UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

| In the Matter of<br><br>CERTAIN RELOAD CARTRIDGES FOR LAPAROSCOPIC SURGICAL STAPLERS | Inv. No. 337-TA-1167 |
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**ORDER NO. 2: NOTICE OF GROUND RULES; ORDER SETTING DATE FOR SUBMISSION OF JOINT DISCOVERY STATEMENT**

(July 8, 2019)

**GROUND RULES**

The conduct of this Investigation shall be governed by the Commission Rules and the Ground Rules attached hereto.

**DISCOVERY STATEMENTS**

In order that the proceeding in this matter may begin expeditiously, the parties are directed to file a joint discovery statement on or before July 19, 2019 addressing the questions and issues set forth in Attachment A.

**TARGET DATE**

The parties are advised that an order will issue setting the target date after the undersigned has considered the positions of the parties as set forth in their respective discovery statements.

**SO ORDERED.**

Charles E. Bullock
Chief Administrative Law Judge

# GROUND RULES FOR SECTION 337 INVESTIGATIONS

These Ground Rules supplement the Commission's Rules of Practice and Procedure, 19 C.F.R. Parts 201 and 210 ("Commission Rules"), in order to aid the Chief Administrative Law Judge in the orderly conduct of the section 337 investigation pursuant to the Administrative Procedure Act, 5 U.S.C. § 556(c).

These Ground Rules govern a U.S. patent-based investigation pursuant to 19 U.S.C. § 1337(a)(1)(B). In the case of an investigation based upon a registered copyright, registered trademark, or a trade secret pursuant to 19 U.S.C. § 1337(a)(1)(B), (C) or (D), additional Ground Rules may govern. In addition, in a case involving a motion for temporary relief pursuant to 19 U.S.C. § 1337(e), additional Ground Rules may also govern.

In case of any conflict between these Ground Rules and any subsequent order issued by the Chief Administrative Law Judge or the Commission in this Investigation, the subsequent order shall control.

## TABLE OF CONTENTS

# JUDGE BULLOCK'S GROUND RULES

## 1. Address; Requirements for Filing, Service, and Copies; Time

### 1.1 Address of the Chief Administrative Law Judge.

The Chief Administrative Law Judge's address is as follows:

The Honorable Charles E. Bullock
U.S. International Trade Commission
500 E Street, S.W., Room 317
Washington, D.C. 20436

### 1.2 Filing Requirement.

All submissions shall be filed with the Office of the Secretary of the Commission in accordance with Commission Rule 210.4(f), unless otherwise specifically provided for in these Ground Rules or by order of the Chief Administrative Law Judge.

### 1.3 Service Copy Requirements.

In accordance with the requirements of Commission Rules 210.4(f)(2) and (g), copies of each submission shall be served on all other parties, including the Commission Investigative Staff. On the same day that the submission is filed, an electronic copy in Word or PDF format shall be sent to the Chief Administrative Law Judge's attorney-advisor, Irina Kushner, at Irina.Kushner@usitc.gov, with a copy to Bullock337@usitc.gov.[1] If the filing is 25 pages or more (excluding attachments) or contains lengthy quotations from a patent, transcript, treatise, or other document, the electronic copy must be in Word format. Electronic copies of confidential documents must be encrypted and the password sent in a separate email.

The service of paper copies is no longer required, except that two copies of all *Markman* briefs, pre-hearing briefs, exhibit lists, and post-trial briefs shall be submitted to the Chief Administrative Law Judge at the address listed in Ground Rule 1.1 the next business day after the submission is filed. Copies of briefs should be printed on double-sided paper and have three holes punched on the left side. If the next business day is a Saturday, Sunday, Federal legal holiday, or a day on which weather or other conditions have made the Commission inaccessible, the two courtesy paper copies shall be submitted the next business day that is not one of the aforementioned days.

[1] Questions should not be submitted to the email address Bullock337@usitc.gov. Questions sent to this mailbox will not be answered.

### 1.4 Concurrent Service.

Service on opposing counsel may be by hand, by facsimile, by e-mail, or by overnight courier. Parties are encouraged to agree upon a method of service so that the parties will receive all submissions at the same time the submissions are received by the Commission.

### 1.5 Computation of Time.

The first day of the ten (10) calendar days for responding to a motion received by the Chief Administrative Law Judge shall be the first business day following the date that said motion was filed in the Office of the Secretary, and shall apply whether a motion is hand delivered, faxed or served by overnight courier on the other parties. In addition to the requirements of Commission Rules 201.14, 201.16(d), and 210.6 for computation of time, if the last day of the period of time for making a submission falls on a day on which weather or other conditions have made the Office of the Secretary of the Commission inaccessible, the period shall run until the end of the next business day which is not one of the aforementioned days.

### 1.6 Request for Extension of Time.

Any request for extension of time must be made by written motion **two days before** the due date and good cause for such extension must be established. Motions filed after this date may not be ruled on prior to the expiration of the deadline and may be denied for failure to abide by this rule.

### 1.7 Confidential Submissions.

The confidential nature of any filing with the Office of the Secretary of the Commission or of any submission to the Chief Administrative Law Judge shall be conspicuously noted on the top page of any filing or other submission. The parties should ensure that any confidential submission complies with Commission Rule 201.8.

## 2. Procedural Schedule

The Chief Administrative Law Judge will promulgate a procedural schedule for the investigation. Modifications of the procedural schedule by any party shall be made by written motion showing good cause. Deadlines marked with an asterisk only apply if it is determined that a *Markman* hearing shall be held. (*See* Rule 6.) The event and deadline dates in the procedural schedule will generally adhere to the following chronological order, although the parties may agree to modify this order when proposing dates in the Joint Proposed Procedural Schedule:

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| First settlement conference |
| Submission of first settlement conference joint report |
| File identification of expert witnesses, including their expertise and curriculum vitae |
| Exchange list of claim terms to be construed* |
| Exchange of proposed claim constructions* |
| Initial deadline for responses to contention interrogatories on issues for which the responding party bears the burden of proof |
| Exchange of initial expert reports on claim construction issues* |
| Exchange of rebuttal expert reports on claim construction issues* |
| Meet and confer to discuss and limit number of disputed claim terms* |
| Initial *Markman* briefs* |
| Rebuttal *Markman* briefs* |
| Submission of joint proposed claim construction chart* |
| Initial deadline for responses to contention interrogatories on issues for which the responding party does not bear the burden of proof |
| Joint Tutorial[2] and *Markman* hearing* |
| Attendance at one-day mediation session[3] |
| Submission of joint report on mediation |
| Submission of updated joint proposed claim construction chart* |
| Proposed issuance of claim construction order*[4] |
| File notice of prior art |
| Cut-off date for supplements to contention interrogatories on issues for which the responding party bears the burden of proof, and on public interest issues (if applicable) |
| Cut-off date for supplements to contention interrogatories on issues for which the responding party does not bear the burden of proof |
| Fact discovery cut-off and completion |
| Deadlines for motions to compel fact discovery |
| Exchange of initial expert reports (identify tests/surveys/data) |

[2] The tutorial shall be limited to a general overview of the technology and should not include any discussion of the asserted patents, the claim terms at issue, or the accused products. In addition, the tutorial should not exceed one hour and should consist of one presentation agreed upon by all parties.

[3] For any questions regarding the mediation program, the parties should refer to the Revised Users' Manual for Commission Mediation Program, available at http://www.usitc.gov.

[4] If the parties limit the number of terms to four or less, the undersigned will generally issue the *Markman* order approximately five weeks after the *Markman* hearing. If, however, the parties propose more than four terms for construction, the earliest the *Markman* order will issue is two months after the *Markman* hearing.

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| File tentative lists of witnesses a party will call to testify at the hearing, with an identification of each witness' relationship to the party |
| Exchange of rebuttal expert reports |
| Expert discovery cut-off and completion |
| Deadline for motions to compel expert discovery |
| Deadline for filing motions for summary determination |
| Second settlement conference |
| Submission of second settlement conference joint report |
| Exchange of exhibit lists among the parties |
| Submit and serve direct exhibits (including witness statements), with physical exhibits available - Complainant(s) and Respondent(s) |
| Submit and serve direct exhibits (including witness statements), with physical exhibits available - Staff |
| File objections to direct exhibits (including witness statements) |
| Submit and serve rebuttal exhibits (including witness statements), with rebuttal physical exhibits available – all parties |
| File responses to objections to direct exhibits (including witness statements) |
| File objections to rebuttal exhibits (including witness statements) |
| File responses to objections to rebuttal exhibits (including witness statements) |
| File pre-trial statements and briefs – Complainant(s) and Respondent(s) |
| File pre-trial statement and brief - Staff |
| File requests for receipt of evidence without a sponsoring witness |
| Deadline to file motions *in limine* |
| File high priority objections statement |
| File responses to requests for receipt of evidence without a sponsoring witness |
| File responses to motions *in limine* |
| File responses to high priority objections statement[5] |
| Pre-trial conference |
| Hearing |
| File initial post-trial briefs and final exhibit lists |
| File reply post-trial briefs |
| Initial Determination |
| Target date for completion of investigation |

[5] Responses to requests for receipt of evidence without a sponsoring witness, responses to motions *in limine*, and responses to high priority objection statements must be submitted no later than a week prior to the pre-trial conference.

