

No.

**United States Court Of Appeals
For The Federal Circuit**

IN RE APPLE INC.,

Petitioner,

ON PETITION FOR A WRIT OF MANDAMUS TO
THE U.S. DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS,
CASE NO. 2:19-CV-00025, JUDGE RODNEY GILSTRAP

**NON-CONFIDENTIAL PETITION AND APPENDIX
FOR WRIT OF MANDAMUS**

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Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Apple Inc. _____ v. _____

Case No. _____

CERTIFICATE OF INTEREST

Counsel for the:

(petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

Apple Inc.

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Apple Inc.	Apple Inc.	Apple Inc.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

Josef Bryks Schenker, Jolene Wang, Ropes & Gray LLP

David Edmond Sipiora, Andrew Nathan Saul, Edward John Mayle, Russell A. Korn, Kilpatrick Townsend & Stockton LLP

Melissa Richards Smith, Gillam & Smith LLP

FORM 9. Certificate of Interest

Form 9
Rev. 10/17

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

Rembrandt Wireless Techs., LP v. Apple Inc., (E.D. Tex. 2:19-cv-00025)
Rembrandt Wireless Techs., LP v. Broadcom Inc., (C.D. Cal. 8:19-cv-708)
Rembrandt Wireless Techs., LP v. Qualcomm Inc., (C.D. Cal. 8:19-cv-705)
IPR2020-00033, IPR2020-00034, IPR2020-00036, IPR2020-00037

1/7/2020

Date

/s/ Douglas Hallward-Driemeier

Signature of counsel

Douglas Hallward-Driemeier

Printed name of counsel

Please Note: All questions must be answered

cc: _____

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Confidential Material Omitted

The material redacted from this brief is subject to a protective order and an order to seal. The confidential information on pages 1, 5, 6, 16, 17, 18, 19, and 28 contains, references, and/or describes Broadcom and Apple employees, details of the supply agreements between Apple and Broadcom, and/or percentages of accused products with chipsets that Apple receives from particular suppliers. This material has been produced and designated by Apple as “Confidential – Attorneys’ Eyes Only,” was filed under seal pursuant to the District Court’s Protective Order dated June 21, 2019, and/or was filed under seal pursuant to the District Court’s Order Granting Apple’s Motion to Seal dated May 23, 2019.

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STATEMENT OF RELATED CASES

Pursuant to Federal Circuit Rule 47.5(a), counsel for Petitioner Apple, Inc. is unaware of any appeal in or from the same proceeding in the United States District Court for the Eastern District of Texas.

Pursuant to Federal Circuit Rule 47.5(b), counsel for Petitioner Apple, Inc. informs the Court that U.S. Patent Nos. 8,457,228 (the “’228 patent”) and 8,023,580 (the “’580 patent”) are asserted in co-pending litigations *Rembrandt Wireless Technologies, LP v. Qualcomm Inc.*, Case No. 19-cv-0705 and *Rembrandt Wireless Technologies, LP v. Broadcom Inc.*, Case No. 19-cv-0708 in the U.S. District Court for the Central District of California filed on April 15, 2019. On November 5, 2019, Apple filed petitions for *inter partes* review against the ’580 Patent in IPR2020-00033 and IPR2020-00034 and against the ’228 Patent in IPR2020-00036 and IPR2020-00037. Counsel is unaware of any other case that may directly affect or be affected by the Court’s decision in this appeal.

CONFIDENTIAL MATERIAL OMITTED

STATEMENT OF JURISDICTION

This Court has jurisdiction to grant mandamus relief under the All Writs Act, 28 U.S.C. § 1651. *See, e.g., In re Link_A_Media Devices Corp.*, 662 F.3d 1221 (Fed. Cir. 2011).

RELIEF SOUGHT

Petitioner Apple Inc. seeks an order directing the district court either to stay proceedings in this case brought in the Eastern District of Texas (“EDTX”) until related matters in the Central District of California (“CDCA”) are resolved, or to transfer the case to CDCA.

ISSUES PRESENTED

In separate suits, with identically worded causes of action, respondent Rembrandt sued Apple and two of its chip suppliers—Broadcom and Qualcomm—alleging infringement by those chips of patents contending to cover Bluetooth technology. Rembrandt sued Broadcom and Qualcomm in California, where relevant evidence and defendant and non-party witnesses are located; it sued their customer, Apple, in Texas, where no relevant evidence or witnesses are located. Together, Broadcom and Qualcomm make █████ of the accused chips in the Apple case. Apple moved to transfer and later to stay the suit against it, to avoid unnecessary duplication of litigation and inconsistent results. The court rejected both motions. The issues presented are:

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1. Did the district court commit legal error by denying Apple’s motion to stay under the customer-suit exception in part because Apple allegedly had “unclean hands” due to seeking *inter partes* review against Rembrandt’s patents-in-suit?

2. Did the district court commit legal error in applying the customer-suit exception by relying on minor differences between the lawsuits, when the doctrine requires only substantial overlap and *potential* to resolve major issues, and despite nearly identical allegations against Apple and its suppliers?

3. Did the district court commit legal error when it denied Apple’s motion to transfer in part because it “cannot consider the existence of the later-filed Rembrandt and Qualcomm lawsuits in its venue analysis”?

4. Did the district court commit a clear abuse of discretion in weighing the public and private factors affecting transfer when it treated EDTX as equally convenient to CDCA, notwithstanding that the fact that *no* witnesses or evidence are in EDTX, whereas *many* non-party witnesses and virtually all evidence regarding the accused chips are present in California, where Rembrandt is litigating duplicative suits?

I. INTRODUCTION

The district court misapplied the law to retain jurisdiction over a case that convenience and judicial economy dictate should be either stayed or transferred to CDCA. Rembrandt's identical claims against chip suppliers Broadcom and Qualcomm in CDCA will be largely, if not entirely, dispositive of Rembrandt's case against Apple, which is sued as their customer. The customer-suit exception was developed for just this situation. Either stay or transfer would allow Rembrandt to pursue its infringement allegations in its chosen venue against the suppliers. Either stay or transfer would likewise avoid the duplication of effort, the need for Apple to litigate far from the relevant evidence without the benefit of compulsory process, and the risk of inconsistent results in proceeding with these suits simultaneously. By artificially and erroneously cabining each inquiry, the district court reached the *least* efficient outcome. This Court should issue a writ of mandamus to correct the district court's errors.

II. STATEMENT OF FACTS

A. **Rembrandt Sued Chip Manufacturers Broadcom and Qualcomm in California, Shortly After Suing Their Customer Apple in Texas Under The Same Infringement Theory**

In rapid succession, Rembrandt filed three lawsuits in two different states that collectively address whether Broadcom and Qualcomm Bluetooth chips infringe the asserted patents. On January 24, 2019, Rembrandt sued Apple in EDTX for

allegedly infringing three asserted claims from the '228 and '580 patents. Appx100-104. Rembrandt accuses Apple products—including iPhones, iPads, iPods, Watches, headphones, and other products (the “Accused Products”)—that incorporate Broadcom and Qualcomm chips of practicing the Enhanced Data Rate (“EDR”) functionality under certain Bluetooth specifications. Appx100-101 (¶29). The case is proceeding through discovery and claim construction, with trial currently set for June 2020. *See* Appx26; Appx1938-1941.

On April 15, 2019, Rembrandt filed separate suits against Broadcom and Qualcomm in CDCA, asserting the same patents and accusing the same chip-based functionality. *See* Appx123-127; Appx143-147. Rembrandt asserts that each defendant’s chips infringe the same asserted claims because they practice EDR under the same Bluetooth specifications. Appx123, Appx126, Appx143, Appx146. Rembrandt’s pleaded theory of infringement is identical across all three cases: “the manufacture, use, sale, importation, exportation, and/or offer for sale of products practicing any of the following Bluetooth specifications that support Enhanced Data Rate (‘EDR’): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5.” Appx100 (¶28); Appx123 (¶27); Appx143 (¶28). Though not formally related, the California litigations are on the same schedule, proceeding through discovery and claim construction, with trials scheduled for late October 2020 in Santa Ana, California. Appx1609; Appx1613.

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On November 5, 2019, Apple filed petitions for *inter partes* review (“IPR”) against Rembrandt’s asserted patents. IPR2020-00033, -00034, -00036, -00037. Rembrandt’s pre-institution responses are due February 13, 2020.

B. The Apple Litigation Has No Connection to EDTX

Neither Rembrandt nor Apple has any relevant witnesses, documents, or facilities in Texas, but most of that evidence is in California. Approximately [REDACTED] of Apple’s Accused Products allegedly infringe because they contain Broadcom or Qualcomm chips.¹ Apple lacks witnesses knowledgeable about the technical details of those chips and will need to rely on the suppliers’ non-party witnesses. Appx186 (¶11). For those Accused Products incorporating [REDACTED] chips, [REDACTED] has [REDACTED]. Appx314. Almost all sources of proof associated with Broadcom or Qualcomm² are located in California. Broadcom’s headquarters are in San Jose, CA, with a large facility and employees knowledgeable about Bluetooth EDR functionality in Irvine, CA (within CDCA). Appx185-186 (¶¶6-7, 10). Specifically, Broadcom employee Burhan Masood works with products containing Bluetooth technology, including those provided by Broadcom to Apple, and “understand[s] the various capabilities of the Bluetooth Specifications, including

¹ More specifically, [REDACTED] contain Broadcom-designed Bluetooth chips, [REDACTED] have Qualcomm-designed chips, and only [REDACTED] hold Apple-designed chips. Appx1524.

² Some of Qualcomm’s documents are located in the United Kingdom. Appx179-181 (¶¶14, 23).

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those pertaining to Bluetooth EDR.” Appx1353. Also, Broadcom employee [REDACTED] is “intimately familiar with the low-level architecture and operations of the Broadcom Bluetooth chips implicated in this dispute.” *Id.* Steven Hall, Broadcom’s former Technical Director involved in development of Broadcom chipsets, is also located in California. Appx186 (¶14); Appx226; Appx230.

Only [REDACTED] of the Apple Accused Products use a Bluetooth EDR chip designed by Apple, Appx1524; Appx178-179 (¶13), and Apple agreed to apply any infringement rulings against the Broadcom chips to its own chips. Even for its own chips, Apple has no documents, employees, or facilities involved in design, development, or implementation of the Accused Functionality in the Accused Products in Texas. Appx180-182 (¶¶20-21, 27-28). Apple employees who worked on EDR functionality, have relevant documents, or were involved in sales and marketing of the accused chips are near Cupertino and Culver City, CA. Appx176 (¶6). These witnesses include Michael Jaynes, finance employee knowledgeable on sales and financial information; [REDACTED], Bluetooth Engineering Software Manager; [REDACTED], Senior Director of Engineering; and [REDACTED], Product Marketing Manager. Appx180-181 (¶¶22-24). Apple employees in Israel worked on Bluetooth in developing one Apple chip included in one Accused Product, as part of a team based in and directed from Cupertino. Appx1359-1361 (¶¶9-12).

Rembrandt's sources of proof also lie outside Texas, either at its headquarters and attorneys' offices in Pennsylvania, or with named inventor Gordon Bremer in Florida. *E.g.*, Appx88 (¶1); Appx1198-1199. Paul Castor, a non-party witness who worked for Zhone Technologies, which previously owned the asserted patents, is located in California and may have information on conception, reduction to practice, or the destruction of evidence thereof. Appx221; Appx214; *In re Rembrandt Techs. LP Patent Litig.*, 899 F.3d 1254, 1261-62, 1268 (Fed. Cir. 2018). In short, no relevant documents, witnesses, or facilities are located in Texas, but the vast majority of evidence is in California (including within CDCA), where Broadcom, Qualcomm, and Apple are located.

C. The District Court Refused To Transfer or Stay This Case, Despite Duplicative Litigation in California

On May 22, 2019, before substantive discovery, Apple moved to transfer the case to CDCA, based on the California litigations. *See* Appx23. The transfer motion was fully briefed by August 19, 2019. *See* Appx24. On November 1, 2019, with the transfer motion unresolved, Apple moved to stay this case under the customer-suit exception, contending that Rembrandt's litigation against its suppliers should take precedence. Appx25; Appx1508-1509. As contemplated under the customer-suit exception, Apple filed a proposed stipulation, agreeing to be bound on issues of infringement and validity for the Accused Products with an Apple or Broadcom chip "by the final outcome in the litigation between Rembrandt and Broadcom" and

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similarly for those with a Qualcomm chip “by the final outcome in the litigation between Rembrandt and Qualcomm.” Appx1604-1605.

On November 27, 2019, the district court issued separate opinions refusing to transfer or stay the action. Appx1, Appx9. The court posited that a stay was inappropriate under the customer-suit exception because, based on Apple’s IPR petition, “Apple does not seek to remove the burdens of litigation from itself” and “has made it impossible for this Court to remove such burden.” Appx11. According to the court, filing IPR petitions deprived Apple of “clean hands” and “violate[d] the express purpose of the customer-suit exception.” Appx12. Without considering that Rembrandt brought suit in CDCA , the court found that a stay would unfairly deprive Rembrandt of its chosen forum. *Id.*

The district court also found the customer-suit exception inapplicable. Appx12, Appx14-15. Specifically, the court found that Apple was not a “mere reseller” eligible for the customer-suit exception because: (1) Apple manufactures its own chips incorporated into the Accused products; and (2) Apple’s source code and manner of incorporating the Broadcom and Qualcomm chips could be relevant to infringement. Appx13-14. The court further found that Apple’s stipulation to be bound by the California litigations would deprive Rembrandt of arguments and theories of infringement applicable only to Apple. Appx13, Appx15. Although the court acknowledged that Rembrandt’s infringement contentions allege that the

Broadcom and Qualcomm chipsets practice publicly available Bluetooth standards, it theorized that Rembrandt could amend those contentions upon receipt of Apple's source code. Appx14-15. Finally, the district court found that Rembrandt's allegations of indirect infringement in the California litigations differentiated them from this suit. Because a stay under the customer-suit exception in favor of the California litigations may not entirely resolve this case, the court denied Apple's motion for a stay.

The court also rejected the obvious alternative to stay—transferring the case to CDCA, gaining efficiencies by allowing Rembrandt's cases to proceed simultaneously. The court reached that illogical result by artificially limiting its analysis to “the situation which existed when suit was instituted”—in other words, by refusing to consider the efficiencies of coordinating the supplier and customer suits before the same court. Appx3 (quoting *Hoffman v. Blaski*, 363 U.S. 335, 343 (1960)).

Notwithstanding that the vast bulk of relevant evidence is in California, no evidence is in Texas, and any remaining evidence is abroad or on the East Coast, the court nonetheless found that EDTX was “roughly equally convenient to all of these sources of proof.” Appx4. Ignoring that *no witnesses or evidence of either party reside in EDTX*, the court concluded that the convenience of the witnesses and parties weighed against transfer because any increased convenience to “Apple and

its potential witnesses would work a commensurate inconvenience on Rembrandt and its potential witnesses.” Appx6. Because it refused to consider the later-filed suits, the court assessed this factor without considering that Rembrandt’s witnesses would *already* need to travel to CDCA for the supplier litigations. Further, notwithstanding its acknowledgement that Broadcom and Qualcomm employees were generally subject to compulsory process in CDCA, and not EDTX, the court concluded that compulsory process only slightly favored transfer on the purported ground that “Apple does not identify” any such specific witnesses. Appx5.

Reasoning that “[v]enue is determined at the time of the filing of the action,” the court categorically refused to consider the co-pending but later-filed California litigations in its analysis of the judicial economy factor as well, crediting instead its own prior experience with the asserted patents in litigation against a different consumer electronics company. Appx6 (citing *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, No. 2:13-cv-312-JRG (E.D. Tex.)). Additionally, the district court ruled that California had no local interest in resolving the dispute, despite Broadcom’s and Qualcomm’s presence there. Appx7. Finding that most relevant factors disfavored transfer, the court denied Apple’s motion.

As a result of the district court’s decisions, the Apple and California litigations continue to proceed in parallel. Both district courts are in the midst of claim construction, which could result in disparate, competing constructions of the same

terms. Additionally, the Texas and California cases are scheduled for separate trials in 2020 only three months apart.

III. STANDARD OF REVIEW

A writ of mandamus is proper if: (1) the right to issuance of the writ is clear and indisputable; (2) there is no other adequate means to attain the relief; and (3) this Court is satisfied that the writ is appropriate under the circumstances. *Cheney v. U.S. Dist. Court for D.C.*, 542 U.S. 367, 380 (2004). Mandamus may be employed to correct “a clear abuse of discretion or usurpation of judicial power.” *In re Link*, 662 F.3d at 1222. Abuse of discretion exists when the district court “relies on an erroneous conclusion of law” or makes “clearly erroneous” findings. *In re EMC Corp.*, 677 F.3d 1351, 1355 (Fed. Cir. 2012); *Minn. Mining and Mfg. Co. v. Norton Co.*, 929 F.2d 670, 673 (Fed. Cir. 1991). Mandamus may be used to contest a patently erroneous error denying transfer or stay. *See, e.g., In re EMC*, 677 F.3d at 1354; *In re Nintendo of Am., Inc.*, 756 F.3d 1363, 1364-65 (Fed. Cir. 2014); *In re Google, Inc.*, 588 F. App’x 988, 991-92 (Fed. Cir. 2014).

IV. REASONS THE WRIT SHOULD ISSUE

“[U]nder the doctrine of comity, when cases involving substantially overlapping issues are pending before two federal district courts, there is a strong preference to avoid duplicative litigation.” *In re Google*, 588 F. App’x at 990 (citations omitted). Despite the substantial overlap between the three cases and the

convenience of CDCA to the litigants and non-parties, the district court denied *both* Apple's motion to stay the case pending the Broadcom and Qualcomm cases *and* its motion to transfer the customer suit to CDCA, to be litigated with the supplier suits. The court arrived at that highly counter-intuitive result only through numerous errors of law. This Court should correct those errors and order the district court either to stay or transfer the present case to CDCA to avoid the wasteful duplication of effort and risk of inconsistent results from litigating customer and supplier suits simultaneously, in different jurisdictions.

MOTION TO STAY

A. The District Court Committed Legal Error in Denying a Stay Based on Apple's Supposed Lack of "Clean Hands" for Having Filed IPR Petitions.

The district court committed clear legal error by penalizing Apple for exercising its statutory right to seek *inter partes* review. The court's cited authority, *Keystone Driller Co. v. Gen. Excavator Co.*, does *not* hold that pursuing multiple lawsuits (which Apple did not do) creates unclean hands, but instead involved the manipulation and suppression of evidence in one lawsuit to obtain a favorable outcome in another. 290 U.S. 240, 242-43, 246-47 (1933). It has no application here.

Seeking the PTAB's review of a patent's validity is not an "unconscionable act" or "misconduct" that would trigger unclean hands. *See id.* at 245. Alleged

infringers have a statutory right to seek IPR, and should not be penalized for exercising that right. 35 U.S.C. § 311. To the contrary, the AIA intended “to encourage ‘coordination between district court infringement litigation and inter partes review to reduce duplication of efforts and costs.’” *The Lincoln Elec. Co. v. Seabery Soluciones*, No. 1:15-cv-1575, 2017 WL 159132, at *1 (N.D. Ohio Jan. 13, 2017) (citation omitted). The district court’s order subverts that purpose.

The court denied the stay because it would not “relieve Apple of the burdens of litigation,” but then adopted a course contrary to efficiency and judicial economy: requiring the parties to litigate multiple cases in multiple districts, in addition to the PTAB. Appx12. Rather than embrace the benefit of eliminating a duplicative district court proceeding, the court erroneously reasoned that stay was inappropriate unless it wholly resolves the prospect of multiple fora. Moreover, the district court ignored Rembrandt’s own responsibility in multiplying litigation by suing Apple, Broadcom, and Qualcomm in different fora. *See supra* Part II.A. Staying this case will allow the CDCA’s and PTAB’s decisions to substantially (if not fully) resolve the issues before the court, as the customer-suit exception and AIA intended. In contrast, affirming the district court’s finding of “unclean hands” simply for filing IPRs would have a chilling effect on IPRs and undermine Congress’s purpose in enacting the AIA.

B. The District Court Committed Legal Error by Applying the Customer-Suit Exception Too Narrowly and Disregarding the Extensive Overlap Between the EDTX and CDCA Litigations.

1. *The customer-suit exception does not require precisely coextensive litigation, but merely “substantial overlap.”*

The customer-suit exception is “designed to facilitate just, convenient, efficient, and less expensive determination” of the lawsuit. *In re Nintendo*, 756 F.3d at 1365. The exception recognizes that “litigation against or brought by the manufacturer of infringing goods takes precedence over a suit by the patent owner against customers of the manufacturer.” *Katz v. Lear Siegler, Inc.*, 909 F.2d 1459, 1464 (Fed. Cir. 1990). Respecting this precedence, “courts apply the customer suit exception to stay earlier-filed litigation against a customer while a later-filed case involving the manufacturer proceeds in another forum.” *Spread Spectrum Screening LLC v. Eastman Kodak Co.*, 657 F.3d 1353, 1357 (Fed. Cir. 2011). By staying the initial suit against the retailer, the court conserves judicial resources and allows for “comprehensive disposition” of both cases, as the outcome of the manufacturer suit will generally resolve or simplify the issues in the retailer suit. *William Gluckin & Co. v. Int’l Playtex Corp.*, 407 F.2d 177, 179 (2d Cir. 1969).

“Wise judicial administration . . . does not counsel rigid mechanical solution of” the customer-suit exception, but rather counsels a “flexible approach.” *Id.*; see also *Colo. River Water Conservation Dist. v. United States*, 424 U.S. 800, 817 (1976). The district court eschewed this flexible approach when it instead applied a

rigid “mere reseller[]” standard. Appx11. The court believed the customer-suit exception inapplicable unless “the consumers in the first-filed action are mere resellers of products manufactured by the party in the second-filed action,” *id.* (quoting *Glob. Equity Mgmt. (SA) Pty. Ltd. v. Ericsson, Inc.*, No. 2:16-cv-618-RWS-RSP, 2017 WL 365398, at *5 n.3 (E.D. Tex. Jan. 25, 2017))—a standard the court applied quite strictly.

The customer-suit exception evaluates the relationship between the customer and manufacturer lawsuits more generally, to see if there is sufficient “overlap” that the latter might significantly narrow the former. A rigid “mere reseller” test ignores this Court’s clarification that “the manufacturer’s case need only have the potential to resolve the ‘major issues’ concerning the claims against the customer—not every issue—in order to justify a stay of the customer suits.” *Spread Spectrum*, 657 F.3d at 1358 (citing *Katz*, 909 F.2d at 1464). Thus, the customer-suit exception applies when there is “substantial overlap” between the cases or when a stay would likely result in “substantial savings of litigation resources.” *See In re Google*, 588 F. App’x at 990-91 (ordering district court stay proceedings due to “substantial similarity involving the infringement and invalidity issues” between manufacturer and retailer suits). The court must also consider “the comparative convenience of both venues for resolving the matter.” *Id.* By applying an inflexible “mere reseller” test and treating minor differences between the Apple and California litigations as

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dispositive, the court disregarded this Court’s instruction and committed clear legal error.

2. *The California litigations will be dispositive as to the vast majority of Apple products, which use Broadcom and Qualcomm chips.*

There is no legitimate question that the California and Texas lawsuits satisfy this Court’s standard. The Apple and California litigations substantially overlap because Apple incorporates into the Accused Products the Broadcom and Qualcomm chipsets targeted by Rembrandt’s infringement contentions. *E.g.*, Appx1524 (¶5). Approximately █████ of Apple’s Accused Products contain a chipset with Bluetooth EDR functionality designed by Broadcom, and an additional █████ contain a chipset with Bluetooth EDR functionality designed by Qualcomm. *Id.*; *see also* Appx178 (¶¶11-12); Appx186 (¶11). Moreover, because Apple has stipulated to be bound by the final outcome of the California litigations, Appx1604-1605, findings on Broadcom’s and Qualcomm’s alleged infringement will be dispositive of findings on Apple products incorporating those Bluetooth chips. *In re Google*, 588 F. App’x at 990 (finding that “significant overlap undermine[d] the district court’s main premise in rejecting a stay”). As in *Google*, where the customer-suit exception applied because infringement by defendants turned on whether the source code for Google’s Android platform as installed on their phones provided the infringing functionality, here the exception likewise applies because infringement turns on

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whether the Broadcom and Qualcomm chipsets incorporated in Apple's phones provide the infringing EDR functionality. *Id.* Indeed, the allegations in all three complaints are identical. *Compare* Appx100-105 (¶¶28, 30-31, 36-38) *with* Appx143-147 (¶¶28, 30-31, 36-38) *and* Appx123-127 (¶¶27, 29-30, 35-37).

Moreover, [REDACTED] has [REDACTED] [REDACTED] making this a quintessential case where the manufacturer—not the retailer—is at the heart of the suit. *See Katz*, 949 F.2d at 1464. And, to maximize efficiency and judicial economy, Apple has agreed to be bound by the outcome of the California litigations. Appx1604-1605. Even without that agreement, though, staying the case under the customer-suit exception would resolve the substantially overlapping issues between the Apple and California litigations.

The district court's mere speculation that the Accused Products may infringe due to the way Apple installed the chipsets, rather than due to the capabilities of the chipsets, is insufficient to deny a stay. Appx14. Apple provided ample evidence that Broadcom and Qualcomm design and develop the accused functionality. *E.g.*, Appx178 (¶¶11-12); Appx186 (¶11). At the very least, the CDCA litigation has the "the *potential* to resolve the 'major issues' concerning the claims against the customer." *Spread Spectrum*, 657 F.3d at 1358 (emphasis added). The district court's speculation that some yet-unasserted theories might remain cannot defeat a stay.

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The district court also denied the motion to stay because Rembrandt alleged direct infringement against Apple for “making and selling infringing products that incorporate” Broadcom’s and Qualcomm’s chipsets, but alleged indirect infringement against the manufacturers for “selling their chipsets” to Apple. Appx15-16. The court relied on *Erfindergemeinschaft Uropep GbR v. Eli Lilly & Co*, which found that the customer-suit exception “conventionally applied to manufacturers and retailers who are both alleged to be direct infringers of an apparatus claim,” but that it did not apply “to cases in which the manufacturer is charged as the indirect infringer of a method patent and the retailer is charged as the direct infringer.” No. 2:15-cv-1202-WCB, 2016 WL 1659924, at *4 (E.D. Tex. Apr. 26, 2016). Here, however, Rembrandt accuses Apple, Broadcom, and Qualcomm of *direct* infringement of *apparatus* claims, Appx100 (¶28); Appx103 (¶36); Appx 143 (¶28); Appx146 (¶36); Appx123 (¶27); Appx126 (¶35), and Apple has agreed to be bound by final judgments against Broadcom and Qualcomm in the California litigations. Appx1604-1605. Thus, the California litigations will resolve Rembrandt’s allegations of infringement against Apple.

3. *The California litigations will further resolve and narrow issues for Apple’s remaining products, which use Apple chips.*

Through the stipulation, Apple agreed to be bound by the outcome of the Broadcom suit for the approximately [REDACTED] of the Accused Products that contain chips made by Apple. Appx1524. The district court found this “unreasonable,” but

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ignored that the customer-suit exception would *narrow* the remaining issues before the court, regardless of whether the [REDACTED] of Apple chips require further adjudication. *Katz*, 909 F.2d at 1464 (affirming injunction ceasing prosecution of action against customers despite potential need to resolve “additional issues,” because “prosecution will be advanced...and may well be mooted”). For instance, the California litigations’ decisions on validity may dispose of the case altogether, including as to Accused Products with Apple chips. Even if the CDCA resolution is limited to [REDACTED] of chips, the resolution would significantly benefit judicial efficiency by limiting the evidence and arguments needed for the remaining [REDACTED].

The district court erroneously found that “the presence of the Apple-manufactured chipsets proves fatal to the customer-suit analysis.” Appx13. Again, this rigid analysis misapplies the customer-suit exception. The district court’s decision to allow the tail of Rembrandt’s claims on the Apple manufactured chips ([REDACTED]) to wag the dog of Rembrandt’s claims on Broadcom and Qualcomm chips ([REDACTED]) is not an efficient use of judicial resources. *See Google*, 588 F. App’x at 991-92 (granting mandamus “[b]ecause the Eastern District of Texas’ orders frustrate the comity doctrine, requiring two federal district courts and the parties to expend resources to resolve substantially similar claims and issues”) (citing *Cheney*, 542 U.S. at 380-81).

The district court committed legal error by applying an inflexible construction of the customer-suit exception to conclude that the exception would provide no benefit to judicial economy and did not apply here simply because there was some risk the California litigations would not resolve every issue of the Apple litigation. This Court should correct that error.

MOTION TO TRANSFER

The district court compounded its errors regarding the stay by refusing to transfer. The very concerns that led the court to reject a stay, including that the Apple suit would not be fully resolved, should have led it instead to transfer. But the court refused to consider the efficiency gains from the pending supplier suits in its transfer analysis. By unduly cabining its analysis of each motion, the court reached the least efficient outcome.

“For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to another district court or division where it might have been brought.” 28 U.S.C. § 1404(a). Section 1404(a) “should be construed to prevent parties who are opposed to a change of venue from defeating a transfer which, but for their own deliberate acts or omissions, would be proper, convenient, and just.” *In re Hoffman-La Roche Inc.*, 587 F.3d 1333, 1337 (Fed. Cir. 2009) (quotation omitted).

To review the district court’s ruling on a motion to transfer, the Federal Circuit applies the law of the regional circuit, here the Fifth Circuit. *In re Link*, 662 F.3d at 1222-23. In granting mandamus, the Fifth Circuit has found certain errors to be a clear abuse of discretion, including that the district court “(1) applied too strict of a standard to demonstrate transfer, (2) misconstrued the weight of plaintiff’s choice of venue, (3) treated choice of venue as a § 1404 factor, [and] (4) misapplied the *forum non conveniens* factors.” *In re TS Tech USA Corp.*, 551 F.3d 1315, 1321-22 (Fed. Cir. 2008) (citation omitted); *see also Hoffman-La Roche*, 587 F.3d at 1336 (noting “clear and indisputable right” to transfer justifies mandamus).

C. The District Court Legally Erred by Refusing to Consider the Later-Filed Broadcom and Qualcomm Cases in Assessing Transfer

The district court erroneously held that “[it] cannot consider the existence of the later-filed Rembrandt [sic] and Qualcomm lawsuits in its venue analysis.” Appx6. Though the court must restrict its analysis to facts at the time of filing to determine whether a case *could have been brought* in that venue, *Hoffman*, 363 U.S. at 343, nothing prohibits the consideration of post-filing facts to decide whether judicial economy favors transfer to an appropriate venue. Indeed such a prohibition would lead to absurd results, including, as this case illustrates, the denial of transfer despite the efficiencies to be gained by having the same court adjudicate suits filed in close succession and asserting identical infringement theories. By failing to consider the ongoing but slightly later-filed California litigations, the district court

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committed legal error constituting a clear abuse of discretion in denying the motion to transfer.

1. *The district court incorrectly relied on Hoffman v. Blaski for the proposition that transfer determinations must ignore later-filed actions.*

The threshold inquiry to ensure that the transferee district is one “where [the suit] might have been brought,” 28 U.S.C. § 1404(a), must be made based on facts at the time of filing. *See In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004) (“[T]he first determination to be made [in applying § 1404(a)] is whether the judicial district to which transfer is sought would have been a district in which the claim could have been filed.”). However, nothing limits the second step—analysis of convenience under public/private factors—to facts at the time of filing. Indeed, such a rule would contradict the established principle, reflected in the customer-suit exception, that, “under the doctrine of comity, when cases involving substantially overlapping issues are pending before two federal district courts, there is a strong preference to avoid duplicative litigation.” *In re Google*, 588 F. App’x at 990.

Hoffman addressed the threshold issue of a transfer motion under § 1404(a), which focused on the statutory test whether the case “might have been brought” in the transferee venue. *See Hoffman*, 363 U.S. at 343 (“But we do not see how the conduct of a defendant after suit has been instituted can add to the forums where it might have been brought.”) (quotation omitted). There, venue was improper in the

transferee court at the time of filing, but petitioners contended that between filing the action and the motion to transfer, a post-filing event (such as a change in residence) could establish proper venue. *Id.* at 342. The Supreme Court held: “We do not think the § 1404(a) phrase ‘where it might have been brought’ can be interpreted to mean, as petitioners’ theory would require[], ‘where it may now be rebrought, with defendants’ consent.’” *Id.* at 342-43.

But no equivalent textual rule prohibits considering post-filing facts as part of the convenience analysis. Indeed, post-filing actions regularly affect the motion to transfer analysis. As this Court has observed, later-filed, co-pending litigation may provide “substantial justification” to maintain venue in the same court as the co-pending litigation. *In re Vistaprint, Ltd.*, 628 F.3d 1342, 1346 (Fed. Cir. 2010) *denying pet’n for mandamus, ColorQuick, LLC. v. Vistaprint Ltd.*, No. 6:09-CV-323, 2010 WL 5136050, at *8 (E.D. Tex. July 22, 2010) (considering co-pending case filed five months after underlying litigation in judicial economy analysis). Similarly, post-filing actions such as a long delay in seeking transfer or the “significant expenditure of party and judicial resources” can weigh against transfer. *Diem LLC v. BigCommerce, Inc.*, No. 6:17-CV-00186-JRG, 2017 WL 6729907, at *5 (E.D. Tex. Dec. 28, 2017) (collecting cases). Indeed, this Court has specifically indicated that the customer-suit exception, which necessarily considers later-filed litigation, can provide a basis to transfer. *See In re Nintendo*, 756 F.3d at 1365

("[T]he customer-suit exception . . . and § 1404(a) are all designed to facilitate just, convenient, efficient, and less expensive determination.").

2. *Failure to consider ongoing litigation during a motion to transfer risks contradictory results and unnecessary inconvenience to litigants and non-party witnesses.*

The district court's rigid analysis ignores the "common-sense approach" to interpreting § 1404(a) endorsed by the Supreme Court, and risks "the kind of mischievous consequences against 'the interest of justice' that § 1404(a) was designed to prevent, that is, unnecessary inconvenience and expense to parties, witnesses, and the public." *Cont'l Grain Co. v. The Barge FBL-585*, 364 U.S. 19, 21 (1960). This principle weighs so heavily that in *Continental Grain*, the Supreme Court transferred the second-filed case, an action *in rem* that could not have been brought elsewhere, to the venue of the first-filed action. Transfer was appropriate because, as here, the cases involved "precisely the same issues" and the same witnesses. Allowing these cases to proceed "in different District Courts [may] lead[] to the wastefulness of time, energy and money that § 1404(a) was designed to prevent," *id.* at 26, and may result in conflicting rulings, including on claim construction and evidentiary issues, and even conflicting verdicts on infringement and invalidity.

The § 1404(a) factors are neither exhaustive nor exclusive, *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008), and the district court should have

evaluated the importance of nearly identical litigation. By applying a rigid rule against considering post-filing events, the court avoided considering how the pending California litigations affected the judicial economy analysis. The court erroneously refused to stay the case, because of the risk that some portion of the case would be unresolved. Yet, the court also refused to take the logical next step—transfer the case to CDCA, so that both the overlapping and distinct issues could be resolved together consistently. *See In re Nintendo*, 756 F.3d at 1365. Other courts have done precisely that. *See e.g., Ricoh Co., Ltd. v. Aeroflux Inc.*, 279 F. Supp. 2d 554, 557-58 (D. Del. 2003) (transferring earlier filed suit based on customer-suit exception and effect of later-filed suit on convenience in § 1404(a) analysis). The court here refused to do so only because it improperly cabined its inquiry.

D. By Ignoring the Substantial Inconvenience to the Parties and Non-Party Witnesses of Proceeding with Three Cases in Two Fora and by Overemphasizing Its Own Location, Experience, and Interest, the District Court Clearly Abused its Discretion in Considering the § 1404(a) Factors.

Despite the substantial overlap between the Texas and California litigations and the concentration of evidence and witnesses in California, the district court found that only a single factor in the § 1404(a) analysis—availability of compulsory process—weighed “only slightly in favor of transfer,” and that all the other factors either weighed against transfer or were neutral. Appx5. The court reached this conclusion as the result of multiple errors. As noted, the court refused to consider

the pending supplier suits. Moreover, the court applied the standard for *dismissal* for improper venue under Fed. R. Civ. P. 12(b)(3), rather than for a motion to transfer for convenience under § 1404(a), and incorrectly drew “all reasonable inferences and resolve[d] factual conflicts in favor of the non-moving party.” Appx3³; *see In re Volkswagen*, 545 F.3d at 308-09 (“[A] plaintiff’s choice of forum under the *forum non conveniens* doctrine is weightier than a plaintiff’s choice of venue under § 1404(a) because the former involves the outright dismissal of a case, and the latter involves only a transfer of venue within the same federal forum.”); *see also Norwood v. Kirkpatrick*, 349 U.S. 29, 32 (1955) (By enacting § 1404(a), Congress did “more than just codify the existing law on forum non conveniens” and “intended to permit courts to grant transfers upon a lesser showing of inconvenience.”).

“Section 1404(a) is intended to place discretion in the district court to adjudicate motions for transfer according to an ‘individualized, case-by-case consideration of convenience and fairness.’” *Stewart Org., Inc. v. Ricoh Corp.*, 487 U.S. 22, 29 (1988) (quoting *Van Dusen v. Barrack*, 376 U.S. 612, 622 (1964)). Drawing all factual inferences against the moving party “would impoverish the

³ For this standard, the court relied on a decision “considering a Rule 12(b)(3) motion” to dismiss for lack of venue. *Cooper v. Farmers New Century Ins. Co.*, 593 F. Supp. 2d 14, 18-19 (D.D.C. 2008). The court also relied on *Sleepy Lagoon*, which also drew its standard from cases involving the 12(b)(3) standard. *See, e.g., Sleepy Lagoon, Ltd., v. Tower Grp., Inc.*, 809 F. Supp. 2d 1300, 1306 (N.D. Okla. 2011); *Audi AG v. Izumi*, 204 F. Supp. 2d 1014, 1017 (E.D. Mich. 2002).

flexible and multifaceted analysis that Congress intended to govern motions to transfer.” *Id.* at 31 (discussing error in “focusing on a single concern or a subset of factors”). Although this Court has not been directly addressed the question, precedent strongly suggests that a district court can and must resolve disputed factual questions when essential to one or more of the transfer factors. *See Cont’l Grain*, 362 U.S. at 26 (Under § 1404(a), “the trial judge can, *after findings*, transfer the whole action to the more convenient court.” (emphasis added)); *In re LimitNone, LLC*, 551 F.3d 572, 577 (7th Cir. 2008) (“District courts [addressing § 1404(a) motions] are permitted, indeed, in some instances required, to make whatever factual findings are necessary prior to issuing a preliminary order.”); *Hustler Magazine, Inc. v. U.S. Dist. Ct.*, 790 F.2d 69, 71 (10th Cir. 1986) (faulting district court for “fail[ing] to give air to those facts which the petitioners assert entitle them to a transfer of the place of trial”). Indeed, this Court regularly addresses facts in transfer cases without stacking the deck against defendants, as the district court here did below. *See, e.g., In re Apple*, 581 F. App’x 886, 888-89 (Fed. Cir. 2014) (faulting district court for ignoring relevant evidence); *In re Nintendo Co., Ltd.*, 589 F.3d 1194, 1198-99 (Fed. Cir. 2009).

Because it started with the wrong standard and refused to consider the later-filed suits, the district court ignored important facts: the specific non-party witnesses located in California; the convenience of CDCA to Rembrandt, which chose to

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litigate against Broadcom and Qualcomm there; the inconvenience of EDTX given the lack of evidence or parties in or near the forum; CDCA's interest in resolving a dispute involving companies located in its district; and CDCA's experience with the patents-in-suit. Consequently, the court failed to engage in the individualized, case-specific analysis of the § 1404(a) factors. *See In re Genentech*, 566 F.3d 1338, 1348 (Fed. Cir. 2009) (finding clear abuse of discretion for mandamus when district court "glossed over" factors in its analysis and "rigidly applied the law to prevent transfer to the more convenient forum").

1. *Because a substantial number of witnesses are outside the compulsory process power of EDTX, this factor strongly weighs in favor of transfer.*

The district court ignored the existence of multiple non-party witnesses within CDCA's subpoena power, and EDTX's lack of any subpoena power over such witnesses. The district court incorrectly found that Apple failed to identify with particularity witnesses subject to compulsory process in CDCA. Appx5. Apple specifically identified several non-party witnesses: Burhan Masood, Broadcom's Engineer Program Manager in Irvine, California; and [REDACTED], Senior Director of Broadcom's Bluetooth Software Team; Steven Hall, former Technical Director at Broadcom involved in developing Broadcom chipsets; and Paul Castor, former Zhong General Counsel involved in destroying documents concerning the patents-

in-suit.⁴ *Supra* Part II.B. Located in San Diego, these witnesses are less than 100 miles from Santa Ana where the California litigations are proceeding. Appx28, Appx37, Appx249; *see* Fed. R. Civ. P. 45(c)(1); . Apple provided further evidence that non-party witnesses from Broadcom and Qualcomm would have information regarding the design of the accused chipsets necessary for the court’s infringement analysis. Appx158-159 (citing *e.g.*, Appx178-181 (¶¶11-12, 14, 23); Appx185-187 (¶¶9-10, 12, 16)); Appx167-168 (citing Appx180-181 (¶¶22-24)); *see also* Appx112-113 (¶¶5-7); Appx132-133 (¶¶6-8). The district court identified no relevant witness located in Texas. *See* Appx4-5. Consequently, this factor weighs strongly in favor of transfer.

2. *With the vast majority of evidence in California and other witnesses far flung from both potential venues, the convenience of the witnesses and parties also weighs in favor of transfer.*

Despite the inconvenience of EDTX and the relative convenience of CDCA to the parties’ and non-parties’ sources of proof, located primarily on the West and East Coasts, the District Court found that EDTX to have a “roughly equally convenient” location that weighed against transfer. Appx4. The district court incorrectly found that transfer “would raise a commensurate inconvenience on Rembrandt’s sources of proof” and “its potential witnesses.” Appx3-4, Appx6. The

Contrary to Apple’s evidence that neither Hall nor Castor could “be counted on to travel from [their] home[s] near San Diego, Ca. to EDTX,” Appx165, the Court assumed they were “willing witnesses.” Appx5.

court held so only by ignoring that Rembrandt voluntarily filed the California litigations against Broadcom and Qualcomm in CDCA. *Supra* Part II.A. Thus, CDCA is a convenient forum for Rembrandt. *See Dyson, Inc. v. Maytag Corp.*, No. 06-cv-6576(DLC), 2006 WL 2884921, at *2 (S.D.N.Y. Oct. 11, 2006) (forum where plaintiff chose to bring patent litigation claims was not inconvenient for separately filed Lanham Act claims).

Given the distance between EDTX and Rembrandt's sources of proof on the East Coast, Appx4, transfer to CDCA would not substantially increase the inconvenience to Rembrandt. Indeed, here such a transfer would avoid the duplication of effort and decrease the burden on witnesses because Rembrandt would not need to present the same evidence and testimony in separate fora. In contrast, transfer would substantially increase the convenience to Apple's employees located in CDCA and in California. *Compare, e.g.*, Appx245 (70 minute flight from Cupertino to Santa Ana), *with* Appx251 (5 hours and 30 minute flight to Shreveport, LA); *see also* Appx180-181 (¶¶22-24).

By finding that EDTX is "roughly equally convenient" to the West Coast, East Coast, and locations abroad, Appx4, the district court committed the same error of relying on Texas's "centralized location" that the Federal Circuit has rejected. *Genentech*, 566 F.3d at 1345; *see also In re Biosearch Techs., Inc.*, 452 F. App'x 986, 988-89 (Fed. Cir. 2011). Though the district court purported to avoid this error,

Appx4-5 n.1, the flaw in its logic is the same. As discussed, transfer to CDCA would not inconvenience Rembrandt. Likewise, the inconvenience to witnesses from Israel is approximately the same whether they must travel to EDTX or CDCA. *See Genentech*, 566 F.3d at 1344. EDTX is not a convenient forum for any witnesses, nor are the sources of proof located therein. *E.g.*, Appx179 (¶14); Appx181-182 (¶27-28); Appx1356-1357 (¶3); Appx187 (¶¶17-18).

