

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
MIDLAND/ODESSA AND PECOS DIVISIONS**

BY: J.A.
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STANDING ORDER GOVERNING PATENT PROCEEDINGS

This Order governs proceedings in all patent cases pending before the undersigned and takes effect upon entry in all patent cases. The Court may accelerate, extend, eliminate, or modify the obligations or deadlines set forth herein based on the circumstances of any case, including, without limitation, the complexity of the case or the number of patents, claims, products, or parties involved. The Local Rules of this Court shall also apply to these actions, except to the extent they are inconsistent. The deadlines set forth herein may be modified by Scheduling Order issued in specific cases.

I. DEADLINES

The parties shall submit a proposed scheduling order to the Court within thirty (30) days after the Court enters its Order for Scheduling Recommendations. The content of the proposed scheduling order shall include proposals for all deadlines set out in the form for scheduling order attached hereto as Exhibit "A." The parties shall endeavor to agree concerning the contents of the proposed scheduling order, but if they are unable to do so, each party's position and the reasons for the disagreement shall be submitted to the Court. The scheduling proposals of the parties shall be considered by the Court, but the setting of all dates is within the discretion of the Court. The parties shall indicate in the proposed order that they have in fact conferred as required by the Federal Rules of Civil Procedure.

In all cases, the *Markman* hearing shall be initially scheduled for 23 weeks after the parties submit their proposed scheduling order to the Court.

Not later than one week before the parties' proposed scheduling order is due to be filed with the Court, the plaintiff shall serve their preliminary infringement contentions chart setting forth where in the accused product(s) each element of the asserted claim(s) are found. The plaintiff shall also identify the priority date (i.e., the earliest date of invention) for each asserted claim and produce: (1) all documents evidencing conception and reduction to practice for each claimed invention, and (2) a copy of the file history for each patent in the suit.

Seven weeks after the parties submit their proposed scheduling order to the Court, the defendant shall serve preliminary invalidity contentions in the form of (1) a chart setting forth where in the prior art references each element of the asserted claim(s) are found, (2) an identification of any limitations the defendant contends are indefinite or lack written description under § 112, and (3) an identification of any claims the defendant contends are directed to ineligible subject matter under § 101. The § 101 contention shall (1) identify the alleged abstract idea, law of nature, and/or natural phenomenon in each challenged claim; (2) identify each claim element alleged to be well-understood, routine, and/or conventional; and (3) to the extent not duplicative of §§ 102/103 prior art contentions, prior art for the contention that claim elements are well-understood, routine, and/or conventional. The defendant shall also produce (1) all prior art referenced in the invalidity contentions, and (2) technical documents, including software where applicable, sufficient to show the operation of the accused product(s).

Plaintiff must file a notice informing the Court when an IPR is filed, the expected time for an institution decision, and the expected time for a final written decision, within 2 weeks of the filing of the IPR.

II. DISCOVERY LIMITS

Except regarding venue, jurisdictional, and claim construction-related discovery, all other discovery shall be stayed until after the *Markman* hearing. Notwithstanding this general stay of discovery, the Court will permit limited discovery by agreement of the parties, or upon request, where exceptional circumstances warrant it. For example, if discovery outside the United States is contemplated via the Hague, the Court is inclined to allow such discovery to commence before the *Markman* hearing.

Following the *Markman* hearing, the following discovery limits apply. The Court will consider reasonable requests to adjust these limits should circumstances warrant.

1. Interrogatories: 30 per side
2. Requests for Admission: 45 per side
3. Requests for Production: 75 per side
4. Fact Depositions: 70 hours per side (for both party and non-party witnesses combined)
5. Expert Depositions: 7 hours per report

Electronically Stored Information. As a preliminary matter, the Court will not require general search and production of email or other electronically stored information (“ESI”) related to email (such as metadata), absent a showing of good cause. If a party believes targeted email/ESI discovery is necessary, it shall propose a procedure identifying custodians and search terms it believes the opposing party should search. The opposing party can oppose or propose an alternate plan. If the parties cannot agree, they shall contact the Court to discuss their respective positions.

III. VENUE & JURISDICTIONAL DISCOVERY

The Court hereby establishes the following limits on discovery related to venue and jurisdiction: each party is limited to 5 interrogatories, 10 Requests for Production, and 10 hours of

deposition testimony. The time to respond to such discovery requests is reduced to 20 days. If a party believes these limits should be expanded, the party shall meet and confer with opposing counsel and if an impasse is reached, the requesting party is directed to contact the Court for a telephonic hearing.