## 3. Motions; Deadlines for Responses

### 3.1 Contents; In General.

All written motions shall consist of: (1) the motion; (2) a separate memorandum of points and authorities in support of the motion;[6] (3) an appendix of declarations, affidavits, exhibits, or other attachments in support of the memorandum of points and authorities; and (4) a Certificate of Service as required by Commission Rule 201.16(c).

All responses to motions shall include the Motion Docket Number assigned to the motion by the Commission's Office of the Secretary in either the title or the first paragraph of any such response,[7] and shall consist of: (1) a memorandum of points and authorities in response to the motion; (2) an appendix of declarations, affidavits, exhibits, or other attachments in support of the memorandum of points and authorities; and (3) a Certificate of Service as required by Commission Rule 201.16(c).

If a motion or related document (*e.g.*, response or reply) contains confidential business information as defined in 19 C.F.R. § 201.6(a), the private parties must file a nonconfidential copy of the motion and/or related document within five business days from the date of filing. For those cases where OUII is a party, OUII shall have ten business days to submit a nonconfidential version of the motion and/or related document. It is incumbent on the party filing the motion to verify with opposing (or third party) counsel what information is confidential. If an exhibit to a motion or related document is not capable of redaction, this must be clearly indicated on the exhibit cover sheet. In addition, for any document a party is claiming is not capable of redaction, a declaration shall be filed justifying why the entire document must remain confidential. When redacting confidential business information, a high level of care must be exercised in order to ensure that non-confidential business information is not redacted or indicated.

#### 3.1.1 Case Citations.

The official case reporter citation must be included for any published decision or order that is cited in a party's motion, brief, or pleading. Additionally, the docket number and the full date of the disposition must be included in the citation of any unreported decision or order that is referenced by the parties. A copy of any cited decision or order that is not available on Westlaw or LEXIS shall be provided in an appendix to the brief or pleading. Further, every party must cite to the specific page(s) of the cited decision or order that includes the holding for which the authority is cited.

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[6] For procedural motions, such as motions for extensions of time, and for motions less than ten pages, a separate memorandum is not necessary.

[7] Motion Docket Numbers may be obtained online through the Commission's Electronic Document Information System (EDIS).

### 3.2 Contents; Certification.

All motions shall include a certification that the moving party has made reasonable, good-faith efforts to resolve the matter with the other parties **at least two business days**[8] prior to filing the motion, and shall state, if known, the position of the other parties on such motion. Said certification shall be placed at the beginning of the motion under a heading entitled "Ground Rule 3.2 Certification" or similar language.

### 3.3 Contents; Motion for Summary Determination.

In addition to the foregoing requirements for all motions, motions for summary determination shall be further accompanied by a separate statement of the material facts as to which the moving party contends there is no genuine issue and which entitle the moving party to a summary determination as a matter of law. The statement shall consist of short numbered paragraphs with specific references to supporting declarations, affidavits or other materials. Motions for summary determination are limited to 50 pages (excluding exhibits).

### 3.4 Contents; Response to Motion for Summary Determination.

In addition to the foregoing requirements for all responses to motions, each party opposing a motion for summary determination shall append to the response a separate statement responding individually to the numbered paragraphs of the motion statement required by Ground Rule 3.3 with which the party disagrees, with specific references to supporting declarations, affidavits or other materials. The responsive statement shall also include any similarly numbered paragraphs of additional facts, similarly referenced and supported, which the opposing party believes warrant denial of summary determination. All material facts set forth in the moving party's statement may be deemed admitted by a non-moving party unless so specifically controverted in the nonmoving party's responsive statement. Responses to motions for summary determination are limited to 50 pages (excluding exhibits).

### 3.5 Contents; Discovery-Related Motions.

Any discovery-related motion must have appended to it the pertinent parts of the discovery request and all objections and answers thereto. Additionally, if a party serves supplemental responses subsequent to the filing of a motion to compel, that party file copies of the supplemental responses, or where documents are produced, a detailed accounting of what additional documents were produced. If any portion of a discovery-related motion becomes moot prior to the issuance of an order, the moving party shall file a Notice identifying which portion(s) of its motion are moot. If a party intends to withdraw its motion, it shall file a Notice of Withdrawal.

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[8] Parties can agree to waive the "two business days" requirement.

### 3.6 Deadline for Filing Response to Motion.

In addition to the requirements of Commission Rules 201.16 and 210.15(c) governing the time period for a nonmoving party's response to a written motion, the date of service of a motion on a nonmoving party by electronic mail, hand-delivery or by an express-type mail or courier service is the date of delivery. The additional time provided under Commission Rule 201.16(d) after service by mail does not apply in such instances, unless service by electronic mail, hand-delivery or by an express-type mail or courier service is to a nonmoving party in a foreign country, in which event the additional time allowed for responses to motions shall be five (5) days.

### 3.7 Request for Shortened Time to Respond to Motion.

A motion may include a request to shorten the period of time during which other parties may respond to the motion. The fact that a shortened response time is requested shall be noted in the title of the motion and the motion shall include an explanation of the grounds for such a request. A request for a shortened response time shall not be made through a separate motion. Requests for shortened response time are disfavored and should only be made for good cause.

### 3.8 No Motion Stops Discovery Except Motion to Quash Subpoena.

No motion stops discovery except a timely motion to quash a subpoena.

## 4. Discovery

### 4.1 Resolution of Disputes; Coordinated Discovery.

All parties shall make reasonable efforts to resolve among themselves disputes arising during discovery. Parties with similar interests must coordinate and consolidate depositions and all other discovery.

#### 4.1.1 Discovery Committee.

Commencing with the first full week after these Ground Rules are issued, a discovery conference committee (the "Discovery Committee") consisting of the lead counsel of each party and the Commission Investigative Staff shall convene at least once every two weeks during the discovery phase of this Investigation, either in person or by telephone, to resolve discovery disputes. The Discovery Committee shall confer in good faith to resolve every outstanding discovery dispute in a timely manner within the deadlines set forth in the Procedural Schedule. Within ten calendar days after the end of each calendar month during the discovery phase, the Discovery Committee shall report in writing to the Chief Administrative Law Judge all disputes that were resolved during the preceding month and all disputes on which there is an impasse as of

the end of that month. No motion to compel discovery may be filed unless the subject matter of the motion has first been brought to the Discovery Committee and the Committee has reached an impasse in resolving the matter.

### 4.2 Stipulations Regarding Discovery Procedure.

Unless otherwise directed by the Chief Administrative Law Judge, the parties may by written stipulation provide that depositions may be taken before any person, at any time or place, upon any notice, and in any manner and when so taken may be used like other depositions. The parties may also modify other procedures governing or limitations placed upon discovery, except that stipulations extending the time provided in Ground Rules 4.4.2, 4.4.3, 4.4.4, and 4.4.5 for responses to discovery may, if they would interfere with the target date of the investigation or with any time set in the procedural schedule or in an order for completion of discovery, for hearing of a motion, or for the trial, be made only with the approval of the Chief Administrative Law Judge upon a written motion showing good cause.

### 4.3 Service of Discovery Requests and Responses.

Discovery requests and responses thereto shall be served upon all parties, including the Commission Investigative Staff, but **shall not be served on the Chief Administrative Law Judge** unless they are pertinent to a motion. Discovery documents need not be served on the Office of the Secretary of the Commission, unless they are appended to motions.

### 4.4 Timing of Discovery Requests, Responses and Objections.

#### 4.4.1 Depositions; Notice.

In addition to the requirements of Commission Rule 210.28(c), unless otherwise ordered, any party desiring to take a deposition shall give notice in writing to every other party of not less than ten (10) days if the deposition is to be taken of a person located in the United States, or of not less than fifteen (15) business days if the deposition is to be taken of a person located outside the United States.

#### 4.4.2 Interrogatories; Deadline for Responses and Objections.

In addition to the requirements of Commission Rule 210.29(b), unless otherwise ordered, the party upon whom interrogatories have been served shall serve a copy of the answers, and any objections, within ten (10) days after the service of the interrogatories.

Any party may serve upon any other party written interrogatories not exceeding 175 in number including all discrete subparts. Leave to serve additional interrogatories shall be granted by the Chief Administrative Law Judge only upon a written motion showing good cause.

#### 4.4.3 Contention Interrogatories.

Parties are expected to respond to contentions interrogatories by the date set forth in the Procedural Schedule. A party may not introduce evidence at the hearing that is outside of the scope of its responses to contention interrogatories.

Conclusory statements in responses to contention interrogatories are insufficient. For example, if a party simply states: "There is also infringement under the doctrine of equivalents," the party is prohibited from later introducing evidence regarding the details of such infringement.

Amendment or supplementation of responses to contention interrogatories after the deadlines set forth in the Procedural Schedule may be made only with leave of the Court and shall be entered only upon a showing of good cause.

#### 4.4.4 Requests for Production of Documents or Things or for Entry Upon Land; Deadline for Responses and Objections.

In addition to the requirements of Commission Rule 210.30(b)(2) with respect to a request for the production of documents or things, or to permit entry upon land, unless otherwise ordered, the party upon whom a request has been served shall serve a written response within ten (10) days after the service of the request.