As the accused infringer, the location of Apple's sources of proof weighs in favor of transfer to that location. *See Genentech*, 566 F.3d at 1345. Here, Apple's sources of proof, its witnesses and the non-party witnesses from Broadcom and Qualcomm are located in California. *E.g.*, Appx179-181 (¶¶14; 16-17, 22-24); Appx186-187 (¶¶10, 12-16); Appx221; Appx1352-1354 (¶¶2, 6, 8). *Accord* Order Granting Mot. to Transfer at 5, *Omni Medsci, Inc. v. Apple Inc.*, No. 18-cv-00429-RWS (E.D. Tex. Aug. 23, 2019) (ECF No. 163) (finding Apple's sources of proof "more easily available" in California, where it maintains its headquarters). Because the vast majority of the evidence and witnesses are located in or equally accessible to California, the district court should have found these factors to weigh in favor of transfer. *See In re Nintendo*, 756 F.3d at 1365-66 (finding "benefits of trying the case against Nintendo" where "a substantial portion of its witnesses and documents are located" to be "indisputable").

3. *CDCA's interest in resolving this dispute concerning several companies located therein weighs in favor of transfer.*

Local interest also favors transfer because Broadcom and Qualcomm are headquartered in California. *In re Hoffman-La Roche, Inc.*, 587 F.3d at 1338 (“[I]f there are significant connections between a particular venue and the events that gave rise to a suit, this factor should be weighed in that venue’s favor.”); *see also In re Nintendo*, 589 F.3d at 1198 (finding local interest weighed in favor of transfer when the accused infringer was incorporated and had its principle place of business in the transferee forum). The court’s rationale that “Rembrandt has not alleged wrongdoing against Broadcom or Qualcomm,” Appx7, again ignores that Rembrandt has sued both suppliers in CDCA, and its infringement contentions against Apple are substantially premised on the functionality of their chipsets. The local interest factor, thus, strongly favors transfer.

4. *The district court's past experience with these patents does not outweigh the co-pending cases in CDCA.*

Despite its “familiarity with the asserted patents,” Appx6, the court clearly abused its discretion when it found that judicial economy weighed against transfer based solely on its past experience involving a different consumer electronics company. *In re Verizon Bus. Network Servs. Inc.*, 635 F.3d 559, 562 (Fed. Cir. 2011) (finding that “any prior suit involving the same patent can[not] override a compelling showing of transfer”); *see also In re Vistaprint*, 628 F.3d at 1347 n.3 (affirming

denial of motion to transfer to allow co-pending litigation to proceed in the same court familiar with the patents-in-suit). By refusing to consider the co-pending California litigations, the district court failed to accurately assess judicial economy. Whether or not this case is transferred, the CDCA must gain its own familiarity with the patents and underlying technology. But transferring this case to CDCA would allow party and non-party witnesses to avoid repeated trips to different fora to provide testimony on the same technology and issues. *See Fujitsu Ltd. v. Tellabs, Inc.*, 639 F. Supp. 2d 761, 768 (E.D. Tex. 2009) (finding judicial economy best served by similar patent actions requiring “similar discovery from overlapping witnesses” proceeding together). Proceeding separately “leads to the wastefulness of time, energy and money that § 1404(a) was designed to prevent.” *Cont’l Grain*, 364 U.S. at 26.

V. MANDAMUS IS APPROPRIATE

Because of the legal and factual errors above, Apple faces an imminent and burdensome trial in a forum with no real interest in this dispute, while trials against Broadcom and Qualcomm proceed in parallel in a more convenient forum chosen by Rembrandt. Mandamus is the only remedy that can avoid this wasteful result. “[T]he harm—inconvenience to witnesses, parties and other—will already have been done by the time the case is tried and appealed, and the prejudice suffered cannot be put back in the bottle.” *In re Volkswagen*, 545 F.3d at 319. If CDCA is

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clearly more convenient, “wait[ing] until final judgment to raise that issue” on appeal is “an inadequate remedy.” *Hoffmann-La Roche*, 587 F.3d at 1336.

Moreover, mandamus is appropriate to resolve “basic and undecided” issues and questions of “first impression.” *In re BP Lubricants USA Inc.*, 637 F.3d 1307, 1310, 1313 (Fed. Cir. 2011). Here, the district court narrowed application of the customer-suit exception and established new rules, including that (1) filing IPR petitions creates “unclean hands” preventing a stay; (2) later-filed suits cannot impact convenience for transfer; and (3) all inferences should be drawn against the non-moving party under § 1404(a). This Court should resolve these fundamental issues now. In retaining jurisdiction over a case devoid of material connection to Texas, notwithstanding the much greater convenience and interest of CDCA, where two other suits are already pending, “the district court clearly abused its discretion,” such that mandamus “is necessarily clear and indisputable.” *Volkswagen*, 545 F.3d at 311.

VI. CONCLUSION

For these reasons, the Court should issue a writ of mandamus directing the district court to stay all proceedings pending final judgment in the Broadcom and Qualcomm cases or alternatively to transfer this case to the Central District of California for coordination with those suits.

Dated: January 7, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 7, 2020, the foregoing Petition for Writ of Mandamus and Appendix has been filed electronically using the Court's CM/ECF system.

A copy of the foregoing was served upon the following counsel of record and district court judge via FedEx:

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Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

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Dated: January 7, 2020

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Attorney for the Petitioner

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Ex. 2010

CERTIFICATE OF COMPLIANCE

The undersigned certifies that this petition complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this brief contains 7,787 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(f). This brief complies with the typeface requirements of Fed. R. App. P. 32(c)(2) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in Times New Roman 14 point font.

Dated: January 7, 2020

/s/ Douglas Hallward-Driemeier
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Attorney for the Petitioner

**CERTIFICATE OF COMPLIANCE MOTIONS OR BRIEFS CONTAINING
MATERIAL SUBJECT TO A PROTECTIVE ORDER**

Briefs Containing Material Subject to a Protective Order:

This petition complies with the limitations set forth in Fed. Cir. R. 28(d) and contains 15 words (including numbers) marked as confidential.

/s/ Douglas Hallward-Driemeier
ROPES & GRAY LLP

Attorney for the Petitioner

Miscellaneous Docket No.

**United States Court Of Appeals
For The Federal Circuit**

IN RE APPLE INC.,

Petitioner,

ON PETITION FOR A WRIT OF MANDAMUS TO
THE U.S. DISTRICT COURT FOR THE
EASTERN DISTRICT OF TEXAS, CASE NO. 2:19-CV-00025
JUDGE RODNEY GILSTRAP

**NON-CONFIDENTIAL APPENDIX IN SUPPORT OF
PETITION FOR WRIT OF MANDAMUS**

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Dated: January 7, 2020

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Confidential Material Omitted

The material omitted from the Non-Confidential Appendix contains confidential business information designated confidential pursuant to the Protective Order or sealed by the Order Granting Apple's Motion to Seal, both of which were filed by the United States District Court for the Eastern District of Texas.

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

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Case No. 2:19-cv-00025-JRG

Jury Trial Requested

PROTECTIVE ORDER

WHEREAS, Plaintiff Rembrandt Wireless Technologies, LP and Defendant Apple Inc., hereafter referred to as “the Parties,” believe that certain information that is or will be encompassed by discovery demands by the Parties involves the production or disclosure of trade secrets, confidential business information, or other proprietary information;

WHEREAS, the Parties seek a protective order limiting disclosure thereof in accordance with

Federal Rule of Civil Procedure 26(c):

THEREFORE, it is hereby stipulated among the Parties and ORDERED that:

1. Each Party may designate as confidential for protection under this Order, in whole or in part, any document, information or material that constitutes or includes, in whole or in part, confidential or proprietary information or trade secrets of the Party or a Third Party to whom the Party reasonably believes it owes an obligation of confidentiality with respect to such document, information or material (“Protected Material”). Protected Material shall



not include: (i) advertising materials that have been actually published or publicly disseminated; and (ii) materials that show on their face they have been disseminated to the public. Nothing in this Protective Order shall prevent or restrict a Producing Party's¹ own disclosure or use of its own Protected Material for any purpose, and nothing in this Order shall preclude any Producing Party from showing its Protected Material to an individual who prepared the Protected Material. Designations under this Order shall be made with care and shall not be made absent a good faith belief that the designated material satisfies the criteria set forth below. If it comes to a Producing Party's attention that designated material does not qualify for protection at all, or does not qualify for the level of protection initially asserted, the Producing Party must promptly notify all other Parties that it is withdrawing or changing the designation.

- (a) **Designating Documents:** Protected Material shall be designated by the Party producing it by affixing a legend or stamp on such document, information or material as follows: "CONFIDENTIAL," "CONFIDENTIAL - ATTORNEYS' EYES ONLY," or "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE." The words "CONFIDENTIAL," "CONFIDENTIAL - ATTORNEYS' EYES ONLY," or "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE" shall be placed clearly on each page of the Protected Material (except deposition and hearing transcripts, native files, and videotapes) for which such protection is sought.
- (b) **Designating Transcripts:** Parties or testifying persons or entities may designate

¹ "Producing Party" means any Party or non-party that discloses or produces any DESIGNATED MATERIAL in this case.

depositions and other testimony with the appropriate designation by indicating on the record at the time the testimony is given or by sending written notice of how portions of the transcript of the testimony is designated within thirty (30) days of receipt of the transcript of the testimony. If no indication on the record is made, all information disclosed during a deposition shall be deemed “CONFIDENTIAL” until the time within which it may be appropriately designated as provided for herein has passed. Any Party that wishes to disclose the transcript, or information contained therein, may provide written notice of its intent to treat the transcript as non-confidential, after which time, any Party that wants to maintain any portion of the transcript as confidential must designate the confidential portions within fourteen (14) days, or else the transcript may be treated as non-confidential. Any Protected Material that is used in the taking of a deposition shall remain subject to the provisions of this Protective Order. In such cases the court reporter shall be informed of this Protective Order and shall be required to operate in a manner consistent with this Protective Order. For deposition and hearing transcripts, the words “CONFIDENTIAL,” “CONFIDENTIAL - ATTORNEYS’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” shall be placed on the cover page of the transcript (if not already present on the cover page of the transcript when received from the court reporter) by each attorney receiving a copy of the transcript after that attorney receives notice of the designation of some or all of that transcript as “CONFIDENTIAL,” “CONFIDENTIAL - ATTORNEYS’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE.”

(c) **Designating Videotaped Depositions:** In the event the deposition is videotaped, the original and all copies of the videotape shall be marked by the video technician to indicate that the contents of the videotape are subject to this Protective Order, including the specific confidentiality level claimed if such a designation is made prior to the videotape being provided by the video technician, substantially along the lines of: “This videotape contains [confidential] testimony used in this case and is not to be viewed, or the contents thereof displayed or revealed, except pursuant to the terms of the operative Protective Order in this matter or pursuant to written stipulation of the Parties.”

(d) **Designating Native Files:** Where electronic files and documents are produced in native electronic format, such electronic files and documents shall be designated for protection by appending to the file names or designators information indicating whether the file contains “CONFIDENTIAL,” “CONFIDENTIAL - ATTORNEYS’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” Material. When such electronic files or documents are printed (for use at a deposition, in a court proceeding, or for provision in printed form to an expert or consultant approved pursuant to Paragraphs 5(e), 30, and 31), the Party printing the electronic files or documents shall place on the printed document the appropriate designation, as well as the production numbers associated with the electronic files or documents.

2. Any document produced under Patent Rules 2-2, 3-2, and/or 3-4 before issuance of this Order with the designation “Confidential” or “Confidential - Outside Attorneys’ Eyes Only” shall receive the same treatment as if designated “CONFIDENTIAL -

ATTORNEYS' EYES ONLY" under this Order, unless and until such document is redesignated to have a different classification under this Order.

3. With respect to documents, information or material designated "CONFIDENTIAL," "CONFIDENTIAL - ATTORNEYS' EYES ONLY," or "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE" ("DESIGNATED MATERIAL"),² subject to the provisions herein and unless otherwise stated, this Order governs, without limitation: (a) all documents, electronically stored information, and/or things as defined by the Federal Rules of Civil Procedure; (b) all pretrial, hearing or deposition testimony, or documents marked as exhibits or for identification in depositions and hearings; (c) pretrial pleadings, exhibits to pleadings and other court filings; (d) affidavits; and (e) stipulations. All copies, reproductions, extracts, digests and complete or partial summaries prepared from any DESIGNATED MATERIALS shall also be considered DESIGNATED MATERIAL and treated as such under this Order.
4. A designation of Protected Material (i.e., "CONFIDENTIAL," "CONFIDENTIAL - ATTORNEYS' EYES ONLY," or "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE") may be made at any time. Inadvertent or unintentional production of documents, information or material that has not been designated as DESIGNATED MATERIAL shall not be deemed a waiver in whole or in part of a claim for confidential treatment. Any Party that inadvertently or unintentionally produces Protected Material without designating it as DESIGNATED MATERIAL may request

² The term DESIGNATED MATERIAL is used throughout this Protective Order to refer to the class of materials designated as "CONFIDENTIAL," "CONFIDENTIAL - ATTORNEYS' EYES ONLY," or "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE," both individually and collectively.

destruction of that Protected Material by notifying the recipient(s), as soon as reasonably possible after the producing Party becomes aware of the inadvertent or unintentional disclosure, and providing replacement Protected Material that is properly designated. The recipient(s) shall then destroy all copies of the inadvertently or unintentionally produced Protected Materials and any documents, information or material derived from or based thereon.

5. “CONFIDENTIAL” documents, information and material may be disclosed only to the following persons, except upon receipt of the prior written consent of the designating Party, upon order of the Court, or as set forth in paragraph 12 herein:
- (a) outside counsel of record in this Action for the Parties;
 - (b) employees of such outside counsel assigned to and reasonably necessary to assist such counsel in the litigation of this Action;
 - (c) mock jurors who have signed an undertaking or agreement agreeing not to publicly disclose Protected Material and to keep any information concerning Protected Material confidential;
 - (d) up to and including three (3) designated representatives of each of the Parties, who are officers or employees of the receiving Party or related entities of the receiving Party, as well as their immediate paralegals and staff, to whom disclosure is reasonably necessary for the litigation of this Action, provided that any such person has agreed to be bound by the terms of this Order by signing the agreement attached hereto as Appendix A, which shall be provided to the producing Party before disclosure of Protected Material to the designated representative. In-house counsel may be designated as a party representative under this paragraph. Designated representatives for one Defendant Party shall not, without prior written consent, have access to Protected Material of another Defendant Party. Either Party may in good faith request the other Party’s consent to designate one or more additional representatives, the other Party shall not unreasonably withhold such consent, and the requesting Party may seek leave of Court to designate such additional representative(s) if the requesting Party believes the other Party has unreasonably withheld such consent;
 - (e) outside consultants or experts (*i.e.*, not existing employees or affiliates of a Party or an affiliate of a Party) retained for the purpose of this litigation, provided that:
 - (1) such consultants or experts are not presently employed by the Parties hereto for

purposes other than this Action (or related actions), nor anticipated at the time of retention to become employed by the Parties for purposes other than this Action (or related actions); (2) such consultants or experts are not presently involved in product design, development, sales, marketing, or pricing decisions on behalf of a supplier of baseband chips or smartphones; (3) before access is given, the consultant or expert has completed the Undertaking attached as Appendix A hereto); and (4) no unresolved objections to such disclosure exist after proper notice has been given to all Parties as set forth in paragraph 30 below;

- (f) any mediator who is assigned to hear this matter, and his or her staff, subject to their agreement to maintain confidentiality to the same degree as required by this Protective Order;
- (g) independent litigation support services, including persons working for or as court reporters, graphics or design services, jury or trial consulting services, and photocopy, document imaging, and database services retained by counsel and reasonably necessary to assist counsel with the litigation of this Action, provided they have an obligation not to publicly disclose Protected Material and to keep any information concerning Protected Material confidential; and
- (h) the Court and its personnel.

Notwithstanding any contrary provisions of paragraph 5(d), those persons identified in paragraph 5(d) shall be allowed access to the scope and settlement amount of any license agreement or settlement agreement regarding the asserted patents in this litigation solely for the purpose of facilitating settlement negotiations in this action.

6. A Party shall designate documents, information or material as “CONFIDENTIAL” only upon a good faith belief that the documents, information or material contain or reflect confidential, proprietary, and/or commercially sensitive information.
7. Documents, information or material produced pursuant to any discovery request in this Action, including but not limited to Protected Material designated as DESIGNATED MATERIAL, shall be used by the Parties only in the litigation of this Action and shall not be used for any other purpose. Any person or entity who obtains access to DESIGNATED MATERIAL or the contents thereof pursuant to this Order shall not make any copies, duplicates, extracts, summaries or descriptions of such DESIGNATED MATERIAL or any portion thereof except as may be reasonably necessary in the litigation of this Action. Any

such copies, duplicates, extracts, summaries or descriptions shall be classified DESIGNATED MATERIALS and subject to all of the terms and conditions of this Order.

8. A Producing Party may designate Protected Material as “CONFIDENTIAL – ATTORNEYS’ EYES ONLY,” if it contains or reflects information that is extremely confidential and/or sensitive in nature and the producing Party reasonably believes that the disclosure of such Protected Material is likely to cause economic harm or significant competitive disadvantage to the producing Party. To the extent such Protected Material includes computer source code, including computer code, scripts, assembly, binaries, object code, source code listings and descriptions of source code, object code listings and descriptions of object code, and Hardware Description Language (HDL) or Register Transfer Level (RTL) files that describe the hardware design of any ASIC or other chip, and/or live data (that is, data as it exists residing in a database or databases) (“Source Code Material”), the producing Party may designate such Protected Material as “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE.”
9. For Protected Material designated CONFIDENTIAL - ATTORNEYS’ EYES ONLY, access to, and disclosure of, such Protected Material shall be limited to individuals listed in paragraphs 5(a-c) and (e-h).
10. For Protected Material designated CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE, the following additional restrictions apply:
 - (a) Any Source Code Material that is produced by Defendant will be made available for inspection at the East Palo Alto, California office of its outside counsel, Ropes & Gray LLP, or any other location mutually agreed by the Parties. Access to a Party’s Source Code Material shall be provided only on “stand-alone” computer(s) (that is, the computer may not be linked to any network, including a local area network (“LAN”), an intranet or the Internet). The stand-alone computer(s) may be connected to a printer;

- (b) Prior to the first inspection of any requested Source Code, the receiving Party shall provide fourteen (14) days' notice of the Source Code that it wishes to inspect. The receiving Party shall provide five (5) days' notice prior to any additional inspections of that code. The receiving Party shall make reasonable efforts to restrict its requests for such access to the stand-alone computer(s) to normal business hours, which for purposes of this paragraph shall be 8:00 a.m. through 6:00 p.m. A list of names of persons who will inspect the Source Code Material will be provided to the producing Party at the time of request for access. Upon reasonable notice from the receiving Party, the producing Party shall make reasonable efforts to accommodate the receiving Party's request for access to the stand-alone computer(s) outside of normal business hours. The Parties agree to cooperate in good faith such that maintaining the producing Party's Source Code Material at the offices of its outside counsel shall not unreasonably hinder the receiving Party's ability to efficiently and effectively conduct the prosecution or defense of this Action. No recordable media or recordable devices, including without limitation sound recorders, computers, cell phones, peripheral equipment, cameras, CDs, DVDs, or drives of any kind, shall be permitted into the Source Code Review Room. The producing Party may visually monitor the activities of the receiving Party's representatives during any Source Code review, but only to ensure that no unauthorized electronic records of the Source Code are being created or transmitted in any way. No copies of all or any portion of the Source Code may leave the room in which the Source Code is inspected except as otherwise provided herein. Except to print source code pursuant to Paragraph 10(h) below, the receiving Party will not copy, remove, or otherwise transfer any Source Code from the Source Code Computer including, without limitation, copying, removing, or transferring the Source Code onto any recordable media or recordable device. The receiving Party's outside counsel and/or experts shall be entitled to take notes relating to the Source Code but may not copy the Source Code into the notes and may not take such notes electronically on the Source Code Computer itself or any other computer. The producing Party will provide a landline telephone in the room, in case the receiving Party's experts need to contact the receiving Party's outside counsel. The receiving Party will not use the landline telephone without prior notification to the producing Party. Proper identification of all authorized persons shall be provided prior to any access to the secure room or the computer containing Source Code. Access to the secure room or the Source Code Computer may be denied, at the discretion of the supplier, to any individual who fails to provide proper identification. The producing Party's outside counsel and/or experts shall be subject to the same restrictions as the receiving Party's outside counsel and/or experts when reviewing source code;
- (c) The producing Party shall provide the receiving Party with information explaining how to start, log on to, and operate the stand-alone computer(s) in order to access the produced Source Code Material on the stand-alone computer(s);
- (d) The producing Party will produce Source Code Material in computer searchable format on the stand-alone computer(s) as described above;

- (e) Access to Protected Material designated CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE shall be limited to outside counsel and up to three (3) outside consultants or experts³ (*i.e.*, not existing employees or affiliates of a Party or an affiliate of a Party) retained for the purpose of this litigation and approved to access such Protected Materials pursuant to paragraph 5(e) above, provided that: (a) such expert or consultant is not a current officer, director, or employee of a Party or of a competitor of a Party, nor anticipated at the time of retention to become an officer, director or employee of a Party or of a competitor of a Party; (b) such expert or consultant is not involved in competitive decision-making on behalf of a Party or a competitor of a Party; and (c) no unresolved objections to disclosure exist after proper notice has been given to all Parties as set forth in Paragraph 30 below. A receiving Party may include excerpts of Source Code Material in a pleading, exhibit, expert report, discovery document, deposition transcript, other Court document, provided that the Source Code Documents are appropriately marked under this Order, restricted to those who are entitled to have access to them as specified herein, and, if filed with the Court, filed under seal in accordance with the Court's rules, procedures and orders with any uncited Source Code redacted;
- (f) To the extent portions of Source Code Material are quoted in a Source Code Document, either (1) the entire Source Code Document will be stamped and treated as CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE or (2) those pages containing quoted Source Code Material will be separately stamped and treated as CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE. Images or copies of Source Code shall not be included in correspondence between the Parties (references to production numbers shall be used instead), and shall be omitted from pleadings and other papers whenever possible. If an electronic or other copy needs to be made for contentions, an expert report, a Court filing (subject to the terms of the preceding paragraph), or any other document, which pursuant to the Court's rules, procedures, or orders must be filed or served electronically, the receiving Party's entire submission, communication, and/or disclosure containing any portion of Source Code (paper or electronic) shall be marked "CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE" and access at all times shall be limited solely to individuals who are expressly authorized to view Source Code under the provisions of this Order;
- (g) Except as set forth elsewhere in paragraph 10 above and below, no electronic copies of Source Code Material shall be made without prior written consent of the producing Party;

³ For the purposes of this paragraph, an outside consultant or expert is defined to include the outside consultant's or expert's direct reports and other support personnel, such that the disclosure to a consultant or expert who employs others within his or her firm to help in his or her analysis shall count as a disclosure to a single consultant or expert.

- (h) The receiving Party shall be permitted to make a reasonable number of printouts and photocopies of Source Code Material, all of which shall be designated and clearly labeled “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE,” and the receiving Party shall maintain a log of all such files that are printed that shall be provided to the supplier upon conclusion of the litigation. The receiving Party shall request only such portions as are reasonably necessary from the standalone computer(s) onto pre-Bates numbered and colored or watermarked paper, which shall be provided by the producing Party, that bears the legend “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE.” Within five (5) days of request, the producing Party shall either (i) provide five (5) copy sets of such pages to the receiving Party or (ii) inform the requesting Party that it objects that the printed portions are excessive and/or not done for a permitted purpose. If, after meeting and conferring, the producing Party and the receiving Party cannot resolve the objection, the producing Party shall be entitled to seek a Court resolution of whether the printed Source Code in question is narrowly tailored and was printed for a permitted purpose;
- (i) Copies may not be made for purposes of review elsewhere in the first instance (*i.e.*, as an alternative to reviewing the Source Code Material in the room in which the stand alone computers are located);
- (j) Printed copies of Source Code may be reviewed by persons or entities permitted to access “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” information at the offices of Outside Counsel of the receiving Party or the offices of the receiving Party’s Outside Consultants, but may not be removed from such offices, except that copies may be made for and used in Court filings and proceedings, expert reports, contentions, and depositions of persons or entities permitted to access “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” information of the Producing Party, provided that the Source Code Material is appropriately designated, restricted to those who are entitled to have access to them as specified herein, and, if filed with the Court, filed under seal in accordance with the Court’s rules, procedures and orders.
- (k) The receiving Party shall maintain a log of all paper copies of the Source Code. The log shall include the names of the reviewers and/or recipients of paper copies along with dates and locations where the paper copies are stored. Upon completion of the litigation, the receiving Party shall provide a copy of this log to the producing Party. The receiving Party shall ensure that such outside counsel, consultants, or experts keep the printouts or photocopies in a secured locked area in the offices of such outside counsel, consultants, or expert. Such photocopies shall also be on colored or watermarked paper. The receiving Party may also temporarily keep the printouts or photocopies at: (i) the Court for any proceedings(s) relating to the Source Code Material, for the dates associated with the proceeding(s); (ii) the sites where any deposition(s) relating to the Source Code Material are taken, for the dates associated with the deposition(s); and (iii) any intermediate location reasonably necessary to transport the printouts or photocopies (*e.g.*, a hotel prior

to a Court proceeding or deposition). Copies of Source Code that are marked as deposition exhibits shall not be provided to the Court Reporter or attached to deposition transcripts; rather, the deposition record will identify the exhibit by its production numbers, unless otherwise agreed by the producing Party. All paper copies of Source Code brought to the deposition must be returned to the receiving Counsel following the deposition for secure transport back to the secured locked area in the offices of the receiving Counsel; and

- (l) A producing Party's Source Code Material may only be transported by the receiving Party at the direction of a person authorized under paragraph 10(e) above to another person authorized under paragraph 10(e) above, on paper via hand carry, Federal Express or other similarly reliable courier. Source Code Material may not be transported or transmitted electronically over a network of any kind, including a LAN, an intranet, or the Internet, except as with respect to the transmission of contentions, expert reports, sealed court filings, or any other document, which pursuant to the Court's rules, procedures, or orders must be filed or served electronically, as set forth in paragraphs 10(f) and 10(j) above and is at all times subject to the transport restrictions set forth herein.
- (m) In the case of any conflict between a provision of Paragraph 10 (regarding source code) and any other provision in this Order, the provision in Paragraph 10 (regarding source code) shall govern.

11. Any attorney representing Plaintiff, whether in-house or outside counsel, and any person associated with Plaintiff and permitted to receive Defendant's Protected Material that is designated CONFIDENTIAL - ATTORNEYS' EYES ONLY and/or CONFIDENTIAL - OUTSIDE ATTORNEYS' EYES ONLY - SOURCE CODE (collectively "HIGHLY SENSITIVE MATERIAL"), who obtains, receives, has access to, or otherwise learns, in whole or in part, Defendant's HIGHLY SENSITIVE MATERIAL under this Order shall not advise on, consult on, prepare, prosecute, supervise, or assist in the preparation or prosecution of any patent application, specifications, claims, and/or responses to office actions, or otherwise affect the scope of claims in patents or patent applications relating to the functionality, operation, and design of Bluetooth transmissions on behalf of Plaintiff or its acquirer, successor, predecessor, or other affiliate during the pendency of this Action and for two years after its conclusion, including any appeals. This provision does not

prohibit Plaintiff's counsel of record or experts in this litigation from participating in or representing it in reexamination proceedings, Post-Grant Review proceedings, *Inter Partes* Review proceedings, or Covered Business Method Review proceedings involving any patent, including the patents-in-suit, provided they (1) do not rely upon or use, directly or indirectly, Defendant's DESIGNATED MATERIAL in those proceedings and (2) do not advise on, consult on, prepare, draft, or edit any amendment to specifications or claims in those proceedings. Further, Plaintiff's counsel of record or experts in this litigation may not reveal Defendant's DESIGNATED MATERIAL to any reexamination, inter partes review, or covered business method review counsel or agent. To ensure compliance with the purpose of this provision, Plaintiff's counsel shall create an "Ethical Wall" between those persons with access to HIGHLY SENSITIVE MATERIAL and any individuals who, on behalf of the Party or its acquirer, successor, predecessor, or other affiliate, prepare, prosecute, supervise or assist in the preparation or prosecution of any patent application pertaining to the field of Bluetooth transmission. These prohibitions are not intended to and shall not preclude counsel from participating in proceedings on behalf of a Party challenging the validity of any patent. Nothing in this paragraph shall apply to any individual permitted to receive any other Party's Protected Material and who in compliance with the terms of this Protective Order obtains, receives, has access to, or otherwise learns, in whole or in part, any other Party's HIGHLY SENSITIVE MATERIAL, if said HIGHLY SENSITIVE MATERIAL is only of financial nature and not of a technical nature.

12. Nothing in this Order shall require production of documents, information or other material that a Party contends is protected from disclosure by the attorney-client privilege, the work product doctrine, or other privilege, doctrine, or immunity. If documents, information or

other material subject to a claim of attorney-client privilege, work product doctrine, or other privilege, doctrine, or immunity is inadvertently or unintentionally produced, such production shall in no way prejudice or otherwise constitute a waiver of, or estoppel as to, any such privilege, doctrine, or immunity. Any Party that inadvertently or unintentionally produces documents, information or other material it reasonably believes are protected under the attorney-client privilege, work product doctrine, or other privilege, doctrine, or immunity may obtain the return of such documents, information or other material by promptly notifying the recipient(s) and providing a privilege log for the inadvertently or unintentionally produced documents, information or other material. The recipient(s) shall gather and return all copies of such documents, information or other material to the producing Party, except for any pages containing privileged or otherwise protected markings by the recipient(s), which pages shall instead be destroyed and certified as such to the producing Party.

13. There shall be no disclosure of any DESIGNATED MATERIAL by any person authorized to have access thereto to any person who is not authorized for such access under this Order. The Parties are hereby ORDERED to safeguard all such documents, information and material to protect against disclosure to any unauthorized persons or entities.
14. Protected Material must be stored and maintained by a Receiving Party at a location in the United States and in a secure manner that ensures that access is limited to the persons authorized under this Order. To ensure compliance with applicable United States Export Administration Regulations, Protected Material may not be exported outside the United States or released to any foreign national (even if within the United States).
15. If a receiving Party learns that, by inadvertence or otherwise, it has disclosed Protected

Material to any person or in any circumstance not authorized under this Stipulated Protective Order, the receiving Party must immediately (a) notify in writing the Designating Party of the unauthorized disclosures, and provide all known, relevant information concerning the nature and circumstances of the disclosure; (b) use its best efforts to retrieve all unauthorized copies of the Protected Material and to ensure that no further or greater unauthorized disclosure and/or use thereof is made, including securing the agreement of the recipient(s) not to further disseminate the Protected Material in any form; (c) inform the person or persons to whom unauthorized disclosures were made of all the terms of this Order; and (d) request such person or persons to execute the Undertaking that is attached hereto as Appendix A. Compliance with the foregoing shall not prevent the producing Party from seeking further relief from the Court. Unauthorized or inadvertent disclosure does not change the status of Discovery Material or waive the right to hold the disclosed document or information as Protected.

16. Nothing contained herein shall be construed to prejudice any Party's right to use any DESIGNATED MATERIAL in taking testimony at any deposition or hearing provided that the DESIGNATED MATERIAL is only disclosed to a person(s) who is: (i) eligible to have access to the DESIGNATED MATERIAL by virtue of his or her employment with the designating Party, (ii) identified in the DESIGNATED MATERIAL as an author, addressee, or copy recipient of such information, (iii) although not identified as an author, addressee, or copy recipient of such DESIGNATED MATERIAL, has, in the ordinary course of business, seen such DESIGNATED MATERIAL, (iv) a current or former officer, director or employee of the producing Party or a current or former officer, director or employee of a company affiliated with the producing Party; (v) counsel for a Party,

including outside counsel and in-house counsel (subject to paragraphs 9 and 10 of this Order); (vi) a consultant, and/or expert retained for the purpose of this litigation and disclosed and approved pursuant to paragraphs 5(e), 30, and 31; (vii) court reporters and videographers; (viii) the Court; or (ix) other persons entitled hereunder to access to DESIGNATED MATERIAL. DESIGNATED MATERIAL shall not be disclosed to any other persons unless prior authorization is obtained from counsel representing the producing Party or from the Court.

17. Parties may, at the deposition or hearing or within thirty (30) days after receipt of a deposition or hearing transcript, designate the deposition or hearing transcript or any portion thereof as “CONFIDENTIAL,” “CONFIDENTIAL - ATTORNEY’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” pursuant to this Order. Access to the deposition or hearing transcript so designated shall be limited in accordance with the terms of this Order. In the absence of any earlier designation being made, until expiration of the 30-day period, the entire deposition or hearing transcript shall be treated as “CONFIDENTIAL.”
18. Any DESIGNATED MATERIAL that is filed with the Court shall be filed under seal and shall remain under seal until further order of the Court. The filing Party shall be responsible for informing the Clerk of the Court that the filing should be sealed and for placing the legend “FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER” above the caption and conspicuously on each page of the filing. Exhibits to a filing shall conform to the labeling requirements set forth in this Order.
19. The Order applies to pretrial discovery. Nothing in this Order shall be deemed to prevent the Parties from introducing any DESIGNATED MATERIAL into evidence at the trial of

this Action, or from using any information contained in DESIGNATED MATERIAL at the trial of this Action, subject to any pretrial order issued by this Court. However, each of the Parties reserves the right to request that the Court seal the courtroom or, if allowed by the Court, during the presentation of any testimony relating to or involving the use of any Protected Material.

20. A Party may request in writing to the other Party that the designation given to any DESIGNATED MATERIAL be modified or withdrawn. If the designating Party does not agree to redesignation within ten (10) days of receipt of the written request, the requesting Party may apply to the Court for relief. Upon any such application to the Court, the burden shall be on the designating Party to show why its classification is proper. Such application shall be treated procedurally as a motion to compel pursuant to Federal Rules of Civil Procedure 37, subject to the Rule's provisions relating to sanctions. In making such application, the requirements of the Federal Rules of Civil Procedure and the Local Rules of the Court shall be met. Pending the Court's determination of the application, the designation of the designating Party shall be maintained.
21. Each outside consultant or expert to whom DESIGNATED MATERIAL is disclosed in accordance with the terms of this Order shall be advised by counsel of the terms of this Order, shall be informed that he or she is subject to the terms and conditions of this Order, and shall sign an acknowledgment that he or she has received a copy of, has read, and has agreed to be bound by this Order. A copy of the acknowledgment form is attached as Appendix A.
22. Absent good cause, drafts of reports of testifying experts, and reports and other written materials, including drafts, of consulting experts, shall not be discoverable. Reports and

materials exempt from discovery under this paragraph shall be treated as attorney work product for the purposes of this case and Protective Order. No conversations or communications between counsel and a testifying or consulting expert will be subject to discovery unless the conversations or communications are relied upon by such experts in formulating opinions that are presented in report or trial or deposition testimony in this case.

23. To the extent that any discovery is taken of persons who are not Parties to this Action (“Third Parties”) and in the event that such Third Parties contended the discovery sought involves trade secrets, confidential business information, or other proprietary information, then such Third Parties may designate material for protection under this Order.
24. Information originating with a Third Party and in a producing Party’s custody or control that a producing Party reasonably and in good faith believes is subject to a confidentiality obligation may be designated by a producing Party as “CONFIDENTIAL,” “CONFIDENTIAL – ATTORNEYS’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” and such Protected Information shall be subject to the restrictions on disclosure specified in this Order. The foregoing notwithstanding, if a Party has a good faith belief that the production of Protected Material is objectionable on the grounds that the requested Protected Material is subject to a Third-Party confidentiality obligation, the producing Party shall confer with the Third Party to resolve the confidentiality issue. Any Party to this Action intending to disclose Third-Party confidential information pursuant to this Order should first provide to such Third Party a copy of this Order and a description of information to be disclosed.
25. To the extent that discovery or testimony is taken of Third Parties, the Third Parties may

designate as “CONFIDENTIAL” or “CONFIDENTIAL - ATTORNEYS’ EYES ONLY” any documents, information or other material, in whole or in part, produced or given by such Third Parties. In the absence of any earlier designation, the Third Parties shall have ten (10) days after production of such documents, information or other materials to make such a designation. Until that time period lapses or until such a designation has been made, whichever occurs sooner, all documents, information or other material so produced or given shall be treated as “CONFIDENTIAL – ATTORNEY’ EYES ONLY” for three (3) days and then as “CONFIDENTIAL” for the remainder of the 10-day period.

26. Within thirty (30) days of final termination of this Action, including any appeals, all DESIGNATED MATERIAL, including all copies, duplicates, abstracts, indexes, summaries, descriptions, and excerpts or extracts thereof (excluding excerpts or extracts incorporated into any privileged memoranda of the Parties and materials which have been admitted into evidence in this Action), shall at the producing Party’s election either be returned to the producing Party or be destroyed. However, notwithstanding this requirement, Outside Counsel may retain DESIGNATED MATERIAL incorporated into court filings, pleadings, written discovery responses, and communications for archival purposes and are not required to delete information that may reside on their respective back-up systems; however, Outside Counsel agree that no Protected Material produced by any other Party or a Third Party shall be retrieved from the electronic back-up systems or archives to be used as reference materials for business operations after conclusion of this litigation. The receiving Party shall verify the return or destruction by affidavit furnished to the producing Party, upon the producing Party’s request.
27. The failure to designate documents, information or material in accordance with this Order

and the failure to object to a designation at a given time shall not preclude the filing of a motion at a later date seeking to impose such designation or challenging the propriety thereof. The entry of this Order and/or the production of documents, information and material hereunder shall in no way constitute a waiver of any objection to the furnishing thereof, all such objections being hereby preserved.

28. Any Party knowing or believing that any other Party is in violation of or intends to violate this Order and has raised the question of violation or potential violation with the opposing Party and has been unable to resolve the matter by agreement may move the Court for such relief as may be appropriate in the circumstances. Pending disposition of the motion by the Court, the Party alleged to be in violation of or intending to violate this Order shall discontinue the performance of and/or shall not undertake the further performance of any action alleged to constitute a violation of this Order.
29. Production of DESIGNATED MATERIAL by each of the Parties shall not be deemed a publication of the documents, information and material (or the contents thereof) produced so as to void or make voidable whatever claim the Parties may have as to the proprietary and confidential nature of the documents, information or other material or its contents. Nothing in this Order shall be construed to effect an abrogation, waiver or limitation of any kind on the rights of each of the Parties to assert any applicable discovery or trial privilege.
30. Prior to disclosing any Protected Material to any person described in Paragraph 5(e) (referenced below as "Person"), the Party seeking to disclose such information shall provide the Producing Party with written notice that includes:
 - (i) the name of the Person;

- (ii) an up-to-date curriculum vitae of the Person;
- (iii) the present employer and title of the Person;
- (iv) an identification of all of the Person's current and past employment and consulting relationships within the last five (5) years, including direct relationships and relationships through entities owned or controlled by the Person, including but not limited to an identification of any individual or entity with or for whom the person is employed or to whom the person provides consulting services and a description of any job responsibilities or consulting services relating to product design, development, sales, marketing, pricing, patenting, or licensing;
- (v) an identification of all published pending patent applications on which the Person is named as an inventor, in which the Person has any ownership interest; and
- (vi) a list of the cases in which the Person has testified at deposition or trial within the last four (4) years.

Further, the Party seeking to disclose Protected Material shall provide such other information regarding the Person's professional activities reasonably requested by the Producing Party for it to evaluate whether good cause exists to object to the disclosure of Protected Material to the outside expert or consultant. During the pendency of and for a period of two (2) years after the final resolution of this action, including all appeals, the Person shall immediately provide written notice of any change with respect to the Person's involvement in the design, development, operation or patenting of electronic speech coding, or the acquisition of intellectual property assets relating to electronic speech coding. Within twelve (12) days of receipt of the disclosure of the Person, the Producing Party or Parties may object in writing to the Person for good cause. In the absence of an

objection at the end of the twelve (12) day period, the Person shall be deemed approved under this Protective Order. There shall be no disclosure of Protected Material to the Person prior to expiration of this twelve (12) day period. If the Producing Party objects to disclosure to the Person within such twelve (12) day period, the Parties shall meet and confer via telephone or in person within seven (7) days following the objection and attempt in good faith to resolve the dispute on an informal basis. If the dispute is not resolved, the Party objecting to the disclosure will have seven (7) days from the date of the meet and confer to seek relief from the Court. If relief is not sought from the Court within that time, the objection shall be deemed withdrawn. If relief is sought, designated materials shall not be disclosed to the Person in question until the Court resolves the objection. Prior to receiving any Protected Material under this Order, the Person must execute a copy of the “UNDERTAKING OF EXPERTS OR CONSULTANTS REGARDING PROTECTIVE ORDER” (Appendix A hereto) and serve it on all Parties.


31. An initial failure to object to a Person under Paragraph 30 shall not preclude the non-objecting Party from later objecting to continued access by that Person for good cause. If an objection is made, the Parties shall meet and confer via telephone or in person within seven (7) days following the objection and attempt in good faith to resolve the dispute informally. If the dispute is not resolved, the Party objecting to the disclosure will have seven (7) days from the date of the meet and confer to seek relief from the Court. The designated Person may continue to have access to information while the objection is being resolved.
32. The United States District Court for the Eastern District of Texas is responsible for the interpretation and enforcement of this Agreed Protective Order, including following

termination of this litigation. All disputes concerning DESIGNATED MATERIAL produced under the protection of this Agreed Protective Order shall be resolved by the United States District Court for the Eastern District of Texas.

33. Each of the Parties shall also retain the right to file a motion with the Court (a) to modify this Order to allow disclosure of DESIGNATED MATERIAL to additional persons or entities if reasonably necessary to prepare and present this Action and (b) to apply for additional protection of DESIGNATED MATERIAL.

So Ordered this

Jun 21, 2019



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

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Case No. 2:19-cv-00025-JRG

Jury Trial Requested

**APPENDIX A
UNDERTAKING OF EXPERTS OR CONSULTANTS REGARDING
PROTECTIVE ORDER**

I, _____, declare that:

1. My address is _____.

My current employer is _____.

My current occupation is _____.

2. I have received a copy of the Protective Order in this action. I have carefully read and understand the provisions of the Protective Order.

3. I will comply with all of the provisions of the Protective Order. I will hold in confidence, will not disclose to anyone not qualified under the Protective Order, and will use only for purposes of this action any information designated as “CONFIDENTIAL,” “CONFIDENTIAL - ATTORNEYS’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” that is disclosed to me.

4. I understand that signing this Undertaking does not authorize me to view Protected

Material I am not otherwise authorized to view pursuant to the terms of the Protective Order.

5. Promptly upon termination of these actions, I will return all documents and things designated as “CONFIDENTIAL,” “CONFIDENTIAL - ATTORNEYS’ EYES ONLY,” or “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” that came into my possession, and all documents and things that I have prepared relating thereto, to the outside counsel for the party by whom I am employed.
6. I hereby submit to the jurisdiction of this Court for the purpose of enforcement of the Protective Order in this action.

I declare under penalty of perjury that the foregoing is true and correct.

Signature _____

Date _____

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

**REMBRANDT WIRELESS
TECHNOLOGIES, LP,**

Plaintiff,

v.

APPLE INC.,

Defendant.

