

**UNITED STATES DISTRICT COURT
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, as determined by the Clerk.¹ See 28 U.S.C. § 2071(b).

SECTION I: CIVIL RULES

LOCAL RULE CV-7 Pleadings Allowed; Form of Motions and Other Documents

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- (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 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 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;

¹ New language appears in underlined text, and deleted language appears in strikeout text.

- (5) for new trial;
- (6) issuance of letters rogatory;
- (7) objections to report and recommendations of magistrate judges or special masters;
- (8) for reconsideration;
- (9) for sanctions under Fed. R. Civ. P. 11, provided the requirements of Fed. R. Civ. P. 11(c)(2) have been met;
- (10) for writs of garnishment; and
- (11) any enforcement remedy provided for by the Federal Debt Collection Procedure Act, 28 U.S.C. § 3101, *et seq.*; ~~and~~
- ~~(12) any motion that is joined by, agreed to, or unopposed by, all the parties.~~

COMMENT: CV-7(i)(12) is deleted to remove joint, agreed, or unopposed motions from the list of motions that do not require a certificate of conference. That exemption was added to the rules when the CM/ECF system first allowed the selection of motion titles as joint, agreed, or unopposed. However, use of those titles has proven inconsistent and parties’ positions are often more nuanced than can be accurately captured by the titles, resulting in motions sometimes being misidentified or misrouted by the court. Accordingly, all joint, agreed, or unopposed motions should again include a certificate of conference reflecting the motions status so that it can be properly handled.

SECTION II: CRIMINAL RULES

LOCAL RULE CR-47 Motions

- (a) **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 cause number 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.

(1) **Page Limits.**

(A) **Dispositive Motions.** Dispositive motions shall not exceed thirty pages, excluding attachments, unless leave of court is first obtained. Likewise, responses to such motions shall not exceed thirty pages, excluding attachments, unless leave of court is first obtained. Any reply brief shall not exceed ten pages, excluding attachments.

(B) **Non-dispositive Motions.** Non-dispositive motions shall not exceed fifteen pages, excluding attachments, unless leave of court is first obtained. Likewise, responses to such motions shall not exceed fifteen pages, excluding attachments, unless leave of court is first obtained. Any reply brief shall not exceed five pages, excluding attachments.

(2) **Briefing Supporting Motions and Responses.** The motion and any briefing shall be contained in one document. The briefing shall contain a concise statement of the reasons in support of the motion and citation of authorities upon which the movant relies. Likewise, the response and any briefing shall be contained in one document. Such briefing shall contain a concise statement of the reasons in opposition to the motion and a citation of authorities upon which the party relies.

(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. Motions for continuance should also state whether the motion is opposed by any co-defendant or certify counsel’s inability to obtain the position of a particular co-defendant despite a good faith attempt to do so. 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 for judgment of acquittal;

(C) motions to suppress;

(D) motions for new trial;

~~(E) any motion that is joined by, agreed to, or unopposed by all the parties;~~

~~(F)~~(E) any motion permitted to be filed *ex parte*;

~~(G)~~(F) objections to report and recommendations of magistrate judges;

~~(H)~~(G) motions for reconsideration;

~~(I)~~(H) dispositive motions; and

(J) any motion related to enforcement of a debt, including relief under the Federal Debt Collection Procedures Act, 28 U.S.C. § 3101, *et seq.* and the All Writs Act, 28 U.S.C. § 1651.

COMMENT: CR-47(a)(3) is amended to require counsel to include the position of any co-defendant in the certificate conference for any motion for continuance. If counsel is unable, despite a good faith attempt, to obtain the position of a particular co-defendant, counsel must certify those facts. Currently, the effort to determine the position of any co-defendant with regard to a motion for continuance often falls to the court. This change shifts that effort to the movant seeking the continuance.

CR-47(a)(3)(E) is deleted to remove joint, agreed, or unopposed motions from the list of motions that do not require a certificate of conference. That exemption was added to the rules when the CM/ECF system first allowed the selection of motion titles as joint, agreed, or unopposed. However, use of those titles has proven inconsistent and parties' positions are often more nuanced than can be accurately captured by the titles, resulting in motions sometimes being misidentified or misrouted by the court. Accordingly, all joint, agreed, or unopposed motions should again include a certificate of conference reflecting the motions status so that it can be properly handled. The remaining exemptions have been renumbered to account for the deletion.

SECTION III: ATTORNEYS

LOCAL RULE AT-1 Admission to Practice

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- (e) **Federal Government Attorneys.** No bar admission fees shall be charged to attorneys who work for the United States government, including Assistant United States Attorneys, Assistant Federal Public Defenders, ~~and~~ CJA Panel attorneys, and current law clerks serving this court. ~~Bar admission fees cannot be waived for federal law clerks, however, as they do not appear in court on behalf of the United States but instead perform job duties that do not require admission to practice in the court.~~ The clerk's office has no authority to waive bar admission fees for attorneys who work for state, county, or city governments.