#### 4.4.5 Request for Admission; Period for Service; Deadline for Responses and Objections.

In addition to the requirements of Commission Rule 210.31(a) and (b), unless otherwise ordered, a request for admission may be served at any time twenty (20) days after the date of service of the Complaint and Notice of Investigation. Unless otherwise ordered, a party upon whom a request for admission has been served, shall serve an answer or objection within ten (10) days after the service of the request, otherwise the matter may be deemed admitted.

#### 4.4.6 Discovery Cutoff and Completion.

All discovery requests, including without limitation requests for admissions, must be initiated in sufficient time prior to the fact discovery cutoff and completion date so that the responses will be due prior to that date within the time periods set forth above. Discovery requests by any party that would require responses after the fact discovery cutoff and completion date must be approved in advance by the Chief Administrative Law Judge upon a showing of compelling circumstances.

## 4.5 Subpoenas.

### 4.5.1 Issuance and Service.

Pursuant to Commission Rule 210.32, application for subpoena may be made *ex parte* to the Chief Administrative Law Judge. The original application with the proposed subpoena attached and one copy thereof must be submitted to the office of the Chief Administrative Law Judges. Electronic copies of subpoenas will not be accepted. A cover letter must accompany the application and should clearly indicate who to contact when the subpoena application is ready. The application shall set forth with specificity the relevancy of the information sought and the reasonableness of the scope of the inquiry. In addition, the subpoena should set forth a time limit for a motion to quash and should also state that the subpoena will be served by overnight delivery, if not sooner. The signature page for the subpoena shall not be on a separate page and must include the case caption. Any dates in a subpoena set for appearance of a deponent or production of documents should not be prior to the deadline for filing of any motions to quash. Samples of subpoenas are attached in Appendix A hereto.

A copy of the issued subpoena and the application shall be served by the applicant upon the subpoenaed party and all other parties to the investigation on the next business day, at the latest, after the subpoena is issued. One (1) copy of the issued subpoena, the application, and the proof of service to the subpoenaed party shall be supplied to the Chief Administrative Law Judge. The application and subpoena need not be filed with or served on the Office of the Secretary of the Commission, including EDIS, unless they are appended to a motion to quash or motion for a protective order.

### 4.5.2 Motion to Quash Subpoena; Deadline.

In addition to the requirements of Commission Rule 210.32(d), any motion to limit or quash a subpoena shall be filed within ten (10) days after receipt thereof, or within such other time as the Chief Administrative Law Judge may allow. Filing of any motion to quash an issued subpoena automatically stays such subpoena pending disposition of the motion by the Chief Administrative Law Judge.

#### 4.5.3 Subpoenas *Ad Testificandum* for Hearings.

Applications for subpoenas *ad testificandum* to appear at the hearing must be submitted fourteen (14) days prior to the start of the hearing. Leave to subpoena a witness after this time will only be granted upon a written motion showing compelling circumstances.

### 4.6 Bates Numbering.

If documents produced by any supplier in response to a document request are furnished to the requester as copies of original documents, every page of every such document shall be numbered sequentially by a unique number (commonly known as a "Bates number"). The Bates number shall appear stamped on the lower right-hand corner of the page.

### 4.7 Translations.

All documents produced in response to a document request shall be the original or true complete copies of originals. If an English translation of any document produced exists, the English translation shall be produced. If any of the parties dispute the translation provided by the producing party, then the translation must be certified by a qualified and neutral translator upon whom counsel can agree.

### 4.8 Privileged Matter.

In order to expedite discovery, the following procedure shall be followed with respect to those documents for which counsel claims privilege (attorney-client or work product).

#### 4.8.1 Claiming Privilege.

If a party objects to discovery on the basis of a claim of privilege, the party asserting the privilege shall, in the objection to the interrogatory, document request, or part thereof, identify with specificity the nature of the privilege (including work product) that is being claimed.[9] The following information shall be provided in the objection, if known or reasonably available, unless divulging such information would cause disclosure of the allegedly privileged information: (A) For oral communications: (i) the name of the person making the communication and the name(s) of persons present while the communication was made; (ii) the date and place of the communication; and (iii) the subject matter of the communication; (B) For documents: (i) the sender(s)/author(s) of the document; (ii) the recipient(s) of the document; (iii) the date of the document; and (iv) the subject matter of the document. The individuals involved in any discovery withheld on the basis of privilege shall be identified by position and entity (corporation, firm, etc.) with which they are employed or associated. If the author/sender or recipient is an attorney or foreign patent agent, he or she shall be so identified.

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[9] If a party asserts that the common interest privilege applies, the party should so note and also identify the underlying privilege (*i.e.*, attorney-client privilege or work product) that protects the discovery from disclosure.

The above information should be provided separately for each document for which privilege/protection is asserted, unless doing so would be excessively burdensome or expensive. In such instances, the party asserting privilege/protection should particularize why providing separate designations would be excessively burdensome or expensive, and then may identify by categories the voluminous documents or communications for which privilege/protection is asserted, providing the above information for each category. A party may only designate documents as privileged/protected by category if each document (A) is within the privilege/protection claimed and (B) shares common characteristics such as sender, receiver, author, or specific subject matter.

Where only part of a document or communication is privileged/protected, the unprivileged/unprotected portion should be disclosed if otherwise discoverable and within the scope of the discovery request. Emails and attachments shall be treated as separate documents. Additionally, the parties are encouraged to confer and reach agreement regarding how to assert privilege/protection claims with respect to email "chains" or "strings."

#### 4.8.2 Motions to Compel Production of Privileged Matter.

Any party seeking production of allegedly privileged documents shall file an appropriate motion only after examining the privileged document list. In opposing any such motion, a party must demonstrate that each element of the applicable privilege(s) has been met. This may be done through the submission of affidavits or other appropriate evidence. Blanket assertions of privilege are insufficient. Failure to submit evidence to support privilege claims may result in waiver of the privilege.

#### 4.8.3 Timing of Privilege Claims.

The privileged document list shall be supplied, unless otherwise ordered or agreed upon by the parties, within ten (10) days after objections based on privilege to the underlying discovery request are due.

## 5. Notice of Prior Art

Parties must file on or before the date set in the procedural schedule, notices of any prior art consisting of the following information: country, number, date, and name of the patentee of any patent; the title, date and page numbers of any publication to be relied upon as anticipation of the patent in suit; or as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit.

If a trademark is involved, the parties must file on or before the date set in the procedural schedule, notices of any art on which a party will rely at the hearing regarding the functionality or non-functionality of any trademarks at issue.

In the absence of such notice, proof of said matters may not be introduced into evidence at the hearing except upon a timely written motion showing good cause.

## 6. *Markman* Hearing on Claim Construction

If the Chief Administrative Law Judge determines that a *Markman* hearing would be beneficial to the Investigation, the Chief Administrative Law Judge may conduct a *Markman* hearing on the date set forth in the procedural schedule for the purpose of construing any disputed claim terms of the patents at issue in the Investigation. To the extent a party alleges a term is indefinite under *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014), the party should make this argument during the *Markman* phase of Investigation. The parties and the Commission Investigative Staff shall meet and confer on these issues no later than ten (10) days before the *Markman* hearing in order to reduce the number of disputed claim terms to a minimum.

Before the *Markman* hearing, Complainant(s), Respondent(s) (if there is more than one Respondent, they are required to file a joint brief), and the Commission Investigative Staff shall file with the Chief Administrative Law Judge, by the date set forth in the procedural schedule, a short written statement of its interpretation of each of the remaining disputed claim terms together with its support for each interpretation as a matter of ordinary meaning, or as derived from the claims, specification, or prosecution history of the patent(s) at issue, or from extrinsic evidence.[10] If there are multiple patents at issue, the brief should be organized by patent, similar to the outline for pre-trial briefs (*see* Appendix B). Briefs are limited to 50 pages. Rebuttal briefs may also be filed by the date set forth in the procedural schedule and are limited to 25 pages. After the *Markman* hearing, the parties shall submit a joint chart, by the date set forth in the procedural schedule, setting forth their post-hearing constructions. Afterwards, the Chief Administrative Law Judge will issue an order construing the disputed claims for the purposes of the Investigation. Thereafter, discovery and briefing in the Investigation shall be limited to that claim construction.

### 6.1 *Markman* Presentation.

Parties should present all of the arguments for each term in sequence, except that similar terms may be grouped together, if agreed upon by the parties. Each side receives an opportunity for an initial presentation and a rebuttal.

## 7. Expert Witnesses and Reports

On or before the dates set forth in the procedural schedule, a party shall disclose to other parties the identity of any person who is retained or employed to provide expert testimony at the hearing and shall provide to the other parties a written report prepared and signed by the witness. The report shall not be filed with the Office of the Secretary of the Commission. The report shall

[10] *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-81 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996).

contain a complete statement of all opinions to be expressed and the basis and reasons therefor; the data or other information considered by the witness in forming the opinions; any exhibits to be used as a summary of or support for the opinions; the qualifications of the witness, including a list of all publications authored by the witness within the preceding ten years; the compensation to be paid for the study and testimony; and a listing of any other cases in which the witness has testified as an expert at trial or by deposition within the preceding four years. The parties shall supplement these disclosures as needed in the manner provided in Commission Rule 210.27(c).

An expert may not rely on general or conclusory statements in his/her expert report if he/she would like to provide substantive testimony about the subject at the hearing. An expert will not, for example, be permitted to testify regarding an obviousness combination if the expert did not include the exact obvious combination in his/her expert report. Additionally, conclusory statements in the expert report are insufficient. For example, if an expert simply states: "There is also infringement under the doctrine of equivalents," the expert is prohibited from later testifying regarding the details of such infringement.