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Case No. 2:19-CV-00025-JRG

**STIPULATED SUPPLEMENTAL PROTECTIVE ORDER BETWEEN
NON-PARTY QUALCOMM INCORPORATED, PLAINTIFF, AND
DEFENDANT**

WHEREAS, the Court entered a Protective Order (Dkt. No. 47) to protect Party and Non-party confidential business information in the above referenced action on June 21, 2019 (“Protective Order”); and

WHEREAS, Rembrandt Wireless Technologies, LP (“Plaintiff”); Apple Inc. (collectively “Defendant”) (together, hereinafter referred to as “the Parties”); and Qualcomm Incorporated (“QUALCOMM”), a non-party to this action, may produce confidential source code, schematics, and other documents in this action that include or incorporate CONFIDENTIAL INFORMATION belonging to QUALCOMM (“QUALCOMM Confidential Information”); and

WHEREAS the Parties and Non-Party QUALCOMM have agreed to provisions in addition to those contained in the Protective Order to protect against misuse or disclosure of such QUALCOMM Confidential Information;

WHEREFORE, IT IS HEREBY ORDERED that source code, schematics, or documents that incorporate QUALCOMM Confidential Information produced in connection with the above-captioned matters that are designated as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” and “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL

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SOURCE CODE” shall be subject to the following restrictions:

I. DEFINITIONS

1. “QUALCOMM MATERIAL”: Confidential information (regardless of how generated, stored, or maintained) or tangible things that include or incorporate Non-Party QUALCOMM Confidential Information, that Non-Party QUALCOMM (i) would not normally reveal to third parties except in confidence, or has undertaken with others to maintain in confidence, (ii) believes in good faith is significantly sensitive, or (iii) protected by a right to privacy under federal or state law, or any other applicable privilege or right related to confidentiality or privacy. QUALCOMM MATERIAL includes all information, documents, source code, schematics, testimony, and things produced, served, or otherwise provided in this action by any Party or by Non-Party QUALCOMM, that include or incorporate QUALCOMM Confidential Information.

2. “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” material: information, documents, and things that include or incorporate QUALCOMM MATERIAL.

3. “Source Code”: includes human-readable programming language text that defines software, firmware, (collectively, “software Source Code”) and integrated circuits (“hardware Source Code”). Text files containing Source Code shall hereinafter be referred to as “Source Code files.” Software Source Code files shall include, but are not limited to, files containing Source Code in “C,” “C+,” BREW, Java ME, J2ME, assembler, digital signal processor (DSP) programming languages, and other human readable text programming languages. Software Source Code files further include “.include files,” “make” files, “link” files, and other human-readable text files used in the generation and/or building of software directly executed on a microprocessor, micro-controller, or DSP. Hardware Source Code files include, but are not limited to, files containing Source Code in VHDL, Verilog, and other Hardware Description Language (“HDL”) formats, including but not limited to, Register Transfer Level (“RTL”) descriptions.

4. “Chip-Level Schematics”: means symbolic representations of analog electric or electronic circuits from which the physical structure of a chip is directly derived.

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5. “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” Material: QUALCOMM MATERIAL that includes Source Code and Chip-Level Schematics that constitute proprietary technical or commercially sensitive competitive information that Non-Party QUALCOMM maintains as highly confidential in its business, the disclosure of which is likely to cause harm to the competitive position of Non-Party QUALCOMM. This includes Source Code and Chip-Level Schematics in the Producing Party’s possession, custody, or control, and made available for inspection by the Producing Party.

6. “Designated QUALCOMM Material”: material that is designated “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” or “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” under this Supplemental Protective Order.

7. “Designated Source Code Material”: material that is designated “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” under this Supplemental Protective Order.

8. “Personnel Retained by a Receiving Party in this Action” means any consultants, experts, or outside counsel (including their support staff) that have been and continue to be retained by a Receiving Party in this action. For the sake of clarity, any person who was retained by a Receiving Party in this action will no longer fall under this definition if that person ceases to be retained by a Receiving Party in this action.

9. “Party” means any Party to the above-captioned action, including all of its officers, directors, employees, consultants, retained experts, and all support staff thereof.

10. “Producing Party” means a party or non-party that discloses or produces Designated QUALCOMM Material in the above-captioned actions.

11. “Receiving Party” a Party that receives Designated QUALCOMM Material from a Producing Party in the above-captioned actions.

12. “Authorized Reviewer(s)” shall mean persons authorized to review “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” and “QUALCOMM – OUTSIDE ATTORNEYS’

EYES ONLY – CONFIDENTIAL SOURCE CODE” material in accordance with this Supplemental Protective Order and the Protective Order.

13. “Counsel of Record”: (i) Outside Counsel who appears on the pleadings, or has entered an appearance in this action, as counsel for a Party, and (ii) partners, principals, counsel, associates, employees, and contract attorneys of such Outside Counsel to whom it is reasonably necessary to disclose the information for this litigation, including supporting personnel employed by the attorneys, such as paralegals, legal translators, legal secretaries, legal clerks and shorthand reporters.

14. “Outside Consultant”: a person with specialized knowledge or experience in a matter pertinent to the litigation who has been retained by Counsel of Record to serve as an expert witness or a litigation consultant in this action (including any necessary support personnel of such person to whom disclosure is reasonably necessary for this litigation), and who is not a current employee of a Party, of a competitor of a Party, or of Non-Party QUALCOMM, and who, at the time of retention, is not anticipated to become an employee of, or a non-litigation consultant of: 1) a Party, 2) a competitor of a Party, 3) a competitor of Non-Party QUALCOMM, or of 4) Non-Party QUALCOMM.

15. “Professional Vendors”: persons or entities that provide litigation support services (e.g., photocopying; videotaping; translating; designing and preparing exhibits, graphics, or demonstrations; organizing, storing, retrieving data in any form or medium; etc.) and their employees and subcontractors who have been retained or directed by Counsel of Record in this action, and who are not current employees of a Party, a competitor of a Party, or of Non-Party QUALCOMM, and who, at the time of retention, are not anticipated to become employees of: 1) a Party, 2) a competitor of a Party, 3) a competitor of Non-Party QUALCOMM, or 4) Non-Party QUALCOMM. This definition includes ESI vendors, and professional jury or trial consultants retained in connection with this litigation to assist a Party, Counsel of Record, or any Outside Consultant in their work. Professional vendors do not include consultants who fall within the definition of Outside Consultant.

II. RELATIONSHIP TO PROTECTIVE ORDER

16. This Supplemental Protective Order shall not diminish any existing restriction with respect to Designated QUALCOMM Material. The Parties and QUALCOMM acknowledge and agree that this Supplemental Protective Order is a supplement to the Protective Order entered in this action on June 21, 2019 in the United States District Court, Eastern District of Texas, in this action. The Protective Order applies to all material designated pursuant to this Supplemental Protective Order. To the extent that there is any confusion or conflict between protective orders with respect to Designated QUALCOMM Material, then this Supplemental Protective Order governs.

17. In addition to the restrictions outlined in this Supplemental Protective Order, material designated as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” shall be subject to obligations with respect to “CONFIDENTIAL – OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” materials outlined in the Protective Order.

18. In addition to the restrictions outlined in this Supplemental Protective Order, material designated as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” shall be subject to obligations with respect to “CONFIDENTIAL – ATTORNEYS’ EYES ONLY” material outlined in the Protective Order.

III. SCOPE

19. The protections conferred by this Supplemental Protective Order cover not only Designated QUALCOMM Material (as defined above), but also any information copied or extracted therefrom, as well as all copies, excerpts, summaries, or compilations thereof. Nothing herein shall alter or change in any way the discovery provisions of the Federal Rules of Civil Procedure or any applicable local rules or General Orders. Identification of any individual pursuant to this Supplemental Protective Order does not make that individual available for deposition, or any other form of discovery outside of the restrictions and procedures of the Federal Rules of Civil Procedure or any applicable rules or General Orders.

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20. This Supplemental Protective Order shall not prevent a disclosure to which Non-Party QUALCOMM consents in writing before that disclosure takes place.

21. This Supplemental Protective Order shall apply to all Designated QUALCOMM Material that is produced or provided for inspection in this action, including all Designated QUALCOMM Material that is in the possession, custody or control of QUALCOMM or any Party in these actions, or that is otherwise relevant to these actions.

IV. ACCESS TO DESIGNATED QUALCOMM MATERIAL

22. Access to “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” Material: Unless otherwise ordered by the Court or permitted in writing by Non-Party QUALCOMM, a Receiving Party may disclose any information, document or thing designated “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” only to:

- a. Persons who appear on the face of Designated QUALCOMM Material as an author, addressee or recipient thereof, or persons who have been designated under FRCP 30(b)(6) to provide testimony on behalf of a Producing Party;
- b. Counsel of Record;
- c. Outside Consultants of the Receiving Party to whom disclosure is reasonably necessary for this litigation, and who have, after the date of this Supplemental Protective Order, signed the “Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A, and the “Certification Of Consultant Re Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case,” attached hereto as Exhibit B;
- d. Any designated arbitrator or mediator who is assigned to hear this matter, or who has been selected by the Parties, and his or her staff; who have, after the date of this Supplemental Protective Order, signed the

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“Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A, and the “Certification Of Consultant Re Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case,” attached hereto as Exhibit B, as well as any arbitrator’s or mediator’s staff who have also signed Exhibits A and B;

- e. Court reporters and videographers employed in connection with this action; and
- f. Professional Vendors to whom disclosure is reasonably necessary for this action, and a representative of which has signed the “Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A, subject to the following exception: Designated QUALCOMM Material shall not be disclosed to mock jurors without Non-Party QUALCOMM’s express written consent;
- g. The Court, its personnel and the jury.

23. Access to “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” Material: Unless otherwise ordered by the Court or permitted in writing by Non-Party QUALCOMM, a Receiving Party may disclose any information, document, or thing designated “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” only to:

- a. Persons who appear on the face of Designated QUALCOMM Material as an author, addressee or recipient thereof, or persons who have been designated under FRCP 30(b)(6) to provide testimony of behalf of a Producing Party or Qualcomm regarding the same;
- b. Counsel of Record;

- c. Outside Consultants of the Receiving Party to whom disclosure is reasonably necessary for this litigation, and who have, after the date of this Supplemental Protective Order, signed the “Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A, and the “Certification Of Consultant Re Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case,” attached hereto as Exhibit B;
- d. Any designated arbitrator or mediator who is assigned to hear this matter, or who has been selected by the Parties, and his or her staff; who have, after the date of this Supplemental Protective Order, signed the “Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A, and the “Certification Of Consultant Re Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case,” attached hereto as Exhibit B, as well as any arbitrator’s or mediator’s staff who have also signed Exhibits A and B, provided, however, that before such disclosure, QUALCOMM is provided notice including: (a) the individual’s name and business title; (b) business address; (c) business or professions; and (d) the individual’s CV. QUALCOMM shall have five (5) business days from receipt of the notice to object in writing to such disclosure (plus three (3) extra days if notice is given other than by hand delivery, e-mail delivery or facsimile transmission). After the expiration of the 5 business days (plus 3 days, if appropriate) period, if no objection has been asserted, then “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY –

CONFIDENTIAL SOURCE CODE” materials may be disclosed pursuant to the terms of this Supplemental Protective Order;

- e. Court reporters and videographers employed in connection with this action, subject to the provisions provided in subparagraph 32(g) herein;
- f. Professional Vendors to whom disclosure is reasonably necessary for this action, and a representative of which has signed the “Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A, subject to the following exception: Designated QUALCOMM Material shall not be disclosed to mock jurors without Non-Party QUALCOMM’s express written consent; and
- g. The Court, its personnel and the jury.

24. Notwithstanding the Protective Order, unless otherwise ordered or agreed in writing by Non-Party QUALCOMM, Designated QUALCOMM Material may not be disclosed to employees of a Receiving Party, including its in-house attorneys and support staff.

25. Notwithstanding the Protective Order, unless otherwise ordered or agreed in writing by Non-Party QUALCOMM, Designated QUALCOMM Material may not be disclosed to mock jurors.

26. The Parties acknowledge that Designated QUALCOMM Material also may be subject to the US government export control and economic sanctions laws (“Export Controlled Information”), including the Export Administration Regulations (“EAR”, 15 CFR 730 et seq., <http://www.bis.doc.gov/>) administered by the Department of Commerce, Bureau of Industry and Security, and the Foreign Asset Control Regulations (31 CFR 500 et seq., <http://www.treas.gov/offices/enforcement/ofac/>) administered by the Department of Treasury, Office of Foreign Assets Control (“OFAC”). Receiving Parties may not directly or indirectly export, re-export, transfer or release (collectively, “Export”) any Designated QUALCOMM Material to any destination, person, entity or end use prohibited or restricted under US law without

prior US government authorization to the extent required by regulation. The US government maintains embargoes and sanctions against the countries listed in Country Groups E:1/2 of the EAR (Supplement 1 to part 740) Export Controlled Information disclosed in this action will be used only for the purposes of this action. Outside Counsel or other individuals authorized to receive Export Controlled Information will not disclose, export, or transfer, in any manner, Export Controlled Information to any foreign person except as permitted by U.S. law, and will not transport any such document outside of U.S. territory, without prior written approval of the Bureau of Industry and Security or other appropriate U.S. government department or agency, except as permitted by U.S. law.

27. Receiving Party may host “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” Material only on either 1) any system inside the firewall of a law firm representing the Receiving Party, or 2) inside the system of a professional ESI Vendor retained by Counsel of Record of the Receiving Party. “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” Material also cannot be sent or transmitted to any person, location, or vendor outside of the United States except to Counsel of Record and Outside Consultants designated pursuant to subparagraphs 22(c) and 23(c) above. To the extent that any “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” Material is transmitted from or to authorized recipients outside of the Receiving Party’s Outside Counsel’s office, or outside of the ESI Vendor’s system, the transmission shall be by hand (and encrypted if in electronic format), by a secure transport carrier (e.g., Federal Express), or by secure electronic means, such as email using an encrypted password protected container (other than Trucrypt), or download via secure FTP. “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” may not be transmitted by electronic means; however, this should not be understood to prohibit the electronic transmittal of testifying experts’ expert reports or drafts, court filings, and trial demonstratives, thereof that may refer to QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE, subject to the limitations set forth in Section 32(g) herein, and as long as such electronic transmittal is by secure electronic means, such as email using an encrypted password protected container

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(other than Trucrypt), or download via secure FTP. Court filings containing QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY and QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE may be submitted via the Court’s ECF filing system subject to the limitations set forth in Section 32(g) herein.

28. Each person to whom Designated QUALCOMM Material may be disclosed, and who is required to sign the “Acknowledgement And Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” attached hereto as Exhibit A and, if applicable, the “Certification Of Consultant Re Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case,” attached hereto as Exhibit B, shall do so, prior to the time such Designated QUALCOMM Material is disclosed to him or her. Counsel for the Receiving Party who makes any disclosure of Designated QUALCOMM Material shall retain each original executed certificate and, upon written request, shall provide copies to counsel for Non-Party QUALCOMM at the termination of this action.

29. Absent written permission from Non-Party QUALCOMM, persons not permitted access to Designated QUALCOMM Material under the terms of this Supplemental Protective Order shall not be present at depositions while Designated QUALCOMM Material is discussed or otherwise disclosed. Pre-trial and trial proceedings shall be conducted in a manner, subject to the supervision of the Court, to protect Designated QUALCOMM Material from disclosure to persons not authorized to have access to such Designated QUALCOMM Material. Any Party intending to disclose or discuss Designated QUALCOMM Material at pretrial or trial proceedings must give advance notice to the Producing Party to assure the implementation of the terms of this Supplemental Protective Order.

V. ACCESS BY OUTSIDE CONSULTANTS

30. **Notice.** If a Receiving Party wishes to disclose Designated QUALCOMM Material to any Outside Consultant, Receiving Party must, prior to the Outside Consultant being granted access to any Designated QUALCOMM Material, provide notice to counsel for Non-Party

QUALCOMM, which notice shall include: (a) the individual's name and business title; (b) country of citizenship; (c) business address; (d) business or profession; (e) the individual's CV; (f) any previous or current relationship (personal or professional) with Non-Party QUALCOMM or any of the Parties to this action; (g) a list of other cases in which the individual has testified (at trial or deposition) within the last six years; (h) a list of all companies with which the individual has consulted or by which the individual has been employed within the last four years, the dates of the consultancy or employment, a brief description of the subject matter of the consultancy or employment, and (i) copies of the "Acknowledgement and Agreement To Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case," attached as Exhibit A, and the "Certification Of Consultant Re Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case," attached hereto as Exhibit B, that have both been signed by that Outside Consultant.

31. **Objections.** With respect to Outside Consultants that have not been previously disclosed to Non-Party QUALCOMM, Non-Party QUALCOMM shall have five (5) business days, starting from the first business day following the date upon which Receiving Party provides the notice and all information required by paragraph 30 to the Producing Party, to object for good cause in writing to such disclosure (plus three (3) extra days if notice is given in any manner other than by hand delivery, e-mail delivery or facsimile transmission). After the expiration of the 5 business days (plus 3-days, if appropriate) period, if no objection for good cause has been asserted by Non-Party QUALCOMM, then Designated QUALCOMM Material may be disclosed to the Outside Consultant pursuant to the terms of this Supplemental Protective Order. Any objection by Non-Party QUALCOMM must be made for good cause, and must set forth in detail the grounds on which it is based. Should Receiving Party disagree with the basis for the objection(s), Receiving Party must first attempt to resolve the objection(s) informally with Non-Party QUALCOMM. If the informal efforts do not resolve the dispute within five (5) business days from the date upon which Receiving Party was first notified of any objection for good cause by Non-Party QUALCOMM, Receiving Party may file a motion requesting that the objection(s) be quashed after

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that five (5) day period has passed. Non-Party Qualcomm shall have the burden of proof by a preponderance of the evidence on the issue of the sufficiency of the objection(s). Pending a ruling by the Court upon any such objection(s), or the subsequent resolution of the objection for good cause by Receiving Party and Non-Party QUALCOMM, the discovery material shall not be disclosed to the person objected to by Non-Party QUALCOMM.

VI. PRODUCTION OF QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE MATERIAL

32. Non-Party QUALCOMM’s Source Code and Chip-Level Schematics:

a. To the extent that a Producing Party makes Non-Party QUALCOMM’s Source Code or Chip-Level Schematics available for inspection:

(i) The Producing Party shall make all relevant and properly requested Non-Party QUALCOMM Source Code available electronically and in text searchable form (1) if produced by Non-Party QUALCOMM, in a separate room at a secure facility selected by Non-Party QUALCOMM or (2) if produced by Defendant, at the offices of Counsel of Record for the producing Defendant or at a secure facility approved by QUALCOMM. The Producing Party shall make the Source Code available for inspection on a stand-alone, non-networked personal computer running a reasonably current version of the Microsoft Windows operating system (“Source Code Computer”). Alternatively, solely at the option of the Producing Party, the Producing Party may make such source code available on a Source Code Computer that is networked, in a configuration deemed secure by Non-Party QUALCOMM. The Source Code Computer shall be configured to permit review of the Source Code through a password-protected account having read-only access. To facilitate review of the Source Code at the secure facility, the Receiving Party may use appropriate tool software on the Source Code Computer, which shall be installed by the Producing Party,

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including at least one text editor like Visual Slick Edit that is capable of printing out Source Code with page and/or line numbers, a source code comparison tool like Winmerge, and at least one multi-text file text search tool such as “grep.” Should it be necessary, other mutually agreed upon tools may be used. Licensed copies of other mutually agreed upon tool software shall be installed on the Source Code Computer by the Producing Party and paid for by the Receiving Party.

(ii) The Producing Party shall make all relevant and properly requested Chip-Level Schematics available for inspection electronically on the Source Code Computer in a secure room at a secure facility selected by Non-Party QUALCOMM. The Producing Party shall ensure that the Source Code Computer includes software sufficient to allow a user to view such electronic Chip-Level Schematics.

- b. The Producing Party shall provide access to the Source Code Computer during the normal operating hours of the secure facility.
- c. The Source Code Computer shall be equipped to allow printing of the Source Code and Chip-Level Schematics made available for inspection by the Producing Party. Copies of Source Code and Chip-Level Schematics shall only be made on watermarked pre-Bates numbered paper, which shall be provided by the Producing Party. Under no circumstances are original printouts of the Source Code or Chip-Level Schematics to be made except for directly onto the watermarked and numbered sides of the paper provided by the Producing Party. Additionally, the Receiving Party may not print any continuous block of source code that results in more than 50 consecutive printed pages, except that Authorized Reviewer(s) may request the printing of a continuous block of more than 50 pages, which request shall not be unreasonably denied by the Producing Party. Counsel for the

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Producing Party will keep the original printouts, and shall provide copies of such original printouts to counsel for the Receiving Party within seven (7) days of (1) any request by the Receiving Party, or (2) otherwise being notified that such original printouts have been made or designated. Counsel of Record for the Receiving Party may request up to 10 copies of each original printout of Source Code or Chip-Level Schematics. No more than 10% or 500 pages of the total Source Code (not including copies of original printouts) whichever is greater, for any software release (or in the case of hardware Source Code, for any hardware product), no more than 500 pages of Chip-Level Schematics, and no continuous blocks of Source Code or Chip-Level Schematics that exceed 50 pages, may be in printed form at any one time, without the express written consent of Non-Party QUALCOMM, which shall not be unreasonably denied. All printed Source Code and Chip-Level Schematics shall be logged by Receiving Party's Counsel of Record and/or other Personnel Retained by a Receiving Party in this action as noted in subparagraph 32 (i) below. No additional electronic copies of the Source Code or Chip-Level Schematics shall be provided by the Producing Party. Hard copies of the Source Code or Chip-Level Schematics also may not be converted into an electronic document, and may not be scanned using optical character recognition ("OCR") technology. Only printouts of Source Code and Chip-Level Schematics may be made, and such printouts must include (1) directory path information and filenames from which the Source Code and Chip-Level Schematics came and (2) line numbers. The Producing Party may refuse to provide copies of Source Code and Chip-Level Schematics printouts that fail to comply with this section.

- d. Authorized Reviewer(s) in this action shall not print Source Code or Chip-Level Schematics which have not been reviewed on the Source Code

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Computer, or in order to review the Source Code or Chip-Level Schematics elsewhere in the first instance, i.e., as an alternative to reviewing that Source Code or Chip-Level Schematics electronically on the Source Code Computer, as the Parties and QUALCOMM acknowledge and agree that the purpose of the protections herein would be frustrated by such actions.

- e. Authorized Reviewer(s) are prohibited from bringing outside electronic devices, including but not limited to laptops, floppy drives, zip drives, or other hardware into the secure room. Nor shall any cellular telephones, personal digital assistants (PDAs), Blackberries, cameras, voice recorders, Dictaphones, external or portable telephone jacks or other outside electronic devices be permitted inside the secure room, except for medical devices, implants, or equipment reasonably necessary for any legitimate medical reason.
- f. If any Authorized Reviewer(s) reviewing Non-Party QUALCOMM's Source Code or Chip-Level Schematics seeks to take notes, all such notes will be taken on bound (spiral or other type of permanently bound) notebooks.
- g. A Receiving Party may make copies of excerpts of no more than 5 continuous lines of Designated Source Code Material for the sole purpose of providing these excerpts in a pleading, exhibit, demonstrative, expert report, discovery document, or other Court document filed with the Court under seal in accordance with the Court's rules, procedures and orders (or drafts thereof) and should designate each such document QUALCOMM - OUTSIDE ATTORNEYS' EYES ONLY – CONFIDENTIAL SOURCE CODE, except that the Receiving Party may request to make copies of excerpts of more than 5 continuous lines of Designated Source Code Material for such purpose, which request shall not be unreasonably denied

by QUALCOMM. Except as approved by QUALCOMM, longer excerpts shall not be copied for use in court documents but shall be referred to by citation to production page numbers and lines. A Receiving Party shall provide notice to QUALCOMM or its counsel for each occasion on which it submits portions of Designated Source Code Material in a pleading or other Court document. In the event copies of Source Code or Chip-Level Schematic printouts are used as exhibits in a deposition, printouts shall not be provided to the court reporter, and the further copies of the original QUALCOMM Source Code or Chip-Level Schematics printouts made for the deposition or trial shall be destroyed at the conclusion of the deposition or trial. The original copies of deposition exhibits designated “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” will be maintained by the deposing party under the terms set forth in this Supplemental Protective Order.

- h. In addition to other reasonable steps to maintain the security and confidentiality of Non-Party QUALCOMM’s Source Code and Chip-Level Schematics, printed copies of the Designated Source Code Material maintained by the Receiving Party must be kept in a locked storage container when not being actively reviewed or otherwise being transferred as permitted by the Protective Order and/or this Supplemental Protective Order.
- i. The Receiving Party’s Counsel of Record shall keep log(s) recording the identity of each individual to whom each hard copy of each Producing Party’s QUALCOMM Source Code or Chip-Level Schematics is provided and when it was provided to that person in the first instance, and within thirty (30) days after the issuance of a final, non-appealable decision resolving all issues in this action, the Receiving Party must serve upon Non-

Party QUALCOMM the log. In addition, any Outside Consultants of the Receiving Party to whom the paper copies of the QUALCOMM Source Code or Chip-Level Schematics were provided must certify in writing that all copies of the QUALCOMM Source Code or Chip-Level Schematics were destroyed or returned to the counsel who provided them the information and that they will make no use of the Source Code or Chip-Level Schematics, or of any knowledge gained from the source code in any future endeavor.

VII. PROCEDURE FOR DESIGNATING MATERIALS

33. Subject to the limitations set forth in the Protective Order and in this Supplemental Protective Order, any Party or Non-Party QUALCOMM may: designate as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” or information that it believes, in good faith, meets the definition set forth in paragraph 2 above; and designate as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” information that it believes, in good faith, meets the definition set forth in paragraph 5 above.

34. Except as provided above in paragraph 32 with respect to “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” Material, any material, including (including physical objects) made available by Non-Party QUALCOMM for initial inspection by counsel for the Receiving Party prior to producing copies of selected items shall initially be considered, as a whole, to constitute “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” information, and shall be subject to this Order. Thereafter, Non-Party QUALCOMM shall have seven (7) calendar days from the inspection to review and designate the appropriate documents as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” prior to furnishing copies to the Receiving Party.

35. Designation in conformity with the Protective Order and this Supplemental Protective Order shall be made as follows:

- a. For information in documentary (including “electronically stored information”) form (apart from transcripts of depositions or other pretrial or trial proceedings): the Designating Party shall affix the legend “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” or “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE” conspicuously on each page that contains Protected Material.

A party or non-party that makes original documents or materials available for inspection need not designate them for protection until after the Receiving Party has indicated which material it would like copied or produced. Before and during the inspection, all material made available for inspection shall be deemed “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY.” After the Receiving Party has identified the documents it wants copied and produced, the Producing Party must determine which documents, or portions thereof, qualify for protection under this Order and, before producing the specified documents, the Producing Party must affix the appropriate legend to each page that contains Designated QUALCOMM Material.

- b. For Testimony Given in Deposition: For deposition transcripts, the Designating Party shall specify any portions of the testimony that it wishes to designate, by line and page number, no later than 20 business days after the final transcript of the deposition has been received. The Party or Non-Party may identify the entirety of the transcript as “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” or “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE,” but all deposition transcripts not designated during the deposition will nonetheless be treated as “QUALCOMM – OUTSIDE ATTORNEYS’

EYES ONLY” or “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE,” until the time within which it may be appropriately designated as provided for herein has passed. Any Protected Material that is used in the taking of a deposition shall remain subject to the provisions of this Supplemental Protective Order and the Protective Order in these actions, along with the transcript pages of the deposition testimony dealing with such Protected Material. In such cases the court reporter shall be informed of this Supplemental Protective Order and shall be required to operate in a manner consistent with this Supplemental Protective Order. Transcript pages containing Designated Material must be separately bound by the court reporter, who must affix to the top of each such page the legend “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” and/or “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE.” An encrypted, password protected copy of deposition transcripts containing Designated Qualcomm Material made pursuant to this paragraph may be hosted electronically by the Receiving Party on any system inside the firewall of a law firm representing the Receiving Party, however, all other restrictions in this Supplemental Protective Order pertaining to Designated Source Code Material apply. In the event the deposition is videotaped, the original and all copies of the videotape shall be marked by the video technician to indicate that the contents of the videotape are subject to this Supplemental Protective Order and the Protective Order, substantially along the lines of “This videotape contains confidential or outside counsel eyes only confidential testimony used in this case and is not to be viewed or the contents thereof to be displayed or revealed except pursuant to the terms of the operative protective orders in this matter or pursuant to written

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stipulation of the parties.” Counsel for any Designating Party shall have the right to exclude from oral depositions, other than the deponent, deponent’s counsel, and the reporter and videographer (if any), any person who is not authorized by the Protective Orders in this action to receive or access Protected Material based on the designation of such Protected Material.

- c. For information produced in some form other than documentary, and for any other tangible items, the Designating Party shall affix, in a prominent place on the exterior of the medium, container or containers in which the information or item is stored, the appropriate legend.
- d. The provisions of subparagraphs 35 (a-c) do not apply to documents produced in native format. For documents produced in native format, the parties shall provide written notice to the Receiving Party of any confidentiality designations at the time of production.

VIII. USE OF DESIGNATED QUALCOMM MATERIAL

36. Use of Designated QUALCOMM Material By Receiving Party: Unless otherwise ordered by the Court, or agreed to in writing by Non-Party QUALCOMM, all Designated QUALCOMM Material, and all information derived therefrom, shall be used by the Receiving Party only for purposes of this action, and shall not be used in any other way, or for any other purpose, including the acquisition, preparation or prosecution before the Patent office of any patent, patent application, for drafting or revising patent claims, or in connection with patent licensing or product development work directly or indirectly intended for commercial purposes related to the particular technologies or information disclosed in the Designated QUALCOMM Material. Information contained or reflected in Designated QUALCOMM Material shall not be disclosed in conversations, presentations by parties or counsel, in court or in other settings that might reveal Designated QUALCOMM Material, except in accordance with the terms of the Protective Order or this Supplemental Protective Order. No Designated QUALCOMM Material shall be transmitted or transported outside of the United States, communicated to any recipient

who is located outside of the United States, or communicated to any recipient who is not a citizen or lawful permanent resident of the United States for any purpose whatsoever without the express written permission of QUALCOMM. Nothing in this Supplemental Protective Order shall prohibit the transmission or communication of Designated QUALCOMM Material between or among qualified recipients located in the United States who are citizens or lawful permanent residents of the United States, by hand delivery or, subject to the other requirements of this Supplemental Protective Order, by telephone, facsimile, or other electronic transmission system, where, under the circumstances, there is no reasonable likelihood that the transmission will be intercepted or misused by any person who is not an Authorized Reviewer.

37. Use of Designated QUALCOMM Material by Non-Party QUALCOMM: Nothing in this Supplemental Protective Order shall limit Non-Party QUALCOMM's use of its own documents and information, nor shall it prevent Non-Party QUALCOMM from disclosing its own confidential information, documents or things to any person. Such disclosure shall not affect any designations made pursuant to the terms of this Supplemental Protective Order, so long as the disclosure is made in a manner that is reasonably calculated to maintain the confidentiality of the information.

38. Use of Designated QUALCOMM Material at Deposition: Non-Party QUALCOMM shall, on request prior to the deposition, make a searchable electronic copy of the QUALCOMM Source Code available on a stand-alone computer connected to a printer during depositions of QUALCOMM personnel otherwise permitted access to such Source Code. To the extent required, the party conducting the deposition may print additional pages of Source Code printouts to be marked as exhibits at such depositions consistent with other provisions and limitations of the Protective Order and this Supplemental Protective Order. Except as may be otherwise ordered by the Court, any person may be examined as a witness at depositions and trial, and may testify concerning all Designated QUALCOMM Material of which such person has prior knowledge.

39. Use of Designated QUALCOMM Material at Hearing or Trial: The parties will give Non-Party QUALCOMM prior notice of, and an opportunity to object to, any intended use of the Designated QUALCOMM Material at any hearing or trial in this case. Said notice shall (a) be served by facsimile or email on counsel for Non-Party QUALCOMM at least five (5) business days prior to the hearing or first day of trial, (2) identify the Designated QUALCOMM Material with specificity while redacting any other Party's Confidential Business Information and (3) identify the measures the party intends to rely upon to protect the Designated QUALCOMM Material when used at any hearing or trial consistent with this Supplemental Protective Order. This section shall not limit in any way the use of Designated QUALCOMM Material during the cross-examination of any witness otherwise permitted access to such Designated QUALCOMM Material, as long as the parties take all necessary steps to protect and maintain the confidentiality of any such Designated QUALCOMM Material.

IX. PROSECUTION AND DEVELOPMENT BAR

40. Unless otherwise permitted in writing between Producing Party and Receiving Party, any individual who personally receives, other than on behalf of Producing Party, any material designated "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY" or "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY – CONFIDENTIAL SOURCE CODE" shall not participate in amending or drafting patent specifications or claims before a Patent Office of any patent or patent application related to the information disclosed in the Designated QUALCOMM Material, from the time of receipt of such material through the date the individual person(s) cease to have access to materials designated "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY" or "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY – CONFIDENTIAL SOURCE CODE," as well as any materials that contain or disclose Designated QUALCOMM Material. This provision shall not apply to post-grant proceedings, including without limitation reexamination, covered business method (CBM), inter partes review (IPR) post grant review (PGR) or opposition proceedings.

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41. Unless otherwise permitted in writing between Non-Party QUALCOMM and Receiving Party, any Outside Consultant retained on behalf of Receiving Party who is to be given access to Non-Party QUALCOMM's documents, Source Code, or Chip-Level Schematics designated as "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY" or "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY – CONFIDENTIAL SOURCE CODE" must agree in writing, using the form in Exhibit B, not to perform hardware or software development work or product development work directly or indirectly intended for commercial purposes related to the information disclosed in the Designated QUALCOMM Material, which is not publicly known, from the time of first receipt of such material through the date the expert consultant ceases to have access to any material designated "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY" or "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY – CONFIDENTIAL SOURCE CODE," as well as any materials that contain or disclose Designated QUALCOMM Material.

X. DESIGNATED QUALCOMM MATERIAL SUBPOENAED OR ORDERED PRODUCED IN OTHER LITIGATION

42. If a Receiving Party is served with a subpoena or a court order that would compel disclosure of any information, documents or things designated in this action as "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY" or "QUALCOMM – OUTSIDE ATTORNEYS' EYES ONLY – CONFIDENTIAL SOURCE CODE," Receiving Party must notify the Producing Party and Non-Party QUALCOMM of such information, documents or things, in writing (by fax and email) promptly, and in no event more than ten (10) calendar days after receiving the subpoena or order. Such notification must include a copy of the subpoena or order. Receiving Party also must immediately inform, in writing, the party who caused the subpoena or order to issue that some or all of the material covered by the subpoena or order is subject to this Supplemental Protective Order and the Protective Order. In addition, the Receiving Party must provide a copy of this Supplemental Protective Order and the Protective Order promptly to the party in the other action that caused the subpoena or order to issue. The purpose of imposing these duties is to alert the interested parties to the existence of this Supplemental Protective Order and the Protective Order,

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and to afford the Party whose Designated QUALCOMM Material in this case, is at issue in the other case, an opportunity to try to protect its confidentiality interests in the court from which the subpoena or order issued. Producing Party shall bear the burdens and the expenses of seeking protection in that court of its Designated QUALCOMM Material. Nothing in these provisions should be construed as authorizing or encouraging any Receiving Party in this action to disobey a lawful directive from another court.

XI. UNAUTHORIZED DISCLOSURE OF DESIGNATED QUALCOMM MATERIAL

43. If a Receiving Party learns that, by inadvertence or otherwise, it has disclosed Designated QUALCOMM Material to any person or in any circumstance not authorized under this Order, the Receiving Party must immediately (a) notify in writing Producing Party and Non-Party QUALCOMM of the unauthorized disclosures, (b) use its best efforts to retrieve all copies of the Designated QUALCOMM Material, (c) inform the person or persons to whom unauthorized disclosures were made of all the terms of this Order, and (d) request such person or persons to execute the “Acknowledgment and Agreement to Be Bound By Supplemental Protective Order Governing Confidential Information of Non-Party Qualcomm In This Case” that is attached hereto as Exhibit A. Nothing in these provisions should be construed as limiting any Producing Party’s rights to seek remedies for a violation of this Supplemental Protective Order.

XII. DURATION

44. Even after the termination of this action, the confidentiality obligations imposed by this Supplemental Protective Order shall remain in effect following the termination of this action, or until Non-Party QUALCOMM agrees otherwise in writing or a court order otherwise directs.

XIII. FINAL DISPOSITION

45. Unless otherwise ordered or agreed in writing by Producing Party, within sixty (60) days of the termination of all of this action, whether through settlement or final judgment (including any and all appeals therefrom), each Receiving Party, including Outside Counsel for each Receiving Party, will destroy all Designated QUALCOMM Material produced by Non-Party QUALCOMM or any other Party in this action and will destroy or redact any such Designated

Rembrandt Wireless

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QUALCOMM Material included in work product, pleadings, motion papers, legal memoranda, correspondence, trial transcripts and trial exhibits admitted into evidence (“derivations”) and all copies thereof, with the exception of copies stored on back-up tapes or other disaster recovery media. Within sixty (60) days of the date of settlement or final judgment, each Receiving Party shall serve Non-Party QUALCOMM with a certification stating that it, including its Outside Counsel, has complied with its obligations under this paragraph. With respect to any copy of Designated QUALCOMM Material or derivation thereof that remains on back-up tapes and other disaster storage media of an Authorized Reviewer(s), neither the Authorized Reviewer(s) nor its consultants, experts, counsel or other party acting on its behalf shall make copies of any such information available to any person for any purpose other than backup or disaster recovery unless compelled by law and, in that event, only after thirty (30) days prior notice to Producing Party or such shorter period as required by court order, subpoena, or applicable law.

So ORDERED and SIGNED this 20th day of November, 2019.


RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

EXHIBIT A

ACKNOWLEDGMENT AND AGREEMENT TO BE BOUND BY SUPPLEMENTAL PROTECTIVE ORDER GOVERNING CONFIDENTIAL INFORMATION OF NON-PARTY QUALCOMM IN THIS CASE

I, _____ [print or type full name], state: My business address is _____;

1. My present employer is _____;

2. My present occupation or job description is _____;

3. I have been informed of and have reviewed the Supplemental Protective Order Governing Discovery from Non-Party QUALCOMM in this case (the “Supplemental Protective Order”) entered in this case, and understand and agree to abide by its terms. I agree to keep confidential all information provided to me in the matter of Rembrandt Wireless Technologies, LP v. Apple Inc., Case No. 2:19-CV-00025 in the United States District Court, Eastern District of Texas in accordance with the restrictions in the Supplemental Protective Order, and to be subject to the authority of that Court in the event of any violation or dispute related to the Supplemental Protective Order.

4. I state under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

[Signature]

Executed On _____

[Printed Name]

EXHIBIT B

CERTIFICATION OF CONSULTANT RE SUPPLEMENTAL PROTECTIVE ORDER GOVERNING CONFIDENTIAL INFORMATION OF NON-PARTY QUALCOMM IN THIS CASE

I, _____ [print or type full name], of _____ am not an employee of the Party who retained me or of a competitor of any Party or Non-Party QUALCOMM and will not use any information, documents, or things that are subject to the Supplemental Protective Order Governing Discovery From Non-Party QUALCOMM in Rembrandt Wireless Technologies, LP v. Apple Inc., Case No. 2:19-CV-00025 in the United States District Court, Eastern District of Texas, for any purpose other than this litigation. I agree not to perform hardware or software development work or product development work intended for commercial purposes related to the information disclosed in the Designated QUALCOMM Material, from the time of receipt of such material through and including the date that I cease to have access to any material designated “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY” or “QUALCOMM – OUTSIDE ATTORNEYS’ EYES ONLY – CONFIDENTIAL SOURCE CODE.”

I state under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

[Signature]

Executed On _____

[Printed Name]

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 2:19-CV-00025-JRG

Hon. Rodney Gilstrap


JURY TRIAL DEMANDED

**ORDER GRANTING UNOPPOSED MOTION FOR LEAVE TO FILE DOCUMENTS
UNDER SEAL**

Before the Court is Defendant Apple Inc.'s Motion for Leave to File Documents Under Seal. (Dkt. No. 29.) The Court, having considered same, is of the opinion the motion should be **GRANTED**.

It is therefore **ORDERED** that Apple Inc. shall have leave to file its Motion to Transfer Venue (Dkt. No. 30) and attachments thereto under **SEAL**.

So ORDERED and SIGNED this 23rd day of May, 2019.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

Rembrandt Wireless
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**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

**REMBRANDT WIRELESS
TECHNOLOGIES, LP,**

Plaintiff,

v.

APPLE INC.,

Defendant.

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CIVIL ACTION NO. 2:19-CV-00025-JRG

MEMORANDUM OPINION AND ORDER

Before the Court is Defendant Apple Inc.’s (“Apple”) Motion to Transfer Venue (the “Motion”). (Dkt. No. 30.) By its Motion, Apple seeks transfer of the above-captioned action to the Central District of California pursuant to 28 U.S.C. § 1404(a). Having considered the Motion and for the reasons set forth herein, the Court is of the opinion that the Motion should be and hereby is **DENIED**.

I. Background

On January 24, 2019, Rembrandt Wireless Technologies, LP (“Rembrandt”) brought suit against Apple alleging infringement of U.S. Patent No. 8,457,228 and U.S. Patent No. 8,023,580 (collectively, the “Asserted Patents”). (Dkt. No. 1.) On April 15, 2019, Rembrandt brought similar suits for infringement of the Asserted Patents against Broadcom Inc. and Broadcom Corp. (collectively, “Broadcom”) and Qualcomm Inc. (“Qualcomm”) in the Central District of California. (Dkt. Nos. 56-18, 56-19.) Most of the Apple products accused of infringement in this action incorporate the accused functionality by means of chips manufactured by Broadcom or

Rembrandt Wireless

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Qualcomm. (Dkt. No. 30-1 ¶¶ 11–13.) Apple now seeks transfer of this action to the Central District of California where the actions against Broadcom and Qualcomm are pending.

II. Legal Standard

If venue in the district in which the case is originally filed is proper, the court may nonetheless transfer a case based on “the convenience of parties and witnesses” to “any other district or division where it might have been brought or to any district or division to which all parties have consented.” 28 U.S.C. § 1404(a). The threshold inquiry when analyzing eligibility for § 1404(a) transfer is “whether the judicial district to which transfer is sought would have been a district in which the claim could have been filed.” *In re Volkswagen AG*, 371 F.3d 201, 203 (5th Cir. 2004) [hereinafter *Volkswagen I*].

Once this initial threshold has been met, courts determine whether the case should be transferred by analyzing various public and private factors. *See Humble Oil & Ref. Co. v. Bell Marine Serv., Inc.*, 321 F.2d 53, 56 (5th Cir. 1963); *accord In re Nintendo Co., Ltd.*, 589 F.3d 1194, 1198 (Fed. Cir. 2009). The private factors are: (1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial of a case easy, expeditious, and inexpensive. *Volkswagen I*, 371 F.3d at 203 (citing *Piper Aircraft Co. v. Reyno*, 454 U.S. 235, 241 n.6 (1981)). The public factors are: (1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws or in the application of foreign law. *Id.* These factors are to be decided based on “the situation which existed when suit was instituted.” *Hoffman*, 363 U.S. at 343. Though the private and public factors apply to most transfer cases, “they are not necessarily

exhaustive or exclusive,” and no single factor is dispositive. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 314–15 (5th Cir. 2008) [hereinafter *Volkswagen II*].

To prevail on a motion to transfer under § 1404(a), the movant must show that transfer is “clearly more convenient” than the venue chosen by the plaintiff. *Id.* at 315; accord *In re Apple Inc.*, 456 F. App’x 907, 909 (Fed. Cir. 2012) (holding that a movant must “meet its burden of demonstrating [] that the transferee venue is ‘clearly more convenient.’”) (internal citation omitted). Absent such a showing, plaintiff’s choice of venue is to be respected. *Volkswagen II*, 545 F.3d at 315. When deciding a motion to transfer under § 1404(a), the court may consider undisputed facts outside of the pleadings such as affidavits or declarations, but it must draw all reasonable inferences and resolve factual conflicts in favor of the non-moving party. *See Sleepy Lagoon, Ltd., v. Tower Grp., Inc.*, 809 F. Supp. 2d 1300, 1306 (N.D. Okla. 2011); *see also Cooper v. Farmers New Century Ins. Co.*, 593 F. Supp. 2d 14, 18–19 (D.D.C. 2008). In determining a motion to transfer venue under § 1404(a), the Court looks to “the situation which existed when suit was instituted.” *Hoffman v. Blaski*, 363 U.S. 335, 343 (1960).

