before **September 14, 2018**. Absent further order of
25 the Court, each side may file no more than five motions in limine.

26 30. If a party wishes to use deposition testimony in lieu of a live witness, if
27 authorized under the rules, the party must submit the designations to opposing counsel by
28 **September 21, 2018**. The parties must exchange counter-designations by **September 28,**

1 **2018.** If deposition testimony is used at trial in lieu of a live witness, the Court will
2 determine the allocation of time against each party, but the time is assessed against the time
3 limits authorized for trial.

4 31. The parties must submit proposed verdict forms by **October 15, 2018.**

5 32. The parties must submit proposed questions for the jury on or before **October**
6 **15, 2018.** The jury will consist of eight (8) jurors. Each party will have three challenges.
7 The Court uses the Arizona blind strike method.

8 33. The Court orders the parties to file proposed jury instructions on or before
9 **October 15, 2018.** Copies of the jury instructions are to be filed with the Court's Case
10 Management/Electronic Case Filing ("CM/ECF") system. **Additionally,** the Court orders
11 the parties to send to chambers via the Court's e-file e-mail address a clean copy of the
12 requested jury instructions with "Court's Instruction No. ____" behind each annotated
13 instruction. The clean instructions must be sent to chambers by **October 15, 2018.** The
14 clean instructions must be on pleading paper in Times New Roman, 14-point font, must be
15 double-spaced, and must not have any header, footer, or page numbers. Further, the clean
16 instructions must be fully completed and in a format that could be read to the jury if adopted
17 by the Court. The parties must remove any brackets, fill in blanks, and make the necessary
18 selections where applicable to any model instructions.

19 37. The Court schedules a status conference for **Monday, October 15, 2018, at**
20 **10:30 a.m.** Lead trial counsel must appear in person absent further order of the Court.

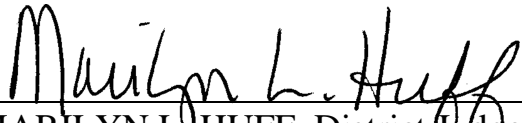
21 38. The Court orders the parties to provide separate exhibit lists to the Courtroom
22 Deputy at the status conference on **October 15, 2018.** The exhibits must be premarked
23 with Plaintiffs using numbers and Defendants using letters in accordance with the Civil
24 Local Rules. Exhibit stickers are available in the Clerk's office. If a party wishes to use
25 electronic or demonstrative equipment during trial, the Court directs the party to contact
26 the Courtroom Deputy to schedule an appropriate time to setup the equipment before the
27 trial begins and submit a proposed order by **October 12, 2018,** to allow the equipment to
28 proceed through security.

1 39. The Court schedules trial for **Tuesday, October 16, 2018, at 9:00 a.m.**

2 40. The Court will not modify the dates and times set forth in this order except
3 for good cause shown.

4 **IT IS SO ORDERED.**

5 DATED: November 30, 2017

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7 MARILYN L. HUFF, District Judge
8 UNITED STATES DISTRICT COURT
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