## 8. Settlement/Mediation

All parties, throughout the duration of the proceedings, shall explore reasonable possibilities for settlement of all or any of the contested issues. All parties shall certify in their pre-trial statements that good faith efforts were undertaken to settle the remaining issues. Additionally, for each of the required settlement conferences and the one-day mediation provided for in the procedural schedule, the parties shall provide the Chief Administrative Law Judge with two copies of a joint report signed by all the parties setting forth any stipulations on which the parties have agreed. These reports are due by the time designated in the procedural schedule or within such other time as the Chief Administrative Law Judge may allow. The reports shall not be filed with the Office of the Secretary of the Commission.

## 9. Pre-trial Submissions

### 9.1 Pre-trial Statement.

Each party who desires to participate in the hearing in this Investigation must file on or before the date set forth in the procedural schedule a pre-trial statement containing the following information:

(a) The names of all known witnesses, their addresses, whether they are fact or expert witnesses (and their area of expertise), and a brief outline of the testimony of each witness. In the case of expert witnesses, a copy of the expert's curriculum vitae shall accompany this submission.

(b) A list of all exhibits which the parties will seek to introduce at the hearing.

(c) A list of any stipulations on which the parties have agreed.

(d) A proposed agenda for the pre-trial conference.

(e) Estimated date and approximate length for appearance of each witness. The parties shall confer on estimated dates and approximate length prior to submission of their pre-trial statements.

(f) Certification regarding good faith efforts to settle.

### 9.2 Pre-trial Brief.

On or before the date set forth in the procedural schedule, each party shall file a pre-trial brief. To the extent there is more than one complainant and/or respondent in an investigation, complainants and/or respondents shall coordinate their efforts and submit a single brief. Exceptions to this rule will be made on a case-by-case basis.

The pre-trial brief shall be prefaced with a table of contents and a table of authorities. The pre-trial brief shall set forth a party's contentions on each of the proposed issues, including citations to legal authorities in support thereof, and shall conform to the general outline set forth in Appendix B hereto. With respect to the issues of infringement, validity, and the technical prong of domestic industry, the parties should present their briefing on a limitation-by-limitation basis. The parties shall meet and confer prior to filing the pre-trial briefs in order to agree on an outline, so that each of the submitted briefs addresses the issues in the same order. If any party has issues that are not specifically named in this general outline, the parties may insert these issues where appropriate.

Any contentions not set forth in detail as required herein shall be deemed abandoned or withdrawn, except for contentions of which a party is not aware and could not be aware in the exercise of reasonable diligence at the time of filing the pre-trial brief.

### 9.3 High Priority Objections for Pre-hearing conference.

The objections placed on the high priority list may be taken from the party's objections to direct, rebuttal and/or supplemental exhibits. No party shall place more than ten objections on the high priority list. The parties should not attempt to circumvent this limitation by including numerous subsections in their objections.

High priority objections and responses thereto shall include the exhibit(s) that is the subject of the objection and/or exhibit(s) that is referenced or discussed in the objection or response. Any high priority objection that does not include said exhibit(s) will not be considered.

### 9.4 Motions *in Limine*.

Unless otherwise permitted by the Chief Administrative Law Judge, each side shall be limited to a maximum of ten motions *in limine*. The parties should not attempt to circumvent this

limitation by including numerous subsections in a motion *in limine*. Additionally, any motion regarding an expert must be its own motion and cannot be combined with arguments relating to other exhibits or witnesses. The parties are limited to ten pages per motion. A separate memorandum is unnecessary for motions *in limine*.

Motions *in limine* and responses thereto shall include the exhibit(s) that is the subject of the motion and/or exhibit(s) that is referenced or discussed in the response. Any motion *in limine* that does not include said exhibit(s) will not be considered.

### 9.5 Exhibits.

#### 9.5.1 Exhibit Lists.

Every exhibit list shall consist of a table enumerating all exhibits and identifying each exhibit by a descriptive title, a brief statement of the purpose for which the exhibit is being offered in evidence, the name of the sponsoring witness, and the status of receipt of the exhibit into evidence. In any exhibit list submitted prior to the offer of any exhibit into evidence, the entry in the column for the status of receipt shall be left blank. In any exhibit list submitted after the exhibit is offered into evidence or withdrawn, the entry in that column shall show the date of admission into evidence or rejection of the exhibit or shall indicate its withdrawal. Exhibit lists shall list all exhibits together in numerical order, *e.g.*, CX-0001, CX-0002, CX-0003C, CX-0004, CX-0005C, etc. The exhibit list must be formatted in a way that it is legible when viewed in hard copy.

The parties shall meet and confer before submitting any joint exhibits to agree upon a common descriptive title, statement of purpose, and sponsoring witnesses.

#### 9.5.2 Numbering and Labeling of Exhibits.

Written exhibits shall be marked serially commencing with the four digit number "0001" and preceded by the prefix "CX-" for Complainant's exhibits, "RX-" for Respondent(s)' exhibits, "SX-" for the Commission Investigative Staff's exhibits, and "JX-" for any joint exhibits. The parties shall not reserve numbers, but instead shall assign all numbers in consecutive sequence.

Each exhibit shall be marked by placing a label bearing the exhibit's number (*e.g.*, CX-0003C or RX-0005) in the upper right portion of the exhibit's first page. The pages of each exhibit must be sequentially numbered in a consistent location on the pages.

If there is more than one respondent in the Investigation, Respondents shall coordinate their numbering to avoid duplication in numbering. Additionally, the parties shall coordinate exhibits to avoid unnecessary duplication (*e.g.*, patents; file wrappers). Further, all exhibits or copies of exhibits shall be clear and legible.

#### 9.5.2.1 Confidential Exhibits.

If an exhibit (or any portion of the exhibit) contains confidential business information, a "C" shall be placed after the exhibit number. For certain lengthy exhibits of which only portions are confidential, the parties may be asked to submit a public version of the exhibit.

On any exhibit list submitted, exhibits which contain confidential business information shall be denoted by placing a "C" after the exhibit number in the listing. No exhibit list shall contain confidential information; all exhibits lists shall be public documents.

#### 9.5.2.2 Physical Exhibits.

Physical exhibits shall be numbered in a separate series commencing the four-digit number "0001" preceded by the prefixes "CPX-", "RPX-", "SPX-" and "JPX-", for Complainant, Respondent, the Commission Investigative Staff, and joint exhibits, respectively. Confidential exhibits shall be denoted with the letter "C" as in the case of documentary exhibits.

#### 9.5.2.3 Demonstrative Exhibits.

Demonstrative exhibits shall be numbered in a separate series commencing with the four-digit number "0001" preceded by the prefixes "CDX-", "RDX-", and "SDX-", for Complainant, Respondent(s), and the Commission Investigative Staff, respectively. Confidential demonstrative exhibits shall be denoted with the letter "C". Demonstrative exhibits are not substantive evidence and must be based on evidence admitted elsewhere during the hearing.

#### 9.4.2.4 One Document Per Exhibit; All Pages Bates-numbered.

Except for good cause shown, each exhibit shall consist of no more than one document. Exceptions to this "one document per exhibit" rule include instances when it would be appropriate to group certain documents together as one exhibit, such as a group of invoices or related e-mails.

### 9.5.3 Inclusion on Exhibit List.

#### 9.5.3.1 Not Substantive Evidence.

The following are not admissible as substantive evidence: (1) claim charts; (2) expert reports; (3) declarations; and (4) a party's own discovery responses. Such documents may be used as demonstratives or for impeachment. To avoid disputes over the inclusion of such documents on the exhibit list, the party including any such document must note on the exhibit list (under "a brief statement of the purpose for which the exhibit is being offered in evidence") that it is not seeking to admit the exhibit as substantive evidence.

#### 9.5.3.2 Exhibits Used for Impeachment.

Exhibits used solely for impeachment must be included on the exhibit list.

#### 9.5.3.3 Documents Not Included on Exhibit List.

A party may not introduce a document at the hearing that was not included on the exhibit list exchanged on the date provided for in the Procedural Schedule, even if the exhibit is for impeachment purposes only.

#### 9.5.3.4 Documents Received After Close of Discovery.

Absent agreement from the parties or good cause, any document received after the close of fact discovery will not be admissible at the evidentiary hearing.

### 9.5.4 Sponsoring Witness.

Each exhibit that is offered into evidence shall have a "sponsoring witness." One of the purposes of having a sponsoring witness associated with an exhibit is to establish a foundation for the exhibit and to prevent exhibits from coming into the record without context. A witness must testify substantively regarding an exhibit to satisfy this rule. Merely identifying the exhibit or stating that he/she reviewed the exhibit to form his/her opinion is not sufficient

Sponsoring witness testimony may be in the form of deposition testimony, rather than live testimony, if all the parties are in agreement.

Except in an investigation in which there is no participating Respondent, if a party believes evidence to be non-controversial and to be appropriate for receipt in evidence without a sponsoring witness, that party may present with each such exhibit on or before the due date set forth in the procedural schedule: (1) an affidavit or declaration that the declarant prepared or someone under the declarant's direction prepared the exhibit; (2) a request that the exhibit be received in evidence without a witness at the hearing; and (3) a statement of grounds for receiving the exhibit in evidence without a witness at the hearing. Any party who wishes to cross-examine the declarant may object in writing within three (3) days of service of the affidavit or declaration and request, specifying whom the party intends to examine. In the absence of objections, and upon good cause shown, the exhibit shall be received in evidence without a witness subject to the right of objection on other grounds.