III. Discussion

The parties do not dispute that this action could have been brought in the Central District of California. However, having considered the private and public interest factors the Court concludes that Apple has failed to meet its burden to show that transfer to the Central District of California is clearly more convenient.

A. Private Interest Factors

1. Ease of Access to Sources of Proof

The Court finds that the ease of access to sources of proof weighs against transfer. As an initial matter, the Court notes that Apple’s argument that this factor favors transfer relies almost

exclusively on the location of potential witnesses. However, this factor focuses on “documents and physical evidence,” not witnesses. *Volkswagen II*, 545 F.3d at 316.

Apple has proffered evidence that relevant marketing, technical, and financial documents in Apple’s custody or control are located in California. (Dkt. No. 30-1 ¶¶ 24–26.) Apple also asserts that relevant documents may be in the possession of Broadcom, Qualcomm, and other potentially relevant witnesses, each of which are located in California. (Dkt. No. 30 at 9–12.)

Rembrandt counters that evidence under the control of Apple, Broadcom, and Qualcomm is scattered beyond California, including at a large Apple facility in Israel. (Dkt. No. 56 at 4–6.) Rembrandt also argues that its own sources of proof are located at its headquarters in Pennsylvania and at the offices of its attorneys in Pennsylvania. (*Id.* at 7.) Additionally, documents in the possession of the inventor of the Asserted Patents, Gordon Bremer, are located in Florida. (*Id.*)

The Court finds that Apple’s sources of proof located in Israel weigh only slightly against transfer because such sources of proof “will be traveling a great distance no matter which venue the case is tried in and will be only slightly more inconvenienced by” by transfer. *In re Genentech, Inc.*, 566 F.3d 1338, 1345 (Fed. Cir. 2009). Taking the remaining sources of proof together—with sources of proof related to the defendant and the accused technology located primarily on the West Coast and sources of proof related to the plaintiff and the Asserted Patents on the East Coast—and noting that the present forum is roughly equally convenient to all these sources of proof, the Court finds that transfer for the convenience of Apple’s sources of proof would raise a commensurate inconvenience on Rembrandt’s sources of proof.¹ Accordingly, the Court finds that this factor weighs against transfer.

¹ The Court does not rely on its centralized location *per se* in finding that this factor weighs against transfer. *See Genentech*, 566 F.3d at 1344. Rather the Court notes that transfer would unfairly work an inconvenience on one party for the benefit of the other. In this manner, *Rembrandt Wireless*

2. Availability of Compulsory Process

The Court finds that this factor weighs slightly in favor of transfer. Apple argues that Apple, Broadcom, and Qualcomm each have employee-witnesses in California that would be subject to compulsory process in the Central District of California. (Dkt. No. 30 at 12–13.) However, Apple does not identify who any of these witnesses are. (*Id.*) As to these unidentified witnesses, Apple necessarily cannot explain “the foreseeability that a *particular* witness would be deposed, called to trial, or both.” *Diem LLC v. BigCommerce, Inc.*, 2017 WL 6729907, at *3 (E.D. Tex. Dec. 28, 2017); *see also Stingray Music USA, Inc. v. Music Choice*, No. 2:16-cv-964-JRG-RSP, 2017 WL 1022741, at *3 (E.D. Tex. Mar. 16, 2017) (according little weight to unnamed potential witnesses). The only two witnesses subject to compulsory process that are particularly identified are Steven Hall and Paul Castor.² (Dkt. No. 30 at 13.) Mr. Hall appears to have relevant information regarding the development of Broadcom’s accused chips. By contrast, Mr. Castor’s knowledge of the destruction of potentially relevant documents is unlikely to be presented to a jury at trial because such evidentiary issues are generally reserved for the Court’s consideration. “Moreover, the availability of depositions within 100 miles of where these . . . witnesses live and work further diminishes the importance of the subpoena power.” *Stingray*, 2017 WL 1022741, at *3. Accordingly, the Court finds that this factor weighs only slightly in favor of transfer.

distinguishable from *Genentech* where the party opposing transfer was a foreign corporation whose travel to *any* U.S. forum would have been inconvenient regardless. *Id.* at 1345.

² The Court notes that Apple also identifies Mr. Castor and Mr. Hall as *willing* witnesses, the convenience of whom should be considered under the third private interest factor. (Dkt. No. 30 at 10.) Witnesses are either willing or unwilling witnesses and accordingly may be considered under one factor or the other, but not both. The lack of clarity as to whether compulsory process would be required to secure the testimony of Mr. Castor or Mr. Hall further diminishes the weight of this factor.

3. Convenience of the Witnesses and Parties

As discussed above, the Court finds that transfer to the Central District of California for the convenience of Apple and its potential witnesses would work a commensurate inconvenience on Rembrandt and its potential witnesses. Accordingly, the Court finds that this factor weighs against transfer.

4. Judicial Economy

Apple notes that related litigation against Rembrandt and Qualcomm is currently pending before the Central District of California. (Dkt. No. 30 at 8.) Therefore, Apple argues, transfer to that District would serve judicial economy and avoid the potential for inconsistent judgments. (*Id.* at 8–9.) While the Court might otherwise be inclined to agree with Apple, this action was filed some four months before the actions in the Central District of California. Venue is determined at the time of the filing of the action. *Hoffman*, 363 U.S. at 343. Therefore, the Court cannot consider the existence of the later-filed Rembrandt and Qualcomm lawsuits in its venue analysis.

Rembrandt in turn points to the prior *Samsung* litigation before this Court, *Rembrandt Wireless Techs., LP v. Samsung Elecs. Co.*, No. 2:13-cv-213-JRG (E.D. Tex.), during which the Court gained an intimate familiarity with the Asserted Patents. (Dkt. No. 56 at 12–14.) The Court agrees with Rembrandt that the Court’s familiarity with the subject matter of this dispute will promote judicial economy. *See In re Vistaprint Ltd.*, 628 F.3d 1342, 1346–47 (Fed. Cir. 2010). Accordingly, this factor weighs against transfer.

B. Public Interest Factors

1. Administrative Difficulties

“The speed with which a case can come to trial and be resolved” favors venue in this Court over the Central District of California. *In re Genentech*, 566 F.3d at 1347. The median time to

trial for patent cases in this District is 639 days versus 813 days in the Central District of California. (Dkt. No. 57-25 at 1, 9.) Accordingly, this factor weighs against transfer.

2. Local Interest

Apple asserts that there is a local interest in this issue being resolved in the Central District of California. (Dkt. No. 30 at 14–15.) Apple is not headquartered in the Central District of California. (Dkt. No. 1 ¶ 3.) Apple argues instead that this action calls into question the “work and reputation” of Broadcom and Qualcomm, who each have a presence in the Central District of California. (Dkt. No. 30 at 14 (citing *In re Hoffman-La Roche*, 587 F.3d 1333, 1336 (Fed. Cir. 2009)).) However, Apple has not identified any *individuals* whose reputations have been implicated by this action or how. *See Hoffman-La Roche*, 587 F.3d at 1336 (noting that local interest is strong where “the cause of action calls into question the work and reputation of several individuals residing in or near that district”).

Moreover, Rembrandt has not alleged wrongdoing against Broadcom or Qualcomm at all. Rather, Rembrandt asserts patent infringement against Apple for manufacturing, using, selling, importing, exporting, or offering for sale allegedly infringing Apple products. (*See, e.g.*, Dkt. No. 1 ¶¶ 28–29.) It is not the plaintiff’s “cause of action,” but the defendant, that “calls into question” Broadcom and Qualcomm’s conduct. *Hoffman-La Roche*, 587 F.3d at 1336. The Court does not find that a defendant’s assertion of the un-alleged conduct of a non-party is sufficient to create a local interest in the actual dispute alleged. Accordingly, the Court finds that this factor is neutral.

3. Other Public Interest Factors

Both this District and the Central District of California are familiar with the law that will govern this case and no issues of conflict of laws exist. Accordingly, the Court finds that these factors are neutral.

Reviewing each of the private and public interest factors, four factors weigh against transfer, one factor weighs slightly in favor of transfer, and the remainder are neutral. Thus, Apple has not demonstrated that the Central District of California is a clearly more convenient forum.

IV. Conclusion

For the reasons set forth herein, Apple's Motion to Transfer Venue (Dkt. No. 30) is **DENIED**. Apple's Unopposed Motion for Oral Hearing (Dkt. No. 71) is likewise **DENIED**.

So ORDERED and SIGNED this 27th day of November, 2019.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

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

**REMBRANDT WIRELESS
TECHNOLOGIES, LP,**

Plaintiff,

v.

APPLE INC.,

Defendant.

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CIVIL ACTION NO. 2:19-CV-00025-JRG

MEMORANDUM OPINION AND ORDER

Before the Court is Defendant Apple Inc.’s (“Apple”) Motion to Stay Based on Customer-Suit Exception (the “Motion”). (Dkt. No. 77.) By its Motion, Apple requests that this Court stay the above-captioned action in light of suits filed by Plaintiff Rembrandt Wireless Technologies, LP (“Rembrandt”) against Broadcom Corp. and Broadcom Inc. (collectively, “Broadcom”) and Qualcomm Inc. (“Qualcomm”) in the Central District of California. Having considered the Motion and for the reasons set forth herein, the Court is of the opinion that the Motion should be and hereby is **DENIED**.

I. Background

On January 24, 2019, Rembrandt brought suit against Apple alleging infringement of U.S. Patent No. 8,457,228 and U.S. Patent No. 8,023,580 (collectively, the “Asserted Patents”). (Dkt. No. 1.) On April 15, 2019, Rembrandt brought similar suits for infringement of the Asserted Patents against Broadcom and Qualcomm in the Central District of California (the “California Suits”). (Dkt. Nos. 77-3, 77-4.)

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Broadcom and Qualcomm manufacture Bluetooth chipsets that are incorporated into the majority of the Apple products accused of infringement in this action (the “Accused Products”). (Dkt. No. 77 at 3; Dkt. No. 77-1 ¶ 5; *see also* Dkt. No. 1 ¶ 29 (listing Apple products accused of infringement.) The remainder of the Accused Products use Apple-manufactured chipsets. (Dkt. No. 77-1 ¶ 5.) Apple develops the software that integrates these chipsets—those manufactured by Broadcom, Qualcomm, and Apple—into the Accused Products. (Dkt. No. 86-5 at 65:7–66:15; *see also* Dkt. No. 86-4.) The chipset and the software work together in the Accused Products to deliver the accused Bluetooth functionality. (Dkt. No. 86-7 at 12, 16.)

Asserting that Broadcom and Qualcomm are the true manufacturers and that Apple is merely a reseller, Apple asks that this action be stayed in favor of the California Suits under the customer-suit exception.

II. Legal Standard

District courts have “the authority to consider motions to stay litigation before them under their broad equitable powers.” *Intellectual Ventures II LLC v. JPMorgan Chase & Co.*, 781 F.3d 1372, 1378 (Fed. Cir. 2015). “Under the first-to-file rule, a district court may choose to stay, transfer, or dismiss a duplicative later-filed action.” *Merial Ltd. v. Cipla Ltd.*, 681 F.3d 1283, 1299 (Fed. Cir. 2012). However, the “customer-suit exception” is an exception to the first-to-file rule. *Glob. Equity Mgmt. (SA) Pty. Ltd. v. Ericsson, Inc.*, 2017 WL 365398, at *7 (E.D. Tex. Jan. 25, 2017). “Generally speaking, courts apply the customer suit exception to stay earlier-filed litigation against a customer while a later-filed case involving the manufacturer proceeds in another forum.” *Spread Spectrum Screening LLC v. Eastman Kodak Co.*, 657 F.3d 1349, 1357 (Fed. Cir. 2011). “This ‘customer-suit’ exception to the ‘first-to-file’ rule exists to avoid, if possible, imposing the burdens of trial on the customer, for it is the manufacturer who is generally the ‘true defendant’ in the dispute.” *In re Nintendo of Am., Inc.*, 756 F.3d 1363, 1365 (Fed. Cir. 2014).

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In evaluating the customer-suit exception, courts consider three factors: “(1) whether the consumers in the first-filed action are mere resellers of products manufactured by the party in the second-filed action; (2) whether the customers in the first-filed action have agreed to be bound by any decision in the second-filed action, and; (3) whether the manufacturers in the second-filed action are the only source of the allegedly infringing activity or product.” *Glob. Equity*, 2017 WL 365398, at *5 n.3. However, the “guiding principles in the customer suit exception cases are efficiency and judicial economy.” *Spectrum Screenings*, 657 F.3d at 1357.

Additionally, in considering a motion to stay, courts evaluate: “(1) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party; (2) whether a stay will simplify the issues in question and the trial of the case; and (3) whether discovery is complete and whether a trial date has been set.” *Glob. Equity*, 2017 WL 365398, at *10.

III. Discussion

The Court does not find that Apple is entitled to the remedy it seeks. As an initial matter the Court notes that Apple does not seek an outcome consistent with the purpose of the customer-suit exception: that the burdens of litigation be lifted from the customer-defendant. Nor does the Court find that a stay is merited under the equitable factors specific to the customer-suit exception or applicable to stays in general.

A. **Apple seeks relief inconsistent with the purpose of the customer-suit exception.**

The customer-suit exception exists to remove “the burdens” of litigation from the customer, “if possible,” and place them instead on “the manufacturer who is generally the ‘true defendant’ in the dispute.” *Nintendo*, 756 F.3d at 1365. However, Apple does not seek to remove the burdens of litigation from itself. Indeed, Apple has made it impossible for this Court to remove such burden. Four days after it filed this Motion, Apple filed three petitions for *inter partes* review of the Asserted Patents before the Patent Trial and Appeal Board (“PTAB”). (Dkt. No. 87-11) As such,

Apple's requested stay would not remove from Apple the burdens of litigation. Rather, Apple seeks to deprive Rembrandt of the forum and procedure of Rembrandt's choosing while Apple continues to litigate issues related to the Asserted Patents in the forum and under the procedure of its own choosing.

This result violates the express purpose of the customer-suit exception. A stay will not relieve Apple of the burdens of litigation. Moreover, Rembrandt will still be forced to litigate in multiple forums, in California and before the PTAB. Apple, who itself has multiplied litigation, cannot now seek a stay in the name of "efficiency and judicial economy." *Spectrum Screenings*, 657 F.3d at 1357.

Nor does the Court find that, acting to create such a tactical advantage for itself, Apple has clean hands to receive equitable remedy it seeks. *Keystone Driller Co. v. Gen. Excavator Co.*, 290 U.S. 240, 244–45 (1933). The Court finds that it would be inequitable to suspend litigation in the plaintiff's chosen forum under the guise of relieving the burdens of litigation from the defendant while the defendant actively pursues litigation against the plaintiff in another forum.

B. Transfer is inappropriate under the customer-suit exception.

Even if Apple's litigation decisions had not already frustrated the purpose of the customer-suit exception, the exception would nonetheless be inapplicable. As to the Accused Products that utilize Apple chipsets, Apple is itself the only manufacturer; it is not a customer at all. However, even as to the Accused Products that utilize Broadcom and Qualcomm chipsets, Apple is not a mere reseller but itself configures and integrates these chipsets into the actual products accused of infringement.

1. Apple is not a customer as to its own chipsets.

It is axiomatic that the customer-suit exception is applied to stay "litigation against a customer." *Spread Spectrum*, 657 F.3d at 1357 (emphasis added). Apple is not a customer of its

own chipsets but is itself the manufacturer. Thus, Apple categorically fails the first and third customer-suit exception factors as to Apple-manufactured chipsets: it is not a mere reseller and Broadcom and Qualcomm are not a source of the allegedly infringing products. *Glob. Equity*, 2017 WL 365398, at *5 n.3.

Apple does purport to agree to be bound by a decision in the second-filed action. (Dkt. No. 77 at 4; Dkt. No. 77-7.) However, the Apple-manufactured chipsets are not accused of infringement in the California Suits. Instead, Apple offers to be bound by any decision regarding the Broadcom-manufactured chipsets as if that decision applied to its own chipsets. The Court finds this approach unreasonable.

Apple's chipsets are not identical to Broadcom's; there is no reason to believe that infringement as to one would necessitate infringement of the other. Moreover, a plaintiff in litigation against both a manufacturer and its customer would typically be barred by collateral estoppel from relitigating an adverse infringement decision. Rembrandt will not be so estopped from litigating infringement as to the Apple and Broadcom chipsets separately and has not agreed to be bound by a decision in the California Suits. Thus, Apple's offer to be bound is not likely to lead to the simplification of issues such an agreement would typically produce when the products at issue are identical.

Accordingly, the Court finds that the customer-suit exception is not applicable to the Accused Products utilizing Apple-manufactured chipsets. Indeed, considering all the Accused Products as whole, the Court finds that the presence of the Apple-manufactured chipsets proves fatal to the customer-suit analysis. However, although neither party has asked the Court to consider a severance, the Court will nonetheless consider whether severing and staying the claims as to the Accused Products utilizing Broadcom- and Qualcomm-manufactured chipsets is appropriate. *See*

In re EMC Corp., 677 F.3d 1351, 1355 (Fed. Cir. 2012) (“To be sure, Rule 21, which authorizes a district court to ‘sever any claim against a party,’ provides a district court broad discretion.”) (quoting Fed. R. Civ. P. 21).

2. Apple is not a mere reseller as to its products employing Broadcom and Qualcomm chipsets.

The Court finds that a stay as to the Accused Products utilizing Broadcom and Qualcomm chipsets is likewise inappropriate. Notably, it is not the Broadcom and Qualcomm chipsets that are accused of infringement in this case. Rather, the Accused Products are Apple-manufactured products, some of which incorporate these chipsets as components. (Dkt. No. 1 ¶ 29.) Apple actively incorporates these components into its products, including by developing the source code that integrates and enables these chips within the Accused Products.

Apple argues that its own conduct and source code is not relevant to infringement, noting that Rembrandt’s infringement contentions in this case mirror those filed in the California Suits and are based on the general Bluetooth standards. Neither party has provided the infringement contentions served in this action for the Court’s review. However, that Rembrandt’s initial infringement contentions are based on the publicly available Bluetooth standards does not foreclose the relevance of Apple’s source code to the issue of infringement. (*See, e.g.*, Dkt. No. 40 ¶ 3(a)(i) (allowing a party to supplement its infringement contentions within 30 days of the receipt of source code).)

Indeed, the claims of the Asserted Patents recite communications devices “configured to” or “capable of” performing certain functions. *See, e.g.*, ’580 Patent, Claim 1; ’228 Patent, Claim 1. Whether Apple’s source code integrating these chipsets enables or inhibits such functionality directly bears on infringement. Thus, Apple is not a mere reseller of its own products that incorporate Broadcom and Qualcomm chipsets.

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Similarly, the Court finds that Broadcom and Qualcomm are not the sole source of the allegedly infringing activity or product because Apple also contributes to the development of the Accused Products.

The Court does find that Apple has agreed to be bound by any decision in the California Suits. Rembrandt criticizes Apple for agreeing only to be bound by a “final judgment.” (Dkt. No. 86 at 11; Dkt. No. 93 at 3.) However, any resolution on the merits in the California Suits will take the form of a final judgment, whether that occurs on summary judgment, after a jury verdict, or as the result of a preclusive decision in another forum. Thus, as to the Accused Products utilizing Broadcom and Qualcomm chipsets, the Court finds Apple’s stipulation sufficient.

Nonetheless, balancing these factors the Court finds that they weigh against a stay of this action even as to the Accused Products employing Broadcom and Qualcomm chipsets.

C. A stay is not appropriate under the general stay factors.

A review of the general stay factors reinforces that a stay is not appropriate in this case.

As to the first factor, the Court has already noted that a stay of this action would present a tactical disadvantage to Rembrandt in view of the recently filed IPR proceedings by Apple. The Court notes the institution of IPR proceedings may itself form the basis for a stay request, and the Court does not prejudge such a request, if made. However, the Court finds that these dueling proceedings weigh against the granting of a stay based on customer-suit grounds, where the purpose of such a stay is to relieve the burdens of litigation from the customer-defendant altogether.

As to the second factor, whether a stay would simplify issues for trial, the Court notes that in the California Suits, Broadcom and Qualcomm are accused of indirect infringement for selling their chipsets to customers, like Apple, who directly infringe by making and selling infringing

products that incorporate these chipsets. (Dkt. No. 86-2 at 3–4.) District courts have routinely declined to impose stays based on the customer-suit exception where a manufacturer is accused of indirect infringement and the customer is accused of direct infringement. *See Erfindergemeinschaft Uropep GbR v. Eli Lilly & Co.*, 2016 WL 1659924, at *4 (E.D. Tex. Apr. 26, 2016) (collecting cases). Indeed, the Court finds that the circumstances of this case are similar to those presented in *Eli Lilly*, where Circuit Judge Bryson, sitting by designation, similarly declined to impose a stay. *Id.*

Moreover, the Accused Products in this action are not identical to those accused of infringement in the California Suits. Rather the chipsets accused of infringement in the California Suits are incorporated into the Apple products accused of infringement in this action. Apple integrates and enables these chipsets to perform certain functions using its own software. Thus, it is not a foregone conclusion that a resolution of issues of infringement in the California Suits would be dispositive of related issues in this action.


Finally, as to the third factor, whether discovery is complete and a trial date has been set, the Court notes that trial in this case is set for June 1, 2020. (Dkt. No. 69.) Fact discovery will close in a month and a half, and expert discovery will close in three months. (*Id.*) Moreover, the Court notes that a claim construction hearing in this action is set for next week, a hearing for which the parties and the Court have already expended considerable resources. (*Id.*)

Weighing these three factors, the Court finds that they reinforce the Court’s conclusion that a stay is not warranted.

IV. Conclusion

For the reasons set forth herein, Apple’s Motion to Stay Based on Customer-Suit Exception (Dkt. No. 77) is **DENIED**.

So ORDERED and SIGNED this 27th day of November, 2019.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

JRG3,JURY,MEDIATION,PATENT/TRADEMARK,PROTECTIVE-ORDER

**U.S. District Court
Eastern District of TEXAS [LIVE] (Marshall)
CIVIL DOCKET FOR CASE #: 2:19-cv-00025-JRG**

Rembrandt Wireless Technologies, LP v. Apple Inc.
Assigned to: District Judge Rodney Gilstrap
Cause: 35:271 Patent Infringement

Date Filed: 01/24/2019
Jury Demand: Both
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Mediator

Jay Gandhi
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Technical Advisor

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 ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
01/24/2019	1	COMPLAINT <i>for Patent Infringement</i> against Apple Inc. (Filing fee \$ 400 receipt number 0540-7108907.), filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Exhibit A, # 2 Exhibit B, # 3 Civil Cover Sheet)(Enger, Eric) (Entered: 01/24/2019)
01/24/2019		Case assigned to District Judge Rodney Gilstrap. (ch,) (Entered: 01/24/2019)
01/24/2019		In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event <i>Notice Regarding Consent to Proceed Before Magistrate Judge</i> . (ch,) (Entered: 01/24/2019)
01/24/2019	2	SUMMONS Issued as to Apple Inc.. (ch,) (Entered: 01/24/2019)
01/24/2019	3	NOTICE of Attorney Appearance by Claire Abernathy Henry on behalf of Rembrandt Wireless Technologies, LP (Henry, Claire) (Entered: 01/24/2019)
01/24/2019	4	NOTICE of Attorney Appearance by Thomas John Ward, Jr on behalf of Rembrandt Wireless Technologies, LP (Ward, Thomas) (Entered: 01/24/2019)
01/24/2019	5	NOTICE of Attorney Appearance by Christopher Michael First on behalf of Rembrandt Wireless Technologies, LP (First, Christopher) (Entered: 01/24/2019)
01/24/2019	6	NOTICE of Attorney Appearance by Michael F Heim on behalf of Rembrandt Wireless Technologies, LP (Heim, Michael) (Entered: 01/24/2019)
01/24/2019	7	NOTICE of Attorney Appearance by Blaine Andrew Larson on behalf of Rembrandt Wireless Technologies, LP (Larson, Blaine) (Entered: 01/24/2019)

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01/28/2019	8	NOTICE of Attorney Appearance by Andrea Leigh Fair on behalf of Rembrandt Wireless Technologies, LP (Fair, Andrea) (Entered: 01/28/2019)
01/30/2019	9	SUMMONS Returned Executed by Rembrandt Wireless Technologies, LP. Apple Inc. served on 1/24/2019, answer due 2/14/2019. (ch,) (Entered: 01/30/2019)
02/06/2019	10	Defendant's Unopposed First Application for Extension of Time to Answer Complaint re Apple Inc..(Smith, Melissa) (Entered: 02/06/2019)
02/07/2019		Defendant's Unopposed First Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Apple Inc. to 3/16/2019. 30 Days Granted for Deadline Extension.(slo,) (Entered: 02/07/2019)
02/07/2019	11	NOTICE of Attorney Appearance by Alisa Anne Lipski on behalf of Rembrandt Wireless Technologies, LP (Lipski, Alisa) (Entered: 02/07/2019)
02/07/2019	12	NOTICE of Attorney Appearance by Kyril Vladimir Talanov on behalf of Rembrandt Wireless Technologies, LP (Talanov, Kyril) (Entered: 02/07/2019)
02/07/2019	13	NOTICE of Attorney Appearance by Amir H. Alavi on behalf of Rembrandt Wireless Technologies, LP (Alavi, Amir) (Entered: 02/07/2019)
02/07/2019	14	NOTICE of Attorney Appearance by Demetrios Anaipakos on behalf of Rembrandt Wireless Technologies, LP (Anaipakos, Demetrios) (Entered: 02/07/2019)
02/11/2019	15	Notice of Filing of Patent/Trademark Form (AO 120). AO 120 mailed to the Director of the U.S. Patent and Trademark Office. (Enger, Eric) (Entered: 02/11/2019)
03/04/2019	16	Defendant's Unopposed Second Application for Extension of Time to Answer Complaint re Apple Inc. (Smith, Melissa) (Entered: 03/04/2019)
03/04/2019		Defendant's Unopposed SECOND Application for Extension of Time to Answer Complaint is granted pursuant to Local Rule CV-12 for Apple Inc. to 3/31/2019. 15 Days Granted for Deadline Extension.(ch,) (Entered: 03/04/2019)
04/01/2019	17	ANSWER to 1 Complaint by Apple Inc..(Smith, Melissa) (Entered: 04/01/2019)
04/01/2019	18	CORPORATE DISCLOSURE STATEMENT filed by Apple Inc. (Smith, Melissa) (Entered: 04/01/2019)
04/01/2019	19	DEMAND for Trial by Jury by Apple Inc.. (Smith, Melissa) (Entered: 04/01/2019)
04/01/2019	20	NOTICE of Attorney Appearance by Jolene L. Wang on behalf of Apple Inc. (Wang, Jolene) (Entered: 04/01/2019)
04/01/2019	21	NOTICE of Attorney Appearance by Josef Bryks Schenker on behalf of Apple Inc. (Schenker, Josef) (Entered: 04/01/2019)
04/01/2019	22	NOTICE of Attorney Appearance by Gabrielle Elizabeth Higgins on behalf of Apple Inc. (Higgins, Gabrielle) (Entered: 04/01/2019)
04/01/2019	23	NOTICE of Attorney Appearance by Mark D Rowland on behalf of Apple Inc. (Rowland, Mark) (Entered: 04/01/2019)
04/01/2019	24	NOTICE of Attorney Appearance by James R Batchelder on behalf of Apple Inc. (Batchelder, James) (Entered: 04/01/2019)
04/01/2019		In accordance with the provisions of 28 USC Section 636(c), you are hereby notified that a U.S. Magistrate Judge of this district court is available to conduct any or all proceedings in this case including a jury or non-jury trial and to order the entry of a final judgment. The form Consent to Proceed Before Magistrate Judge is available on our website. All signed consent forms, excluding pro se parties, should be filed electronically using the event <i>Notice Regarding Consent to Proceed Before Magistrate Judge</i> . (nkl,) (Entered: 04/01/2019)
04/10/2019	25	ORDER - Scheduling Conference set for 5/10/2019 01:30 PM before District Judge Rodney Gilstrap. Signed by District Judge Rodney Gilstrap on 4/10/2019. (ch,) (Entered: 04/11/2019)
04/23/2019		NOTICE of Hearing: Scheduling Conference RESET for 5/20/2019 09:00 AM in Ctrm 361 (Tyler) before District Judge Rodney Gilstrap. ***Please note that the DATE, TIME and LOCATION have changed for this hearing.*** (jml) (Entered: 04/23/2019)
04/30/2019	26	NOTICE of Attorney Appearance by Louis Liao on behalf of Rembrandt Wireless Technologies, LP (Liao, Louis) (Entered: 04/30/2019)
04/30/2019	27	NOTICE by Rembrandt Wireless Technologies, LP <i>Plaintiff's Notice of Compliance Regarding P.R. 3-1 & 3-2 Infringement Contentions</i> (Alavi, Amir) (Entered: 04/30/2019)
05/20/2019		Minute Entry for proceedings held before Judge Rodney Gilstrap: Scheduling Conference held on 5/20/2019. Counsel for the parties appeared and were asked if they consented to a trial before the United States Magistrate Judge. The Court then gave Markman and Jury Selection dates; deadlines for submitting Mediator names (3 days); and deadlines for submitting Agreed Scheduling and Discovery Orders (14 days). (Court Reporter Shelly Holmes, CSR-TCRR.) (jml) (Entered: 05/21/2019)

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Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

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05/21/2019	28	NOTICE by Apple Inc. <i>Joint Notice of Agreed Mediator</i> (Smith, Melissa) (Entered: 05/21/2019)
05/22/2019	29	Unopposed MOTION to Seal <i>Motion to Transfer Venue</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order) (Smith, Melissa) (Entered: 05/22/2019)
05/22/2019	30	Opposed SEALED PATENT MOTION to <i>Transfer Venue</i> by Apple Inc.. (Attachments: # 1 Affidavit Jaynes, # 2 Affidavit Masood, # 3 Text of Proposed Order)(Smith, Melissa) (Entered: 05/22/2019)
05/22/2019	31	Additional Attachments to Main Document: 30 Opposed SEALED PATENT MOTION to <i>Transfer Venue</i> .. (Attachments: # 1 Affidavit Schenker, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M, # 15 Exhibit N, # 16 Exhibit O, # 17 Exhibit P, # 18 Exhibit Q, # 19 Exhibit R, # 20 Exhibit S, # 21 Exhibit T)(Smith, Melissa) (Entered: 05/22/2019)
05/23/2019	32	ORDER granting 29 Motion to Seal. Signed by District Judge Rodney Gilstrap on 05/23/2019. (klc,) (Entered: 05/23/2019)
05/24/2019	33	REDACTION to 30 Opposed SEALED PATENT MOTION to <i>Transfer Venue</i> by Apple Inc.. (Attachments: # 1 Affidavit Jaynes, # 2 Affidavit Masood)(Smith, Melissa) (Entered: 05/24/2019)
05/29/2019	34	ORDER REFERRING CASE to Mediator Hon. Jay C. Gandhi, JAMS, 555 W. 5th Street, 32nd Floor, Los Angeles, California, telephone number 213-620-1133, fax number 213-620-0100 and email address jgandhi@jamsadr.com, is hereby appointed as mediator. Signed by District Judge Rodney Gilstrap on 5/29/2019. (ch,) (Entered: 05/30/2019)
05/31/2019	35	Joint MOTION for Extension of Time to File Response/Reply as to 30 Opposed SEALED PATENT MOTION to <i>Transfer Venue</i> by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order)(Larson, Blaine) (Entered: 05/31/2019)
06/03/2019	36	Unopposed MOTION for Entry of Docket Control Order by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order)(Larson, Blaine) (Entered: 06/03/2019)
06/03/2019	37	Joint MOTION for Entry of Agreed Discovery Order by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order)(Alavi, Amir) (Entered: 06/03/2019)
06/03/2019	38	ORDER granting 35 Motion for Extension of Time to File Response/Reply. Signed by District Judge Rodney Gilstrap on 6/3/2019. (ch,) (Entered: 06/04/2019)
06/04/2019	39	DOCKET CONTROL ORDER granting 36 Unopposed MOTION for Entry of Docket Control Order. Pretrial Conference set for 4/27/2020 09:00 AM before District Judge Rodney Gilstrap., Amended Pleadings due by 9/16/2019., Jury Selection set for 6/1/2020 09:00AM before District Judge Rodney Gilstrap., Mediation Completion due by 12/30/2019., Markman Hearing set for 12/2/2019 01:30 PM before District Judge Rodney Gilstrap., Motions due by 4/6/2020., Proposed Pretrial Order due by 4/20/2020. Signed by District Judge Rodney Gilstrap on 6/4/2019. (ch,) (Entered: 06/05/2019)
06/04/2019	40	ORDER granting 37 Joint MOTION for Entry of Agreed Discovery Order. Signed by District Judge Rodney Gilstrap on 6/4/2019. (ch,) (Entered: 06/05/2019)
06/07/2019	41	Joint MOTION for Extension of Time to File <i>Proposed Protective Order</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 06/07/2019)
06/10/2019	42	ORDER granting 41 Joint MOTION for Extension of Time to File Proposed Protective Order. Signed by District Judge Rodney Gilstrap on 6/10/2019. (ch,) (Entered: 06/10/2019)
06/10/2019	43	NOTICE of Discovery Disclosure by Apple Inc. <i>Regarding Initial Disclosures</i> (Smith, Melissa) (Entered: 06/10/2019)
06/17/2019	44	Joint MOTION for Extension of Time to File <i>Protective Order</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 06/17/2019)
06/18/2019	45	ORDER granting 44 Motion for Extension of Time to File Protective Order. Signed by District Judge Rodney Gilstrap on 6/18/2019. (ch,) (Entered: 06/19/2019)
06/20/2019	46	Joint MOTION for Protective Order <i>Motion for Entry of Protective Order</i> by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Exhibit Ex. A-Proposed Protective Order)(Talanov, Kyril) (Entered: 06/20/2019)
06/21/2019	47	PROTECTIVE ORDER. Signed by District Judge Rodney Gilstrap on 6/21/2019. (nkl,) (Entered: 06/21/2019)
07/09/2019	48	NOTICE of Discovery Disclosure by Apple Inc. <i>Regarding PR 3-3 and 3-4</i> (Smith, Melissa) (Entered: 07/09/2019)
07/18/2019	49	Joint MOTION for Entry of Agreed E-Discovery Order by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order)(Alavi, Amir) (Entered: 07/18/2019)
07/19/2019	50	ORDER REGARDING E-DISCOVERY granting 49 Joint MOTION for Entry of Agreed E-Discovery Order. Signed by District Judge Rodney Gilstrap on 7/19/2019. (ch,) (Entered: 07/22/2019)
07/22/2019	51	NOTICE of Attorney Appearance by David Edmond Sipiora on behalf of Apple Inc. (Sipiora, David) (Entered: 07/22/2019)

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Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

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07/22/2019	52	NOTICE of Attorney Appearance by Russell A Korn on behalf of Apple Inc. (Korn, Russell) (Entered: 07/22/2019)
07/22/2019	53	NOTICE of Attorney Appearance by Andrew Nathan Saul on behalf of Apple Inc. (Saul, Andrew) (Entered: 07/22/2019)
07/22/2019	54	NOTICE of Attorney Appearance - Pro Hac Vice by Edward John Mayle on behalf of Apple Inc.. Filing fee \$ 100, receipt number 0540-7359665. (Mayle, Edward) (Entered: 07/22/2019)
07/29/2019	55	NOTICE of Discovery Disclosure by Apple Inc. <i>Regarding PR 4-1 Disclosures</i> (Smith, Melissa) (Entered: 07/29/2019)
08/05/2019	56	SEALED RESPONSE to Motion re 30 Opposed SEALED PATENT MOTION <i>to Transfer Venue</i> filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order, # 2 Declaration of Louis Liao, # 3 Exhibit P, # 4 Exhibit Z)(Alavi, Amir) (Entered: 08/05/2019)
08/05/2019	57	Additional Attachments to Main Document: 56 Sealed Response to Motion,.. (Attachments: # 1 Exhibit A, # 2 Exhibit B, # 3 Exhibit C, # 4 Exhibit D, # 5 Exhibit E, # 6 Exhibit F - Part 1 of 2, # 7 Exhibit F - Part 2 of 2, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M, # 15 Exhibit N, # 16 Exhibit O, # 17 Exhibit Q, # 18 Exhibit R, # 19 Exhibit S, # 20 Exhibit T, # 21 Exhibit U, # 22 Exhibit V, # 23 Exhibit W, # 24 Exhibit X, # 25 Exhibit Y)(Alavi, Amir) (Entered: 08/05/2019)
08/07/2019	58	REDACTION to 56 Sealed Response to Motion, by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Declaration of Louis Liao, # 2 Exhibit P, # 3 Exhibit Z, # 4 Text of Proposed Order)(Alavi, Amir) (Entered: 08/07/2019)
08/12/2019	59	SEALED PATENT REPLY to Response to PATENT Motion re 30 Opposed SEALED PATENT MOTION <i>to Transfer Venue</i> filed by Apple Inc.. (Attachments: # 1 Decl. of D'Orazio, # 2 Decl. of Jain, # 3 Decl. of Porta, # 4 Supplemental Decl. of Masood, # 5 Supplemental Decl. of Jaynes, # 6 Exhibit U)(Smith, Melissa) (Entered: 08/12/2019)
08/13/2019	60	Additional Attachments to Main Document: 59 Sealed PATENT Reply to Response to PATENT Motion,.. (Attachments: # 1 Supp. Declaration of Schenker, # 2 Exhibit V, # 3 Exhibit W, # 4 Exhibit X, # 5 Exhibit Y, # 6 Exhibit Z, # 7 Exhibit AA, # 8 Exhibit BB)(Smith, Melissa) (Entered: 08/13/2019)
08/14/2019	61	REDACTION to 59 Sealed PATENT Reply to Response to PATENT Motion, by Apple Inc.. (Attachments: # 1 Supplemental Decl. of Masood, # 2 Supplemental Decl. of Jaynes)(Smith, Melissa) (Entered: 08/14/2019)
08/16/2019	62	Unopposed MOTION to Amend/Correct <i>Docket Control Order</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 08/16/2019)
08/16/2019	63	NOTICE of Discovery Disclosure by Apple Inc. <i>Regarding First Amended Initial Disclosures</i> . (Smith, Melissa) (Entered: 08/16/2019)
08/19/2019	64	SEALED SUR-REPLY to Reply to Response to Motion re 30 Opposed SEALED PATENT MOTION <i>to Transfer Venue</i> filed by Rembrandt Wireless Technologies, LP. (Alavi, Amir) (Entered: 08/19/2019)
08/19/2019	65	AMENDED DOCKET CONTROL ORDER: Pretrial Conference set for 4/27/2020 09:00 AM before District Judge Rodney Gilstrap., Jury Selection set for 6/1/2020 09:00AM before District Judge Rodney Gilstrap , Markman Hearing set for 12/2/2019 09:00 AM before Magistrate Judge Roy S. Payne., Amended Pleadings due by 9/16/2019.). Signed by District Judge Rodney Gilstrap on 08/19/2019. (klc,) (Entered: 08/20/2019)
08/21/2019	66	REDACTION to 64 Sealed Sur-Reply to Reply to Response to Motion <i>to Transfer Venue</i> by Rembrandt Wireless Technologies, LP. (Alavi, Amir) (Entered: 08/21/2019)
08/23/2019	67	NOTICE of Discovery Disclosure by Apple Inc. <i>Regarding P.R. 4-2 Disclosures</i> (Smith, Melissa) (Entered: 08/23/2019)
09/03/2019	68	Unopposed MOTION to Amend/Correct <i>Docket Control Order</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 09/03/2019)
09/04/2019	69	SECOND AMENDED DOCKET CONTROL ORDER granting 68 Unopposed MOTION to Amend/Correct <i>Docket Control Order</i> . <i>Markman Hearing set for 12/2/2019 01 30 PM before District Judge Rodney Gilstrap</i> . Signed by District Judge Rodney Gilstrap on 9/4/2019. (ch,) (Entered: 09/05/2019)
09/09/2019	70	Joint 4-3 Claim Construction Statement by Rembrandt Wireless Technologies, LP. (Larson, Blaine) (Entered: 09/09/2019)
09/19/2019	71	Unopposed MOTION for Hearing re 30 Opposed SEALED PATENT MOTION <i>to Transfer Venue</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 09/19/2019)
10/16/2019	72	NOTICE of Designation of Attorney in Charge to David Edmond Sipiora on behalf of Apple Inc. (Sipiora, David) (Entered: 10/16/2019)
10/21/2019	73	CLAIM CONSTRUCTION BRIEF filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Declaration of Blaine Larson, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit 12, # 14 Exhibit 13)(Larson, Blaine) (Entered: 10/21/2019)

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Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

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10/30/2019	74	MOTION to Quash , <i>for a Protective Order, and for Fee Shifting</i> by Broadcom Corp., Broadcom Inc.. (Attachments: # 1 Declaration of Edward J. Mayle in Support of Non-Parties Broadcom Inc. and Broadcom Corporation to Quash, for a Protective Order, and For Fee Shifting, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit 12, # 14 Exhibit 13, # 15 Text of Proposed Order)(Sipiora, David) (Entered: 10/30/2019)
10/30/2019	75	CORPORATE DISCLOSURE STATEMENT filed by Broadcom Corp., Broadcom Inc. identifying Corporate Parent Broadcom Inc. for Broadcom Corp.. (Sipiora, David) (Entered: 10/30/2019)
10/30/2019	76	Opposed MOTION TO JOIN BROADCOMS MOTION AND REQUEST FOR A PROTECTIVE ORDER PROHIBITING DISCLOSURE OF BROADCOM CONFIDENTIAL INFORMATION TO DR. ROBERT MORROW re 74 MOTION to Quash , <i>for a Protective Order, and for Fee Shifting</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 10/30/2019)
11/01/2019	77	Opposed SEALED PATENT MOTION <i>TO STAY BASED ON CUSTOMER-SUIT EXCEPTION</i> by Apple Inc.. (Attachments: # 1 Affidavit Jaynes, # 2 Affidavit Mayle, # 3 Exhibit 1, # 4 Exhibit 2, # 5 Exhibit 3, # 6 Exhibit 4, # 7 Exhibit 5, # 8 Exhibit 6, # 9 Exhibit 7, # 10 Text of Proposed Order)(Smith, Melissa) (Entered: 11/01/2019)
11/04/2019	78	REDACTION to 77 Opposed SEALED PATENT MOTION <i>TO STAY BASED ON CUSTOMER-SUIT EXCEPTION</i> by Apple Inc.. (Attachments: # 1 Affidavit Jaynes, # 2 Mayle, # 3 Exhibit 1, # 4 Exhibit 2, # 5 Exhibit 3, # 6 Exhibit 4, # 7 Exhibit 5, # 8 Exhibit 6, # 9 Exhibit 7)(Smith, Melissa) (Entered: 11/04/2019)
11/04/2019	79	RESPONSIVE CLAIM CONSTRUCTION BRIEF filed by Apple Inc.. (Attachments: # 1 Affidavit Rowland, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K)(Smith, Melissa) (Entered: 11/04/2019)
11/12/2019	80	ORDER re 77 Opposed SEALED PATENT MOTION <i>TO STAY BASED ON CUSTOMER-SUIT EXCEPTION</i> . Signed by District Judge Rodney Gilstrap on 11/12/2019. (ch,) (Entered: 11/12/2019)
11/12/2019	81	REPLY CLAIM CONSTRUCTION BRIEF filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Declaration of Eric Enger, # 2 Exhibit 14, # 3 Exhibit 15, # 4 Exhibit 16, # 5 Exhibit 17, # 6 Exhibit 18, # 7 Exhibit 19, # 8 Exhibit 20, # 9 Exhibit 21)(Enger, Eric) (Entered: 11/12/2019)
11/12/2019	82	NOTICE of Attorney Appearance by Scott W Clark on behalf of Rembrandt Wireless Technologies, LP (Clark, Scott) (Entered: 11/12/2019)
11/12/2019	83	ORDER Court hereby appoints Mr. David Keyzer as the Courts technical advisor in this case. Signed by District Judge Rodney Gilstrap on 11/12/2019. (ch,) (Entered: 11/13/2019)
11/13/2019	84	RESPONSE to Motion re 74 MOTION to Quash , <i>for a Protective Order, and for Fee Shifting</i> filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Declaration of Blaine Larson, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C)(Larson, Blaine) (Entered: 11/13/2019)
11/13/2019	85	RESPONSE to Motion re 76 Opposed MOTION TO JOIN BROADCOMS MOTION AND REQUEST FOR A PROTECTIVE ORDER PROHIBITING DISCLOSURE OF BROADCOM CONFIDENTIAL INFORMATION TO DR. ROBERT MORROW re 74 MOTION to Quash , <i>for a Protective Order, and for Fee Shifting</i> filed by Rembrandt Wireless Technologies, LP. (Larson, Blaine) (Entered: 11/13/2019)
11/13/2019	86	SEALED PATENT RESPONSE to SEALED PATENT MOTION re 77 Opposed SEALED PATENT MOTION <i>TO STAY BASED ON CUSTOMER-SUIT EXCEPTION</i> filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Affidavit Declaration of Louis Liao, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M)(Alavi, Amir) (Entered: 11/13/2019)
11/15/2019	87	REDACTION to 86 Sealed Patent Response to Sealed Patent Motion, by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Declaration of Louis Liao, # 2 Exhibit A, # 3 Exhibit B, # 4 Exhibit C, # 5 Exhibit D, # 6 Exhibit E, # 7 Exhibit F, # 8 Exhibit G, # 9 Exhibit H, # 10 Exhibit I, # 11 Exhibit J, # 12 Exhibit K, # 13 Exhibit L, # 14 Exhibit M)(Alavi, Amir) (Entered: 11/15/2019)
11/18/2019	88	Joint P.R. 4-5(d) Claim Construction Chart by Rembrandt Wireless Technologies, LP. (Larson, Blaine) (Entered: 11/18/2019)
11/18/2019	89	REPLY to Response to Motion re 77 Opposed SEALED PATENT MOTION <i>TO STAY BASED ON CUSTOMER-SUIT EXCEPTION</i> Reply Memorandum of Law in Support of Defendant Apple Inc.s Motion to Stay filed by Apple Inc.. (Sipiora, David) (Entered: 11/18/2019)
11/19/2019	90	Unopposed MOTION for Protective Order <i>Regarding Third Party Qualcomm Inc.</i> by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order)(Larson, Blaine) (Entered: 11/19/2019)
11/20/2019	91	STIPULATED SUPPLEMENTAL PROTECTIVE ORDER BETWEEN NON-PARTY QUALCOMM INCORPORATED, PLAINTIFF, AND DEFENDANT granting 90 Unopposed MOTION for Protective Order Regarding Third Party Qualcomm Inc.. Signed by District Judge Rodney Gilstrap on 11/20/2019. (ch,) (Entered: 11/21/2019)
11/21/2019	92	SEALED SUR-REPLY to Reply to Response to Motion re 77 Opposed SEALED PATENT MOTION <i>TO STAY BASED ON CUSTOMER-SUIT EXCEPTION</i> filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1