Venue or jurisdictional discovery automatically opens upon the filing of an initial venue or jurisdictional motion and shall be completed no later than 10 weeks after the filing of such motion. Parties shall file a notice of venue or jurisdictional discovery if the discovery will delay a response to a motion to transfer.

IV. CLAIM CONSTRUCTION

When the parties submit their joint claim construction statement, in addition to the term and the parties' proposed constructions, the parties should indicate which party or side proposed that term, or if that was a joint proposal.

Briefing Procedure and Page Limits. The Court will require non-simultaneous *Markman* briefing with the following default page limits. When exceptional circumstances warrant, the Court will consider reasonable requests to adjust these limits.

Unless otherwise agreed to by the parties, the default order of terms in the parties' briefs shall be based on the patent number (lowest to highest), the claim number (lowest to highest), and order of appearance within the lowest number patent and claim.

Brief	1-2 Patents	3-5 Patents	More than 5 Patents
Opening (Defendant)	20 pages	30 pages	30 pages, plus 5 additional pages for each patent over 5 up to a maximum of 45 pages
Response (Plaintiff)	20 pages	30 pages	30 pages, plus 5 additional pages for each patent over 5 up to a maximum of 45 pages
Reply (Defendant)	10 pages	15 pages	15 pages, plus 2 additional pages for each patent over 5 up to a maximum of 21 pages

Sur-Reply (Plaintiff)	10 pages	15 pages	15 pages, plus 2 additional pages for each patent over 5 up to a maximum of 21 pages
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After briefing concludes, the parties shall file a Joint Claim Construction Statement.


Technology Tutorials and *Markman* Hearing. Technology tutorials are optional, especially in cases where a technical advisor has been appointed. If the parties submit one, the tutorial should be in electronic form, with voiceovers, and submitted at least 10 days before the *Markman* hearing. In general, tutorials should be: (1) directed to the underlying technology (rather than argument related to infringement or validity), and (2) limited to 15 minutes per side. The tutorial will not be part of the record and the parties may not rely on or cite to the tutorial in other aspects of the litigation.

The Court generally sets aside one hour for the *Markman* hearing; however, the Court is open to reserving more or less time, depending on the complexity of the case and input from the parties. Generally, the party opposing the Court's preliminary construction shall go first. If both parties oppose the Court's preliminary construction, the plaintiff shall typically go first.

The Court will provide preliminary constructions to the parties ahead of the *Markman* hearing. At the *Markman* hearing, the Court encourages oral arguments that fine-tune the preliminary constructions over arguments repeated from the briefs.

It is so **ORDERED**.

SIGNED and ENTERED this 2nd day of August 2022.



 DAVID COUNTS
 UNITED STATES DISTRICT JUDGE

APPENDIX A – PROPOSED SCHEDULING ORDER

Deadline	Item
30 days after the Court enters its Order for Scheduling Recommendations	The Parties shall file a motion to enter an agreed Scheduling Order. If the parties cannot agree, the parties shall submit a separate Joint Motion for entry of Scheduling Order briefly setting forth their respective positions on items where they cannot agree.
1 week before the parties' proposed scheduling order is due to be filed with the Court	Plaintiff serves preliminary infringement contentions in the form of a chart setting forth where in the accused product(s) each element of the asserted claim(s) are found. Plaintiff shall also identify the earliest priority date (i.e. the earliest date of invention) for each asserted claim and produce: (1) all documents evidencing conception and reduction to practice for each claimed invention, and (2) a copy of the file history for each patent in suit.
7 weeks after the parties' proposed scheduling order is due to be filed with the Court	Defendant serves preliminary invalidity contentions in the form of (1) a chart setting forth where in the prior art references each element of the asserted claim(s) are found, (2) an identification of any limitations the Defendant contends are indefinite or lack written description under section 112, and (3) an identification of any claims the Defendant contends are directed to ineligible subject matter under section 101. Defendant shall also produce (1) all prior art referenced in the invalidity contentions, and (2) technical documents, including software where applicable, sufficient to show the operation of the accused product(s).
9 weeks after the parties' proposed scheduling order is due to be filed with the Court	Parties exchange claim terms for construction.
11 weeks after the parties' proposed scheduling order is due to be filed with the Court	Parties exchange proposed claim constructions.
12 weeks after the parties' proposed scheduling order is due to be filed with the Court	Parties disclose extrinsic evidence. The parties shall disclose any extrinsic evidence, including the identity of any expert witness they may rely upon with respect to claim construction or indefiniteness. With respect to any expert identified, the parties shall identify the scope of the topics for the witness's expected testimony. With respect to items of extrinsic evidence, the parties shall identify each such item by production number or produce a copy of any such item if not previously produced.
13 weeks after the parties' proposed scheduling order is due to be filed with the Court	Deadline to meet and confer to narrow terms in dispute and exchange revised list of terms/constructions.

