

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF OKLAHOMA**

MILLER MENDEL, INC., a Washington Corporation; TYLER MILLER, an Oregon State resident,)	
)	
Plaintiff,)	
vs.)	Case No. <u>CIV-18-990-C</u>
)	
THE CITY OF OKLAHOMA CITY, a municipal corporation,)	
)	
Defendant.)	

JOINT STATUS REPORT AND DISCOVERY PLAN

Date of Conference: May 9, 2019

Appearing for Plaintiff: Kurt M. Rylander, Rylander & Associates PC (via telephone), and Todd A. Nelson, GableGotwals

Appearing for Defendant: Douglas J. Sorocco and Evan W. Talley, Dunlap Codding, P.C.

Jury Trial Demanded - Non-Jury Trial

1. **BRIEF PRELIMINARY STATEMENT.** State briefly and in ordinary language the facts and positions of the parties to inform the judge of the general nature of the case.

Plaintiff makes and sells through licenses its eSOPH system (<http://millermendel.com/index.php/page/esoph>). The eSOPH system is protected by, among other things, U.S. Patent 10,043,188 for “Background Investigation Management Service,” (the ‘188 Patent). Plaintiff is suing the City of Oklahoma for infringement of the ‘188 Patent. The City of Oklahoma uses a system provided under contract by competitor Guardian Alliance Technologies (<https://guardianalliancetechnologies.com/>), the Guardian Alliance Technologies investigative software platform. Plaintiff contends this constitutes infringement of the ‘188 Patent. Plaintiff is seeking damages and other relief as set forth in the Amended Complaint.

Defendant contends its use of the Guardian Alliance Technologies’ investigative software platform does not infringe the ‘188 Patent because such use does not practice each and

every elements of any claim of the '188 Patent. In addition to its non-infringement position, Defendant contends the '188 Patent is invalid under at least 35 U.S.C. §§ 101, 102, 103, and 112.

2. **JURISDICTION**. State the basis on which the jurisdiction of the Court is invoked and any presently known objections.

This is a patent infringement case against the City of Oklahoma. It is exclusive Federal jurisdiction. Jurisdiction and venue are properly invoked under 28 U.S.C. §§ 1331, 1338 and 1400.

3. **STIPULATED FACTS**. List stipulations as to all facts that are not disputed, including jurisdictional facts.

1. Title in the '188 Patent is owned by Plaintiff, Tyler Miller and Miller Mendel, Inc. is the exclusive licensee.
2. OKC, through its employees and agents, uses software provided under contract by MMI's competitor Guardian Alliance Technologies, the Guardian Alliance Technologies investigative software platform (the "Guardian Alliance Software").
3. OKC's use of the Guardian Alliance Software occurs in, at least, Oklahoma.
4. The Guardian Alliance Software was obtained by OKC as a result of OKC's November 2017 Request for Proposal 181003 for a Police Applicant Tracking Software for the Oklahoma City Police Department.
5. MMI submitted its eSOPH product in response to the November 2017 RFP 181003, which was evaluated by OKC.
6. OKC had notice of the '188 Patent at least as early as the filing of the original Complaint in this case.
7. OKC has not ceased use of the Guardian Alliance Software.
8. The application date for the '188 Patent is May 26, 2015.
9. The '188 Patent issued on August 7, 2018.

4. **CONTENTIONS AND CLAIMS FOR DAMAGES OR OTHER RELIEF SOUGHT**.

- a. **Plaintiff**: Plaintiff Tyler Miller is the sole and exclusive owner of valid and enforceable U.S. Patent 10,043,188, and is licensed exclusively to Miller Mendel, Inc. Defendant uses a system provided by Guardian Alliance Technologies. Plaintiff contends this constitutes infringement the '188 Patent, directly and/or contributorily and/or by inducement, literally and/or equivalently. Plaintiff contends Defendant is liable for actual damages but no less than a reasonable royalty. Plaintiff contends the infringement to be

willful in that Plaintiff believes Defendant knew or should have known of Plaintiff's patent rights, thus giving rise to exceptional case entitlement.

b. Defendant: Defendant OKC came to use an investigative software platform provided by Guardian Alliance Technologies in November 2017 through Request for Proposal No. 181003. The '188 Patent had not issued at the time Defendant began using the Guardian Alliance Technologies platform. Defendant contends its use of the Guardian Alliance Technologies' investigative software platform does not infringe the '188 Patent directly, contributorily, or by inducement, either literally or equivalently, because such use does not practice each and every elements of any claim of the '188 Patent. In addition to its non-infringement position, Defendant contends the '188 Patent is invalid under at least 35 U.S.C. §§ 101, 102, 103, and 112.