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		Declaration of Louis Liao, # 2 Exhibit A, # 3 Exhibit B)(Alavi, Amir) (Entered: 11/21/2019)
11/25/2019	93	SUR-REPLY to Reply to Response to Motion re 77 Opposed SEALED PATENT MOTION TO STAY BASED ON CUSTOMER-SUIT EXCEPTION filed by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Affidavit, # 2 Exhibit A, # 3 Exhibit B)(Liao, Louis) Modified on 11/26/2019 (ch,). (Entered: 11/25/2019)
11/26/2019		NOTICE FROM CLERK re 93 Sur-Reply to Reply to Response to Motion. This was unsealed per the attorney. (ch,) (Entered: 11/26/2019)
11/27/2019	94	MEMORANDUM OPINION AND ORDER -. Signed by District Judge Rodney Gilstrap on 11/27/2019. (ch,) (Entered: 11/27/2019)
11/27/2019	95	MEMORANDUM OPINION AND ORDER. Signed by District Judge Rodney Gilstrap on 11/27/2019. (ch,) (Main Document 95 replaced on 11/27/2019) (kle,). (Entered: 11/27/2019)
11/27/2019		NOTICE of Hearing:Markman Hearing RESET for 12/2/2019 11:00 AM in Ctrm 106 (Marshall) before District Judge Rodney Gilstrap. ***Please note that the TIME for the hearing has changed.***(jml) (Entered: 11/27/2019)
12/02/2019	96	NOTICE by Apple Inc. APPLE INC.S NOTICE OF FILING HEARING PRESENTATION (Attachments: # 1 Hearing Slides)(Smith, Melissa) (Entered: 12/02/2019)
12/02/2019	97	Minute Entry for proceedings held before District Judge Rodney Gilstrap: Markman Hearing held on 12/2/2019. (Court Reporter Shelly Holmes, CSR-TCRR.) (Attachments: # 1 Attorney Attendance Sheet) (jml) (Entered: 12/02/2019)
12/04/2019	98	PAPER TRANSCRIPT REQUEST by Apple Inc. for proceedings held on December 2, 2019 Markman Hearing before Judge Gilstrap. (Smith, Melissa)(Forwarded to Shelly Holmes) Modified on 12/4/2019 (ch,). (Entered: 12/04/2019)
12/06/2019	99	NOTICE OF FILING OF OFFICIAL TRANSCRIPT of Proceedings held on 12/2/19 (Claim Construction Hearing) before Judge Rodney Gilstrap. Court Reporter/Transcriber: Shelly Holmes, CSR, TCRR, Telephone number: (903) 923-7464 (Shelly_Holmes@txed.uscourts.gov). <P> NOTICE RE REDACTION OF TRANSCRIPTS: The parties have seven (7) days to file with the Court a Notice of Intent to Request Redaction of this transcript. If no such Notice is filed, the transcript will be made remotely electronically available to the public without redaction after 90 calendar days. The policy is located on our website at www.txed.uscourts.gov <P> Transcript may be viewed at the court public terminal or purchased through the Court Reporter/Transcriber before the deadline for Release of Transcript Restriction. After that date it may be obtained through PACER.. Motion to Redact due 12/27/2019. Release of Transcript Restriction set for 3/5/2020. (sholmes,) (Entered: 12/06/2019)
12/09/2019	100	*** STIPULATION <i>Joint Stipulation Regarding Broadcom Source Code</i> by Rembrandt Wireless Technologies, LP. (Enger, Eric) Modified on 12/9/2019 (ch,). (Entered: 12/09/2019)
12/09/2019		***FILED IN ERROR. PER ATTORNEY Document # 100 , Stipulation. PLEASE IGNORE.*** (ch,) (Entered: 12/09/2019)
12/09/2019	101	STIPULATION <i>Joint Stipulation Regarding Broadcom Source Code</i> by Rembrandt Wireless Technologies, LP. (Enger, Eric) (Entered: 12/09/2019)
12/09/2019	102	NOTICE by Broadcom Corp , Broadcom Inc. re 74 MOTION to Quash , <i>for a Protective Order, and for Fee Shifting NOTICE OF SUPPLEMENTAL AUTHORITY</i> (Attachments: # 1 Exhibit A)(Smith, Melissa) (Entered: 12/09/2019)
12/12/2019	103	Joint MOTION to Amend/Correct <i>the Docket Control Order</i> by Rembrandt Wireless Technologies, LP. (Attachments: # 1 Text of Proposed Order)(Enger, Eric) (Entered: 12/12/2019)
12/13/2019	104	NOTICE by Rembrandt Wireless Technologies, LP re 74 MOTION to Quash , <i>for a Protective Order, and for Fee Shifting Notice of Supplemental Authority</i> (Attachments: # 1 Exhibit 1)(Enger, Eric) (Entered: 12/13/2019)
12/16/2019	105	Joint MOTION to Amend/Correct 103 Joint MOTION to Amend/Correct <i>the Docket Control Order</i> by Apple Inc.. (Attachments: # 1 Text of Proposed Order)(Smith, Melissa) (Entered: 12/16/2019)
12/17/2019	106	THIRD AMENDED DOCKET CONTROL ORDER granting 105 Joint MOTION to Amend/Correct 103 Joint MOTION to Amend/Correct <i>the Docket Control Order. Mediation Completion due by 2/20/2020. Signed by District Judge Rodney Gilstrap on 12/17/2019. (ch,) (Entered 12/17/2019)</i>

PACER Service Center			
Transaction Receipt			
12/24/2019 11:49:25			
PACER Login:	rg0009:2622221:0	Client Code:	104677-5027
Description:	Docket Report	Search	2:19-cv-00025-

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Billable Pages:	11	Cost:	110

ACCO,(JDEx),AO120,DISCOVERY,MANADR,PROTORD,RELATED-G

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA (Southern Division - Santa Ana)
CIVIL DOCKET FOR CASE #: 8:19-cv-00705-JLS-JDE

Rembrandt Wireless Technologies, LP v. Qualcomm Inc.
Assigned to: Judge Josephine L. Staton
Referred to: Magistrate Judge John D. Early
Related Case: [8:19-cv-00708-JLS-JDE](#)
Cause: 15:1126 Patent Infringement

Date Filed: 04/15/2019
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

Rembrandt Wireless Technologies, LP

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V.

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Rembrandt Wireless

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Counter Claimant

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David H Ben-Meir
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V.

Counter Defendant

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represented by **Alisa A Lipski**
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ATTORNEY TO BE NOTICED

Amir H Alavi
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Blaine A Larson
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Rembrandt Wireless

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Hojoon Josh Ji
 (See above for address)
 TERMINATED 08/13/2019

Kyрил V Talanov
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Louis Liao
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Michael F Heim
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Scott W Clark
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 PRO HAC VICE
 ATTORNEY TO BE NOTICED

David M Stein
 (See above for address)
 ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
04/15/2019	1	COMPLAINT Receipt No: 0973-23552716 - Fee: \$400, filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attorney David M Stein added to party Rembrandt Wireless Technologies, LP(pty:pla))(Stein, David) (Entered: 04/15/2019)
04/15/2019	2	Request for Clerk to Issue Summons on Complaint (Attorney Civil Case Opening) 1 filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/15/2019	3	CIVIL COVER SHEET filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/15/2019	4	REPORT ON THE FILING OF AN ACTION Regarding a Patent or a Trademark (Initial Notification) filed by Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/15/2019	5	NOTICE of Interested Parties filed by Plaintiff Rembrandt Wireless Technologies, LP, (Stein, David) (Entered: 04/15/2019)
04/16/2019	6	NOTICE of Related Case(s) filed by Plaintiff Rembrandt Wireless Technologies, LP. Related Case(s): 8:19-cv-00708 (Stein, David) (Entered: 04/16/2019)
04/16/2019	7	NOTICE OF ASSIGNMENT to District Judge Josephine L. Staton and Magistrate Judge John D. Early. (car) (Entered: 04/16/2019)
04/16/2019	8	NOTICE TO PARTIES OF COURT-DIRECTED ADR PROGRAM filed. (car) (Entered: 04/16/2019)
04/16/2019	9	21 DAY Summons Issued re Complaint (Attorney Civil Case Opening) 1 as to Defendant Qualcomm Inc. (car) (Entered: 04/16/2019)
04/16/2019	10	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Blaine A. Larson. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at cacd_attyadm@cacd.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (car) Modified on 4/16/2019 (car). (Entered: 04/16/2019)

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04/16/2019	11	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Christopher M. First. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (car) (Entered: 04/16/2019)
04/16/2019	12	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Eric J. Enger. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (car) (Entered: 04/16/2019)
04/16/2019	13	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Michael F. Heim. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (car) (Entered: 04/16/2019)
04/17/2019	14	INITIAL STANDING ORDER FOR CASES ASSIGNED TO JUDGE JOSEPHINE L. STATON (tg) (Entered: 04/17/2019)
04/19/2019	15	APPLICATION of Non-Resident Attorney Michael F. Heim to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581436) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	16	APPLICATION of Non-Resident Attorney Christopher M. First to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581506) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	17	APPLICATION of Non-Resident Attorney Blaine A. Larson to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581528) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	18	APPLICATION of Non-Resident Attorney Eric J. Enger to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581582) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	19	APPLICATION of Non-Resident Attorney Demetrios Anaipakos to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581619) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	20	APPLICATION of Non-Resident Attorney Kyril Talanov to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581653) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	21	APPLICATION of Non-Resident Attorney Louis Liao to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581690) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	22	APPLICATION of Non-Resident Attorney Amir Alavi to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583982) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/22/2019	23	NOTICE of Deficiency in Electronically Filed Pro Hac Vice Application RE: APPLICATION of Non-Resident Attorney Michael F. Heim to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581436) 15 ; APPLICATION of Non-Resident Attorney Christopher M. First to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581506) 16 ; APPLICATION of Non-Resident Attorney Blaine A. Larson to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581528) 17 ; APPLICATION of Non-Resident Attorney Eric J. Enger to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581582) 18 ; APPLICATION of Non-Resident Attorney Demetrios Anaipakos to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-

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		23581619) 19 ; APPLICATION of Non-Resident Attorney Kyril Talanov to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581653) 20 ; APPLICATION of Non-Resident Attorney Louis Liao to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23581690) 21 ; APPLICATION of Non-Resident Attorney Amir Alavi to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583982) 22 . The following error(s) was/were found: Local Rule 83-2.1.3.3(a) Application not complete: state and/or federal courts to which the applicant has been admitted are not listed. (lom) (Entered: 04/22/2019)
04/22/2019	24	NOTICE of Appearance filed by attorney Hojoon Josh Ji on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Attorney Hojoon Josh Ji added to party Rembrandt Wireless Technologies, LP(pty:pla))(Ji, Hojoon) (Entered: 04/22/2019)
04/22/2019	25	ORDER by Judge Josephine L. Staton granting 15 Non-Resident Attorney Michael F Heim APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	26	ORDER by Judge Josephine L. Staton granting 16 Non-Resident Attorney Christopher M First APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	27	ORDER by Judge Josephine L. Staton granting 17 Non-Resident Attorney Blaine A Larson APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	28	ORDER by Judge Josephine L. Staton granting 18 Non-Resident Attorney Eric J Enger APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	29	ORDER by Judge Josephine L. Staton: granting 19 Non-Resident Attorney Demetrios Anaipakos APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	30	ORDER by Judge Josephine L. Staton granting 20 Non-Resident Attorney Kyril Talanov APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	31	ORDER by Judge Josephine L. Staton granting 21 Non-Resident Attorney Louis Liao APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	32	ORDER by Judge Josephine L. Staton granting 22 Non-Resident Attorney Amir Alavi APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/24/2019	33	Notice of Appearance or Withdrawal of Counsel: for attorney Alisa A Lipski counsel for Plaintiff Rembrandt Wireless Technologies, LP. Adding Alisa A. Lipski as counsel of record for Rembrandt Wireless Technologies, LP for the reason indicated in the G-123 Notice. Filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attorney Alisa A Lipski added to party Rembrandt Wireless Technologies, LP(pty:pla))(Lipski, Alisa) (Entered: 04/24/2019)
04/30/2019	34	PROOF OF SERVICE Executed by Plaintiff Rembrandt Wireless Technologies, LP, upon Defendant Qualcomm Inc. served on 4/18/2019, answer due 5/9/2019. Service of the Summons and Complaint were executed upon Becky DeGeorge who is designated by law to accept service of process on behalf of Registered Agent CSC Lawyers, Inc. in compliance with Federal Rules of Civil Procedure by service on a domestic corporation, unincorporated association, or public entity.Original Summons returned. (Larson, Blaine) (Entered: 04/30/2019)
05/02/2019	35	STIPULATION Extending Time to Answer the complaint as to Qualcomm Inc. answer now due 6/10/2019, re Complaint (Attorney Civil Case Opening) 1 filed by Defendant Qualcomm Inc..(Attorney David H Ben-Meir added to party Qualcomm Inc.(pty:dft))(Ben-Meir, David) (Entered: 05/02/2019)
05/03/2019	36	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Richard S Zembek. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (jp) (Entered: 05/03/2019)
05/03/2019	37	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Eric C Green. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of

Rembrandt Wireless

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		this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (jp) (Entered: 05/03/2019)
05/06/2019	38	APPLICATION of Non-Resident Attorney Richard S. Zembek to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23684227) filed by Defendant Qualcomm Inc.. (Attachments: # 1 Proposed Order) (Ben-Meir, David) (Entered: 05/06/2019)
05/06/2019	39	APPLICATION of Non-Resident Attorney Eric C. Green to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23684363) filed by Defendant Qualcomm Inc.. (Attachments: # 1 Proposed Order) (Ben-Meir, David) (Entered: 05/06/2019)
05/07/2019	40	NOTICE of Deficiency in Electronically Filed Pro Hac Vice Application RE: APPLICATION of Non-Resident Attorney Eric C. Green to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23684363) 39 , APPLICATION of Non-Resident Attorney Richard S. Zembek to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23684227) 38 . The following error(s) was/were found: Local Rule 83-2.1.3.3(a) Application not complete: state and/or federal courts to which the applicant has been admitted are not listed. (lt) (Entered: 05/07/2019)
05/08/2019	41	Amended APPLICATION of Non-Resident Attorney Richard S. Zembek to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400.00 Previously Paid on 5/7/2019, Receipt No. 0973-23684363) filed by Defendant Qualcomm Inc.. (Attachments: # 1 Proposed Order) (Ben-Meir, David) (Entered: 05/08/2019)
05/08/2019	42	Amended APPLICATION of Non-Resident Attorney Eric C. Green to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400.00 Previously Paid on 5/7/2019, Receipt No. 0973-23684363) filed by Defendant Qualcomm Inc.. (Attachments: # 1 Proposed Order) (Ben-Meir, David) (Entered: 05/08/2019)
05/09/2019	43	ORDER by Judge Josephine L. Staton: granting 38 , 41 Non-Resident Attorney Richard S Zembek APPLICATION to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc., designating David H Ben-Meir as local counsel. (jp) (Entered: 05/09/2019)
05/09/2019	44	ORDER by Judge Josephine L. Staton: granting 39 , 42 Non-Resident Attorney Eric C Green APPLICATION to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc., designating David H Ben-Meir as local counsel. (jp) (Entered: 05/09/2019)
06/06/2019	45	Second STIPULATION for Extension of Time to File Answer to June 24, 2019 re Complaint (Attorney Civil Case Opening) 1 filed by Defendant Qualcomm Inc.. (Attachments: # 1 Proposed Order)(Ben-Meir, David) (Entered: 06/06/2019)
06/06/2019	46	ORDER GRANTING Stipulation to Extend Time to Respond to Complaint By Two Weeks (L.R. 8-3) 45 by Judge Josephine L. Staton that Qualcomm shall have up to and including 6/24/2019, to answer, move, or otherwise respond to the Complaint. (jp) (Entered: 06/06/2019)
06/24/2019	47	ANSWER to Complaint (Attorney Civil Case Opening) 1 with JURY DEMAND, COUNTERCLAIM against Rembrandt Wireless Technologies, LP filed by Defendant Qualcomm Inc.. (Attachments: # 1 Exhibit 1, # 2 Exhibit 2, # 3 Exhibit 3, # 4 Exhibit 4, # 5 Exhibit 5)(Zembek, Richard) (Entered: 06/24/2019)
06/24/2019	48	CORPORATE DISCLOSURE STATEMENT filed by Defendant Qualcomm Inc. identifying None as Corporate Parent. (Zembek, Richard) (Entered: 06/24/2019)
06/25/2019	49	ORDER SETTING SCHEDULING CONFERENCE by Judge Josephine L. Staton. Scheduling Conference is set for 8/9/2019 at 10:30 a.m. (tg) (Entered: 06/25/2019)
07/15/2019	50	ANSWER to Answer to Complaint (Attorney Civil Case Opening), Counterclaim, 47 Answer to Qualcomm Inc.'s Counterclaims filed by Plaintiff Rembrandt Wireless Technologies, LP.(Lipski, Alisa) (Entered: 07/15/2019)
07/26/2019	51	JOINT REPORT Rule 26(f) Discovery Plan ; estimated length of trial 7 days, filed by Plaintiff Rembrandt Wireless Technologies, LP.. (Stein, David) (Entered: 07/26/2019)
08/07/2019	52	MINUTE (In Chambers) SCHEDULING ORDER IN A PATENT CASE by Judge Josephine L. Staton: On the Court's own motion, the Scheduling Conference set for hearing 8/9/2019, is VACATED and the following schedule is set. The Court will set a trial date and an exhibit conference date at the Final PretrialConference set for 10/30/2020 at 10:30 AM. (SEE DOCUMENT FOR FURTHER INFORMATION). (jp) (Entered: 08/07/2019)
08/07/2019	53	CIVIL TRIAL ORDER for cases assigned to Judge Josephine L. Staton. (tg) (Entered: 08/07/2019)
08/07/2019	54	ORDER/REFERRAL to ADR Procedure No. 3 by Judge Josephine L. Staton. Case is ordered to a private mediator based upon a stipulation of the parties. ADR Proceeding to be held no later than August 28, 2020. (tg) (Entered: 08/07/2019)
08/13/2019	55	Notice of Appearance or Withdrawal of Counsel: for attorney David M Stein counsel for Plaintiff Rembrandt Wireless Technologies, LP, Counter Defendant Rembrandt Wireless Technologies, LP. Hojoon Josh Ji is no longer counsel of record for the aforementioned party in this case for the reason indicated in the G-123 Notice. Filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 08/13/2019)
09/09/2019	56	NOTICE OF MOTION AND MOTION for Order for Stipulated Protective Order filed by Plaintiff Rembrandt

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		Wireless Technologies, LP. (Attachments: # 1 Proposed Stipulated Protective Order) (Stein, David) (Entered: 09/09/2019)
09/09/2019	57	STIPULATION for Discovery as to Electronic Discovery filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 09/09/2019)
09/11/2019	58	MINUTES (IN CHAMBERS) Order Denying Stipulated for Protective Order 56 by Magistrate Judge John D. Early. The Motion (Dkt. 56) is DENIED, without prejudice to the parties submitting a new proposed protective order (see document for further details). (hr) (Entered: 09/11/2019)
09/12/2019	59	NOTICE TO FILER OF DEFICIENCIES in Electronically Filed Documents RE: Stipulation for Discovery as to Electronic Discovery 57 . The following error(s) was/were found: 1. District Judge Josephine L. Staton refers all civil discovery to the Magistrate Judge assigned to the case. 2. There is no signature line or separate proposed document submitted with this document for Magistrate Judge John D. Early's signature. In response to this notice, the Court may: (1) order an amended or correct document to be filed; (2) order the document stricken; or (3) take other action as the Court deems appropriate. You need not take any action in response to this notice unless and until the Court directs you to do so. (hr) (Entered: 09/12/2019)
10/02/2019	60	NOTICE OF MOTION AND MOTION for Order for Stipulated Protective Order filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Stipulated Protective Order) (Stein, David) (Entered: 10/02/2019)
10/02/2019	61	STIPULATION for Discovery as to Electronic Discovery filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 10/02/2019)
10/02/2019	62	PROTECTIVE ORDER by Magistrate Judge John D. Early: granting 60 MOTION for Protective Order. (see document for details) (hr) (Entered: 10/02/2019)
10/02/2019	63	ORDER GOVERNING ELECTRONIC DISCOVERY by Magistrate Judge John D. Early, re Stipulation for Discovery as to Electronic Discovery 61 . (see document for details) (hr) (Entered: 10/02/2019)
11/15/2019	64	Joint Statement Regarding Technology Tutorial filed by Plaintiff Rembrandt Wireless Technologies, LP (Stein, David) (Entered: 11/15/2019)
11/20/2019	65	APPLICATION of Non-Resident Attorney Scott W. Clark to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-24820894) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 11/20/2019)
11/22/2019	66	STATEMENT Joint P R. 4-3 Claim Construction Statement filed by Plaintiff Rembrandt Wireless Technologies, LP (Attachments: # 1 Exhibit A)(Enger, Eric) (Entered: 11/22/2019)
11/22/2019	67	ORDER by Judge Josephine L. Staton: granting 65 Non-Resident Attorney Scott W Clark APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 11/25/2019)
12/04/2019	68	EX PARTE APPLICATION of Non-Resident Attorney Marc B. Collier to Appear Pro Hac Vice on behalf of Defendant Qualcomm Inc. (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-24891468) filed by Defendant Qualcomm Inc.. (Attachments: # 1 Proposed Order) (Ben-Meir, David) (Entered: 12/04/2019)
12/06/2019	69	BRIEF filed by Plaintiff Rembrandt Wireless Technologies, LP. <i>Rembrandt's Opening Claim Construction Brief</i> (Attachments: # 1 Declaration of Eric Enger, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit 12, # 14 Exhibit 13, # 15 Exhibit 14, # 16 Exhibit 24, # 17 Exhibit 25, # 18 Exhibit 26, # 19 Exhibit 27, # 20 Exhibit 28, # 21 Exhibit 29)(Enger, Eric) (Entered: 12/06/2019)
12/06/2019	70	BRIEF filed by Defendant Qualcomm Inc.. <i>Qualcomm Inc.'s Opening Claim Construction Brief</i> (Attachments: # 1 Declaration of Eric Green, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit 12, # 14 Exhibit 13, # 15 Exhibit 14, # 16 Exhibit 15, # 17 Exhibit 16)(Ben-Meir, David) (Entered: 12/06/2019)
12/09/2019	71	<i>Stipulation re Damages Contentions</i> (Attachments: # 1 Proposed Order)(Alavi, Amir) (Entered: 12/09/2019)
12/10/2019	72	ORDER by Judge Josephine L. Staton: granting 68 Non-Resident Attorney Marc B. Collier APPLICATION to Appear Pro Hac Vice on behalf of Qualcomm Inc., designating David H Ben-Meir as local counsel. (lom) (Entered: 12/11/2019)
12/20/2019	73	RESPONSE filed by Plaintiff Rembrandt Wireless Technologies, LP <i>Rembrandt's Responsive Claim Construction Brief</i> (Attachments: # 1 Declaration of Christopher First, # 2 Exhibit 30, # 3 Exhibit 31, # 4 Exhibit 32, # 5 Exhibit 33, # 6 Exhibit 34, # 7 Exhibit 35)(First, Christopher) (Entered: 12/20/2019)
12/20/2019	74	RESPONSE filed by Defendant Qualcomm Inc. <i>Qualcomm's Responsive Claim Construction Brief</i> (Attachments: # 1 Declaration, # 2 Exhibit 17, # 3 Exhibit 18, # 4 Exhibit 19)(Zembek, Richard) (Entered: 12/20/2019)
12/20/2019	75	ORDER by Judge Josephine L. Staton. Pursuant to the stipulation 71 of the parties, Qualcomm's deadline for responsive damages contentions is extended to 12/27/2019. (jp) (Entered: 12/23/2019)

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA (Southern Division - Santa Ana)
CIVIL DOCKET FOR CASE #: 8:19-cv-00708-JLS-JDE

Rembrandt Wireless Technologies, LP et al v. Broadcom Incorporated, et al
Assigned to: Judge Josephine L. Staton
Referred to: Magistrate Judge John D. Early
Related Case: [8:19-cv-00705-JLS-JDE](#)
Cause: 15:1126 Patent Infringement

Date Filed: 04/15/2019
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

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V.

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Defendant

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Demetrios Anaipakos
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Counter Claimant

Broadcom Incorporated

represented by **David E Sipiora**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Andrew N Saul
(See above for address)
ATTORNEY TO BE NOTICED

Edward J Mayle
(See above for address)
ATTORNEY TO BE NOTICED

Emil W Herich
(See above for address)
ATTORNEY TO BE NOTICED

Kristopher L Reed
(See above for address)
ATTORNEY TO BE NOTICED

Matthew Christian Holohan
(See above for address)
TERMINATED 05/29/2019

Russell A Korn
(See above for address)
ATTORNEY TO BE NOTICED

V.

Counter Defendant

Rembrandt Wireless Technologies, LP

represented by **Alisa A Lipski**
(See above for address)
ATTORNEY TO BE NOTICED

Amir H Alavi
(See above for address)
ATTORNEY TO BE NOTICED

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Blaine A Larson
 (See above for address)
 ATTORNEY TO BE NOTICED

Christopher M First
 (See above for address)
 ATTORNEY TO BE NOTICED

Demetrios Anaipakos
 (See above for address)
 ATTORNEY TO BE NOTICED

Eric J Enger
 (See above for address)
 ATTORNEY TO BE NOTICED

Hoon Ji
 (See above for address)
 TERMINATED 08/13/2019

Kyryl V Talanov
 (See above for address)
 ATTORNEY TO BE NOTICED

Louis Liao
 (See above for address)
 ATTORNEY TO BE NOTICED

Michael F Heim
 (See above for address)
 ATTORNEY TO BE NOTICED

Scott W Clark
 (See above for address)
 PRO HAC VICE
 ATTORNEY TO BE NOTICED

David M Stein
 (See above for address)
 ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
04/15/2019	1	COMPLAINT Receipt No: 0973-23553282 - Fee: \$400, filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attorney David M Stein added to party Rembrandt Wireless Technologies, LP(pty:pla))(Stein, David) (Entered: 04/15/2019)
04/15/2019	2	CIVIL COVER SHEET filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/15/2019	3	Request for Clerk to Issue Summons on Complaint (Attorney Civil Case Opening) 1 , Civil Cover Sheet (CV-71) 2 filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/15/2019	4	Request for Clerk to Issue Summons on Complaint (Attorney Civil Case Opening) 1 filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/15/2019	5	NOTICE of Interested Parties filed by Plaintiff Rembrandt Wireless Technologies, LP, (Stein, David) (Entered: 04/15/2019)
04/15/2019	6	REPORT ON THE FILING OF AN ACTION Regarding a Patent or a Trademark (Initial Notification) filed by Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 04/15/2019)
04/16/2019	7	NOTICE OF ASSIGNMENT to District Judge Josephine L. Staton and Magistrate Judge Autumn D. Spaeth. (esa) (Entered: 04/16/2019)
04/16/2019	8	NOTICE TO PARTIES OF COURT-DIRECTED ADR PROGRAM filed. (esa) (Entered: 04/16/2019)
04/16/2019	9	21 DAY Summons issued re Complaint 1 as to defendant Broadcom Incorporated. (esa) (Entered: 04/16/2019)
04/16/2019	10	21 DAY Summons issued re Complaint 1 as to defendant Broadcom Corporation. (esa) (Entered: 04/16/2019)
04/16/2019	11	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Michael F. Heim. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate

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		any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (esa) (Entered: 04/16/2019)
04/16/2019	12	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Eric J. Enger. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (esa) (Entered: 04/16/2019)
04/16/2019	13	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Christopher M First. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (esa) (Entered: 04/16/2019)
04/16/2019	14	NOTICE OF PRO HAC VICE APPLICATION DUE for Non-Resident Attorney Blaine A. Larson. A document recently filed in this case lists you as an out-of-state attorney of record. However, the Court has not been able to locate any record that you are admitted to the Bar of this Court, and you have not filed an application to appear Pro Hac Vice in this case. Accordingly, within 5 business days of the date of this notice, you must either (1) have your local counsel file an application to appear Pro Hac Vice (Form G-64) and pay the applicable fee, or (2) complete the next section of this form and return it to the court at caed_attyadm@caed.uscourts.gov . You have been removed as counsel of record from the docket in this case, and you will not be added back to the docket until your Pro Hac Vice status has been resolved. (esa) (Entered: 04/16/2019)
04/16/2019	15	NOTICE of Related Case(s) filed by Plaintiff Rembrandt Wireless Technologies, LP. Related Case(s): 8:19-cv-00705 (Stein, David) (Entered: 04/16/2019)
04/17/2019	16	INITIAL STANDING ORDER FOR CASES ASSIGNED TO JUDGE JOSEPHINE L. STATON (tg) (Entered: 04/17/2019)
04/17/2019	17	ORDER RE TRANSFER PURSUANT TO Local Rule 83-1.3.1 and General Order 19-03 -Related Case- filed. Related Case No: SACV 19-705-JLS (JDEx). Case referred from Magistrate Judge Autumn D. Spaeth to Magistrate Judge John D. Early for DISCOVERY. The case number will now read as follows: SACV 19-00708-JLS (JDEx). Signed by Magistrate Judge John D. Early. (dv) (Entered: 04/17/2019)
04/19/2019	18	APPLICATION of Non-Resident Attorney Michael F. Heim to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583196) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	19	APPLICATION of Non-Resident Attorney Christopher M. First to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583246) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	20	APPLICATION of Non-Resident Attorney Blaine A. Larson to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583281) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	21	APPLICATION of Non-Resident Attorney Eric J. Enger to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583323) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	22	APPLICATION of Non-Resident Attorney Demetrios Anaipakos to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583359) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	23	APPLICATION of Non-Resident Attorney Kyril Talanov to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583401) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/19/2019	24	APPLICATION of Non-Resident Attorney Louis Liao to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583430) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)

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04/19/2019	25	APPLICATION of Non-Resident Attorney Amir Alavi to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583927) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 04/19/2019)
04/22/2019	26	NOTICE of Deficiency in Electronically Filed Pro Hac Vice Application RE: APPLICATION of Non-Resident Attorney Michael F. Heim to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583196) 18 ; APPLICATION of Non-Resident Attorney Christopher M. First to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583246) 19 ; APPLICATION of Non-Resident Attorney Blaine A. Larson to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583281) 20 ; APPLICATION of Non-Resident Attorney Eric J. Enger to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583323) 21 , APPLICATION of Non-Resident Attorney Demetrios Anaipakos to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583359) 22 ; APPLICATION of Non-Resident Attorney Kyril Talanov to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583401) 23 ; APPLICATION of Non-Resident Attorney Louis Liao to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583430) 24 ; APPLICATION of Non-Resident Attorney Amir Alavi to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23583927) 25 . The following error(s) was/were found: Local Rule 83-2.1.3.3(a) Application not complete: state and/or federal courts to which the applicant has been admitted are not listed. (lom) (Entered: 04/22/2019)
04/22/2019	27	NOTICE of Appearance filed by attorney Hojoon Josh Ji on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Attorney Hojoon Josh Ji added to party Rembrandt Wireless Technologies, LP(pty:pla))(Ji, Hojoon) (Entered: 04/22/2019)
04/22/2019	28	ORDER by Judge Josephine L. Staton granting 18 Non-Resident Attorney Michael F Heim APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	29	ORDER by Judge Josephine L. Staton granting 19 Non-Resident Attorney Christopher M First APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	30	ORDER by Judge Josephine L. Staton granting 20 Non-Resident Attorney Blaine A Larson APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	31	ORDER by Judge Josephine L. Staton granting 21 Non-Resident Attorney Eric J Enger APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	32	ORDER by Judge Josephine L. Staton granting 22 Non-Resident Attorney Demetrios Anaipakos APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/22/2019)
04/22/2019	33	ORDER by Judge Josephine L. Staton granting 23 Non-Resident Attorney Kyril Talanov APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/23/2019)
04/22/2019	34	ORDER by Judge Josephine L. Staton granting 24 Non-Resident Attorney Louis Liao APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/23/2019)
04/22/2019	35	ORDER by Judge Josephine L. Staton granting 25 Non-Resident Attorney Amir Alavi APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 04/23/2019)
04/24/2019	36	NOTICE TO FILER OF DEFICIENCIES in Electronically Filed Documents RE: Notice of Appearance 27 . The following error(s) was/were found: Incorrect event selected. Correct event to be used is: Notice of Appearance or Withdrawal of Counsel G123. In response to this notice, the Court may: (1) order an amended or correct document to be filed; (2) order the document stricken; or (3) take other action as the Court deems appropriate. You need not take any action in response to this notice unless and until the Court directs you to do so. (ak) (Entered: 04/24/2019)
04/24/2019	37	Notice of Appearance or Withdrawal of Counsel: for attorney Alisa A Lipski counsel for Plaintiff Rembrandt Wireless Technologies, LP. Adding Alisa A. Lipski as counsel of record for Rembrandt Wireless Technologies, LP for the reason indicated in the G-123 Notice. Filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attorney Alisa A Lipski added to party Rembrandt Wireless Technologies, LP(pty:pla))(Lipski, Alisa) (Entered: 04/24/2019)
04/30/2019	38	PROOF OF SERVICE Executed by Plaintiff Rembrandt Wireless Technologies, LP, upon Defendant Broadcom Incorporated served on 4/18/2019, answer due 5/9/2019. Service of the Summons and Complaint were executed upon Jason Nally, Admin Assistant with registered agent Corporation Service Company in compliance with Federal Rules of Civil Procedure by service on a domestic corporation, unincorporated association, or public entity. Original Summons

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		returned. (Larson, Blaine) (Entered: 04/30/2019)
04/30/2019	39	PROOF OF SERVICE Executed by Plaintiff Rembrandt Wireless Technologies, LP, upon Defendant Broadcom Corporation served on 4/18/2019, answer due 5/9/2019. Service of the Summons and Complaint were executed upon Becky DeGeorge who is designated by law to accept service of process on behalf of registered agent CSC Lawyers, Inc. in compliance with Federal Rules of Civil Procedure by service on a domestic corporation, unincorporated association, or public entity. Original Summons returned. (Larson, Blaine) (Entered: 04/30/2019)
05/06/2019	40	Notice of Appearance or Withdrawal of Counsel: for attorney David E Sipiora counsel for Defendants Broadcom Corporation, Broadcom Incorporated. Adding David E. Sipiora as counsel of record for Broadcom Inc. and Broadcom Corp. for the reason indicated in the G-123 Notice. Filed by Defendant Broadcom Inc. and Broadcom Corp.. (Attorney David E Sipiora added to party Broadcom Corporation(pty:dft), Attorney David E Sipiora added to party Broadcom Incorporated(pty:dft))(Sipiora, David) (Entered: 05/06/2019)
05/06/2019	41	Notice of Appearance or Withdrawal of Counsel: for attorney Matthew Christian Holohan counsel for Defendants Broadcom Corporation, Broadcom Incorporated. Adding Matthew C. Holohan as counsel of record for Broadcom Inc. and Broadcom Corp. for the reason indicated in the G-123 Notice. Filed by Defendant Broadcom Inc. and Broadcom Corp.. (Attorney Matthew Christian Holohan added to party Broadcom Corporation(pty:dft), Attorney Matthew Christian Holohan added to party Broadcom Incorporated(pty:dft))(Holohan, Matthew) (Entered: 05/06/2019)
05/06/2019	42	CORPORATE DISCLOSURE STATEMENT filed by Defendants Broadcom Corporation, Broadcom Incorporated identifying Broadcom Inc. as Corporate Parent. (Holohan, Matthew) (Entered: 05/06/2019)
05/06/2019	43	Joint STIPULATION Extending Time to Answer the complaint as to Broadcom Corporation answer now due 6/10/2019; Broadcom Incorporated answer now due 6/10/2019, re Complaint (Attorney Civil Case Opening) 1 filed by Defendants Broadcom Corporation; Broadcom Incorporated.(Holohan, Matthew) (Entered: 05/06/2019)
05/10/2019	44	Notice of Appearance or Withdrawal of Counsel: for attorney Emil W Herich counsel for Defendants Broadcom Corporation, Broadcom Incorporated. Adding Emil W. Herich as counsel of record for defendants for the reason indicated in the G-123 Notice. Filed by defendants Broadcom Inc. and Broadcom Corp.. (Attorney Emil W Herich added to party Broadcom Corporation(pty:dft), Attorney Emil W Herich added to party Broadcom Incorporated (pty:dft))(Herich, Emil) (Entered: 05/10/2019)
05/29/2019	45	Notice of Appearance or Withdrawal of Counsel: for attorney Matthew Christian Holohan counsel for Defendants Broadcom Corporation, Broadcom Incorporated. Matthew C. Holohan is no longer counsel of record for the aforementioned party in this case for the reason indicated in the G-123 Notice. Filed by Defendants Broadcom Inc. and Broadcom Corp.. (Holohan, Matthew) (Entered: 05/29/2019)
05/29/2019	46	First APPLICATION of Non-Resident Attorney Edward J. Mayle to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23819131) filed by Attorney for Defendants Broadcom Corporation, Broadcom Incorporated. (Attachments: # 1 Exhibit certificate of good standing) (Herich, Emil) (Entered: 05/29/2019)
05/29/2019	47	NOTICE of Deficiency in Electronically Filed Pro Hac Vice Application RE: First APPLICATION of Non-Resident Attorney Edward J. Mayle to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23819131) 46 . The following error(s) was/were found: Local Rule 5-4.3.4 Application not hand-signed. Local Rule 83-2.1.3.3(b) Proposed order not attached. Please note that electronic, image or stamp signatures are not allowed. (lt) (Entered: 05/29/2019)
05/30/2019	48	APPLICATION of Non-Resident Attorney Edward J. Mayle to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated (Pro Hac Vice Fee - \$400 Previously Paid on 5/29/2019, Receipt No. 0973-23819131) filed by Defendants Broadcom Corporation, Broadcom Incorporated. (Attachments: # 1 Proposed Order) (Herich, Emil) (Entered: 05/30/2019)
05/31/2019	49	Notice of Appearance or Withdrawal of Counsel: for attorney Kristopher L Reed counsel for Defendants Broadcom Corporation, Broadcom Incorporated. Adding Kristopher L. Reed as counsel of record for Broadcom Inc. and Broadcom Corp. for the reason indicated in the G-123 Notice. Filed by Defendants Broadcom Inc. and Broadcom Corp.. (Attorney Kristopher L Reed added to party Broadcom Corporation(pty:dft), Attorney Kristopher L Reed added to party Broadcom Incorporated(pty:dft))(Reed, Kristopher) (Entered: 05/31/2019)
05/31/2019	50	ORDER by Judge Josephine L. Staton: granting 46 , 48 Non-Resident Attorney Edward J Mayle APPLICATION to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated, designating Emil W Herich as local counsel. (jp) (Entered: 05/31/2019)
06/10/2019	51	APPLICATION of Non-Resident Attorney Andrew N. Saul to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23890498) filed by Defendants Broadcom Corporation, Broadcom Incorporated. (Attachments: # 1 Proposed Order) (Herich, Emil) (Entered: 06/10/2019)
06/10/2019	52	NOTICE OF MOTION AND MOTION to Dismiss Case <i>Under Fed. R. Civ. P. 12(b)(6)</i> filed by Defendants Broadcom Corporation, Broadcom Incorporated. Motion set for hearing on 8/23/2019 at 10:30 AM before Judge Josephine L. Staton. (Attachments: # 1 Declaration Declaration of Edward John Mayle in Support of Defendants Motion to Dismiss Under Fed. R. Civ. P. 12(b)(6), # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Proposed Order) (Reed, Kristopher) (Entered: 06/10/2019)

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06/11/2019	53	ORDER by Judge Josephine L. Staton: granting 51 Non-Resident Attorney Andrew N Saul APPLICATION to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated, designating Emil W Herich as local counsel. (jp) (Entered: 06/11/2019)
06/13/2019	54	ORDER SETTING SCHEDULING CONFERENCE by Judge Josephine L. Staton. Scheduling Conference is set for 8/2/2019 at 10:30 a.m. (tg) (Entered: 06/13/2019)
06/26/2019	55	APPLICATION of Non-Resident Attorney Russell A. Korn to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-23987960) filed by Defendants Broadcom Corporation, Broadcom Incorporated. (Attachments: # 1 Proposed Order) (Herich, Emil) (Entered: 06/26/2019)
06/27/2019	56	ORDER by Judge Josephine L. Staton: granting 55 Non-Resident Attorney Russell A Korn APPLICATION to Appear Pro Hac Vice on behalf of Defendants Broadcom Corporation, Broadcom Incorporated, designating Emil W Herich as local counsel. (jp) (Entered: 06/27/2019)
07/19/2019	57	JOINT REPORT Rule 26(f) Discovery Plan ; estimated length of trial 7 days, filed by Plaintiff Rembrandt Wireless Technologies, LP.. (Stein, David) (Entered: 07/19/2019)
07/31/2019	58	MINUTES (In Chambers) SCHEDULING ORDER IN A PATENT CASE by Judge Josephine L. Staton: The present case alleges that Defendant infringed Plaintiffs utility patent. The Court has reviewed the Joint Rule 26(f) Report (Doc. 57) and, VACATED the Scheduling Conference set for hearing 8/2/2019. The Court sets the schedule in this case as set forth below. Claim Construction Hearing set for 1/21/2020 at 9:00 AM. Final Pretrial Conference set for 10/30/2020 at 10:30 AM. (SEE DOCUMENT FOR FURTHER INFORMATION). (jp) (Entered: 07/31/2019)
07/31/2019	59	CIVIL TRIAL ORDER for cases assigned to Judge Josephine L. Staton. (tg) (Entered: 07/31/2019)
07/31/2019	60	ORDER/REFERRAL to ADR Procedure No. 3 by Judge Josephine L. Staton. Case is ordered to a private mediator based upon a stipulation of the parties. ADR Proceeding to be held no later than August 28, 2020. (tg) (Entered: 07/31/2019)
08/02/2019	61	OPPOSITION to NOTICE OF MOTION AND MOTION to Dismiss Case <i>Under Fed. R. Civ. P. 12(b)(6)</i> 52 filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Declaration of Blaine Larson, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit 12)(Stein, David) (Entered: 08/02/2019)
08/09/2019	62	REPLY in support of NOTICE OF MOTION AND MOTION to Dismiss Case <i>Under Fed. R. Civ. P. 12(b)(6)</i> 52 filed by Defendants Broadcom Corporation, Broadcom Incorporated. (Attachments: # 1 Declaration of Edward John Mayle, # 2 Exhibit 1, # 3 Exhibit 2)(Mayle, Edward) (Entered: 08/09/2019)
08/12/2019	63	Notice of Electronic Filing re Reply (Motion related), 62 e-mailed to Hojoon Josh Ji bounced due to Recipient Not Found. The primary e-mail address associated with the attorney record has been deleted. Pursuant to Local Rules it is the attorneys obligation to maintain all personal contact information including e-mail address in the CM/ECF system. THERE IS NO PDF DOCUMENT ASSOCIATED WITH THIS ENTRY. (cbr) TEXT ONLY ENTRY (Entered: 08/12/2019)
08/13/2019	64	Notice of Appearance or Withdrawal of Counsel: for attorney David M Stein counsel for Plaintiff Rembrandt Wireless Technologies, LP. Hojoon Josh Ji is no longer counsel of record for the aforementioned party in this case for the reason indicated in the G-123 Notice. Filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 08/13/2019)
08/22/2019	65	MINUTES (IN CHAMBERS) ORDER DENYING DEFENDANTS' MOTION TO DISMISS (Doc. 52) by Judge Josephine L. Staton denying 52 MOTION to Dismiss Case: For the Foregoing reasons, the Court DENIES Defendants' Motion. (see document for further details) (bm) (Entered: 08/22/2019)
09/05/2019	66	ANSWER to Complaint (Attorney Civil Case Opening) 1 with JURY DEMAND, COUNTERCLAIM against Rembrandt Wireless Technologies, LP filed by Defendants Broadcom Corporation, Broadcom Incorporated.(Sipiora, David) (Entered: 09/05/2019)
09/09/2019	67	NOTICE TO FILER OF DEFICIENCIES in Electronically Filed Documents RE: Answer to Complaint and Counterclaim filed by Defendants Broadcom Corporation, Broadcom Incorporated 66 . The following error(s) was/were found: (1) No Notice of Interested Parties and/or no copies. Other error(s) with document(s): (2) Counsel must comply with Local Rule 7.1-1. In response to this notice, the Court may: (1) order an amended or correct document to be filed; (2) order the document stricken; or (3) take other action as the Court deems appropriate. You need not take any action in response to this notice unless and until the Court directs you to do so. (jp) (Entered: 09/09/2019)
09/09/2019	68	NOTICE OF MOTION AND MOTION for Order for Stipulated Protective Order filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Stipulated Protective Order) (Stein, David) (Entered: 09/09/2019)
09/09/2019	69	STIPULATION for Discovery as to Electronic Discovery filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 09/09/2019)
09/11/2019	70	MINUTES (IN CHAMBERS) Order Denying Stipulated for Protective Order 68 by Magistrate Judge John D. Early.