14 weeks after the parties' proposed scheduling order is due to be filed with the Court	Defendant files Opening claim construction brief, including any arguments that any claim terms are indefinite.
17 weeks after the parties' proposed scheduling order is due to be filed with the Court	Plaintiff files Responsive claim construction brief.
19 weeks after the parties' proposed scheduling order is due to be filed with the Court	Defendant files Reply claim construction brief.
21 weeks after the parties' proposed scheduling order is due to be filed with the Court	Plaintiff files a Sur-Reply claim construction brief.
3 business days after submission of Plaintiff's Sur-Reply claim construction brief	Parties submit Joint Claim Construction Statement.
22 weeks after the parties' proposed scheduling order is due to be filed with the Court	Parties submit optional technical tutorials to the Court and technical advisor (if appointed).
23 weeks after the parties' proposed scheduling order is due to be filed with the Court	<i>Markman</i> Hearing.
1 business day after <i>Markman</i> hearing	Fact Discovery opens; deadline to serve Initial Disclosures per Rule 26(a).
6 weeks after <i>Markman</i> hearing	Deadline to add parties.
8 weeks after <i>Markman</i> hearing	Deadline to serve Final Infringement and Invalidity Contentions. After this date, leave of Court is required for any amendment to infringement or invalidity contentions. This deadline does not relieve the parties of their obligation to amend if new information is identified after initial contentions.
16 weeks after <i>Markman</i> hearing	Deadline to amend pleadings. A motion is not required unless the amendment adds patents or patent claims. (Note: This includes amendments in response to a 12(c) motion).
26 weeks after <i>Markman</i>	Deadline for the first of two meet and confers to discuss significantly narrowing the number of claims asserted and prior art references at issue. Unless the parties agree to the narrowing, they are ordered to contact the Court to arrange a teleconference with the Court to resolve the disputed issues.
30 weeks after <i>Markman</i> hearing	Close of Fact Discovery.
31 weeks after <i>Markman</i> hearing	Opening Expert Reports.
35 weeks after <i>Markman</i> hearing	Rebuttal Expert Reports.
38 weeks after <i>Markman</i> hearing	Close of Expert Discovery.

39 weeks after <i>Markman</i> hearing	Deadline for the second of two meet and confers to discuss narrowing the number of claims asserted and prior art references at issue to triable limits. If it helps the parties determine these limits, the parties are encouraged to contact the Court for an estimate of the amount of trial time anticipated per side. The parties shall file a Joint Report within 5 business days regarding the results of the meet and confer.
40 weeks after <i>Markman</i> hearing	Dispositive motion deadline and <i>Daubert</i> motion deadline.
42 weeks after <i>Markman</i> hearing	Serve Pretrial Disclosures (jury instructions, exhibits lists, witness lists, discovery and deposition designations).
44 weeks after <i>Markman</i> hearing	Serve objections to pretrial disclosures/rebuttal disclosures.
45 weeks after <i>Markman</i> hearing	Serve objections to rebuttal disclosures; file motions <i>in limine</i> .
46 weeks after <i>Markman</i> hearing	File Joint Pretrial Order and Pretrial Submissions (jury instructions, exhibits lists, witness lists, discovery and deposition designations); file oppositions to motions <i>in limine</i>
47 weeks after <i>Markman</i> hearing	Deadline to meet and confer regarding remaining objections and disputes on motions <i>in limine</i> .
8 weeks before trial	Parties to contact Court to confirm their pretrial conference and trial dates.
3 business days before Final Pretrial Conference.	File joint notice identifying remaining objections to pretrial disclosures and disputes on motions <i>in limine</i> .
49 weeks after <i>Markman</i> hearing (or as soon as practicable)	Final Pretrial Conference. Held in person unless otherwise requested.
52 weeks after <i>Markman</i> hearing (or as soon as practicable)	Jury Selection/Trial.