### 9.5.5 Foreign Language Exhibits.

No foreign language exhibits will be received into evidence unless a translation thereof is provided at the time set for the exchange of exhibits. The translation shall be included as part of the foreign language exhibit.

#### 9.5.6 Authenticity.

All documents that appear to be regular on their face shall be deemed authentic, unless it is shown by particularized evidence that the document is a forgery or is not what it purports to be.

#### 9.5.7 Exchange of Proposed Exhibits Among Parties.

Copies of documentary proposed exhibits, along with a proposed exhibit list shall be served on the opposing parties (including the Commission Investigative Staff) on the date ordered in the procedural schedule. Once the parties have exchanged their proposed exhibit lists, they shall eliminate any duplicative exhibits or renumber such exhibits as joint exhibits and update their exhibit lists before they are submitted to the Chief Administrative Law Judge by the due date in the procedural schedule. Proposed physical exhibits need not be served, but shall be identified in the proposed exhibit list and made available for inspection by the other parties on the date established for the submission and service of proposed exhibits. Proposed exhibits shall not be filed with the Office of the Secretary of the Commission.

##### 9.5.7.1 Exchange of Demonstrative Exhibits.

Demonstrative exhibits must be exchanged by 9:00 p.m. the evening before the day on which the demonstrative exhibit will be used. Demonstrative exhibits may, however, be created by a witness during examination through, for example, asking the witness to draw a picture or annotate an exhibit. Such exhibits need not be exchanged in advance.

#### 9.5.8 Service of Proposed Exhibits Upon the Chief Administrative Law Judge.

On the date that is set forth in the procedural schedule, the Chief Administrative Law Judge shall receive an electronic PDF version of all proposed exhibits, along with a proposed exhibit list. The electronic version of proposed exhibits may be submitted on an external hard drive or a flash drive.

## 10. Hearing - Evidence and Exhibits

### 10.1 Material To Be Received Into Evidence.

Only factual material and expert opinion shall be received into evidence. Legal argument shall be presented in the briefs.

#### 10.1.1 Admission of Exhibits Into Evidence.

With the exception of witness statements, exhibits will be admitted into evidence after the witness is done testifying. The parties should meet and confer and attempt to resolve any objections to the exhibits. Once the parties have reached an agreement, the party requesting that the exhibits

be admitted into evidence should present a list to the Chief Administrative Law Judge, with a copy to the court reporter. The exhibits will be read into the record and it will be confirmed that neither the opposing party nor the Commission Investigative Staff has any objections. After that, the Chief Administrative Law Judge will admit the exhibits into evidence.

If parties need to submit additional exhibits after the hearing has concluded, they should do so via motion.

### 10.2 Legal Experts.

Legal experts may only testify as to procedures of the U.S. Patent and Trademark Office.

### 10.3 Witness Testimony.

All direct witness testimony, with the exception of adverse witnesses, shall be made by witness statements in lieu of live testimony. The Commission Investigative Staff may, however, ask the witness supplemental direct testimony on the witness stand. Witness statements shall be marked and offered into evidence as exhibits, and witnesses shall be available for cross-examination on the witness stand unless waived. Witnesses will not read their prepared testimony into the record.

#### 10.3.1 Format of Witness Statements.

A witness statement shall be in the form of numbered questions from counsel, with each question followed by the witness' own answer to that question, and with the final question from counsel asking the witness whether or not the witness statement contains the witness's answers to the questions from counsel, followed by the witness' answer to this question and the witness' signature. The witness statement shall be assigned an exhibit number and each question shall be numbered consecutively.

#### 10.3.2 Language of Witness Statements.

A witness statement shall be in the language of the witness, and a foreign language witness statement shall be accompanied by a certified translation thereof.

#### 10.3.3 Deposition Testimony in Lieu of Live Testimony.

Absent an agreement among the parties, deposition testimony can only be admitted as evidence if it falls within one of the exceptions set forth in Commission Rule 210.28(h) or is being used for impeachment purposes. An expert witness can generally discuss deposition testimony of other witnesses, but cannot directly quote deposition testimony.

### 10.3.4 Witness Exhibit Binder.

In examining witnesses on direct with prepared written testimony, counsel shall provide the witness, the Chief Administrative Law Judge, both of the CALJ's attorney-advisors, and other counsel, just prior to the commencement of the examination of each witness, with a binder containing only the witnesses' prepared written testimony (*i.e.*, the direct witness binder should not contain copies of the exhibits referred to therein). The witness binder should also contain a table of all exhibits referred to within the prepared written testimony, along with a blank column entitled "Received Into Evidence" or having similar language.

When examining adverse witnesses who have not prepared written testimony, or when cross-examining witnesses, counsel shall provide the witness, the Chief Administrative Law Judge, both of the Chief Administrative Law Judge's attorney-advisors, and other counsel, just prior to the commencement of the examination of each witness, with a binder (or binders) containing all exhibits, in numerical order, and individually tabbed, to be used in the examination of the witness. Each binder must be labeled on its spine with the name and number of the investigation and the nature of the contents of the binder, *e.g.*, Cross-Examination of Witness - Volume 1 of 1. In addition, the front of the witness binder must include a table of all exhibits to be used in the examination of the witness with a blank column entitled "Received Into Evidence" or having similar language.

If there are certain exhibits (*i.e.*, patent, prosecution histories) that will be used frequently with more than one witness, these exhibits may be placed within a separate exhibit binder. The exhibits contained within this specific binder do not need to be included in the separate witness binder for each witness.

All exhibits to be used with the witness must appear in the witness binder, unless it has already been included in another party's binder for that same witness (*i.e.*, counsel for Respondents can used exhibits appearing in the witness' examination binder of the Commission Investigative Staff). If the document is not included in a witness binder, it cannot be used with the witness.

### 10.3.5 Exhibits in Dispute.

Counsel shall provide copies of any disputed exhibits or exhibits that need to be discussed at the hearing to the Chief Administrative Law Judge for his review and consideration, unless a copy of such an exhibit is included in a witness binder that has already been distributed.

## 11. Hearing Procedure

### 11.1 Hearing; Order of Examination.

The order of examination at the hearing is as follows (subject to alteration at the pre-trial conference or other changes in the discretion of the Chief Administrative Law Judge):

(1) Brief Opening Statements
   (a) Complainant (limited to one hour)
   (b) Respondent (limited to one hour)
   (c) Commission Investigative Staff (limited to half an hour)

(2) Complainant's Case-in-Chief.

(3) Respondent's Case-in-Chief: In the event there is more than one respondent, the order of presentation will be determined at the pre-trial conference. Respondents, where possible, should avoid unnecessary duplication of effort.

(4) Commission Investigative Staff's Case-in-Chief.

(5) Complainant's Rebuttal

(6) Respondent's Rebuttal

### 11.2 Closing Argument.

The Chief Administrative Law Judge normally does not schedule closing arguments. Parties may request closing arguments, which are to be held at the discretion of the Chief Administrative Law Judge. Typically, such closing arguments are held after all post-hearing briefs have been submitted.

### 11.3 Hearing Hours.

Normal hearing hours are 9:00 a.m. to 4:30 p.m. with a one-hour and fifteen minute luncheon recess, beginning each day at approximately 12:30 p.m. Two fifteen-minute breaks will also occur.

### 11.4 Trial Decorum.

#### 11.4.1 Conversations at Trial.

No cross conversation between opposing counsel will be permitted on the record. Rather if counsel has anything to say to opposing counsel, such statement must be made through the Chief Administrative Law Judge.

### 11.4.2 Reading Matter; Cell Phones and Beepers; Food and Beverages.

No reading of extraneous material will be permitted in the courtroom. Audible cell phone and beeper signals shall be turned off in the courtroom during trial, and all cell phone calls must be taken outside of the courtroom. No food, gum, or beverages other than bottled water will be permitted in the courtroom during trial.

### 11.4.3 Photos or Video Recording.

No photo taking or tape/video recording is permitted in the courtroom.

### 11.4.4 Swearing of Witnesses.

When a witness is sworn, the witness shall remain standing. All others in the trial room must be seated and quiet.

### 11.4.5 Arguments on Objection.

Arguments or objections may only be made by counsel prior to a ruling. Once a ruling is made, no further discussion of the matter will be permitted.

### 11.4.6 Courtroom Attire.

Jackets (*i.e.*, suit jackets or blazers) are required in the courtroom. Men must wear ties.

## 11.5 Examination of Witnesses.

### 11.5.1 Scope of Examination; In General.

Except in extraordinary circumstances, examination of witnesses for Complainant's case-in-chief and Respondent(s)' case-in-chief shall be limited to direct, cross, redirect, and re-cross.

### 11.5.2 Scope of Cross-examination.

Cross-examination will be limited to the scope of the direct examination. The Commission Investigative Staff may, however, ask the witness supplemental direct testimony on the witness stand and is not limited to the scope of direct examination.