COMMENT: Current law clerks serving this court are added to the list of attorneys for which no bar admission fees shall be charged.

SECTION V: PATENT RULES

LOCAL PATENT RULE 3-1 Disclosure of Asserted Claims and Infringement Contentions

Not later than 10 days before the Initial Case Management Conference with the Court, a party claiming patent infringement must serve on all parties a “Disclosure of Asserted Claims and Infringement Contentions.” Separately for each opposing party, the “Disclosure of Asserted Claims and 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_(a)(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.

COMMENT: This section reference is updated to reflect the practice of EDTX judges, and has the additional benefit of being more precise.

LOCAL PATENT RULE 3-3 Invalidity Contentions

Not later than ~~435~~ days after ~~the Initial Case Management Conference with the Court~~~~service upon it of the “Disclosure of Asserted Claims and Infringement Contentions,”~~ each party opposing a claim of patent infringement, shall serve on all parties its “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 ~~sales or public disclosures~~ under ~~pre-AIA~~ 35 U.S.C. § 102(b) / ~~post-AIA~~ 35 U.S.C. § 102(a)(1) shall be identified by specifying the item offered for sale or publicly used or ~~the information~~ 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 ~~pre-AIA~~ 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 ~~pre-AIA~~ 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). ~~Prior art references under post-AIA 35 U.S.C. § 102(a)(1) showing that the claimed invention was otherwise available to the public shall be identified by specifying the form and nature of the reference, the manner in which the reference was made public, and the date on which the reference was made public;~~

(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.

COMMENT: The preamble of P.R. 3-3 is amended to ensure a defendant an opportunity to prepare invalidity contentions at a point, at minimum, after the Rule 16 conference while maintaining the historical 45 day timeframe for doing so. P.R. 3-1 envisions the service of infringement contentions shortly before the Rule 16 conference with the court. Recently, some plaintiffs have tried to accelerate a defendant’s invalidity contention deadline by serving

infringement contentions with the complaint, thus practically resulting in a defendant having far fewer than 45 days to meaningfully prepare invalidity contentions because of the inherent delays in investigating a new complaint and retaining counsel and/or technical expertise necessary to conduct an invalidity analysis. To prevent such tactics, this amendment provides the defendant an opportunity to perform its invalidity contention preparations during a period after the Rule 16 conference, more in line with the spirit of the Patent Rules and historical practice in the district. This anchoring of the contention deadlines to the Rule 16 conference also allows both parties an opportunity to raise any case specific scheduling issues as part of the Rule 16 conference process. As with all portions of the Patent Rules, this timing is subject to any order of the court setting different times, consistent with P.R. 1-2.

P.R. 3-3(a) is updated to reflect changes resulting from the AIA. Current section 102(b) has been changed from prior 102(b). The original 102(b) discussed prior art sales. The current 102(b) involves exceptions to prior art and does not list any class of prior art. Adding this language clarifies the rule. The word “sales or public uses” is added because current section 102(a)(1) is not specific to sales and instead includes all prior art. Section 102(f) read: “(f) he did not himself invent the subject matter sought to be patented”. It was substantively eliminated from the AIA as a form of prior art, so there is no post-AIA analogue. Section 102(g) relies on the “first to invent” system and deals with an allegation that a competing inventor was the first to invent the patented subject matter. Since the AIA transitioned to “first to file”, this type of prior art does not exist post-AIA. Section 102(a)(1) added a new category of prior art—any information that was “otherwise available to the public.” MPEP calls this a “catch-all” designed to include any public information, rather than a specific class of information. “Even if a document or other disclosure is not a printed publication, or a transaction is not a sale, either may be prior art under the ‘otherwise available to the public’ provision of AIA 35 U.S.C. 102(a)(1).” MPEP2152.02(e). Because of its generalized nature, the rule includes broad language for the required disclosure.

The remaining changes to P.R. 3-3(c) & (d) are stylistic updates.

LOCAL PATENT RULE 3-6 Amending Contentions

(a) Leave not required. Each party’s “Infringement Contentions” and “Invalidity Contentions” shall be deemed to be that party’s final contentions, except as set forth below.

(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 “Amended Infringement Contentions” without leave of court that amend its “Infringement Contentions” with respect to the information required by ~~Patent~~ R. 3-1(c) and (d).

(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 “Amended Invalidation Contentions” without leave of court that amend its “Invalidation Contentions” with respect to the information required by P. R. 3-3 if:

(A) a party claiming patent infringement has served “Amended Invalidation Contentions” pursuant to P. R. 3-6(a)(1), or

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

(b) Leave required. Amendment or supplementation of any Invalidation Contentions or Invalidation 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.

COMMENT: P.R. 3-6 is amended to correct a typographical error in the rule and to add clarity the cross-reference in P.R. 3-6(a)(2)(A) to amended contentions served pursuant to P.R. 3-6(a)(1).

So ORDERED and SIGNED this 9th day of November, 2020.



RODNEY GILSTRAP
Chief Judge