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		The Motion (Dkt. 68) is DENIED, without prejudice to the parties submitting a new proposed protective order (see document for further details). (hr) (Entered: 09/11/2019)
09/12/2019	71	NOTICE TO FILER OF DEFICIENCIES in Electronically Filed Documents RE: Stipulation for Discovery as to Electronic Discovery 69 . The following error(s) was/were found: 1. District Judge Josephine L. Staton refers all civil discovery to the Magistrate Judge assigned to the case. 2. There is no signature line or separate proposed document submitted with this document for Magistrate Judge John D. Early's signature. In response to this notice, the Court may: (1) order an amended or correct document to be filed; (2) order the document stricken; or (3) take other action as the Court deems appropriate. You need not take any action in response to this notice unless and until the Court directs you to do so. (hr) (Entered: 09/12/2019)
09/26/2019	72	<i>First Amended</i> ANSWER to Complaint (Attorney Civil Case Opening) 1 with JURY DEMAND, Amended COUNTERCLAIM against Rembrandt Wireless Technologies, LP filed by Defendants Broadcom Corporation, Broadcom Incorporated.(Sipiora, David) (Entered: 09/26/2019)
09/30/2019	73	NOTICE OF MOTION AND MOTION for Order for Entry of Protective Order filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Stipulated Protective Order) (Stein, David) (Entered: 09/30/2019)
09/30/2019	74	STIPULATION for Discovery as to Electronic Discovery filed by Plaintiff Rembrandt Wireless Technologies, LP. (Stein, David) (Entered: 09/30/2019)
10/01/2019	75	STIPULATED ORDER GOVERNING ELECTRONIC DISCOVERY by Magistrate Judge John D. Early, re Stipulation for Discovery as to Electronic Discovery 74 . (see document for further details) (hr) (Entered: 10/01/2019)
10/01/2019	76	PROTECTIVE ORDER by Magistrate Judge John D. Early: granting 73 MOTION for Protective Order. (see document for details) (hr) (Entered: 10/01/2019)
10/17/2019	77	<i>Plaintiff Rembrandt Wireless Technologies, L.P.'s</i> ANSWER to Answer to Counterclaim, 72 <i>Broadcom's First Amended Counterclaims</i> filed by Plaintiff Rembrandt Wireless Technologies, LP.(Alavi, Amir) (Entered: 10/17/2019)
11/01/2019	78	NOTICE OF MOTION AND MOTION for Relief from Pursuant to Section 31 of the Protective Order re Order on Motion for Order 76 filed by Defendant Broadcom Corporation, Broadcom Incorporated. Motion set for hearing on 12/5/2019 at 10:00 AM before Magistrate Judge John D. Early. (Attachments: # 1 Joint Stipulation Regarding Defendants Motion for Relief Pursuant to Section 31 of the Protective Order, # 2 Declaration Declaration of Edward John Mayle in Support of Defendants Motion for Relief Pursuant to Section 31 of the Protective Order, # 3 Exhibit A, # 4 Exhibit B, # 5 Exhibit C, # 6 Proposed Order)(Sipiora, David) (Entered: 11/01/2019)
11/15/2019	79	Joint Statement Regarding Technology Tutorial filed by Plaintiff Rembrandt Wireless Technologies, LP (Stein, David) (Entered: 11/15/2019)
11/20/2019	80	APPLICATION of Non-Resident Attorney Scott W. Clark to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP (Pro Hac Vice Fee - \$400 Fee Paid, Receipt No. 0973-24821058) filed by Plaintiff Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order) (Stein, David) (Entered: 11/20/2019)
11/21/2019	81	MEMORANDUM in Support of MOTION for Relief from Pursuant to Section 31 of the Protective Order re Order on Motion for Order 76 78 filed by Defendants Broadcom Corporation, Broadcom Incorporated. (Sipiora, David) (Entered: 11/21/2019)
11/22/2019	82	STATEMENT Joint P R. 4-3 Claim Construction Statement filed by Plaintiff Rembrandt Wireless Technologies, LP (Attachments: # 1 Exhibit A)(Enger, Eric) (Entered: 11/22/2019)
11/22/2019	83	ORDER by Judge Josephine L. Staton: granting 80 Non-Resident Attorney Scott W Clark APPLICATION to Appear Pro Hac Vice on behalf of Plaintiff Rembrandt Wireless Technologies, LP, designating David M Stein as local counsel. (jp) (Entered: 11/25/2019)
11/26/2019	84	Stipulation re Damages Contentions filed by Plaintiff Rembrandt Wireless Technologies, LP (Attachments: # 1 Proposed Order)(Stein, David) (Entered: 11/26/2019)
12/04/2019	85	ORDER by Judge Josephine L. Staton. Pursuant to the stipulation 84 of the parties and for good cause shown, Broadcom's deadline for responsive damages contentions is extended to 12/16/2019. (jp) (Entered: 12/04/2019)
12/05/2019	86	MINUTES OF Hearing and Order re Motion for Relief 78 held before Magistrate Judge John D. Early. The Motion (Dkt. 78), to the extent it seeks an order sustaining Defendants' objection under Paragraph 31 of the Protective Order, is GRANTED and Plaintiff shall not provide Defendants' Protected Materials under the Protective Order to Dr. Morrow. In all other respects, the Motion is DENIED. (see document for further details) Court Recorder: CS 12/05/19. (hr) (Entered: 12/05/2019)
12/06/2019	87	BRIEF filed by Plaintiff Rembrandt Wireless Technologies, LP. <i>Rembrandt's Opening Claim Construction Brief</i> (Attachments: # 1 Declaration of Eric Enger, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit 12, # 14 Exhibit 13, # 15 Exhibit 14, # 16 Exhibit 15, # 17 Exhibit 16, # 18 Exhibit 17, # 19 Exhibit 18, # 20 Exhibit 19, # 21 Exhibit 20, # 22 Exhibit 21, # 23 Exhibit 22, # 24 Exhibit 23, # 25 Exhibit 24)(Enger, Eric) (Entered: 12/06/2019)
12/06/2019	88	BRIEF filed by Defendants Broadcom Corporation, Broadcom Incorporated. <i>Defendants' Opening Claim Construction Brief</i> (Attachments: # 1 Declaration of Edward John Mayle, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5, # 7 Exhibit 6, # 8 Exhibit 7, # 9 Exhibit 8, # 10 Exhibit 9, # 11 Exhibit 10, # 12 Exhibit 11, # 13 Exhibit

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		12, # 14 Exhibit 13, # 15 Exhibit 14, # 16 Exhibit 15)(Sipiora, David) (Entered: 12/06/2019)
12/09/2019	89	Joint STIPULATION for Order Regarding Source Code Rembrandt Wireless Technologies, LP. (Attachments: # 1 Proposed Order)(Enger, Eric) (Entered: 12/09/2019)
12/10/2019	90	TRANSCRIPT ORDER as to Plaintiff Rembrandt Wireless Technologies, LP for Court Smart (CS). Court will contact Jenira Velez at jvelez@ggtriallaw.com with further instructions regarding this order. Transcript preparation will not begin until payment has been satisfied with the transcription company. (Stein, David) (Entered: 12/10/2019)
12/12/2019	91	TRANSCRIPT for proceedings held on 12/5/19 10:04 A.M.. Court Reporter/Electronic Court Recorder: EXCEPTIONAL REPORTING SERVICES, INC , phone number (361) 949-2988. Transcript may be viewed at the court public terminal or purchased through the Court Reporter/Electronic Court Recorder before the deadline for Release of Transcript Restriction. After that date it may be obtained through PACER. Notice of Intent to Redact due within 7 days of this date. Redaction Request due 1/2/2020. Redacted Transcript Deadline set for 1/13/2020. Release of Transcript Restriction set for 3/11/2020. (lca) (Entered: 12/13/2019)
12/12/2019	92	NOTICE OF FILING TRANSCRIPT filed for proceedings 12/5/19 10:04 A.M. re Transcript 91 THERE IS NO PDF DOCUMENT ASSOCIATED WITH THIS ENTRY. (lca) TEXT ONLY ENTRY (Entered: 12/13/2019)
12/16/2019	93	ORDER Re Joint Stipulation Regarding Source Code 89 by Judge Josephine L. Staton that the Parties to abide by the terms of the Joint Stipulation Regarding Source Code. (jp) (Entered: 12/17/2019)
12/20/2019	94	RESPONSE filed by Plaintiff Rembrandt Wireless Technologies, LP <i>Rembrandt's Responsive Claim Construction Brief</i> (Attachments: # 1 Declaration of Christopher First, # 2 Exhibit 30, # 3 Exhibit 31, # 4 Exhibit 32, # 5 Exhibit 33, # 6 Exhibit 34, # 7 Exhibit 35, # 8 Exhibit 36, # 9 Exhibit 37, # 10 Exhibit 38, # 11 Exhibit 39, # 12 Exhibit 40, # 13 Exhibit 41, # 14 Exhibit 42, # 15 Exhibit 43, # 16 Exhibit 44, # 17 Exhibit 45, # 18 Exhibit 46, # 19 Exhibit 47, # 20 Exhibit 48, # 21 Exhibit 49, # 22 Exhibit 50)(First, Christopher) (Entered: 12/20/2019)
12/20/2019	95	RESPONSE filed by Defendants Broadcom Corporation, Broadcom Incorporated <i>Defendants Responsive Claim Construction Brief</i> (Attachments: # 1 Declaration of Edward J. Mayle, # 2 Exhibit 1, # 3 Exhibit 2, # 4 Exhibit 3, # 5 Exhibit 4, # 6 Exhibit 5)(Sipiora, David) (Entered: 12/20/2019)

PACER Service Center			
Transaction Receipt			
12/24/2019 10:02:17			
PACER Login:	rg0009:2622221:0	Client Code:	104677-5027
Description:	Docket Report	Search Criteria:	8:19-cv-00708-JLS-JDE End date: 12/24/2019
Billable Pages:	19	Cost:	1 90

California 95014. Apple may be served with process through its registered agent, CT Corporation System (C0168406), 818 West Seventh Street, Suite 930, Los Angeles, CA 90017.

JURISDICTION AND VENUE

4. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331 and 1338(a) because this action arises under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*

5. The Court has personal jurisdiction over Defendant, including because Defendant has minimum contacts within the State of Texas; Defendant has purposefully availed itself of the privileges of conducting business in the State of Texas; Defendant regularly conducts business within the State of Texas; and Plaintiff's cause of action arises directly from Defendant's business contacts and other activities in the State of Texas, including at least by virtue of Defendant's infringing systems, devices, and methods, which are at least sold, practiced, and/or used in the State of Texas. Further, this Court has general jurisdiction over Defendant, including due to its continuous and systematic contacts with the State of Texas. Further, on information and belief, Defendant is subject to the Court's jurisdiction, including because Defendant has committed patent infringement in the State of Texas.

6. Venue is proper in this federal district pursuant to 28 U.S.C. §§1391(b)-(c) and 1400(b). Without limitation, on information and belief, Defendant has regular and established places of business in this District, and in Texas, and at least some of its infringement of the patents-in-suit occurs in this District, and in Texas.

7. Without limitation, on information and belief, venue is proper in this District because Defendant has physical places from which its business is conducted within this District comprising Apple stores, including at 6121 West Park Boulevard in Plano, Texas and 2601

Preston Road in Frisco, Texas; the business conducted at such places is steady, uniform, orderly, and/or methodical, and is settled and not transient, including, but not limited to, distribution, sales, and/or offers for sale of infringing products. On information and belief, Defendant also has Apple Stores in multiple locations throughout the state of Texas, and it has significant corporate facilities in Austin, Texas as well. Further, on information and belief, Defendant is subject to venue in this District, including because Defendant has committed patent infringement in this District. Pursuant to 35 U.S.C. § 271, Defendant infringes the patents-in-suit by the infringing acts described herein in this District. Further, Defendant solicits and induces customers/users in this District, including via its stores and website at www.apple.com. On information and belief, Defendant has customers/users who are residents of this District and who purchase, acquire, and/or use Defendant's infringing products in this District.

8. The patents accused of infringement in this lawsuit, US Patent Nos. 8,457,228 and 8,023,580, were previously asserted in this District against Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. and Samsung Telecommunications America, LLC. As part of that lawsuit, this Court construed the meaning of certain terms and phrases from those patents, and ultimately conducted a jury trial, during which both of those patents were found to be valid and infringed. After extensively reviewing the post-trial motions, this Court denied Samsung's motions for judgment as a matter of law, and its request for a new trial, and entered Judgment in favor of the patent owner, Rembrandt. That liability Judgment and the underlying claim construction was affirmed by the U.S Court of Appeals for the Federal Circuit. Given this history, this Court has significant knowledge regarding the asserted patents, and principles of judicial economy further support venue in this Judicial District.

INFRINGEMENT OF U.S. PATENT NO. 8,457,228

9. On June 4, 2013, United States Patent No. 8,457,228 was duly and legally issued for inventions entitled “System and Method of Communication Using at Least Two Modulation Methods.” The ‘228 Patent claims priority back through a string of continuation applications to US Application No. 09/205,205, which was filed on December 4, 1998, and to Provisional Application No. 60/067,562, filed on December 5, 1997. Thus, each of the asserted claims of the ‘228 Patent are entitled to a priority date of December 5, 1997. The ‘228 Patent expired on December 4, 2018, but Rembrandt is entitled to damages for infringement that occurred prior to the expiration of the ‘228 Patent. Rembrandt was assigned the ‘228 Patent and continues to hold all rights and interest in the ‘228 Patent, including the right to recover damages for past infringement. A true and correct copy of the ‘228 Patent is attached hereto as Exhibit A.

10. According to the ‘228 Patent, prior master/slave systems could only communicate when all network devices used a single common type of modulation method. *See* ‘228 Patent at 1:29-67, 3:64-4:5. Thus, if a slave using an additional type of modulation method were added to the network, the new slave could not easily communicate with the master using the different modulation type because it would not be compatible with the common type of modulation method. *Id.* Annotated figure 1 of the ‘228 Patent shows a master/slave system, where all devices in the network communicate using only a single common type of modulation method (such as the amplitude modulation used by AM radio), even though some of the devices may be capable of communication via other types of modulation methods:

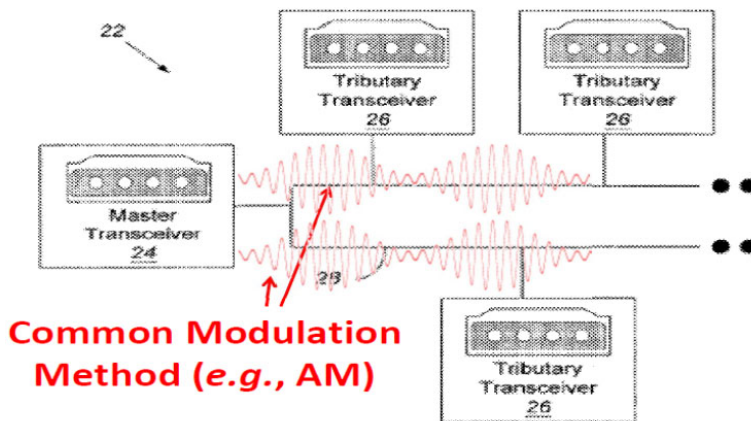


FIG. 1
Prior Art

11. The master/slave concept is described in the '228 Patent at col. 3, line 64-col. 5, line 7, with reference to Fig. 2. Briefly, Fig. 2 discloses a polled multipoint master/slave system. At the beginning of a session, the master established a common modulation type for communication with all its slaves (sequence 32 in Fig. 2). All slaves were identical in that they shared a common modulation with the master. The master then communicated with its slaves, one at a time, by sending a training sequence with the address of the slave with which it wants to communicate, followed by data, and finally a trailing sequence to end the communication (sequences 34-38 in Fig. 2). A slave could not initiate a communication, but, if the slave were polled by the master, it could respond to the master in a similar fashion (sequences 42-46 in Fig. 2). When the master had completed its communications with the first slave, it could then communicate with a second slave using the same negotiated common modulation (sequences 48-54 in Fig. 2).

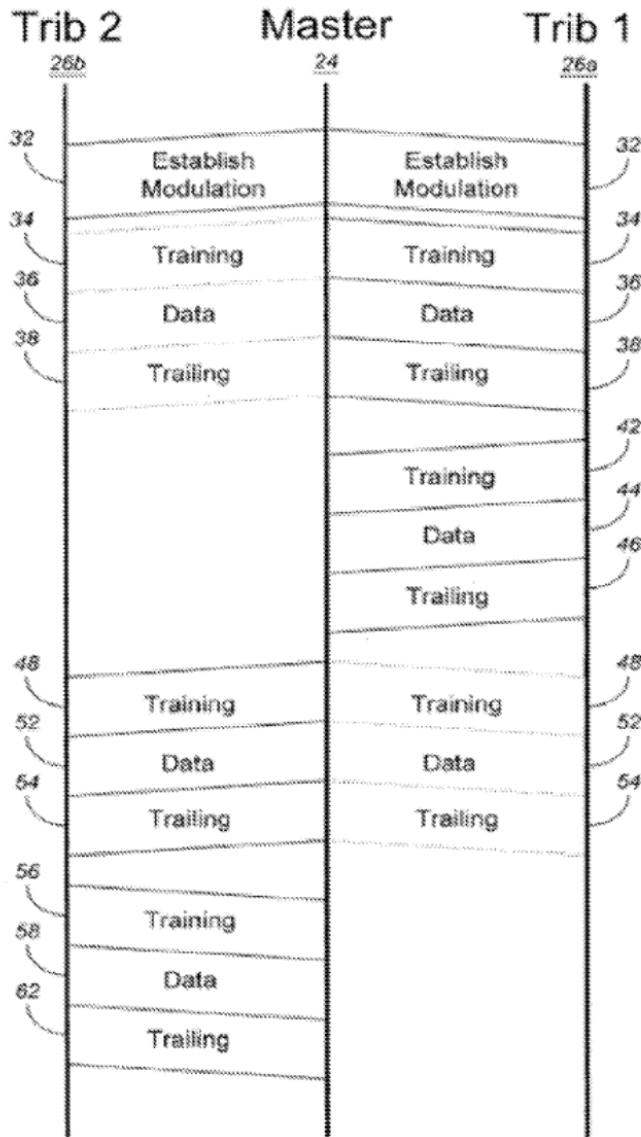


FIG. 2

12. In the context of the master/slave system described above, inventor Gordon Bremer created “a system and method of communication in which multiple modulation methods are used to facilitate communication among a plurality of modems in a network, which have heretofore been incompatible.” ‘228 Patent at 2:20-23. Mr. Bremer solved the problem with his claimed master/slave communication system in which slaves can seamlessly communicate over a network through a master using different types of modulation methods, thereby permitting

selection of the modulation type best suited for a particular application. '228 Patent at 2:27-3:14, 5:32-46.

13. The claimed invention of the '228 Patent is further described with reference to Figure 2 and in Figures 3-8 and the written description. Specifically, Figures 3 and 4 show block diagrams of the master transceiver and tributary transceivers, while Figure 5 shows a ladder diagram illustrating the operation of those transceivers. Figures 6 and 7 show state diagrams for exemplary tributary transceivers. Figure 8 shows a signal diagram for exemplary transmissions.

14. Annotated FIG. 4 shows an embodiment of the patented technology where some devices in the network communicate using one type of modulation method (e.g., amplitude modulation used by AM radio), while other devices communicate using a different type of modulation method (e.g., the frequency modulation used by FM radio):

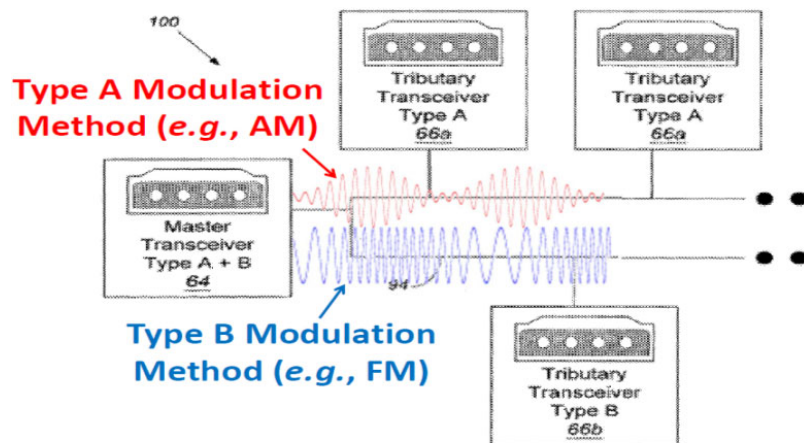
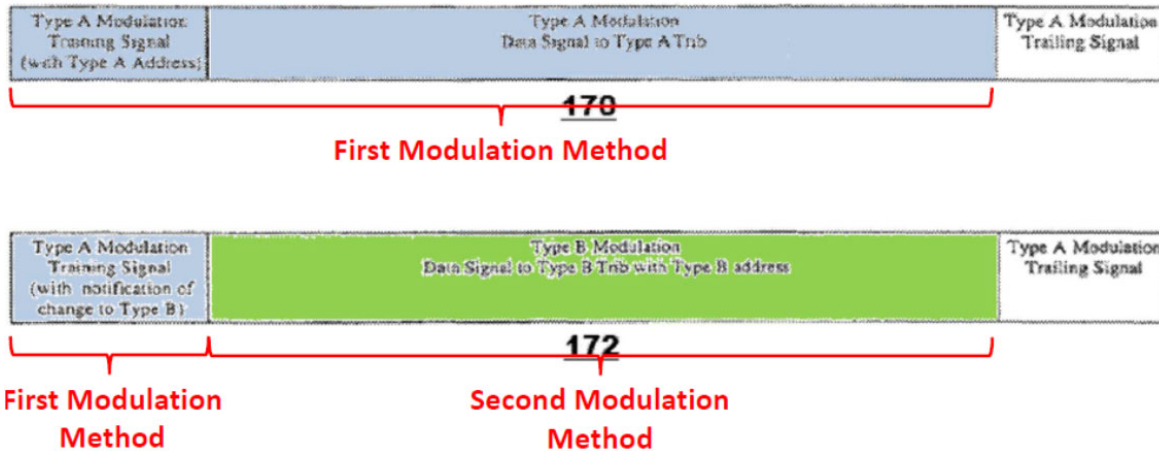


FIG. 4

'228 Patent at 6:4-13. Such a system provides for greater efficiency, seamless communication with all devices, backward-compatibility, and decreased costs. *Id.* at 3:9-14; *see also id.* at 2:1-18, 5:32-46.

15. Annotated FIG. 8 shows two communications intended for different slaves. The first communication 170 uses a first type of modulation method for both the initial training signal

and the subsequent data signal, while communication 172 uses the first type of modulation method for the training signal and the second type of modulation method for the data signal:



‘228 Patent at Fig. 8, 4:45-48, 4:66-5:1. Information in the training signal indicates whether there will be an impending change from the first type of modulation method to the second type of modulation method. *Id.* (training signal includes “notification of change to Type B” modulation method).

16. Mr. Bremer’s solution is captured and claimed in his seamless “switches” from one modulation type to another and is described with reference to Fig. 5:

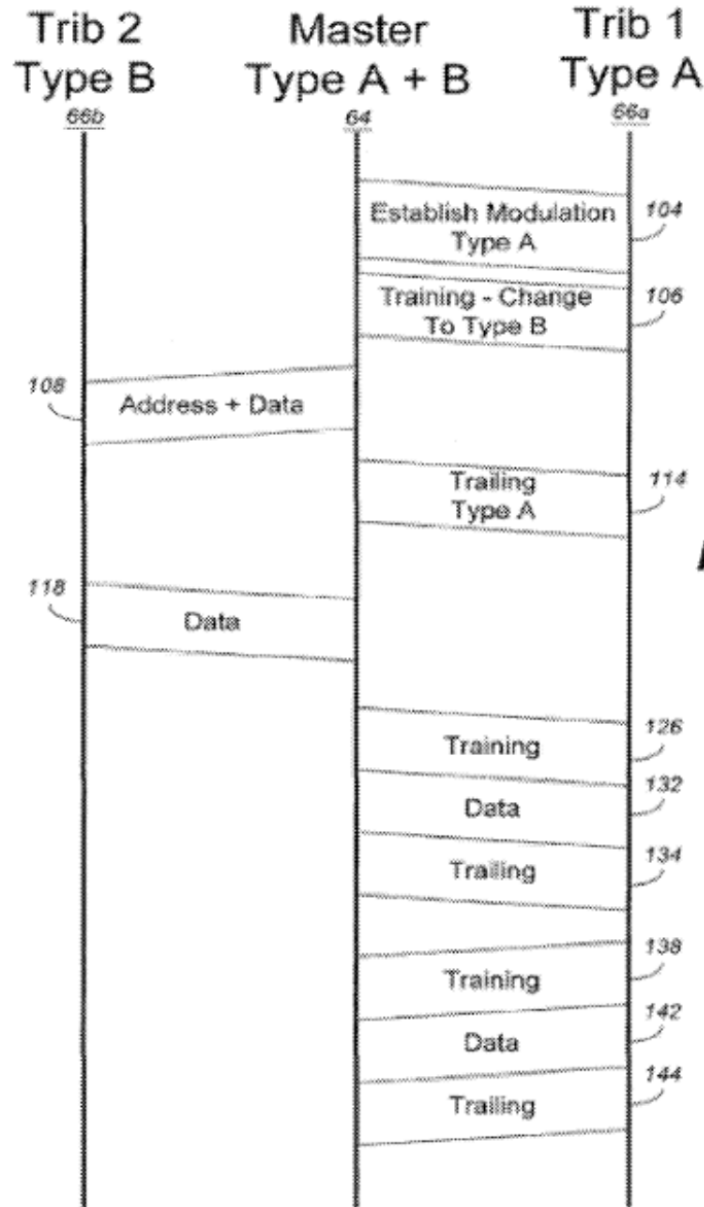


FIG. 5

17. With reference to FIG. 5, for the Master (“Master Type A and B 64”) to communicate with a Type A trib (“Trib 1 Type A 66a”) using a negotiated first modulation type A method in the normal fashion, the Master transmits a “first message” (sequences 126, 132, 134). The “first message” includes (i) “first information” (training sequence 126) modulated according to the first modulation type A method and (ii) “second information” (transmission sequence 132) modulated according to the first modulation type A method and including data

intended for the Type A trib. The “first information” includes first message address information that is indicative of the Type A trib being an intended destination of the “second information.” ‘228 Patent at 7:11-13 (“a training sequence 126 in which an address of a particular type A trib 66a is identified”).

18. For the Master (“Master Type A and B 64”) to communicate with a Type B trib (“Trib 2 Type B 66b”) using a second modulation type B method, the Master transmits a “second message” (sequences 106, 108, 114). The “second message” includes “third information” (training sequence 106) modulated according to the first modulation type A method and including information that is indicative of an impending change in modulation to the second modulation type B method. ‘228 Patent at 6:27-30 (“To switch from type A modulation to type B modulation, master transceiver 64 transmits a training sequence 106 to type A trib in which these trib is notified of an impending change to type B modulation.”). The “second message” also includes “fourth information” (transmission sequence 108) that is transmitted after transmission of the “third information,” is modulated according to the second modulation type B method, and includes data intended for the Type B trib. ‘228 Patent at 6:32-36 (“After notifying the type A trib 66a of the change to type B modulation, master transceiver 64, using type B modulation, transmits data along with an address in sequence 108, which is destined for a particular type B trib 66b.”). In addition, the “second message” includes second message address information that is indicative of the Type B trib being an intended destination of the fourth information. *Id.*

19. The specification of the ‘228 Patent describes the claimed switches as follows:

“To switch from type A modulation to type B modulation, master transceiver 64 transmits a training sequence 106 to type A trib 66a in which these trib is notified of an impending change to type B modulation.... After notifying the type A trib 66a of the change to type B modulation, master transceiver 64, using type B modulation, transmits

data along with an address in sequence 108, which is destined for a particular type B trib 66b....” [Col. 6, ll. 27-36.]

“If, however, master transceiver transmits a training sequence in which the type A trib 66a-66a are notified of a change to type B modulation as indicated by sequence 106, then a transition is made to state 124 where all type B transmissions are ignored until a type A modulation trailing sequence (e.g., sequence 114) is detected. Upon detecting the type A trailing sequence, a type A trib 66a returns to state 122 where it awaits a training sequence.” [Col. 7, ll. 3-10.]

“To initiate a communication session with a type A trib 66a, master transceiver 64 transmits a training sequence 126 in which an address of a particular Type A trib 66a is identified. The identified Type A trib 66a recognizes its own address and transitions to state 128 to receive data from master transceiver 64 as part of sequence 132.” [Col. 7, ll. 11-16.]

20. The technology recited in the claims of the ‘228 Patent provides an inventive concept and does not claim an abstract idea. Due to the inventive combination of elements, the claimed inventions achieve many benefits over prior art systems and methods, including the benefits noted above (*i.e.*, greater efficiency, seamless communication with all devices, backward-compatibility, and decreased costs). ‘228 Patent at 3:9-14; *see also id.* at 2:1-18, 5:32-46.

21. The claimed inventive concepts greatly enhance and facilitate technological systems, architectures, and methods through the use of a master communication device in a master/slave relationship with other slave communication devices. The master communication device transmits messages with particular sequences using two different types of modulation methods to facilitate communication between different type slave devices. The technology recited in the claims of the ‘228 Patent improves the functioning of computer devices and improves over existing technological processes, including with respect to master-slave communication systems that implement different types of modulation methods.

22. The '228 Patent describes systems and methods that solved technical problems. Those problems included the ability to communicate in a master-slave environment amongst devices that implement different families of modulation techniques. These problems also included backwards compatibility with older devices using different types of modulation.

23. The technological improvements described and claimed in the '228 Patent were not conventional or generic at the time of their invention, but rather required novel and non-obvious solutions to problems and shortcomings in the art at the time. The inventions claimed in the '228 Patent also cover more than just the performance of well-understood, routine or conventional activities known in the art. For example, '228 Claim 21 is directed to a particular master communication device that can communicate with slave devices using different families of modulation techniques.

24. The '228 Patent claims inventions that provide technological solutions to technological problems. As disclosed above, the written description of the '228 Patent describes in technical detail each of the elements of the claims, including a master device that can communicate with slave devices using different types of modulation methods according to particular sequences of messages.

25. The claims of the '228 Patent are not directed to basic tools of scientific and technological work, fundamental economic practices, or the use of an abstract mathematical formula. Rather, the claims are directed to a master communication device that can communicate with slave devices (which implement entirely different families of modulation techniques) using particular sequences of messages containing different types of modulation methods.

26. The '228 Patent does not preempt any abstract idea or otherwise preempt anything that would render them unpatentable. For example, one is free to practice the prior art of record. The '228 claims do not improperly inhibit further discovery by tying up any building blocks of human ingenuity or technological work.

27. The '228 Patent claims cannot be practiced by a human alone. Indeed, master/slave communication systems using different types of modulation methods exist only in the context of wireless communication devices.

28. Upon information and belief, Apple has infringed directly and indirectly and continues to infringe directly and indirectly claim 21 of the '228 Patent. The infringing acts include, but are not limited to, the manufacture, use, sale, importation, exportation, and/or offer for sale of products practicing any of the following Bluetooth specifications that support Enhanced Data Rate ("EDR"): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5 (collectively, the "Bluetooth EDR Specifications"). Such Apple products that support one or more of the Bluetooth EDR Specifications are hereinafter referred to as the "Apple Bluetooth EDR Products."

29. Apple's Bluetooth EDR Products include but are not limited to the: iPhone XR; iPhone XS; iPhone XS Max; iPhone X; iPhone 8, iPhone 8 Plus; iPhone 7; iPhone 7 Plus; iPhone SE; iPhone 6; iPhone 6 Plus; iPhone 5; iPhone 5S; iPhone 5C; iPhone 4; iPhone 4S; iPhone 3G; iPhone 3GS; iPad Pro (3rd Generation); iPad (2018); iPad Pro (2nd Generation, 10.5" and 12.9"); iPad (2017); iPad Pro (1st Generation, 9.7" and 12.9"); iPad Air 2; iPad Air; iPad 4th Generation; iPad 3rd Generation; iPad 2; iPad; iPad mini 4; iPad mini 3; iPad mini 2; iPad mini; iPod Touch 6th Generation; iPod Touch 5th Generation; iPod Touch 4th Generation; iPod Touch 3rd Generation; iPod Touch 2nd Generation; iPod Nano 7th Generation; Apple Watch, Series 4; Apple

Watch Series 3; Apple Watch Nike+; Apple Watch Hermes; Apple Watch Series 2; Apple Watch Series 1; Apple TV 5th Generation; Apple TV 4th Generation; Apple TV 3rd Generation; Apple TV 2nd Generation; Apple TV 4K; AirPort Extreme; MacBook; MacBook Pro; MacBook Air; iMac Pro; Mac Mini; iMac; Mac Pro; Beats Solo2 Wireless Headphones; Beats Studio Wireless Headphones; Beats PowerBeats3 Wireless In-Ear Headphones; Beats PowerBeats2 Wireless In-Ear Headphones; AirPods; Beats Pill+ Wireless Speaker; Beats Pill Wireless Speaker; Beats Pill XL Wireless Speaker; Beats Studio3 Wireless; Beats Solo3 Wireless Headphones; BeatsX Earphones; Powerbeats3 Wireless Earphones; HomePod; and all other devices that use Bluetooth EDR.

30. Apple's Bluetooth EDR Products satisfy the limitations of the claims of the '228 Patent. For example, each of Apple's Bluetooth EDR Product is a "master communication device" that can operate in the role of the master in a master-slave relationship and communicate with other Bluetooth EDR Products operating in the role of slaves. Further, each of Apple's Bluetooth EDR Products can transmit using at least two "different types" of modulation methods: (1) a "first" Gaussian Frequency Shift Keying (GFSK) modulation method; and (2) a "second" Differential Phase Shift Keying (DPSK) modulation method. Each of Apple's Bluetooth EDR Products can transmit a "first message" in the form of a Basic Rate packet (with a GFSK access code/header and a GFSK payload) and a "second message" in the form of an Enhanced Rate packet (with a GFSK access code/header and a DPSK payload). Further, the access code/header of both messages includes "first message address data" comprising an LT_ADDR field.

31. Upon information and belief, at least as of the filing of this complaint, Apple also indirectly infringes claim 21 of the '228 Patent by active inducement under 35 U.S.C. § 271(b).

Apple has induced, caused, urged, encouraged, aided and abetted its direct and indirect customers to make, use, sell, offer for sale and/or import and export products which are interoperable according to the Bluetooth EDR Specifications and thereby infringe the '228 Patent. Apple has done so by acts including but not limited to selling products that are interoperable according to the Bluetooth EDR Specifications to their customers; marketing the infringing capabilities of such products; and providing instructions, technical support and other support and encouragement for the use of such products. Such conduct by Apple was intended to and actually resulted in direct infringement, including the making, using, selling, offering for sale and/or importation and exportation of infringing Apple Bluetooth EDR Products into and out of the United States. Apple has notice of the '228 Patent by at least the date of this complaint but, upon information and belief, Apple knew of the '228 Patent far earlier as a result of Apple following and/or press coverage of Rembrandt's prior litigation asserting the '228 Patent against Samsung (Apple's biggest competitor), or based on information learned from its vendor, Broadcom Inc., which also supplied Bluetooth products to Samsung.

32. The acts of infringement by Apple have caused damage to Rembrandt, and Rembrandt is entitled to recover from Apple the damages sustained by Rembrandt as a result of Apple's wrongful acts in an amount subject to proof at trial. Specifically, Rembrandt seeks damages for Apple's infringement of the '228 Patent from its date of issuance, June 4, 2013, until the date that Samsung became licensed to the '228 Patent and became obligated to mark its licensed products with the '228 Patent number, which occurred on August 27, 2018.

33. Upon information and belief, since at least the filing of this lawsuit, Apple's aforementioned actions have been, and continue to be, committed in a knowing and willful manner and constitute willful infringement of the '228 Patent.

INFRINGEMENT OF U.S. PATENT NO. 8,023,580

34. On September 20, 2011, United States Patent No. 8,023,580 was duly and legally issued for inventions entitled “System and Method of Communication Using at Least Two Modulation Methods.” The ‘580 Patent claims priority back through a string of continuation applications to US Application No. 09/205,205, which was filed on December 4, 1998, and to Provisional Application No. 60/067,562, filed on December 5, 1997. Thus, each of the asserted claims of the ‘580 Patent are entitled to a priority date of December 5, 1997. The ‘580 Patent expired on December 4, 2018, but Rembrandt is entitled to damages for infringement that occurred prior to the expiration of the ‘580 Patent. Rembrandt was assigned the ‘580 Patent and continues to hold all rights and interest in the ‘580 Patent, including the right to recover damages for past infringement. A true and correct copy of the ‘580 Patent is attached hereto as Exhibit B.

35. The ‘580 Patent shares the same specification as the ‘228 Patent. Accordingly, the above statements in paragraphs 9-26 above apply equally to the ‘580 Patent, and Rembrandt incorporates them by reference herein.

36. Upon information and belief, Apple has infringed directly and indirectly and continues to infringe directly and indirectly claims 2 and 59 of the ‘580 Patent. The infringing acts include, but are not limited to, the manufacture, use, sale, importation, and/or offer for sale of Apple Bluetooth EDR Products that practice any of the Bluetooth EDR Specifications (as those terms are defined above for the ‘228 Patent).

37. Apple’s Bluetooth EDR Products satisfy the limitations of the claims of the ‘580 Patent. For example, each of Apple’s Bluetooth EDR Product is a “communication device” that can operate in the role of the master in a master-slave relationship and communicate with other Bluetooth EDR Products operating in the role of slaves. Further, each of Apple’s Bluetooth

EDR Products can transmit using two “different types” of modulation methods: (1) a “first” Gaussian Frequency Shift Keying (GFSK) modulation method; and (2) a “second” Differential Phase Shift Keying (DPSK) modulation method. Each of Apple’s Bluetooth EDR Products can transmit a “first sequence” with a GFSK access code/header whose LT_ADDR and TYPE fields indicate the modulation method of a “second sequence” comprising a packet payload. Depending on the “first sequence,” the “second sequence” will have either a GFSK payload (in the case of a Basic Rate packet) or a DPSK payload (in the case of an Enhanced Rate packet). Further, after transmitting an Enhanced Rate packet, each of Apple’s Bluetooth EDR Products can subsequently transmit a Basic Rate packet with a payload communicating using the first GFSK modulation method.

38. Upon information and belief, at least as of the filing of this complaint, Apple also indirectly infringes claims 2 and 59 of the ‘580 Patent by active inducement under 35 U.S.C. § 271(b). Apple has induced, caused, urged, encouraged, aided and abetted its direct and indirect customers to make, use, sell, offer for sale and/or import products which are interoperable according to the Bluetooth EDR Specifications and thereby infringe the ‘580 Patent. Apple has done so by acts including but not limited to selling products that are interoperable according to the Bluetooth EDR Specifications to their customers; marketing the infringing capabilities of such products; and providing instructions, technical support and other support and encouragement for the use of such products. Such conduct by Apple was intended to and actually resulted in direct infringement, including the making, using, selling, offering for sale and/or importation of infringing Apple Bluetooth EDR Products in the United States. Apple has notice of the ‘580 Patent by at least the date of this complaint but, upon information and belief, Apple knew of the ‘580 Patent far earlier as a result of Apple following and/or press coverage of

Rembrandt's prior litigation asserting the '580 Patent against Samsung (Apple's biggest competitor), or based on information learned from its vendor, Broadcom Inc., which also supplied Bluetooth products to Samsung.

39. The acts of infringement by Apple have caused damage to Rembrandt, and Rembrandt is entitled to recover from Apple the damages sustained by Rembrandt as a result of Apple's wrongful acts in an amount subject to proof at trial. Specifically, Rembrandt seeks damages for Apple's infringement of the '580 Patent from the date by which Rembrandt disclaimed claims 32, 34, 40, 43, and 44, which occurred on December 4, 2014, until the date that Samsung became licensed to the '580 Patent and became obligated to mark its licensed products with the '580 Patent number, which occurred on August 27, 2018.

40. Upon information and belief, since at least the filing of this lawsuit, Apple's aforementioned actions have been, and continue to be, committed in a knowing and willful manner and constitute willful infringement of the '580 Patent.