When counsel is presenting a witness with a question that refers back to the witness' previous testimony, counsel shall refrain from summarizing the witness' previous testimony because this can lead to a time-consuming objection that counsel's summary was not an accurate recitation of the witness' previous testimony. If counsel wishes to refer back to a witness' previous testimony, counsel must directly quote the prior testimony.

If counsel wishes the witness to limit his/her answer to a yes or no, counsel must preface the question with a request that the witness answer "yes, no, or I can't answer that question yes or no."

### 11.5.3 Scope of Redirect and Re-cross Examination.

Redirect examination will be limited to matters brought out on cross-examination. Re-cross examination will be limited to matters brought out on redirect examination.

### 11.5.4 Coordination of Witnesses.

The parties are expected to coordinate examination of witnesses so as to allot appropriate time for examination of each of the witnesses within the total time allotted for the trial.

### 11.5.5 Scope of Expert Witness Testimony.

An expert's testimony at the trial shall be limited in accordance with the scope of his or her expert report(s), deposition testimony, or within the discretion of the Chief Administrative Law Judge. Direct testimony from an expert that is outside this scope will be excluded.

### 11.5.6 Coordination of Respondents' Cross-examination.

Respondents shall coordinate cross-examination through one attorney as far as practicable to avoid duplication. If that is not possible, counsel who intends to cross-examine must be present in the trial room during the entire preceding cross-examination of the witness so as not to engage in repetitive questioning.

### 11.5.7 Requests for Clarification of a Question.

Requests for clarification of a question only may come from the witness or the Chief Administrative Law Judge.

### 11.5.8 Use of Translators.

If a translator will be used at trial, the parties are responsible for obtaining one qualified, neutral translator upon whom counsel can agree. It is suggested that the translator be chosen from a list of approved translators, such as may be kept by various federal district courts or federal agencies. Translators will be sworn in.

### 11.5.9 Conferring with Witness during a Break in Testimony.

Counsel shall not confer with a witness during a break in the witness' testimony on the witness' substantive testimony.

#### 11.5.10 Sequestration of Witnesses.

Sequestration of fact witnesses is not required, but may be requested by the parties. Such requests should be made at the pre-trial conference.

#### 11.5.11 Submission of Updated Schedule of Estimated Time and Date of Witnesses.

At 8:30 a.m. on each day in which the court is in session, the parties should submit an updated schedule of estimated time and date of hearing witnesses. This list should be emailed to Irina.Kushner@usitc.gov, with a copy to Bullock337@usitc.gov.

### 11.6 Report on Time.

The parties are responsible for keeping track of the time that each party has used. At the beginning of each hearing day, the parties should provide a report regarding time. The parties should meet and confer prior to the submission of the report and present it jointly. This report can be read into the record and does not need to be submitted on paper.

### 11.7 Close of Hearing Procedures.

#### 11.7.1 Removal of Binders.

The parties shall remove the binders provided to the Chief Administrative Law Judge and his attorney-advisors at the conclusion of the hearing.

#### 11.7.2 Physical Exhibits.

All physical exhibits left at the Commission should be identified on a "List of Physical Exhibits." The list should include the exhibit number and a description of the exhibit. If the party intends to leave a photograph in lieu of a physical exhibit, the party should so state on the list. Physical exhibits will not be returned to the parties until the conclusion of the investigation, including all appeals.

#### 11.7.3 Corrections to Transcripts.

If a transcript needs to be corrected after the conclusion of the hearing, the party requesting the change shall do so through a motion. Once an order issues adopting the proposed correction, it is incumbent upon the party requesting the change to send a copy of the order to Ace-Federal Reporters, Inc. so that the corrections can be made.

## 12. Submission of Exhibits.

On the same day that initial post-hearing briefs are due, the parties shall each submit the following[11]: [1] the final exhibit lists; [2] the Chief Administrative Law Judge's binder set of all the final exhibits in the format set forth in Ground Rule 12.2; [3] an electronic version of the final set of exhibits to the Chief Administrative Law Judge for his use in drafting the final initial determination; and [4] the Commission set of exhibits, with rejected exhibits submitted under separate cover and so marked. All submissions should be delivered to the Chief Administrative Law Judge's office. They should not be delivered directly to Docket Services.

Each side is only responsible for submitting its own exhibits. Source code (both paper and electronic copies) should be submitted in a manner jointly agreed upon by the parties.

### 12.1 Final Exhibit List.

Each party must submit a final exhibit list prepared in accordance with Ground Rule 9.5.1 reflecting the status of all exhibits, including those admitted or rejected during the hearing. Withdrawn exhibits do not need to be on the exhibit list.

The parties should submit three versions of the final exhibit list: (1) a list identifying all confidential exhibits: (2) a list identifying all public exhibits; and (3) a master list with all exhibits (both confidential and public). Each side is only responsible for submitting its own exhibit list, except that Complainant(s) is also responsible for submitting the three versions of the joint exhibit lists.

Each party should also submit a list of rejected exhibits. Only one version of this list is required.

### 12.2 Chief Administrative Law Judge's Binder Set.

The exhibits in the Chief Administrative Law Judge's binder set shall be individually tabbed, with each tab reflecting the number of the corresponding exhibit, *e.g.*, CX-0003C. Each binder must be labeled on its spine with the name and number of the investigation and the nature of the contents of the binder, *e.g.*, Complainant's Exhibits CX-0001 through CX-0018C. The exhibits in the binder set shall be in consecutive numerical order, and shall not be separated according to confidential or public status.

Native files (such as Excel, videos) should be printed to PDF and placed in the binders. If the native file cannot be printed to PDF in a legible manner, a placeholder should be placed in the binder indicating that the file can be found in the Chief Administrative Law Judge's Electronic Copy.

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[11] Complainant(s) are responsible for submitting joint exhibits.

### 12.3 Chief Administrative Law Judge's Electronic Copy.

The parties should provide an electronic copy of the exhibits. This electronic copy may be submitted on an external hard drive or flash drive and need not be separated in the manner set forth in Ground Rule 12.4.

### 12.4 Commission's Copy.

The Commission set of exhibits shall be submitted in electronic format. The procedure for submitting exhibits electronically is set forth at:
http://www.usitc.gov/docket_services/documents/EDIS3UserGuide-CDSubmission.pdf.

There are twenty-four standard exhibit categories: CX, CDX, CPX, RX, RDX, RPX, JX, JDX, JPX, SX, SDX, SPX, CX-[four-digit number]C, CDX-[four-digit number]C, CPX-[four-digit number]C, RX-[four-digit number]C, RDX-[four-digit number]C, RPX-[four-digit number]C, JX-[four-digit number]C, JDX-[four-digit number]C, JPX-[four-digit number]C, SX-[four-digit number]C, SDX-[four-digit number]C, and SPX-[four-digit number]C. Each category of exhibit must be placed on a separate CD and labeled with the Investigation name, number, and the range of exhibits contained on the CD.

These CDs are used to upload the exhibits to EDIS. **It is the responsibility of the parties to make sure the CDs are correct.** The parties should therefore carefully check each CD to confirm public and confidential exhibits are separated and that source code is not placed on CDs to be uploaded to EDIS, unless agreed to by the parties.

A Table of Contents file in PDF format which lists the names of all files on the disc should be created and included on each disc.

The parties shall also submit any rejected exhibits on discs, with the rejected exhibits also separated into the twenty-four standard exhibit categories referenced above. The rejected exhibits shall be submitted under separate cover and so marked.

Any exhibits that are not included with the Commission exhibits and on the final exhibit list at the conclusion of the hearing will not be considered as part of the record to be certified to the Commission when the final initial determination issues.

#### 12.4.1 Native Files.

Native files (such as Excel, videos) should be printed to PDF and placed on the CDs in the appropriate category. If the native file cannot be printed to PDF in a legible manner, a placeholder should be placed on the CD in the appropriate category indicating that the exhibit is a native file. Parties should submit a separate CD containing all native files.

### 12.4.2 Format of Commission's Exhibit Set.

The following shall apply **ONLY** if a party has received permission from the Secretary to file the Commission's exhibit set on paper:

Exhibits in the Commission set shall consist of loose sheets (which may be clipped but not stapled) in folders (file folders, accordion folders, etc.) that are provided in sequentially-numbered boxes. Each folder must be labeled to reflect the number of the exhibit contained therein, *e.g.*, RX-0014C. In each of the boxes of the Commission exhibit set, the folders containing the exhibits shall be placed in numerical order.

### 12.5 Binder Exhibit Set for the Office of General Counsel.

No later than thirty (30) days after the submission of post-trial reply briefs, each party shall deliver one additional binder set of exhibits (except withdrawn exhibits) directly to the Office of General Counsel. This submission should be accompanied by a final exhibit list. Rejected exhibits should be submitted under separate cover and so marked. In the alternative, the parties may submit this set electronically pursuant to Ground Rule 12.4.

## 13. Post-trial Briefs.

### 13.1 Initial Post-trial Briefs; Filing and Content.

On or before the date set forth in the procedural schedule, each party shall file a post-trial brief (and submit the courtesy copy required by Ground Rule 1.3). The post-trial brief shall discuss the issues and evidence tried within the framework of the general issues determined by the Commission's Notice of Investigation and those issues that are included in the pre-trial brief and any permitted amendments thereto. All other issues shall be deemed waived.

The parties are expected to follow the outline used in pre-trial briefs in the post-trial brief, except that the parties should remove references to any issue that the parties agree is no longer in dispute.