5. **APPLICABILITY OF FED. R. CIV. P. 5.1 AND COMPLIANCE.**

Do any of the claims or defenses draw into question the constitutionality of a federal or state statute where notice is required under 28 U.S.C. § 2403 or Fed. R. Civ. P. 5.1?

Yes No

6. **MOTIONS PENDING AND/OR ANTICIPATED** (include date of filing, relief requested, and date responsive brief to be filed).

No motions are pending at this time. Plaintiffs anticipate a motion for summary or partial summary judgment. Defendant anticipates a motion for judgment on the pleadings, a motion for summary judgment or partial summary judgment, and a motion to stay the proceedings during the pendency following the filing of a petition for *inter partes* review of the '188 Patent in the United States Patent and Trademark Office.

7. **COMPLIANCE WITH RULE 26(a)(1).** Have the initial disclosures required by Fed. R. Civ. P. 26(a)(1) been made? Yes No

The parties have agreed to exchange initial disclosures on May 14, 2019.

8. **PLAN FOR DISCOVERY.**

- A. The discovery planning conference (Fed. R. Civ. P. 26(f)) was held on April 30, 2019.
- B. The parties anticipate that discovery should be completed within 18 months. See No. 14 below for explanation and proposed specialized schedule.

- C. In the event ADR is ordered or agreed to, what is the minimum amount of time necessary to complete necessary discovery prior to the ADR session?

Plaintiffs' position is that ADR will be appropriate following damages discovery. Defendant's position is that ADR may be appropriate prior to damages discovery.

- D. Have the parties discussed issues relating to disclosure or discovery of electronically stored information, including the form or forms in which it should be produced, pursuant to Fed. R. Civ. P. 26(f)(3)(C)?

Yes No

Yes. The parties agree that issues concerning ESI will be addressed in relation to the parties' respective discovery requests and responses thereto, and the parties will work in good faith to produce ESI in a form compatible with the other party's document review system. The parties anticipate filing a proposed stipulated ESI order.

- E. Have the parties discussed issues relating to claims of privilege or of protection as trial-preparation material pursuant to Fed. R. Civ. P. 26(f)(3)(D)?

Yes No

The parties have agreed that, to the extent necessary, the parties will provide privilege logs of responsive communications and information created prior to the initiation of the present suit. Plaintiff asserts that attorney-client communications with patent prosecution counsel, and attorney work product of patent prosecution counsel which was not filed with the USPTO, are covered by privilege.

To the extent the parties have made any agreements pursuant to Fed. R. Civ. P. 26(f)(3)(D) and Fed. R. Civ. P. 502(e) regarding a procedure to assert claims of privilege/protection after production and are requesting that the court include such agreement in an order, please set forth the agreement in detail below and submit a proposed order adopting the same.

- F. Identify any other discovery issues which should be addressed at the scheduling conference, including any subjects of discovery, limitations on discovery, protective orders needed, or other elements (Fed. R. Civ. P. 26(f)) which should be included in a particularized discovery plan.

In addition to the matters addressed in No. 14 below, the parties anticipate filing a joint motion for protective order.

9. **ESTIMATED TRIAL TIME:** 4-5 days
10. **BIFURCATION REQUESTED:** Yes No
11. **POSSIBILITY OF SETTLEMENT:** Good Fair Poor
12. **SETTLEMENT AND ADR PROCEDURES:**
- A. Compliance with LCvR 16.1(a)(1) - ADR discussion: Yes No
- B. The parties request that this case be referred to the following ADR process:
- Court-Ordered Mediation subject to LCvR 16.3
- Judicial Settlement Conference
- Other _____
- None - the parties do not request ADR at this time.
13. **Parties consent to trial by Magistrate Judge?** Yes No
14. **Type of Scheduling Order Requested.** Standard - Specialized (If a specialized scheduling order is requested, counsel should include a statement of reasons and proposal.)

The Parties believe that a specialized order should be entered which includes the following milestones, among others.

- Infringement, non-infringement, and invalidity contentions, and responses thereto
- Identification of claim terms to be construed, exchange of proposed constructions, and claim construction briefing schedule
- Claim Construction Hearing Date
- Claim Construction Discovery Deadline
- Claim Construction Expert Reports (primary and rebuttal) Deadlines
- Factual Discovery Deadline
- Expert Reports (primary and rebuttal) Deadlines

The parties attach a Proposed Scheduling Order which contains the parties' respective proposals.

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