REMBRANDT AND THE PATENTS-IN-SUIT

41. Rembrandt has diligently protected the inventions in the patents-in-suit. For example, Rembrandt sought to obtain licenses from Apple competitors Samsung and BlackBerry, and it was engaged in litigation against both Samsung and Blackberry, including a jury trial against Samsung and a subsequent appeal brought by Samsung after the jury verdict in favor of Rembrandt. Ultimately, both Samsung and BlackBerry took a license and/or a release to the '228 and '580 Patents. Prior to Samsung obtaining a license, a jury found Samsung liable for infringing the '228 and '580 Patents based on Samsung's use of Bluetooth EDR, and awarded past-damages of \$15.7 million, which constituted a royalty rate of approximately 5 ½ cents per

infringing unit. The Federal Circuit affirmed the finding that Bluetooth EDR infringed the ‘228 and ‘580 Patents.

42. The value of the patents-in-suit is further demonstrated by their repeated success against validity challenges. The claims were construed in the prior litigation after a Markman hearing. After a week-long trial, a jury found that all the asserted claims were valid. The Federal Circuit affirmed that finding that the ‘228 and ‘580 Patents were valid and infringed by Samsung, and that the claim construction was legally correct. Moreover, the United States Patent & Trademark Office refused to even institute *inter partes* reviews against claim 21 of the ‘228 Patent and claims 2 and 59 of the ‘580 Patent. And the United States Patent & Trademark Office recently confirmed the validity of claim 21 of the ‘228 Patent and claims 2 and 59 of the ‘580 Patent in the course of *ex parte* reexamination challenges instituted by Samsung. In sum, the validity of the asserted claims of the ‘228 and ‘580 Patents has been reconfirmed in the course of a jury trial and subsequent appeal, and in post-trial proceedings at the US Patent & Trademark Office .

JURY DEMAND

43. Rembrandt hereby demands a trial by jury on all issues.

PRAYER FOR RELIEF

WHEREFORE, Rembrandt requests entry of judgment in its favor and against Apple as follows:

- a) A declaration that Apple has infringed and is infringing U.S. Patent Nos. 8,457,228 and 8,023,580;
- b) A declaration that Apple’s infringement was willful;

- c) An award of damages to Rembrandt arising out of Apple's infringement of U.S. Patent Nos. 8,457,228 and 8,023,580, including enhanced damages pursuant to 35 U.S.C. § 284, together with prejudgment and post-judgment interest, in an amount according to proof;
- d) An award of attorneys' fees pursuant to 35 U.S.C. § 285 or as otherwise permitted by law; and,
- e) Granting Rembrandt its costs and further relief as the Court may deem just and proper.

Dated: January 24, 2019

Respectfully submitted,

/s/ Eric J. Enger

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*Attorneys for REMBRANDT WIRELESS
TECHNOLOGIES, LP*

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

<p>I. (a) PLAINTIFFS</p> <p>REMBRANDT WIRELESS TECHNOLOGIES, LP</p> <p>(b) County of Residence of First Listed Plaintiff _____ (EXCEPT IN U.S. PLAINTIFF CASES)</p> <p>(c) Attorneys (Firm Name, Address, and Telephone Number) Michael F. Heim, HEIM PAYNE & CHORUSH, LLP, 1111 Bagby Street, Suite 2100, Houston, TX 77002 (713)221-2000</p>	<p>DEFENDANTS</p> <p>APPLE INC.</p> <p>County of Residence of First Listed Defendant _____ (IN U.S. PLAINTIFF CASES ONLY)</p> <p>NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED</p> <p>Attorneys (If Known)</p>
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<p>II. BASIS OF JURISDICTION (Place an "X" in One Box Only)</p> <p><input type="checkbox"/> 1 U.S. Government Plaintiff</p> <p><input checked="" type="checkbox"/> 3 Federal Question (U.S. Government Not a Party)</p> <p><input type="checkbox"/> 2 U.S. Government Defendant</p> <p><input type="checkbox"/> 4 Diversity (Indicate Citizenship of Parties in Item III)</p>	<p>III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)</p> <p>(For Diversity Cases Only)</p> <table style="width:100%;"> <tr> <td style="width:33%;">Citizen of This State</td> <td style="width:10%;"><input type="checkbox"/> 1</td> <td style="width:10%;"><input type="checkbox"/> 1</td> <td style="width:33%;">Incorporated or Principal Place of Business In This State</td> <td style="width:10%;"><input type="checkbox"/> 4</td> <td style="width:10%;"><input type="checkbox"/> 4</td> </tr> <tr> <td>Citizen of Another State</td> <td><input type="checkbox"/> 2</td> <td><input type="checkbox"/> 2</td> <td>Incorporated and Principal Place of Business In Another State</td> <td><input type="checkbox"/> 5</td> <td><input type="checkbox"/> 5</td> </tr> <tr> <td>Citizen or Subject of a Foreign Country</td> <td><input type="checkbox"/> 3</td> <td><input type="checkbox"/> 3</td> <td>Foreign Nation</td> <td><input type="checkbox"/> 6</td> <td><input type="checkbox"/> 6</td> </tr> </table>	Citizen of This State	<input type="checkbox"/> 1	<input type="checkbox"/> 1	Incorporated or Principal Place of Business In This State	<input type="checkbox"/> 4	<input type="checkbox"/> 4	Citizen of Another State	<input type="checkbox"/> 2	<input type="checkbox"/> 2	Incorporated and Principal Place of Business In Another State	<input type="checkbox"/> 5	<input type="checkbox"/> 5	Citizen or Subject of a Foreign Country	<input type="checkbox"/> 3	<input type="checkbox"/> 3	Foreign Nation	<input type="checkbox"/> 6	<input type="checkbox"/> 6
Citizen of This State	<input type="checkbox"/> 1	<input type="checkbox"/> 1	Incorporated or Principal Place of Business In This State	<input type="checkbox"/> 4	<input type="checkbox"/> 4														
Citizen of Another State	<input type="checkbox"/> 2	<input type="checkbox"/> 2	Incorporated and Principal Place of Business In Another State	<input type="checkbox"/> 5	<input type="checkbox"/> 5														
Citizen or Subject of a Foreign Country	<input type="checkbox"/> 3	<input type="checkbox"/> 3	Foreign Nation	<input type="checkbox"/> 6	<input type="checkbox"/> 6														

IV. NATURE OF SUIT (Place an "X" in One Box Only) [Click here for: Nature of Suit Code Descriptions.](#)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES		
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excludes Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	<p>PERSONAL INJURY</p> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 362 Personal Injury - Medical Malpractice	<p>PERSONAL INJURY</p> <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 367 Health Care/Pharmaceutical Personal Injury Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <p>PERSONAL PROPERTY</p> <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157	<input type="checkbox"/> 375 False Claims Act <input type="checkbox"/> 376 Qui Tam (31 USC 3729(a)) <input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 896 Arbitration <input type="checkbox"/> 899 Administrative Procedure Act/Review or Appeal of Agency Decision <input type="checkbox"/> 950 Constitutionality of State Statutes	
<p>REAL PROPERTY</p> <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	<p>CIVIL RIGHTS</p> <input type="checkbox"/> 440 Other Civil Rights <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 445 Amer w/Disabilities - Employment <input type="checkbox"/> 446 Amer w/Disabilities - Other <input type="checkbox"/> 448 Education	<p>PRISONER PETITIONS</p> <p>Habeas Corpus:</p> <input type="checkbox"/> 463 Alien Detainee <input type="checkbox"/> 510 Motions to Vacate Sentence <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <p>Other:</p> <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 560 Civil Detainee - Conditions of Confinement	<p>LABOR</p> <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Management Relations <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 751 Family and Medical Leave Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Retirement Income Security Act	<p>PROPERTY RIGHTS</p> <input type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 835 Patent - Abbreviated New Drug Application <input type="checkbox"/> 840 Trademark	<p>SOCIAL SECURITY</p> <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g))	<p>FEDERAL TAX SUITS</p> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609

V. ORIGIN (Place an "X" in One Box Only)

1 Original Proceeding 2 Removed from State Court 3 Remanded from Appellate Court 4 Reinstated or Reopened 5 Transferred from Another District (specify) 6 Multidistrict Litigation - Transfer 8 Multidistrict Litigation - Direct File

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):
 35 U.S.C. Sections 101, et seq.

Brief description of cause:
 Patent infringement

VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A CLASS ACTION UNDER RULE 23, F.R.Cv.P. DEMAND \$ _____ CHECK YES only if demanded in complaint:
 JURY DEMAND: Yes No

VIII. RELATED CASE(S) IF ANY (See instructions):

JUDGE Rodney Gilstrap DOCKET NUMBER 2:13-cv-00213-JRG

DATE 01/24/2019 SIGNATURE OF ATTORNEY OF RECORD /s/ Eric J. Enger

FOR OFFICE USE ONLY

RECEIPT # _____ AMOUNT _____ APPLYING IFP _____ JUDGE _____ MAG JUDGE _____

Rembrandt Wireless
 Ex. 2010

INSTRUCTIONS FOR ATTORNEYS COMPLETING CIVIL COVER SHEET FORM JS 44

Authority For Civil Cover Sheet

The JS 44 civil cover sheet and the information contained herein neither replaces nor supplements the filings and service of pleading or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. Consequently, a civil cover sheet is submitted to the Clerk of Court for each civil complaint filed. The attorney filing a case should complete the form as follows:

- I.(a) Plaintiffs-Defendants.** Enter names (last, first, middle initial) of plaintiff and defendant. If the plaintiff or defendant is a government agency, use only the full name or standard abbreviations. If the plaintiff or defendant is an official within a government agency, identify first the agency and then the official, giving both name and title.
- (b) County of Residence.** For each civil case filed, except U.S. plaintiff cases, enter the name of the county where the first listed plaintiff resides at the time of filing. In U.S. plaintiff cases, enter the name of the county in which the first listed defendant resides at the time of filing. (NOTE: In land condemnation cases, the county of residence of the "defendant" is the location of the tract of land involved.)
- (c) Attorneys.** Enter the firm name, address, telephone number, and attorney of record. If there are several attorneys, list them on an attachment, noting in this section "(see attachment)".
- II. Jurisdiction.** The basis of jurisdiction is set forth under Rule 8(a), F.R.Cv.P., which requires that jurisdictions be shown in pleadings. Place an "X" in one of the boxes. If there is more than one basis of jurisdiction, precedence is given in the order shown below.
- United States plaintiff. (1) Jurisdiction based on 28 U.S.C. 1345 and 1348. Suits by agencies and officers of the United States are included here.
- United States defendant. (2) When the plaintiff is suing the United States, its officers or agencies, place an "X" in this box.
- Federal question. (3) This refers to suits under 28 U.S.C. 1331, where jurisdiction arises under the Constitution of the United States, an amendment to the Constitution, an act of Congress or a treaty of the United States. In cases where the U.S. is a party, the U.S. plaintiff or defendant code takes precedence, and box 1 or 2 should be marked.
- Diversity of citizenship. (4) This refers to suits under 28 U.S.C. 1332, where parties are citizens of different states. When Box 4 is checked, the citizenship of the different parties must be checked. (See Section III below; **NOTE: federal question actions take precedence over diversity cases.**)
- III. Residence (citizenship) of Principal Parties.** This section of the JS 44 is to be completed if diversity of citizenship was indicated above. Mark this section for each principal party.
- IV. Nature of Suit.** Place an "X" in the appropriate box. If there are multiple nature of suit codes associated with the case, pick the nature of suit code that is most applicable. Click here for: [Nature of Suit Code Descriptions](#).
- V. Origin.** Place an "X" in one of the seven boxes.
- Original Proceedings. (1) Cases which originate in the United States district courts.
- Removed from State Court. (2) Proceedings initiated in state courts may be removed to the district courts under Title 28 U.S.C., Section 1441. When the petition for removal is granted, check this box.
- Remanded from Appellate Court. (3) Check this box for cases remanded to the district court for further action. Use the date of remand as the filing date.
- Reinstated or Reopened. (4) Check this box for cases reinstated or reopened in the district court. Use the reopening date as the filing date.
- Transferred from Another District. (5) For cases transferred under Title 28 U.S.C. Section 1404(a). Do not use this for within district transfers or multidistrict litigation transfers.
- Multidistrict Litigation – Transfer. (6) Check this box when a multidistrict case is transferred into the district under authority of Title 28 U.S.C. Section 1407.
- Multidistrict Litigation – Direct File. (8) Check this box when a multidistrict case is filed in the same district as the Master MDL docket.
- PLEASE NOTE THAT THERE IS NOT AN ORIGIN CODE 7.** Origin Code 7 was used for historical records and is no longer relevant due to changes in statute.
- VI. Cause of Action.** Report the civil statute directly related to the cause of action and give a brief description of the cause. **Do not cite jurisdictional statutes unless diversity.** Example: U.S. Civil Statute: 47 USC 553 Brief Description: Unauthorized reception of cable service
- VII. Requested in Complaint.** Class Action. Place an "X" in this box if you are filing a class action under Rule 23, F.R.Cv.P.
- Demand. In this space enter the actual dollar amount being demanded or indicate other demand, such as a preliminary injunction.
- Jury Demand. Check the appropriate box to indicate whether or not a jury is being demanded.
- VIII. Related Cases.** This section of the JS 44 is used to reference related pending cases, if any. If there are related pending cases, insert the docket numbers and the corresponding judge names for such cases.

Date and Attorney Signature. Date and sign the civil cover sheet.

Rembrandt Wireless

Ex. 2010

Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

Page 180 of 345

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12 Attorneys for Plaintiff *Rembrandt Wireless Technologies, LP*

13 UNITED STATES DISTRICT COURT
14 CENTRAL DISTRICT OF CALIFORNIA
15

16 REMBRANDT WIRELESS
17 TECHNOLOGIES, LP,

18 Plaintiff,

19 v.
20

21 QUALCOMM INC.,
22

23 Defendant.
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25
26
27
28

) Case No.: 8:19-cv-705

) COMPLAINT FOR
) INFRINGEMENT OF U.S.
) PATENT NOS. 8,457,228 &
) 8,023,580

) DEMAND FOR JURY TRIAL

1 Plaintiff Rembrandt Wireless Technologies LP (“Rembrandt” or “Plaintiff”)
2 hereby submits this Complaint against Defendant Qualcomm Inc. (“Qualcomm”)
3 and states as follows:

4 **THE PARTIES**

5 1. Rembrandt is a Virginia limited partnership, having a principal place
6 of business at 401 City Ave., Suite 900, Bala Cynwyd, Pennsylvania 19004.

7 2. Rembrandt is the assignee and owner of the patents at issue in this
8 action: United States Patent No. 8,457,228 (“the ’228 Patent”) and United States
9 Patent No. 8,023,580 (“the ’580 Patent”).

10 3. Rembrandt is informed and believes, and on that basis alleges, that
11 Qualcomm is a Delaware corporation with its principal place of business at 5775
12 Morehouse Drive, San Diego, CA. Qualcomm may be served with process
13 through its registered agent, CSC – Lawyers Incorporating Service, 2710 Gateway
14 Oaks Drive, Suite 150N, Sacramento, CA 95833.

15 **JURISDICTION AND VENUE**

16 4. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§
17 1331 and 1338(a) because this action arises under the patent laws of the United
18 States, 35 U.S.C. §§ 101 *et seq.*

19 5. The Court has personal jurisdiction over Defendant, including because
20 Defendant has minimum contacts within the State of California; Defendant has
21 purposefully availed itself of the privileges of conducting business in the State of
22 California; Defendant regularly conducts business within the State of California;
23 and Plaintiff’s cause of action arises directly from Defendant’s business contacts
24 and other activities in the State of California, including at least by virtue of
25 Defendant’s infringing systems, devices, and methods, which are at least sold,
26 practiced, and/or used in the State of California. Further, this Court has general
27 jurisdiction over Defendant, including due to its continuous and systematic
28 contacts with the State of California. Further, on information and belief, Defendant

1 is subject to the Court’s jurisdiction, including because Defendant has committed
2 patent infringement in the State of California.

3 6. Venue is proper in this federal district pursuant to 28 U.S.C.
4 §§1391(b)-(c) and 1400(b). Without limitation, on information and belief,
5 Defendant has regular and established places of business in this District, and in
6 California, and at least some of its infringement of the patents-in-suit occurs in this
7 District, and in California.

8 7. Without limitation, on information and belief, venue is proper in this
9 District because Defendant has physical places from which its business is
10 conducted within this District comprising Qualcomm offices, including at 3347
11 Michelson Drive, Suite 250, Irvine, CA 92612; the business conducted at such
12 places is steady, uniform, orderly, and/or methodical, and is settled and not
13 transient, including, but not limited to, distribution, sales, and/or offers for sale,
14 including related to infringing methods and apparatuses. On information and
15 belief, Defendant also has Qualcomm offices in multiple locations throughout the
16 state of California, and it has significant corporate facilities in San Diego, CA and
17 Santa Clara, CA as well. Further, on information and belief, Defendant is subject
18 to venue in this District, including because Defendant has committed patent
19 infringement in this District. Pursuant to 35 U.S.C. § 271, Defendant infringes the
20 patents-in-suit by the infringing acts described herein in this District. Further,
21 Defendant solicits and induces customers/users in this District, including via its
22 development, marketing, and sales of its infringing chips. On information and
23 belief, Defendant has customers/users who are residents of this District and who
24 purchase, acquire, and/or use Defendant's infringing products in this District.

25 **INFRINGEMENT OF U.S. PATENT NO. 8,457,228**

26 8. On June 4, 2013, United States Patent No. 8,457,228 was duly and
27 legally issued for inventions entitled “System and Method of Communication
28 Using at Least Two Modulation Methods.” The ’228 Patent claims priority back

1 through a string of continuation applications to US Application No. 09/205,205,
 2 which was filed on December 4, 1998, and to Provisional Application No.
 3 60/067,562, filed on December 5, 1997. Thus, each of the asserted claims of the
 4 '228 Patent are entitled to a priority date of December 5, 1997. The '228 Patent
 5 expired on December 4, 2018, but Rembrandt is entitled to damages for
 6 infringement that occurred before the expiration of the '228 Patent. Rembrandt
 7 was assigned the '228 Patent and continues to hold all rights and interest in the
 8 '228 Patent, including the right to recover damages for past infringement. A true
 9 and correct copy of the '228 Patent is attached as Exhibit A.

10 9. According to the '228 Patent, prior master/slave systems could
 11 communicate only when all network devices used a single common type of
 12 modulation method. *See* '228 Patent at 1:29-67, 3:64-4:5. Thus, if a slave using
 13 an additional type of modulation method were added to the network, the new slave
 14 could not easily communicate with the master using the different modulation type
 15 because it would not be compatible with the common type of modulation method.
 16 *Id.* Annotated figure 1 of the '228 Patent shows a master/slave system, where all
 17 devices in the network communicate using only a single common type of
 18 modulation method (such as the amplitude modulation used by AM radio), even
 19 though some of the devices may be capable of communication via other types of
 20 modulation methods:

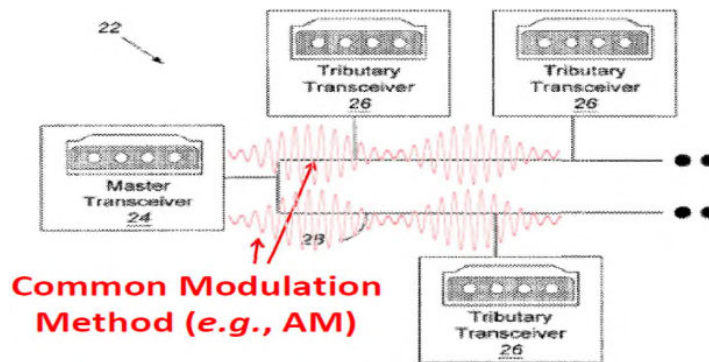


FIG. 1
 Prior Art

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10. The master/slave concept is described in the '228 Patent at col. 3, line 64-col. 5, line 7, with reference to Fig. 2. Briefly, Fig. 2 discloses a polled multipoint master/slave system. At the beginning of a session, the master established a common modulation type for communication with all its slaves (sequence 32 in Fig. 2). All slaves were identical in that they shared a common modulation with the master. The master then communicated with its slaves, one at a time, by sending a training sequence with the address of the slave with which it wants to communicate, followed by data, and finally a trailing sequence to end the communication (sequences 34-38 in Fig. 2). A slave could not initiate a communication, but, if the slave were polled by the master, it could respond to the master in a similar fashion (sequences 42-46 in Fig. 2). When the master had completed its communications with the first slave, it could then communicate with a second slave using the same negotiated common modulation (sequences 48-54 in Fig. 2).

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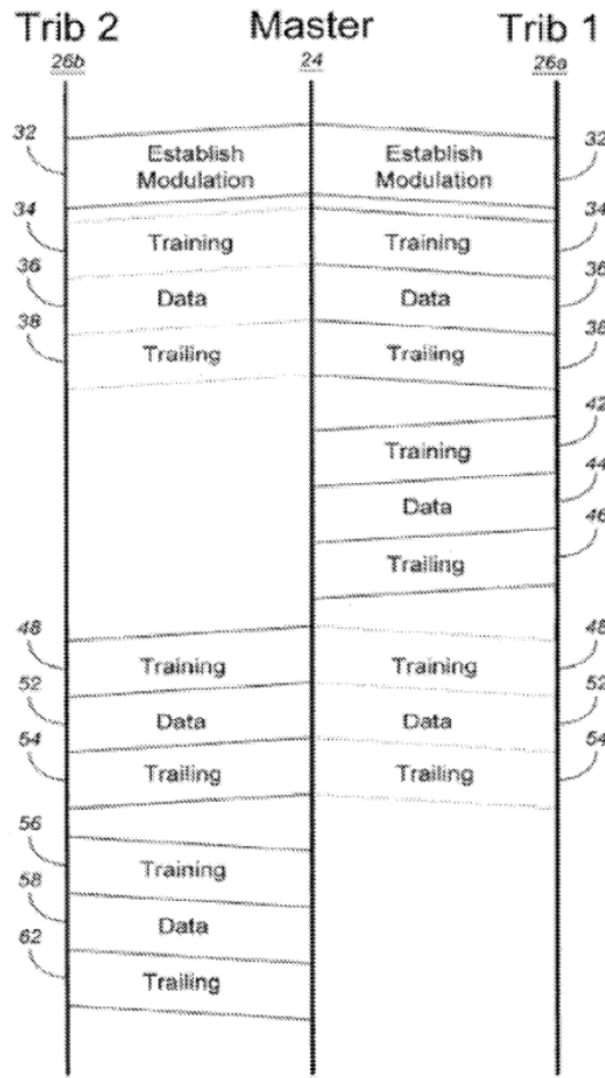
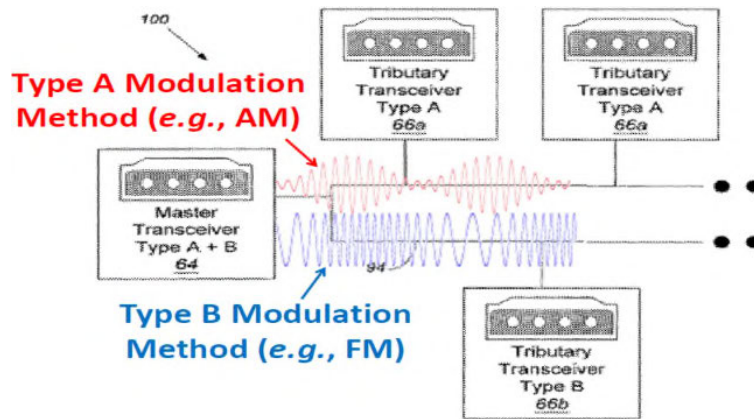


FIG. 2

20 11. In the context of the master/slave system described above, inventor
 21 Gordon Bremer created “a system and method of communication in which multiple
 22 modulation methods are used to facilitate communication among a plurality of
 23 modems in a network, which have heretofore been incompatible.” ’228 Patent at
 24 2:20-23. Mr. Bremer solved the problem with his claimed master/slave
 25 communication system in which slaves can seamlessly communicate over a
 26 network through a master using different types of modulation methods, thereby
 27 permitting selection of the modulation type best suited for a particular application.
 28 ’228 Patent at 2:27-3:14, 5:32-46.

1 12. The claimed invention of the '228 Patent is further described with
 2 reference to Figure 2 and in Figures 3-8 and the written description. Specifically,
 3 Figures 3 and 4 show block diagrams of the master transceiver and tributary
 4 transceivers, while Figure 5 shows a ladder diagram illustrating the operation of
 5 those transceivers. Figures 6 and 7 show state diagrams for exemplary tributary
 6 transceivers. Figure 8 shows a signal diagram for exemplary transmissions.

7 13. Annotated Fig. 4 shows an embodiment of the patented technology
 8 where some devices in the network communicate using one type of modulation
 9 method (e.g., amplitude modulation used by AM radio), while other devices
 10 communicate using a different type of modulation method (e.g., the frequency
 11 modulation used by FM radio):

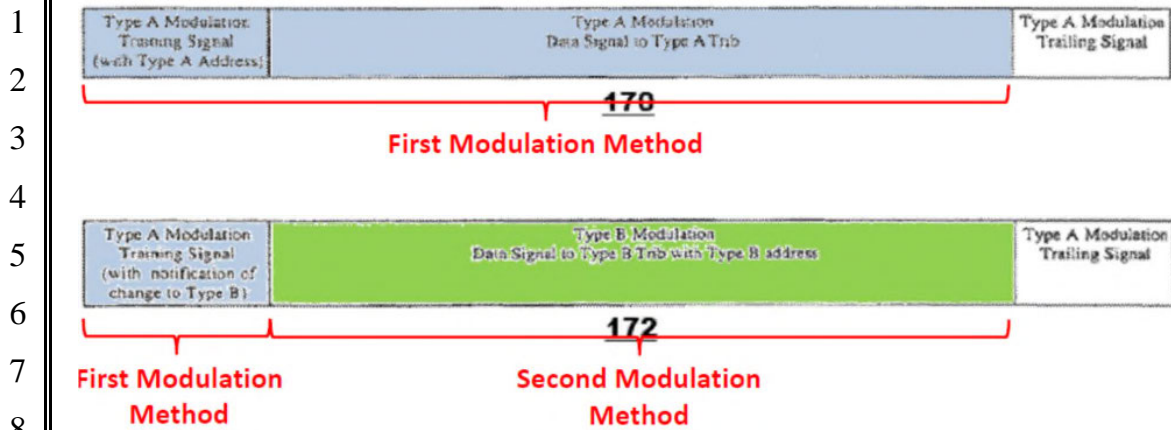


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FIG. 4

20 '228 Patent at 6:4-13. Such a system provides for greater efficiency, seamless
 21 communication with all devices, backward-compatibility, and decreased costs. *Id.*
 22 at 3:9-14; *see also id.* at 2:1-18, 5:32-46.

23 14. Annotated Fig. 8 shows two communications intended for different
 24 slaves. The first communication 170 uses a first type of modulation method for
 25 both the initial training signal and the subsequent data signal, while
 26 communication 172 uses the first type of modulation method for the training signal
 27 and the second type of modulation method for the data signal:

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’228 Patent at Fig. 8, 4:45-48, 4:66-5:1. Information in the training signal indicates whether there will be an impending change from the first type of modulation method to the second type of modulation method. *Id.* (training signal includes “notification of change to Type B” modulation method).

15. Mr. Bremer’s solution is captured and claimed in his seamless “switches” from one modulation type to another and is described with reference to Fig. 5:

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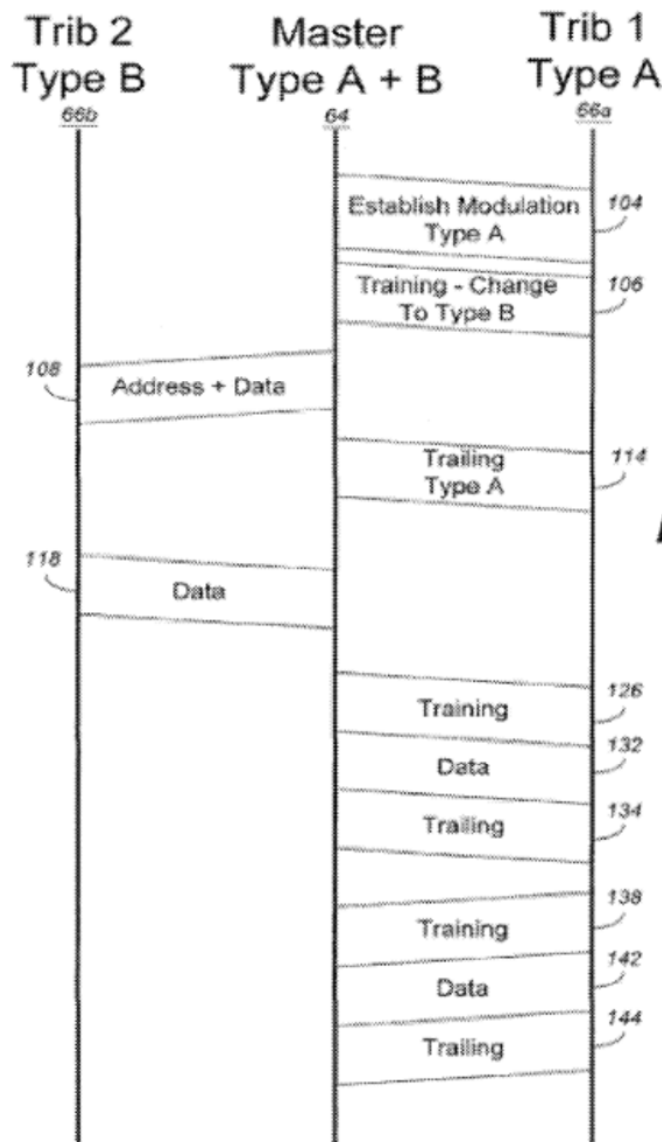


FIG. 5

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16. With reference to Fig. 5, for the Master (“Master Type A and B 64”) to communicate with a Type A trib (“Trib 1 Type A 66a”) using a negotiated first modulation type A method in the normal fashion, the Master transmits a “first message” (sequences 126, 132, 134). The “first message” includes (i) “first information” (training sequence 126) modulated according to the first modulation type A method and (ii) “second information” (transmission sequence 132) modulated according to the first modulation type A method and including data

1 intended for the Type A trib. The “first information” includes first message
2 address information that is indicative of the Type A trib being an intended
3 destination of the “second information.” ’228 Patent at 7:11-13 (“a training
4 sequence 126 in which an address of a particular type A trib 66a is identified”).

5 17. For the Master (“Master Type A and B 64”) to communicate with a
6 Type B trib (“Trib 2 Type B 66b”) using a second modulation type B method, the
7 Master transmits a “second message” (sequences 106, 108, 114). The “second
8 message” includes “third information” (training sequence 106) modulated
9 according to the first modulation type A method and including information that is
10 indicative of an impending change in modulation to the second modulation type B
11 method. ’228 Patent at 6:27-30 (“To switch from type A modulation to type B
12 modulation, master transceiver 64 transmits a training sequence 106 to type A trib
13 in which these trib is notified of an impending change to type B modulation.”).
14 The “second message” also includes “fourth information” (transmission sequence
15 108) that is transmitted after transmission of the “third information,” is modulated
16 according to the second modulation type B method, and includes data intended for
17 the Type B trib. ’228 Patent at 6:32-36 (“After notifying the type A trib 66a of
18 the change to type B modulation, master transceiver 64, using type B modulation,
19 transmits data along with an address in sequence 108, which is destined for a
20 particular type B trib 66b.”). In addition, the “second message” includes second
21 message address information that is indicative of the Type B trib being an intended
22 destination of the fourth information. *Id.*

23 18. The specification of the ’228 Patent describes the claimed switches as
24 follows:

25 “To switch from type A modulation to type B modulation, master
26 transceiver 64 transmits a training sequence 106 to type A trib 66a in which
27 these trib is notified of an impending change to type B modulation....
28 After notifying the type A trib 66a of the change to type B modulation,
master transceiver 64, using type B modulation, transmits data along with an

1 address in sequence 108, which is destined for a particular type B trib
2 66b....” [Col. 6, ll. 27-36.]

3 “If, however, master transceiver transmits a training sequence in
4 which the type A trib 66a-66a are notified of a change to type B modulation
5 as indicated by sequence 106, then a transition is made to state 124 where all
6 type B transmissions are ignored until a type A modulation trailing sequence
7 (e.g., sequence 114) is detected. Upon detecting the type A trailing
8 sequence, a type A trib 66a returns to state 122 where it awaits a training
9 sequence.” [Col. 7, ll. 3-10.]

10 “To initiate a communication session with a type A trib 66a, master
11 transceiver 64 transmits a training sequence 126 in which an address of a
12 particular Type A trib 66a is identified. The identified Type A trib 66a
13 recognizes its own address and transitions to state 128 to receive data from
14 master transceiver 64 as part of sequence 132.” [Col. 7, ll. 11-16.]

15 19. The technology recited in the claims of the ’228 Patent provides an
16 inventive concept and does not claim an abstract idea. Due to the inventive
17 combination of elements, the claimed inventions achieve many benefits over prior
18 art systems and methods, including the benefits noted above (*i.e.*, greater
19 efficiency, seamless communication with all devices, backward-compatibility, and
20 decreased costs). ’228 Patent at 3:9-14; *see also id.* at 2:1-18, 5:32-46.

21 20. The claimed inventive concepts greatly enhance and facilitate
22 technological systems, architectures, and methods through the use of a master
23 communication device in a master/slave relationship with other slave
24 communication devices. The master communication device transmits messages
25 with particular sequences using two different types of modulation methods to
26 facilitate communication between different type slave devices. The technology
27 recited in the claims of the ’228 Patent improves the functioning of computer
28 devices and improves over existing technological processes, including with respect
to master-slave communication systems that implement different types of
modulation methods.

1 21. The '228 Patent describes systems and methods that solved technical
2 problems. Those problems included the ability to communicate in a master-slave
3 environment amongst devices that implement different families of modulation
4 techniques. These problems also included backwards compatibility with older
5 devices using different types of modulation.

6 22. The technological improvements described and claimed in the '228
7 Patent were not conventional or generic at the time of their invention, but rather
8 required novel and non-obvious solutions to problems and shortcomings in the art
9 at the time. The inventions claimed in the '228 Patent also cover more than just
10 the performance of well-understood, routine or conventional activities known in
11 the art. For example, Claim 21 of the '228 Patent is directed to a particular master
12 communication device that can communicate with slave devices using different
13 families of modulation techniques.

14 23. The '228 Patent claims inventions that provide technological solutions
15 to technological problems. The written description of the '228 Patent describes in
16 technical detail each of the elements of the claims, including a master device that
17 can communicate with slave devices using different types of modulation methods
18 according to particular sequences of messages.

19 24. The claims of the '228 Patent are not directed to basic tools of
20 scientific and technological work, fundamental economic practices, or the use of an
21 abstract mathematical formula. Rather, the claims are directed to a master
22 communication device that can communicate with slave devices (which implement
23 entirely different families of modulation techniques) using particular sequences of
24 messages containing different types of modulation methods.

25 25. The '228 Patent does not preempt any abstract idea or otherwise
26 preempt anything that would render them unpatentable. For example, one is free to
27 practice the prior art of record. The '228 claims do not improperly inhibit further
28

1 discovery by tying up any building blocks of human ingenuity or technological
2 work.

3 26. The '228 Patent claims cannot be practiced by a human alone.
4 Indeed, master/slave communication systems using different types of modulation
5 methods exist only in the context of wireless communication devices.

6 27. Upon information and belief, Qualcomm has infringed directly and
7 indirectly and continues to infringe directly and indirectly claim 21 of the '228
8 Patent. The infringing acts include, but are not limited to, the manufacture, use,
9 sale, importation, and/or offer for sale of products practicing any of the following
10 Bluetooth specifications that support Enhanced Data Rate ("EDR"): Version 2.0 +
11 EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1,
12 Version 4.2, or version 5 (collectively, the "Bluetooth EDR Specifications"). Such
13 Qualcomm products that support one or more of the Bluetooth EDR Specifications
14 are hereinafter referred to as the "Qualcomm Bluetooth EDR Products."

15 28. Qualcomm's Bluetooth EDR Products include, but are not limited to,
16 the: APQ8009; APQ8016E; APQ8053; APQ8096SG; BlueCore 5; CSR1010;
17 CSR1011; CSR1012; CSR1013; CSR101x; CSR1020; CSR1021; CSR1024;
18 CSR1025; CSR102x; CSR8311; CSR8350; CSR8510; CSR8605; CSR8610;
19 CSR8615; CSR8620; CSR8630; CSR8635; CSR8640; CSR8645; CSR8670;
20 CSR8675; CSR8811; CSRA65700; CSRA68100; CSRA68105; CSRB5341;
21 CSRB5342; CSRB5348; QCA4020; QCA4024; QCA9379; QCC300X Product
22 Family; QCC3001; QCC3002; QCC3003; QCC3004; QCC3005; QCC3006;
23 QCC3007; QCC3008; QCC30XX Product Family; QCC3020; QCC3021;
24 QCC3024; QCC3026; QCC3031; QCC3034; QCC5100 Product Family;
25 QCC5120; QCC5121; QCC5124; QCC5125; QSC400 Series; QSC603; QSC605;
26 WCN1312, SCN3660, WCN3680, AR3012, AR6003, AR6005G, AR9462,
27 Snapdragon 200-800 series; and all other devices that use or permit use of
28 Bluetooth EDR.

1 29. Qualcomm’s Bluetooth EDR Products satisfy the limitations of the
2 claims of the ’228 Patent. For example, each of Qualcomm’s Bluetooth EDR
3 Product is a “master communication device” that can operate in the role of the
4 master in a master-slave relationship and communicate with other Bluetooth EDR
5 Products operating in the role of slaves. Further, each of Qualcomm’s Bluetooth
6 EDR Products can transmit using at least two “different types” of modulation
7 methods: (1) a “first” Gaussian Frequency Shift Keying (GFSK) modulation
8 method; and (2) a “second” Differential Phase Shift Keying (DPSK) modulation
9 method. Each of Qualcomm’s Bluetooth EDR Products can transmit a “first
10 message” in the form of a Basic Rate packet (with a GFSK access code/header and
11 a GFSK payload) and a “second message” in the form of an Enhanced Rate packet
12 (with a GFSK access code/header and a DPSK payload). Further, the access
13 code/header of the both messages includes “first message address data” comprising
14 an LT_ADDR.

15 30. Upon information and belief, at least as of the filing of this complaint,
16 Qualcomm also indirectly infringes one or more claims of the ’228 Patent by active
17 inducement under 35 U.S.C. § 271(b). Qualcomm has induced, caused, urged,
18 encouraged, aided and abetted its direct and indirect customers to make, use, sell,
19 offer for sale and/or import products which are interoperable according to the
20 Bluetooth EDR Specifications and thereby infringe the ’228 Patent. Qualcomm
21 has done so by acts including, but not limited to, selling products that are
22 interoperable according to the Bluetooth EDR Specifications to their customers;
23 marketing the infringing capabilities of such products; and providing instructions,
24 technical support and other support and encouragement for the use of such
25 products. Such conduct by Qualcomm was intended to and actually resulted in
26 direct infringement, including the making, using, selling, offering for sale and/or
27 importation of infringing Qualcomm Bluetooth EDR Products in the United States.
28 Qualcomm has notice of the ’228 Patent by at least the date of this complaint but,

1 upon information and belief, Qualcomm knew of the '228 Patent far earlier as a
2 result of Qualcomm following and/or press coverage of Rembrandt's prior
3 litigation asserting the '228 Patent against Samsung, one of Qualcomm's biggest
4 customers. Moreover, Qualcomm knew of the '228 Patent at least as early as
5 December 3, 2013, as it was served a subpoena in the *Rembrandt v. Samsung*
6 litigation that identified the '228 patent by its full patent number, and set forth the
7 standards upon which Rembrandt's infringement case was premised.

8 31. The acts of infringement by Qualcomm have caused damage to
9 Rembrandt, and Rembrandt is entitled to recover from Qualcomm the damages
10 sustained by Rembrandt as a result of Qualcomm's wrongful acts in an amount
11 subject to proof at trial. Specifically, Rembrandt seeks damages for Qualcomm's
12 infringement of the '228 Patent from its date of issuance, June 4, 2013, until the
13 date that Samsung became licensed to the '228 Patent and became obligated to
14 mark its licensed products with the '228 Patent number, which occurred on August
15 27, 2018.

16 32. Upon information and belief, since at least the filing of this lawsuit,
17 Qualcomm's aforementioned actions have been, and continue to be, committed in a
18 knowing and willful manner and constitute willful infringement of the '228 Patent.

19 **INFRINGEMENT OF U.S. PATENT NO. 8,023,580**

20 33. On September 20, 2011, United States Patent No. 8,023,580 was duly
21 and legally issued for inventions entitled "System and Method of Communication
22 Using at Least Two Modulation Methods." The '580 Patent claims priority back
23 through a string of continuation applications to US Application No. 09/205,205,
24 which was filed on December 4, 1998, and to Provisional Application No.
25 60/067,562, filed on December 5, 1997. Thus, each of the asserted claims of the
26 '580 Patent are entitled to a priority date of December 5, 1997. The '580 Patent
27 expired on December 4, 2018, but Rembrandt is entitled to damages for
28 infringement that occurred before the expiration of the '580 Patent. Rembrandt

1 was assigned the '580 Patent and continues to hold all rights and interest in the
2 '580 Patent, including the right to recover damages for past infringement. A true
3 and correct copy of the '580 Patent is attached as Exhibit B.

4 34. The '580 Patent shares the same specification as the '228 Patent.
5 Accordingly, the above statements in paragraphs 8-26 above apply equally to the
6 '580 Patent, and Rembrandt incorporates them by reference herein.

7 35. Upon information and belief, Qualcomm has infringed directly and
8 indirectly and continues to infringe directly and indirectly claims 2 and 59 of the
9 '580 Patent. The infringing acts include, but are not limited to, the manufacture,
10 use, sale, importation, and/or offer for sale of Qualcomm Bluetooth EDR Products
11 that practice any of the Bluetooth EDR Specifications (as those terms are defined
12 above for the '228 Patent).

13 36. Qualcomm's Bluetooth EDR Products satisfy the limitations of the
14 claims of the '580 Patent. For example, each of Qualcomm's Bluetooth EDR
15 Product is a "communication device" that can operate in the role of the master in a
16 master-slave relationship and communicate with other Bluetooth EDR Products
17 operating in the role of slaves. Further, each of Qualcomm's Bluetooth EDR
18 Products can transmit using two "different types" of modulation methods: (1) a
19 "first" Gaussian Frequency Shift Keying (GFSK) modulation method; and (2) a
20 "second" Differential Phase Shift Keying (DPSK) modulation method. Each of
21 Qualcomm's Bluetooth EDR Products can transmit a "first sequence" with a GFSK
22 access code/header whose LT_ADDR and TYPE fields indicate the modulation
23 method of a "second sequence" comprising a packet payload. Depending on the
24 "first sequence," the "second sequence" will have either a GFSK payload (in the
25 case of a Basic Rate packet) or a DPSK payload (in the case of an Enhanced Rate
26 packet). Further, after transmitting an Enhanced Rate packet, each of Qualcomm's
27 Bluetooth EDR Products can subsequently transmit a Basic Rate packet with a
28 payload communicating using the first GFSK modulation method.

1 37. Upon information and belief, at least as of the filing of this complaint,
2 Qualcomm also indirectly infringes one or more claims of the '580 Patent by active
3 inducement under 35 U.S.C. § 271(b). Qualcomm has induced, caused, urged,
4 encouraged, aided and abetted its direct and indirect customers to make, use, sell,
5 offer for sale and/or import products which are interoperable according to the
6 Bluetooth EDR Specifications and thereby infringe the '580 Patent. Qualcomm
7 has done so by acts including but not limited to selling products that are
8 interoperable according to the Bluetooth EDR Specifications to their customers;
9 marketing the infringing capabilities of such products; and providing instructions,
10 technical support and other support and encouragement for the use of such
11 products. Such conduct by Qualcomm was intended to and actually resulted in
12 direct infringement, including the making, using, selling, offering for sale and/or
13 importation of infringing Qualcomm Bluetooth EDR Products in the United States.
14 Qualcomm has notice of the '580 Patent by at least the date of this complaint but,
15 upon information and belief, Qualcomm knew of the '580 Patent far earlier as a
16 result of Qualcomm following and/or press coverage of Rembrandt's prior
17 litigation asserting the '580 Patent against Samsung, one of Qualcomm's biggest
18 customers. Moreover, Qualcomm knew of the '580 Patent at least as early as
19 December 3, 2013, as it was served a subpoena in the *Rembrandt v. Samsung*
20 litigation that identified the '580 patent by its full patent number, and set forth the
21 standards upon which Rembrandt's infringement case was premised.