A reasonable page limit will be imposed for all post-trial briefs, which will be determined on a case-by-case basis. Parties are required to use double-spacing (with the exception of headings, footnotes, quotations, etc.), at least 12 point font, and 1 inch margins (excluding headers for CBI and footers, such as page numbers). If the parties have any questions regarding the acceptable formatting requirements for post-trial briefs, they should contact the Chief Administrative Law Judge's attorney-advisor.

To the extent there is more than one complainant and/or respondent in an investigation, complainants and/or respondents shall coordinate their efforts and submit a single brief. Exceptions to this rule will be made on a case-by-case basis. This rule shall also apply to post-hearing reply briefs.

### 13.2 Post-trial Reply Briefs; Filing and Content.

On or before the date set forth in the procedural schedule, each party shall file a post-trial reply brief. The post-trial reply brief shall discuss the issues and evidence discussed in the initial post-trial briefs of each opposing party.

A reasonable page limit will be imposed on all post-trial reply briefs, which will be determined on a case-by-case basis. Parties must submit a courtesy electronic copy of their brief to the Chief Administrative Law Judge in Word format. The rules relating to post-hearing briefs detailed in Ground Rule 13.1 also apply to reply briefs.

### 13.3 Issues Not in Dispute.

If a party does not dispute any issue for which the opposing side bears the burden of proof, the party must affirmatively state that it is not disputing the issue in this investigation. If such a statement is not made, the party is expected to substantively address the issue in its brief and not rely on conclusory statements.

If a party is only disputing certain elements of a claim for purposes of infringement or invalidity, the party must affirmatively state that it is not disputing the remainder. For example, if a party is only disputing a specific element of claim 1, it can conclude with: "For purposes of this Investigation, [Name of party] is not disputing the remainder of the elements of the claim."

### 13.4 Citations to Evidence.

When citing to witness testimony, the party must include a parenthetical identifying the witness whose testimony is being cited. For example, if a party is citing to the trial testimony of their witness, Dr. Smith, the party should include the citation: Tr. (Smith) at 123:1-124:14. If citing to the direct testimony of Dr. Smith, the party should include the citation: CX-0001C (Smith) at Q/A 1-5. This rule also applies if the cited exhibit is testimony received during a deposition.

### 13.5 Citations to Pre-hearing Briefs.

It is preferable to cite to the evidentiary record rather than pre-hearing briefs. Parties may not incorporate any portion of their pre-hearing briefs into their post-hearing briefs by reference.

### 13.6 Citation to Demonstrative Exhibits.

Demonstrative exhibits are not admitted as substantive evidence. If a party cites to a demonstrative exhibit in its post-trial brief, it must include a parenthetical identifying the substantive evidence on which the demonstrative is based, *e.g.*, RDX-0001 (summarizing RX-0001). If the demonstrative was prepared during examination of the witness, the party should so state

## 14. Cooperation Among Parties.

Due to the time limitations imposed by section 337, counsel shall attempt to resolve, by stipulation or negotiated agreement, any procedural problems encountered, including those relating to discovery and submission of evidence. To assure the proper cooperative spirit in this investigation, continuing good faith communications between counsel for the parties is essential and expected.

## 15. *Ex Parte* Contacts.

There shall be no *ex parte* contacts with the Chief Administrative Law Judge. Any questions of a technical or procedural nature shall be directed to the Chief Administrative Law Judge's attorney-advisor, Irina Kushner, at (202) 205-2694, or Irina.Kushner@usitc.gov

# APPENDIX A

**UNITED STATES INTERNATIONAL TRADE COMMISSION**
**Washington, D.C.**

| | |
|---|---|
| In the Matter of<br><br>**Certain . . .** | Investigation No. 337-TA-___ |

**SUBPOENA DUCES TECUM**

**TO:** NAME
ADDRESS

**TAKE NOTICE**: By authority of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application for subpoena made by ["Complainant(s)" / "Respondent(s)"/ etc., followed by name of company] ,

**YOU ARE HEREBY ORDERED** to produce at _____, on , or at such other time and place agreed upon, all of the documents and things in your possession, custody or control which are listed and described in Attachment A hereto. Such production will be for the purpose of inspection and copying, as desired.

If production of any document listed and described in Attachment A hereto is withheld on the basis of a claim of privilege, each withheld document shall be separately identified in a privileged document list. The privileged document list must identify each document separately, specifying for each document at least: (1) the date; (2) author(s)/sender(s); (3) recipient(s), including copy recipients; and (4) general subject matter of the document. The sender(s) and recipient(s) shall be identified by position and entity (corporation or firm, etc.) with which they

are employed or associated. If the sender or the recipient is an attorney or a foreign patent agent, he or she shall be so identified. The type of privilege claimed must also be stated, together with a certification that all elements of the claimed privilege have been met and have not been waived with respect to each document.

If any of the documents or things listed and described in Attachment A hereto are considered "confidential business information," as that term is defined in the Protective Order attached hereto, such documents or things shall be produced subject to the terms and provisions of the Protective Order.

Any motion to limit or quash this subpoena shall be filed within **ten (10) days** after the receipt hereof. At the time of filing of any motion concerning this subpoena, two courtesy copies shall be served concurrently on the Chief Administrative Law Judge at his office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set his hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this ___ day of _____, 201_.

_____

Charles E. Bullock
Chief Administrative Law Judge
United States International Trade Commission

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

| | |
|---|---|
| In the Matter of<br><br>**Certain . . .** | Investigation No. 337-TA-___ |

**SUBPOENA AD TESTIFICANDUM**

**TO:** NAME
ADDRESS

**TAKE NOTICE**: By authority of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), 5 U.S.C. § 556(c)(2), and pursuant to 19 C.F.R. § 210.32 of the Rules of Practice and Procedure of the United States International Trade Commission, and upon an application for subpoena made by ["Complainant(s)" / "Respondent(s)" / etc., followed by name of company].

**YOU ARE HEREBY ORDERED** to present yourself for purposes of your deposition upon oral examination on_____, at_____, or at such other time and place agreed on, concerning the subject matter set forth in Attachment A hereto.

This deposition will be taken before a Notary Public or other person authorized to administer oaths and will continue from day to day until completed.

If any of your testimony is considered "confidential business information," as that term is defined in the Protective Order attached hereto, such testimony shall be so designated and treated according to the terms and provisions of the Protective Order.

Any motion to limit or quash this subpoena shall be filed within **ten (10) days** after the receipt hereof. At the time of filing of any motion concerning this subpoena, two courtesy copies shall be served concurrently on the Chief Administrative Law Judge at his office.

IN WITNESS WHEREOF the undersigned of the United States International Trade Commission has hereunto set his hand and caused the seal of said United States International Trade Commission to be affixed at Washington, D.C. on this ___ day of _____, 201_.

Charles E. Bullock
Chief Administrative Law Judge
United States International Trade Commission

# APPENDIX B

**GENERAL OUTLINE FOR ALL BRIEFS**

I. INTRODUCTION

A. Procedural History

B. The Parties

C. Overview of the Technology

D. The Patents at Issue

E. The Products at Issue

II. JURISDICTION

III. PATENT "A"

A. Claim Construction

A. Infringement

1. Claim 1

2. Claim 2

B. Domestic Industry – "Technical Prong"

C. Validity

Anticipation Under 35 U.S.C. § 102(a)

Obviousness Under 35 U.S.C. § 103(a)

A. Unenforceability

B. Other Defenses

IV. PATENT "B" ...

V. DOMESTIC INDUSTRY - ECONOMIC PRONG

Significant Investment in Plant and Equipment

Significant Employment of Labor or Capital

I. REMEDY AND BONDING

# ATTACHMENT A

## JOINT DISCOVERY STATEMENT

The parties shall file a Joint Discovery Statement that includes the following:

1. The parties' positions on the applicable topics of the "Discovery Statement Checklist" (*see* Exhibit A).

2. The parties' positions on the applicable topics of the "Joint Electronic Discovery Submission" (*see* Exhibit B).

3. The parties' proposed limitations and procedures for fact and expert discovery including:

    a. Any recommendations for limiting the production of documents, including electronically stored information.

    b. Any recommendations for limiting fact depositions, whether by numbers or days of depositions (*e.g.*, maximum number of deponents, limiting depositions by agreeing on a maximum number of days a party may depose witnesses, etc.).

    c. A protocol for electronic discovery, including a brief description of any disputes regarding the scope of electronic discovery.

    d. Whether the parties recommend that expert discovery precede or follow any summary determination practice.

    e. Whether the parties agree to allow depositions, preceding the hearing, of hearing witnesses not already deposed.

    f. Whether the parties agree to conduct depositions in a particular location (*e.g.*, bring up to five foreign witnesses to the U.S. for deposition).

    g. Whether the parties recommend that the ALJ set a date before which contention interrogatory responses need not be provided.

    h. Recommendations for limiting the number of claim terms to be presented to the ALJ for construction.

4. When the parties believe the best time is to engage in mediation. The parties should also identify what discovery should precede mediation.

## EXHIBIT A

## DISCOVERY STATEMENT CHECKLIST

1. Issues to be litigated

   a. Identify all issues to be litigated (*e.g.,* infringement, affirmative defenses, importation, domestic industry, remedy, bonding, and public interest (if delegated to the undersigned by the Commission))

   b. Identify specific proposals in which these issues can be narrowed to make the hearing more meaningful and efficient.

