

III. Patent Disclosures

3.5. Invalidation and Unenforceability Contentions

Not later than eighty (80) days after service of the Responsive Pleading, each party asserting that a claim of a patent is invalid or unenforceable, shall serve on all parties its Invalidation and Unenforceability Contentions which shall contain at least the following information:

- (a) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication shall be identified by its title, date of publication, and where feasible, author and publisher. Prior art under 35 U.S.C. § 102(b) shall be identified by specifying the item offered for sale or publicly used or known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. Prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the person(s) from whom and the circumstances under which the invention or any part of it was derived. Prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the person(s) or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s);
- (b) Whether each item of prior art anticipates each asserted claim or renders it obvious under 35 U.S.C. §102 or §103. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness;
- (c) For each alleged item of prior art, a chart identifying specifically where each limitation of each asserted claims are found, including for each limitation that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function;
- (d) Any grounds of invalidity based on 35 U.S.C. § 101, or 35 U.S.C. § 112, including invalidity contentions based on written description, enablement, indefiniteness, and/or best mode.
- (e) The grounds for any charge that any of the asserted claims are unenforceable for inequitable conduct, including the identification of any information alleged to have been withheld, misstated, or otherwise misrepresented to the United States Patent Office, the basis for claiming such information was material to patentability, and the basis for claiming that the patentee withheld, misstated, or misrepresented such information with the requisite intent.