

GENERAL ORDER 06-6

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

GENERAL ORDER AMENDING PATENT RULE 3-6

It is hereby ORDERED that the following amendment to Appendix M to the local rules, the “Rules of Practice for Patent Cases,” having been approved by the judges of this court, is adopted for immediate implementation:¹

3-6. Final Contentions.

Each party’s “Preliminary Infringement Contentions” and “Preliminary Invalidity Contentions” shall be deemed to be that party’s final contentions, except as set forth below.

(a) If a party claiming patent infringement believes in good faith that ~~(1)~~ the Court’s Claim Construction Ruling or (2) the documents produced pursuant to P. R. 3-4 so requires, not later than 30 days after service by the Court of its Claim Construction Ruling, that party may serve “Final Infringement Contentions” without leave of court that amend its “Preliminary Infringement Contentions” with respect to the information required by Patent R. 3-1(c) and (d).

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

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

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

¹New language appears in underlined text; deleted language appears in ~~strickout~~ text.

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Comment: Deletion of the language removes a potential ambiguity from the rule. The former rule language could be read as allowing a party to amend its infringement contentions based on disclosures it received months before so long as the amendment is made within 30 days of receiving the court's *Markman* opinion. Although it makes sense to allow a party to amend its infringement contentions without leave of court based on the *Markman* opinion, a party should not be allowed to wait until after the *Markman* opinion to amend when the amendment is based on disclosures received months before.

The amended rule still allows a party to amend its preliminary infringement contentions within 30 days of the *Markman* without leave of court. Parties also would still be able to amend based on new discovery, but they would need to seek leave (and show good cause) to do so.

Signed this 27 day of February, 2006.

FOR THE COURT:


THAD HEARTFIELD
Chief Judge