2. A description of information and evidence that each party intends to submit to prove its own case;

3. A description of the specific information and evidence that each party will be seeking from other parties and third persons;

4. Possible limitations on document preservation (including electronically stored information);

5. Preliminary issues that are likely to arise that will require judicial intervention;

6. Identification of dispositive issues that should be resolved early in the Investigation, and specific proposals for disposition of such issues;

7. Identification of issues amenable to stipulations (*e.g.*, electronic service of discovery);

8. Proposed discovery limitations including, but not limited to:

   a. limitations on types of discovery beyond those in the Commission Rules and applicable Ground Rules (*i.e.,* limits on depositions, number of interrogatories, requests for admission);

   b. limitations on scope of discovery;

   c. limitations on timing and sequence of discovery;

   d. agreements to allow depositions of hearing witnesses named if not already deposed; and preservation depositions, foreign discovery, or other anticipated issues;

   e. agreements to exchange certain information without the use of formal discovery;

f. agreements or limitations on discovery of electronically-stored information[1];

g. limitations on restoration of electronically-stored information.

9. Status of any settlement discussions;

10. Status of any litigation that may affect any issue in this Investigation;

11. Status of any proceedings (including reexaminations) before the U.S. Patent and Trademark Office;

12. Proposal for any modifications to the protective order now in effect for this Investigation;

13. Whether a *Markman* hearing is necessary and if so, a proposed date for the *Markman* hearing; and

14. Position as to target date.

[1] This should include a brief summary of any agreements reached in the Joint Electronic Discovery Submission to be submitted herewith.

**EXHIBIT B**

**UNITED STATES INTERNATIONAL TRADE COMMISSION**
**Washington, D.C.**

Before the Honorable Charles E. Bullock
Chief Administrative Law Judge

| **In the Matter of** | |
|---|---|
| **CERTAIN RELOAD CARTRIDGES FOR LAPAROSCOPIC SURGICAL STAPLERS** | **Inv. No. 337-TA-1167** |

**JOINT ELECTRONIC DISCOVERY SUBMISSION AND [PROPOSED] ORDER**

One or more of the parties to this litigation have indicated that they believe that relevant information may exist or be stored in electronic format, and that this content is potentially responsive to current and/or anticipated discovery requests. This Joint Submission and [Proposed] Order (and any subsequent orders) shall govern the electronic discovery process in this action. The parties and the undersigned recognize that this Joint Electronic Discovery Submission and [Proposed] Order is based on facts and circumstances as they are currently known to each party, that the electronic discovery process is iterative, and that additions and modifications to this Submission may become necessary as more information becomes known to the parties.

**I. Competence**. Counsel certify that they are sufficiently knowledgeable in matters relating to their clients' technological systems to discuss competently issues relating to electronic discovery, or have involved someone competent to address these issues on their behalf.

**II. Meet and Confer**. Counsel are required to meet and confer regarding certain matters relating to electronic discovery. Counsel hereby certify that they have met and conferred to discuss these issues prior to submission of the Discovery Statement.

Date(s) of parties' meet-and-confer conference(s): _____

**III. Unresolved Issues**: After the meet-and-confer conference(s) taking place on the aforementioned date(s), the following issues remain outstanding and/or require judicial intervention:

A. Preservation

1. The parties have discussed the obligation to preserve potentially relevant electronically stored information and agree to the following scope and methods for preservation, including but not limited to: retention of electronic data and implementation of a data preservation plan; identification of potentially relevant data; disclosure of the programs and manner in which the data is maintained; identification of computer system(s) utilized; and identification of the individual(s) responsible for data preservation, etc.

Complainant(s):

_____

_____

_____

_____

Respondent(s):

_____

_____

_____

_____

2. State the extent to which the parties have disclosed or have agreed to disclose the dates, contents, and/or recipients of "litigation hold" communications.

_____

_____

_____

_____

3. The parties anticipate the need for judicial intervention regarding the following issues concerning the duty to preserve, the scope, or the method(s) of preserving electronically stored information:

B. Search and Review

1. The parties have discussed methodologies or protocols for the search and review of electronically stored information, as well as the disclosure of techniques to be used. Some of the approaches that may be considered include: the use and exchange of keyword search lists, "hit reports," and/or responsiveness rates; concept search; machine learning, or other advanced analytical tools; limitations on the fields or file types to be searched; date restrictions; limitations on whether back-up, archival, legacy, or deleted electronically stored information will be searched; testing; sampling; etc. To the extent the parties have reached agreement as to search and review methods, provide details below.

Complainant(s):

Respondent(s):

2. The parties anticipate the need for judicial intervention regarding the following issues concerning the search and review of electronically stored information:

C. Production

1. Source(s) of Electronically Stored Information. The parties anticipate that discovery may occur from one or more of the following potential source(s) of electronically stored information [*e.g.,* email, word processing documents, spreadsheets, presentations, databases, web sites, etc.]:

Complainant(s):

Respondent(s):

2. Limitations on Production. The parties have discussed factors relating to the scope of production, including but not limited to: (i) number of custodians; (ii) identity of custodians; (iii) date ranges for which potentially relevant data will be drawn; (iv) locations of data; (v) timing of productions; and (vi) electronically stored information in the custody or control of non-parties. To the extent the parties have reached agreements related to any of these factors, describe below:

Complainant(s):

_____

_____

_____

_____

Respondent(s):

_____

_____

_____

_____

3. Form(s) of Production:

The parties have reached the following agreements regarding the form(s) of production:

Complainant(s):

_____

_____

_____

_____

Respondent(s):

a. Please specify any exceptions to the form(s) of production indicated above (*e.g.*, word processing documents in TIFF with load files, but spreadsheets in native form):

b. The parties anticipate the need for judicial intervention regarding the following issues concerning the form(s) of production:

4. Privileged Material Identification. The parties have agreed to the following method(s) for the identification (including the logging, if any, or alternatively, the disclosure of the number of documents withheld), and the redaction of privileged documents:

5. Cost of Production. The parties have analyzed their client's data repositories and have estimated the costs associated with the production of electronically stored information. The factors and components underlying these costs are estimated as follows:

a. Costs

Complainant(s):

Respondent(s):

b. Cost Allocation. The parties have considered cost-shifting or cost-sharing and have reached the following agreements, if any:

c. Cost Savings. The parties have considered cost-saving measures, such as the use of a common electronic discovery vendor or a shared document repository, and have reached the following agreements, if any:

6. The parties anticipate the need for judicial intervention regarding the following issues concerning the production of electronically stored information:

D. Other Issues:

The preceding constitutes the agreement(s) reached and existing disputes (if any) between the parties to certain matters concerning electronic discovery as of this date. To the extent additional agreements are reached, modifications are necessary, or disputes are identified, they will be outlined in subsequent submissions or agreements and promptly presented to the undersigned for consideration.[2]

DATED: _____

Respectfully submitted,

_____

*Counsel for Complainants*

_____

*Counsel for Respondents*

[2] Additional written status reports filed pursuant to Ground Rule 4.1.1(Discovery Committee) shall include the status of electronic discovery and identify any issues or disputes that have arisen, including any additional agreements or modifications to the e-discovery submission, as well as any newly arisen disputes.

**CERTAIN RELOAD CARTRIDGES FOR LAPAROSCOPIC SURGICAL STAPLERS** **Inv. No. 337-TA-1167**

Certificate of Service – Page 1

I, Lisa R. Barton, hereby certify that the attached **ORDER NO. 2** has been served upon the following parties as indicated, on **July 8, 2019**.

Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street SW, Room 112
Washington, DC 20436

| | |
|---|---|
| **On Behalf of Complainants Ethicon LLC, Ethicon Endo-Surgery, Inc., Ethicon US, LLC:** | |
| | |
| Anish R. Desai, Esq.<br>**WEIL, GOTSHAL & MANGES LLP**<br>765 5TH Avenue<br>New York, NY 10153 | ☐ Via Hand Delivery<br>☐ Via Express Delivery<br>☑ Via First Class Mail<br>☐ Other:_____ |
| | |
| **RESPONDENTS:** | |
| Intuitive Surgical Inc.<br>1020 Kifer Road<br>Building 101<br>Sunnyvale, CA 94086 | ☐ Via Hand Delivery<br>☐ Via Express Delivery<br>☑ Via First Class Mail<br>☐ Other: |
| Intuitive Surgical Operations, Inc.<br>1020 Kifer Road<br>Sunnyvale, CA 94086 | ☐ Via Hand Delivery<br>☐ Via Express Delivery<br>☑ Via First Class Mail<br>☐ Other:_____ |
| Intuitive Surgical Holdings, LLC<br>1020 Kifer Road<br>Sunnyvale, CA 94086 | ☐ Via Hand Delivery<br>☐ Via Express Delivery<br>☑ Via First Class Mail<br>☐ Other:_____ |
| Intuitive Surgical S. DE/r.I. DE C.V.<br>Circuito Internacional Sur #12-A, Parque Industrial Nelson<br>Carretera A. San Luis R.c., Km 14<br>Mexicali Baja California, Mexico 21397 | ☐ Via Hand Delivery<br>☐ Via Express Delivery<br>☑ Via First Class Mail<br>☐ Other:_____ |