22 38. The acts of infringement by Qualcomm have caused damage to
23 Rembrandt, and Rembrandt is entitled to recover from Qualcomm the damages
24 sustained by Rembrandt as a result of Qualcomm's wrongful acts in an amount
25 subject to proof at trial. Specifically, Rembrandt seeks damages for Qualcomm's
26 infringement of the '580 Patent from the date by which Rembrandt disclaimed
27 claims 32, 34, 40, 43, and 44, which occurred on December 4, 2014, until the date
28 that Samsung became licensed to the '580 Patent and became obligated to mark its

1 licensed products with the '580 Patent number, which occurred on August 27,
2 2018.

3 39. Upon information and belief, since at least the filing of this lawsuit,
4 Qualcomm's aforementioned actions have been, and continue to be, committed in a
5 knowing and willful manner and constitute willful infringement of the '580 Patent.

6 **REMBRANDT AND THE PATENTS-IN-SUIT**

7 40. Rembrandt has diligently protected the inventions in the patents-in-
8 suit. For example, Rembrandt sought to obtain licenses from Samsung (one of
9 Qualcomm's biggest customers) and BlackBerry (with whom Qualcomm has a
10 "strategic relationship"), and it was engaged in litigation against both Samsung and
11 BlackBerry, including a jury trial against Samsung and a subsequent appeal
12 brought by Samsung after the jury verdict in favor of Rembrandt. Ultimately, both
13 Samsung and BlackBerry took a license and/or a release to the '228 and '580
14 Patents. Before Samsung obtained a license, a jury found Samsung liable for
15 infringing the '228 and '580 Patents based on Samsung's use of Bluetooth EDR,
16 and awarded past-damages of \$15.7 million, which constituted a royalty rate of
17 approximately 5 ½ cents per infringing unit. The Federal Circuit affirmed the
18 finding that Bluetooth EDR infringed the '228 and '580 Patents.

19 41. The value of the patents-in-suit is further demonstrated by their
20 repeated success against validity challenges. The claims were construed in the
21 prior litigation after a *Markman* hearing. After a week-long trial, a jury found that
22 all the asserted claims were valid. The Federal Circuit affirmed that finding that
23 the '228 and '580 Patents were valid and infringed by Samsung, and that the claim
24 construction was legally correct. Moreover, the United States Patent & Trademark
25 Office refused to even institute *inter partes* reviews against claim 21 of the '228
26 Patent and claims 2 and 59 of the '580 Patent. And the United States Patent &
27 Trademark Office recently confirmed the validity of claim 21 of the '228 Patent
28 and claims 2 and 59 of the '580 Patent in the course of *ex parte* reexamination

1 challenges instituted by Samsung. In sum, the validity of the asserted claims of the
2 '228 and '580 Patents has been reconfirmed in the course of a jury trial and
3 subsequent appeal, and in post-trial proceedings at the U.S. Patent & Trademark
4 Office.

5 **JURY DEMAND**

6 42. Rembrandt demands a trial by jury on all issues so triable.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, Rembrandt requests entry of judgment in its favor and
9 against Qualcomm as follows:

- 10 a) A declaration that Qualcomm has infringed and is infringing U.S.
11 Patent Nos. 8,457,228 and 8,023,580;
- 12 b) A declaration that Qualcomm's infringement was willful;
- 13 c) An award of damages to Rembrandt arising out of Qualcomm's
14 infringement of U.S. Patent Nos. 8,457,228 and 8,023,580, including
15 enhanced damages pursuant to 35 U.S.C. § 284, together with
16 prejudgment and post-judgment interest, in an amount according to
17 proof;
- 18 d) An award of attorneys' fees pursuant to 35 U.S.C. § 285 or as is
19 otherwise permitted by law; and,
- 20 e) Granting Rembrandt its costs and further relief as the Court may deem
21 just and proper.
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1 Dated: April 15, 2019

Respectfully submitted,

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/s/ David M. Stein

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12 Attorneys for Plaintiff *Rembrandt Wireless Technologies, LP*

13 UNITED STATES DISTRICT COURT
14 CENTRAL DISTRICT OF CALIFORNIA

16 REMBRANDT WIRELESS
17 TECHNOLOGIES, LP,

18 Plaintiff,

19 v.

21 BROADCOM INCORPORATED and
22 BROADCOM CORPORATION,

23 Defendant.

) Case No.: 8:19-cv-708

) COMPLAINT FOR
) INFRINGEMENT OF U.S.
) PATENT NOS. 8,457,228 &
) 8,023,580

) DEMAND FOR JURY TRIAL

1 Plaintiff Rembrandt Wireless Technologies LP (“Rembrandt” or “Plaintiff”)
2 hereby submits this Complaint against Defendants Broadcom Incorporated and
3 Broadcom Corporation (collectively, “Broadcom”) and states as follows:

4 **THE PARTIES**

5 1. Rembrandt is a Virginia limited partnership, having a principal place
6 of business at 401 City Ave., Suite 900, Bala Cynwyd, Pennsylvania 19004.

7 2. Rembrandt is the assignee and owner of the patents at issue in this
8 action: United States Patent No. 8,457,228 (“the ’228 Patent”) and United States
9 Patent No. 8,023,580 (“the ’580 Patent”).

10 3. Rembrandt is informed and believes, and on that basis alleges, that
11 Broadcom Incorporated is a Delaware corporation with its principal places of
12 business at 1320 Ridder Park Dr., San Jose, California 95131. Broadcom
13 Incorporated may be served with process through its registered agent, Corporation
14 Service Company, 251 Little Falls Drive, Wilmington, Delaware, 19808.

15 4. Rembrandt is informed and believes, and on that basis alleges, that
16 Broadcom Corporation is a California corporation with its principal place of
17 business at 1320 Ridder Park Dr., San Jose, California 95131. On information and
18 belief, Broadcom Corporation is a wholly-owned subsidiary of Broadcom
19 Incorporated. Broadcom Corporation may be served with process through its
20 registered agent, CSC – Lawyers Incorporating Service, 2710 Gateway Oaks
21 Drive, Suite 150N, Sacramento, CA 95833.

22 **JURISDICTION AND VENUE**

23 5. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§
24 1331 and 1338(a) because this action arises under the patent laws of the United
25 States, 35 U.S.C. §§ 101 *et seq.*

26 6. The Court has personal jurisdiction over Defendants, including
27 because Defendants have minimum contacts within the State of California;
28 Defendants have purposefully availed themselves of the privileges of conducting

1 business in the State of California; Defendants regularly conduct business within
2 the State of California; and Plaintiff’s cause of action arises directly from
3 Defendants’ business contacts and other activities in the State of California,
4 including at least by virtue of Defendants’ infringing systems, devices, and
5 methods, which are at least sold, practiced, and/or used in the State of California.
6 Further, this Court has general jurisdiction over Defendants, including due to their
7 continuous and systematic contacts with the State of California. Further, on
8 information and belief, Defendants are subject to the Court’s jurisdiction, including
9 because Defendants have committed patent infringement in the State of California.

10 7. Venue is proper in this federal district pursuant to 28 U.S.C.
11 §§1391(b)-(c) and 1400(b). Without limitation, on information and belief,
12 Defendants have regular and established places of business in this District, and in
13 California, and at least some of its infringement of the patents-in-suit occurs in this
14 District, and in California.

15 8. Without limitation, on information and belief, venue is proper in this
16 District because Defendants have physical places from which their business is
17 conducted within this District comprising Broadcom offices, including at 15101
18 Alton Parkway, Irvine, California 92618 and 5300 California Avenue, Irvine,
19 California 92617; the business conducted at such places is steady, uniform,
20 orderly, and/or methodical, and is settled and not transient, including, but not
21 limited to, distribution, sales, and/or offers for sale, including related to infringing
22 methods and apparatuses. On information and belief, Defendants also have
23 Broadcom offices in multiple locations throughout the state of California, and it
24 has significant corporate facilities in San Diego, CA and Santa Clara, CA as well.
25 Further, on information and belief, Defendants are subject to venue in this District,
26 including because Defendants have committed patent infringement in this District.
27 Pursuant to 35 U.S.C. § 271, Defendants infringe the patents-in-suit by the
28 infringing acts described herein in this District. Further, Defendants solicit and

1 induce customers/users in this District, including via their development, marketing,
2 and sales of its infringing chips. On information and belief, Defendants have
3 customers/users who are residents of this District and who purchase, acquire,
4 and/or use Defendants' infringing products in this District.

5 **INFRINGEMENT OF U.S. PATENT NO. 8,457,228**

6 9. On June 4, 2013, United States Patent No. 8,457,228 was duly and
7 legally issued for inventions entitled "System and Method of Communication
8 Using at Least Two Modulation Methods." The '228 Patent claims priority back
9 through a string of continuation applications to US Application No. 09/205,205,
10 which was filed on December 4, 1998, and to Provisional Application No.
11 60/067,562, filed on December 5, 1997. Thus, each of the asserted claims of the
12 '228 Patent are entitled to a priority date of December 5, 1997. The '228 Patent
13 expired on December 4, 2018, but Rembrandt is entitled to damages for
14 infringement that occurred before the expiration of the '228 Patent. Rembrandt
15 was assigned the '228 Patent and continues to hold all rights and interest in the
16 '228 Patent, including the right to recover damages for past infringement. A true
17 and correct copy of the '228 Patent is attached as Exhibit A.

18 10. According to the '228 Patent, prior master/slave systems could
19 communicate only when all network devices used a single common type of
20 modulation method. *See* '228 Patent at 1:29-67, 3:64-4:5. Thus, if a slave using
21 an additional type of modulation method were added to the network, the new slave
22 could not easily communicate with the master using the different modulation type
23 because it would not be compatible with the common type of modulation method.
24 *Id.* Annotated figure 1 of the '228 Patent shows a master/slave system, where all
25 devices in the network communicate using only a single common type of
26 modulation method (such as the amplitude modulation used by AM radio), even
27 though some of the devices may be capable of communication via other types of
28 modulation methods:

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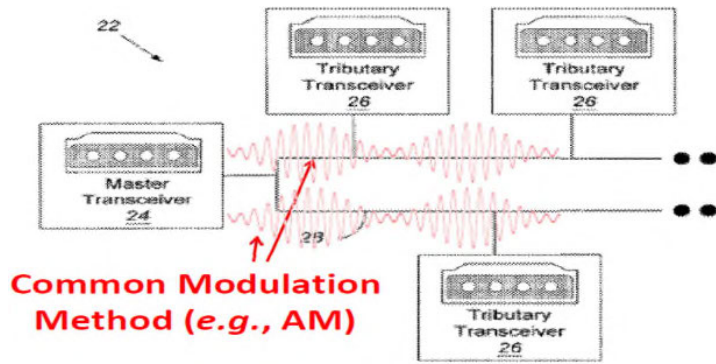


FIG. 1
Prior Art

11. The master/slave concept is described in the '228 Patent at col. 3, line 64-col. 5, line 7, with reference to Fig. 2. Briefly, Fig. 2 discloses a polled multipoint master/slave system. At the beginning of a session, the master established a common modulation type for communication with all its slaves (sequence 32 in Fig. 2). All slaves were identical in that they shared a common modulation with the master. The master then communicated with its slaves, one at a time, by sending a training sequence with the address of the slave with which it wants to communicate, followed by data, and finally a trailing sequence to end the communication (sequences 34-38 in Fig. 2). A slave could not initiate a communication, but, if the slave were polled by the master, it could respond to the master in a similar fashion (sequences 42-46 in Fig. 2). When the master had completed its communications with the first slave, it could then communicate with a second slave using the same negotiated common modulation (sequences 48-54 in Fig. 2).

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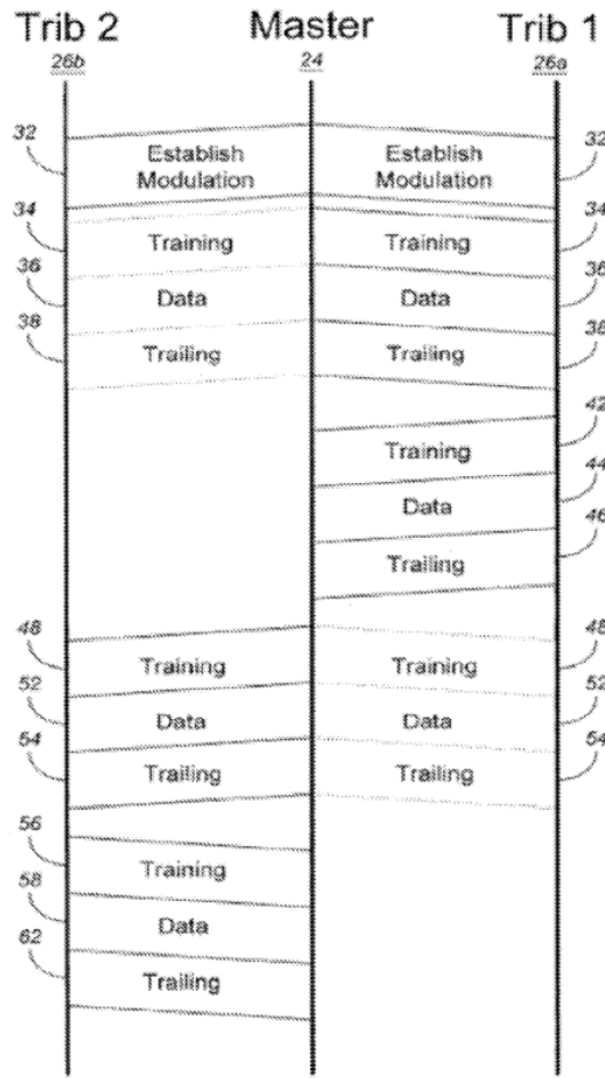
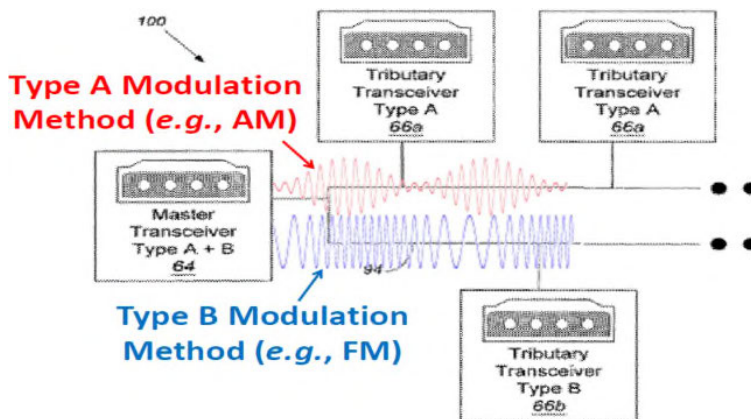


FIG. 2

20 12. In the context of the master/slave system described above, inventor
21 Gordon Bremer created “a system and method of communication in which multiple
22 modulation methods are used to facilitate communication among a plurality of
23 modems in a network, which have heretofore been incompatible.” ’228 Patent at
24 2:20-23. Mr. Bremer solved the problem with his claimed master/slave
25 communication system in which slaves can seamlessly communicate over a
26 network through a master using different types of modulation methods, thereby
27 permitting selection of the modulation type best suited for a particular application.
28 ’228 Patent at 2:27-3:14, 5:32-46.

1 13. The claimed invention of the '228 Patent is further described with
 2 reference to Figure 2 and in Figures 3-8 and the written description. Specifically,
 3 Figures 3 and 4 show block diagrams of the master transceiver and tributary
 4 transceivers, while Figure 5 shows a ladder diagram illustrating the operation of
 5 those transceivers. Figures 6 and 7 show state diagrams for exemplary tributary
 6 transceivers. Figure 8 shows a signal diagram for exemplary transmissions.

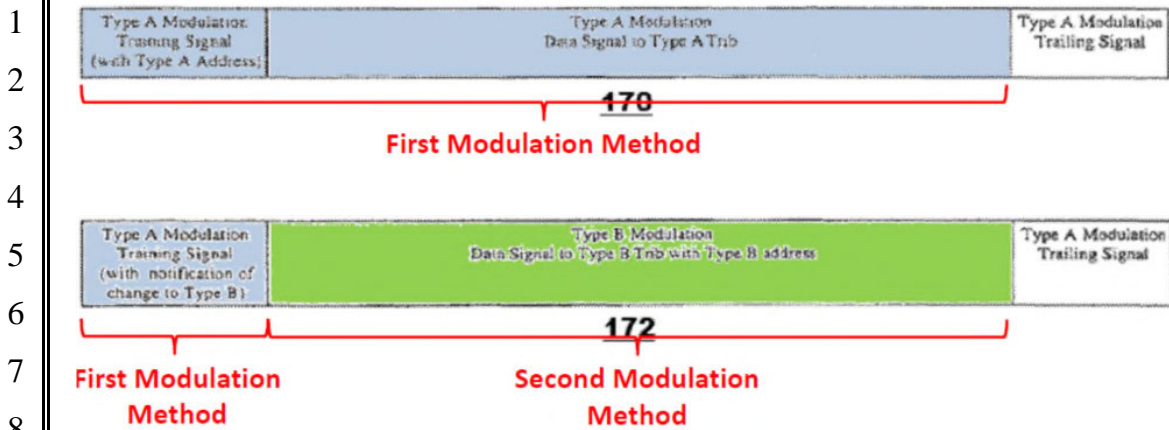
7 14. Annotated Fig. 4 shows an embodiment of the patented technology
 8 where some devices in the network communicate using one type of modulation
 9 method (e.g., amplitude modulation used by AM radio), while other devices
 10 communicate using a different type of modulation method (e.g., the frequency
 11 modulation used by FM radio):



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FIG. 4

20 '228 Patent at 6:4-13. Such a system provides for greater efficiency, seamless
 21 communication with all devices, backward-compatibility, and decreased costs. *Id.*
 22 at 3:9-14; *see also id.* at 2:1-18, 5:32-46.

23 15. Annotated Fig. 8 shows two communications intended for different
 24 slaves. The first communication 170 uses a first type of modulation method for
 25 both the initial training signal and the subsequent data signal, while
 26 communication 172 uses the first type of modulation method for the training signal
 27 and the second type of modulation method for the data signal:
 28



’228 Patent at Fig. 8, 4:45-48, 4:66-5:1. Information in the training signal indicates whether there will be an impending change from the first type of modulation method to the second type of modulation method. *Id.* (training signal includes “notification of change to Type B” modulation method).

16. Mr. Bremer’s solution is captured and claimed in his seamless “switches” from one modulation type to another and is described with reference to Fig. 5:

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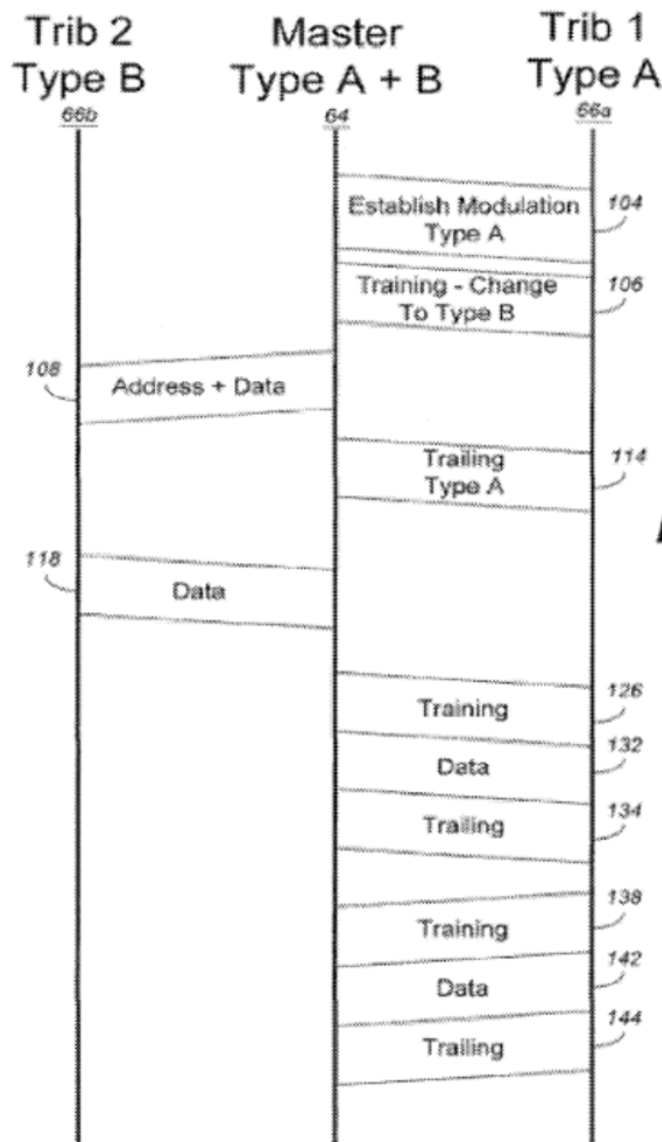


FIG. 5

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17. With reference to Fig. 5, for the Master (“Master Type A and B 64”) to communicate with a Type A trib (“Trib 1 Type A 66a”) using a negotiated first modulation type A method in the normal fashion, the Master transmits a “first message” (sequences 126, 132, 134). The “first message” includes (i) “first information” (training sequence 126) modulated according to the first modulation type A method and (ii) “second information” (transmission sequence 132) modulated according to the first modulation type A method and including data

1 intended for the Type A trib. The “first information” includes first message
2 address information that is indicative of the Type A trib being an intended
3 destination of the “second information.” ’228 Patent at 7:11-13 (“a training
4 sequence 126 in which an address of a particular type A trib 66a is identified”).

5 18. For the Master (“Master Type A and B 64”) to communicate with a
6 Type B trib (“Trib 2 Type B 66b”) using a second modulation type B method, the
7 Master transmits a “second message” (sequences 106, 108, 114). The “second
8 message” includes “third information” (training sequence 106) modulated
9 according to the first modulation type A method and including information that is
10 indicative of an impending change in modulation to the second modulation type B
11 method. ’228 Patent at 6:27-30 (“To switch from type A modulation to type B
12 modulation, master transceiver 64 transmits a training sequence 106 to type A trib
13 in which these trib is notified of an impending change to type B modulation.”).
14 The “second message” also includes “fourth information” (transmission sequence
15 108) that is transmitted after transmission of the “third information,” is modulated
16 according to the second modulation type B method, and includes data intended for
17 the Type B trib. ’228 Patent at 6:32-36 (“After notifying the type A trib 66a of
18 the change to type B modulation, master transceiver 64, using type B modulation,
19 transmits data along with an address in sequence 108, which is destined for a
20 particular type B trib 66b.”). In addition, the “second message” includes second
21 message address information that is indicative of the Type B trib being an intended
22 destination of the fourth information. *Id.*

23 19. The specification of the ’228 Patent describes the claimed switches as
24 follows:

25 “To switch from type A modulation to type B modulation, master
26 transceiver 64 transmits a training sequence 106 to type A trib 66a in which
27 these trib is notified of an impending change to type B modulation....
28 After notifying the type A trib 66a of the change to type B modulation,
master transceiver 64, using type B modulation, transmits data along with an

1 address in sequence 108, which is destined for a particular type B trib
2 66b....” [Col. 6, ll. 27-36.]

3 “If, however, master transceiver transmits a training sequence in
4 which the type A trib 66a-66a are notified of a change to type B modulation
5 as indicated by sequence 106, then a transition is made to state 124 where all
6 type B transmissions are ignored until a type A modulation trailing sequence
7 (e.g., sequence 114) is detected. Upon detecting the type A trailing
8 sequence, a type A trib 66a returns to state 122 where it awaits a training
9 sequence.” [Col. 7, ll. 3-10.]

10 “To initiate a communication session with a type A trib 66a, master
11 transceiver 64 transmits a training sequence 126 in which an address of a
12 particular Type A trib 66a is identified. The identified Type A trib 66a
13 recognizes its own address and transitions to state 128 to receive data from
14 master transceiver 64 as part of sequence 132.” [Col. 7, ll. 11-16.]

15 20. The technology recited in the claims of the ’228 Patent provides an
16 inventive concept and does not claim an abstract idea. Due to the inventive
17 combination of elements, the claimed inventions achieve many benefits over prior
18 art systems and methods, including the benefits noted above (*i.e.*, greater
19 efficiency, seamless communication with all devices, backward-compatibility, and
20 decreased costs). ’228 Patent at 3:9-14; *see also id.* at 2:1-18, 5:32-46.

21 21. The claimed inventive concepts greatly enhance and facilitate
22 technological systems, architectures, and methods through the use of a master
23 communication device in a master/slave relationship with other slave
24 communication devices. The master communication device transmits messages
25 with particular sequences using two different types of modulation methods to
26 facilitate communication between different type slave devices. The technology
27 recited in the claims of the ’228 Patent improves the functioning of computer
28 devices and improves over existing technological processes, including with respect
to master-slave communication systems that implement different types of
modulation methods.

1 22. The '228 Patent describes systems and methods that solved technical
2 problems. Those problems included the ability to communicate in a master-slave
3 environment amongst devices that implement different families of modulation
4 techniques. These problems also included backwards compatibility with older
5 devices using different types of modulation.

6 23. The technological improvements described and claimed in the '228
7 Patent were not conventional or generic at the time of their invention, but rather
8 required novel and non-obvious solutions to problems and shortcomings in the art
9 at the time. The inventions claimed in the '228 Patent also cover more than just
10 the performance of well-understood, routine or conventional activities known in
11 the art. For example, Claim 21 of the '228 Patent is directed to a particular master
12 communication device that can communicate with slave devices using different
13 families of modulation techniques.

14 24. The '228 Patent claims inventions that provide technological solutions
15 to technological problems. The written description of the '228 Patent describes in
16 technical detail each of the elements of the claims, including a master device that
17 can communicate with slave devices using different types of modulation methods
18 according to particular sequences of messages.

19 25. The claims of the '228 Patent are not directed to basic tools of
20 scientific and technological work, fundamental economic practices, or the use of an
21 abstract mathematical formula. Rather, the claims are directed to a master
22 communication device that can communicate with slave devices (which implement
23 entirely different families of modulation techniques) using particular sequences of
24 messages containing different types of modulation methods.

25 26. The '228 Patent does not preempt any abstract idea or otherwise
26 preempt anything that would render them unpatentable. For example, one is free to
27 practice the prior art of record. The '228 claims do not improperly inhibit further
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1 discovery by tying up any building blocks of human ingenuity or technological
2 work.

3 27. The '228 Patent claims cannot be practiced by a human alone.
4 Indeed, master/slave communication systems using different types of modulation
5 methods exist only in the context of wireless communication devices.

6 28. Upon information and belief, Broadcom has infringed directly and
7 indirectly and continues to infringe directly and indirectly claim 21 of the '228
8 Patent. The infringing acts include, but are not limited to, the manufacture, use,
9 sale, importation, and/or offer for sale of products practicing any of the following
10 Bluetooth specifications that support Enhanced Data Rate ("EDR"): Version 2.0 +
11 EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1,
12 Version 4.2, or version 5 (collectively, the "Bluetooth EDR Specifications"). Such
13 Broadcom products that support one or more of the Bluetooth EDR Specifications
14 are hereinafter referred to as the "Broadcom Bluetooth EDR Products."

15 29. Broadcom's Bluetooth EDR Products include, but are not limited to,
16 the: BCM2035, BCM2040, BCM2042, BCM2044, BCM2044S, BCM2045,
17 BCM2046, BCM2047, BCM2048, BCM2049, BCM2070, BCM20702,
18 BCM20705, BCM20705A1, BCM20705B0, BCM20730, BCM20733, BCM4329,
19 BCM4330, BCM4313, BCM4334, BCM4335, BCM4356, BCM4358, BCM4375,
20 BCM43012, BCM43142, BCM43241, BCM43572; and all other devices that use
21 or permit use of Bluetooth EDR.

22 30. Broadcom's Bluetooth EDR Products satisfy the limitations of the
23 claims of the '228 Patent. For example, each of Broadcom's Bluetooth EDR
24 Product is a "master communication device" that can operate in the role of the
25 master in a master-slave relationship and communicate with other Bluetooth EDR
26 Products operating in the role of slaves. Further, each of Broadcom's Bluetooth
27 EDR Products can transmit using at least two "different types" of modulation
28 methods: (1) a "first" Gaussian Frequency Shift Keying (GFSK) modulation

1 method; and (2) a “second” Differential Phase Shift Keying (DPSK) modulation
2 method. Each of Broadcom’s Bluetooth EDR Products can transmit a “first
3 message” in the form of a Basic Rate packet (with a GFSK access code/header and
4 a GFSK payload) and a “second message” in the form of an Enhanced Rate packet
5 (with a GFSK access code/header and a DPSK payload). Further, the access
6 code/header of the both messages includes “first message address data” comprising
7 an LT_ADDR.

8 31. Upon information and belief, at least as of the filing of this complaint,
9 Broadcom also indirectly infringes one or more claims of the ’228 Patent by active
10 inducement under 35 U.S.C. § 271(b). Broadcom has induced, caused, urged,
11 encouraged, aided and abetted its direct and indirect customers to make, use, sell,
12 offer for sale and/or import products which are interoperable according to the
13 Bluetooth EDR Specifications and thereby infringe the ’228 Patent. Broadcom has
14 done so by acts including, but not limited to, selling products that are interoperable
15 according to the Bluetooth EDR Specifications to their customers; marketing the
16 infringing capabilities of such products; and providing instructions, technical
17 support and other support and encouragement for the use of such products. Such
18 conduct by Broadcom was intended to and actually resulted in direct infringement,
19 including the making, using, selling, offering for sale and/or importation of
20 infringing Broadcom Bluetooth EDR Products in the United States. Broadcom has
21 notice of the ’228 Patent by at least the date of this complaint but, upon
22 information and belief, Broadcom knew of the ’228 Patent far earlier as a result of
23 Broadcom following and/or press coverage of Rembrandt’s prior litigation
24 asserting the ’228 Patent against Samsung, one of Broadcom’s biggest customers.
25 Moreover, Broadcom knew of the ’228 Patent at least as early as December 3,
26 2013, as it was served a subpoena in the *Rembrandt v. Samsung* litigation that
27 identified the ’228 patent by its full patent number, and set forth the standards upon
28 which Rembrandt’s infringement case was premised. Further, Broadcom

1 employee Stephen Hall was deposed in the *Rembrandt v. Samsung* litigation and
2 attended trial in that case, where he was a witness.

3 32. The acts of infringement by Broadcom have caused damage to
4 Rembrandt, and Rembrandt is entitled to recover from Broadcom the damages
5 sustained by Rembrandt as a result of Broadcom's wrongful acts in an amount
6 subject to proof at trial. Specifically, Rembrandt seeks damages for Broadcom's
7 infringement of the '228 Patent from its date of issuance, June 4, 2013, until the
8 date that Samsung became licensed to the '228 Patent and became obligated to
9 mark its licensed products with the '228 Patent number, which occurred on August
10 27, 2018.

11 33. Upon information and belief, since at least the filing of this lawsuit,
12 Broadcom's aforementioned actions have been, and continue to be, committed in a
13 knowing and willful manner and constitute willful infringement of the '228 Patent.

14 **INFRINGEMENT OF U.S. PATENT NO. 8,023,580**

15 34. On September 20, 2011, United States Patent No. 8,023,580 was duly
16 and legally issued for inventions entitled "System and Method of Communication
17 Using at Least Two Modulation Methods." The '580 Patent claims priority back
18 through a string of continuation applications to US Application No. 09/205,205,
19 which was filed on December 4, 1998, and to Provisional Application No.
20 60/067,562, filed on December 5, 1997. Thus, each of the asserted claims of the
21 '580 Patent are entitled to a priority date of December 5, 1997. The '580 Patent
22 expired on December 4, 2018, but Rembrandt is entitled to damages for
23 infringement that occurred before the expiration of the '580 Patent. Rembrandt
24 was assigned the '580 Patent and continues to hold all rights and interest in the
25 '580 Patent, including the right to recover damages for past infringement. A true
26 and correct copy of the '580 Patent is attached as Exhibit B.

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1 35. The '580 Patent shares the same specification as the '228 Patent.
2 Accordingly, the above statements in paragraphs 9-27 above apply equally to the
3 '580 Patent, and Rembrandt incorporates them by reference herein.

4 36. Upon information and belief, Broadcom has infringed directly and
5 indirectly and continues to infringe directly and indirectly claims 2 and 59 of the
6 '580 Patent. The infringing acts include, but are not limited to, the manufacture,
7 use, sale, importation, and/or offer for sale of Broadcom Bluetooth EDR Products
8 that practice any of the Bluetooth EDR Specifications (as those terms are defined
9 above for the '228 Patent).

10 37. Broadcom's Bluetooth EDR Products satisfy the limitations of the
11 claims of the '580 Patent. For example, each of Broadcom's Bluetooth EDR
12 Product is a "communication device" that can operate in the role of the master in a
13 master-slave relationship and communicate with other Bluetooth EDR Products
14 operating in the role of slaves. Further, each of Broadcom's Bluetooth EDR
15 Products can transmit using two "different types" of modulation methods: (1) a
16 "first" Gaussian Frequency Shift Keying (GFSK) modulation method; and (2) a
17 "second" Differential Phase Shift Keying (DPSK) modulation method. Each of
18 Broadcom's Bluetooth EDR Products can transmit a "first sequence" with a GFSK
19 access code/header whose LT_ADDR and TYPE fields indicate the modulation
20 method of a "second sequence" comprising a packet payload. Depending on the
21 "first sequence," the "second sequence" will have either a GFSK payload (in the
22 case of a Basic Rate packet) or a DPSK payload (in the case of an Enhanced Rate
23 packet). Further, after transmitting an Enhanced Rate packet, each of Broadcom's
24 Bluetooth EDR Products can subsequently transmit a Basic Rate packet with a
25 payload communicating using the first GFSK modulation method.

26 38. Upon information and belief, at least as of the filing of this complaint,
27 Broadcom also indirectly infringes one or more claims of the '580 Patent by active
28 inducement under 35 U.S.C. § 271(b). Broadcom has induced, caused, urged,

1 encouraged, aided and abetted its direct and indirect customers to make, use, sell,
2 offer for sale and/or import products which are interoperable according to the
3 Bluetooth EDR Specifications and thereby infringe the '580 Patent. Broadcom has
4 done so by acts including but not limited to selling products that are interoperable
5 according to the Bluetooth EDR Specifications to their customers; marketing the
6 infringing capabilities of such products; and providing instructions, technical
7 support and other support and encouragement for the use of such products. Such
8 conduct by Broadcom was intended to and actually resulted in direct infringement,
9 including the making, using, selling, offering for sale and/or importation of
10 infringing Broadcom Bluetooth EDR Products in the United States. Broadcom has
11 notice of the '580 Patent by at least the date of this complaint but, upon
12 information and belief, Broadcom knew of the '580 Patent far earlier as a result of
13 Broadcom following and/or press coverage of Rembrandt's prior litigation
14 asserting the '580 Patent against Samsung, one of Broadcom's biggest customers.
15 Moreover, Broadcom knew of the '580 Patent at least as early as December 3,
16 2013, as it was served a subpoena in the *Rembrandt v. Samsung* litigation that
17 identified the '580 patent by its full patent number, and set forth the standards upon
18 which Rembrandt's infringement case was premised.

19 39. The acts of infringement by Broadcom have caused damage to
20 Rembrandt, and Rembrandt is entitled to recover from Broadcom the damages
21 sustained by Rembrandt as a result of Broadcom's wrongful acts in an amount
22 subject to proof at trial. Specifically, Rembrandt seeks damages for Broadcom's
23 infringement of the '580 Patent from the date by which Rembrandt disclaimed
24 claims 32, 34, 40, 43, and 44, which occurred on December 4, 2014, until the date
25 that Samsung became licensed to the '580 Patent and became obligated to mark its
26 licensed products with the '580 Patent number, which occurred on August 27,
27 2018.

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1 40. Upon information and belief, since at least the filing of this lawsuit,
2 Broadcom's aforementioned actions have been, and continue to be, committed in a
3 knowing and willful manner and constitute willful infringement of the '580 Patent.

4 **REMBRANDT AND THE PATENTS-IN-SUIT**

5 41. Rembrandt has diligently protected the inventions in the patents-in-
6 suit. For example, Rembrandt sought to obtain licenses from Samsung (one of
7 Broadcom's biggest customers) and BlackBerry (another of Broadcom's
8 customers), and it was engaged in litigation against both Samsung and Blackberry,
9 including a jury trial against Samsung and a subsequent appeal brought by
10 Samsung after the jury verdict in favor of Rembrandt. Ultimately, both Samsung
11 and BlackBerry took a license and/or a release to the '228 and '580 Patents.
12 Before Samsung obtained a license, a jury found Samsung liable for infringing the
13 '228 and '580 Patents based on Samsung's use of Bluetooth EDR, and awarded
14 past-damages of \$15.7 million, which constituted a royalty rate of approximately 5
15 ½ cents per infringing unit. The Federal Circuit affirmed the finding that
16 Bluetooth EDR infringed the '228 and '580 Patents.

17 42. The value of the patents-in-suit is further demonstrated by their
18 repeated success against validity challenges. The claims were construed in the
19 prior litigation after a *Markman* hearing. After a week-long trial, a jury found that
20 all the asserted claims were valid. The Federal Circuit affirmed that finding that
21 the '228 and '580 Patents were valid and infringed by Samsung, and that the claim
22 construction was legally correct. Moreover, the United States Patent & Trademark
23 Office refused to even institute *inter partes* reviews against claim 21 of the '228
24 Patent and claims 2 and 59 of the '580 Patent. And the United States Patent &
25 Trademark Office recently confirmed the validity of claim 21 of the '228 Patent
26 and claims 2 and 59 of the '580 Patent in the course of *ex parte* reexamination
27 challenges instituted by Samsung. In sum, the validity of the asserted claims of the
28 '228 and '580 Patents has been reconfirmed in the course of a jury trial and

1 subsequent appeal, and in post-trial proceedings at the U.S. Patent & Trademark
2 Office.

3 **JURY DEMAND**

4 43. Rembrandt demands a trial by jury on all issues so triable.

5 **PRAYER FOR RELIEF**

6 WHEREFORE, Rembrandt requests entry of judgment in its favor and
7 against Broadcom as follows:

- 8 a) A declaration that Broadcom has infringed and is infringing U.S.
9 Patent Nos. 8,457,228 and 8,023,580;
- 10 b) A declaration that Broadcom's infringement was willful;
- 11 c) An award of damages to Rembrandt arising out of Broadcom's
12 infringement of U.S. Patent Nos. 8,457,228 and 8,023,580, including
13 enhanced damages pursuant to 35 U.S.C. § 284, together with
14 prejudgment and post-judgment interest, in an amount according to
15 proof;
- 16 d) An award of attorneys' fees pursuant to 35 U.S.C. § 285 or as is
17 otherwise permitted by law; and,
- 18 e) Granting Rembrandt its costs and further relief as the Court may deem
19 just and proper.
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Dated: April 15, 2019

Respectfully submitted,

/s/ David M. Stein

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 2:19-CV-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED



DEFENDANT APPLE INC.'S MOTION TO TRANSFER VENUE

Rembrandt Wireless
Ex. 2010

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Abbreviation	Definition
Jaynes Decl.	Declaration of Michael Jaynes in Support of Defendant Apple Inc.'s Motion to Transfer Venue
Broadcom Decl.	Declaration of Burhan Masood in Support of Defendant Apple Inc.'s Motion to Transfer Venue
Ex. __	Exhibit in the Declaration of Josef B. Schenker in Support of Defendant Apple Inc.'s Motion to Transfer Venue

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I. INTRODUCTION

Apple respectfully requests that the Court transfer this case to the Central District of California (CDCA). Even Rembrandt recognizes the nexus of this case to the CDCA—it sued non-parties Broadcom and Qualcomm there on the same two patents it asserts against Apple here. All three complaints make the same general allegation: Broadcom, Qualcomm, and Apple infringe by practicing the Bluetooth specifications that support Bluetooth Enhanced Data Rate (“EDR”).

[REDACTED]

[REDACTED] Rembrandt has raised identical issues both in this District and the CDCA: namely, whether Broadcom’s and Qualcomm’s chips infringe the asserted patents.

Judicial economy, convenience of the witnesses and relative ease of access to the evidence all weigh heavily in favor of transfer to the CDCA. Broadcom and Qualcomm have multiple facilities throughout California, including in CDCA, and their respective employees with whom Apple interacted concerning the relevant chips are located there. [REDACTED]

[REDACTED]

[REDACTED] At trial, [REDACTED]

[REDACTED] A trial in the CDCA would be much more convenient for the relevant Broadcom and Qualcomm witnesses. If necessary, the CDCA court can also compel the Broadcom and Qualcomm witnesses to appear at trial to explain the accused technology to the jury, which this Court cannot. Other non-party witnesses, including Steven Hall (who was involved in developing EDR) and Zhong (a prior owner of the asserted patents), are also located in California outside the subpoena power of this District.

In addition to these non-party witnesses, the Apple employees involved [REDACTED]

[REDACTED] are located in

or near Cupertino and Culver City, California; and those Apple employees involved in [REDACTED]

[REDACTED] are located in or near Cupertino, a short flight from the CDCA. In contrast, no known evidence or witnesses are located within this District.

Given the pending suits against Apple’s Bluetooth chip suppliers and the location of the center of gravity for the accused EDR functionality in the CDCA, and given the absence of relevant witnesses or evidence in this District, transfer is appropriate based on all the private and public factors. Accordingly, transfer to the CDCA is warranted.

II. RELEVANT FACTUAL BACKGROUND

A. Non-Parties Broadcom and Qualcomm and the Accused Chips

1. Rembrandt’s Infringement Allegations Focus on Functionality Provided by Third-Party Chip Suppliers

Rembrandt accuses Apple of infringing three claims from U.S. Patent Nos. 8,457,228 (the “228 patent”); and 8,023,580 (the “580 patent”). Accused Apple products include certain Apple iPhones, iPads, iPods, Watches, TV’s, MacBooks, Macs, Beats Headphones, AirPods, Beats Speakers, AirPort Extreme, HomePod, and “all other devices that use Bluetooth EDR” (collectively, the “Accused Products”). (ECF No. 1 (“Compl.”) ¶29.) Rembrandt separately sued Broadcom (8:19-cv-00708) and Qualcomm (8:19-cv-00705) in the CDCA, accusing Broadcom and Qualcomm of infringing the same three claims across the same two patents in the same manner. (Ex. C ¶8; Ex. D ¶7.)

Specifically, Rembrandt alleges that Apple’s, Broadcom’s, and Qualcomm’s “infringing acts include, but are not limited to, the manufacture, use, sale, importation, exportation, and/or offer for sale of products practicing any of the following Bluetooth specifications that support Enhanced Data Rate (“EDR”): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5” (the “Accused Functionality”). (Compl. ¶28; Ex. C ¶28; Ex. D ¶27.) Likewise, all three complaints allege infringement by “all [] devices that use Bluetooth EDR.” (Compl. ¶28; Ex. C ¶29; Ex. D ¶28.)

The accused Bluetooth EDR functionality [REDACTED]

[REDACTED] (Jaynes Decl. ¶¶11–

12.) Indeed, Rembrandt recognizes as much and specifically identifies Broadcom as Apple’s Bluetooth supplier in its Complaint. (Compl. ¶31.) [REDACTED]

[REDACTED] (Jaynes Decl. ¶13.) [REDACTED]

[REDACTED] (Broadcom Decl. ¶11.)

Accordingly, [REDACTED]

[REDACTED] (Jaynes Decl. ¶¶11–12.) Instead, for those devices incorporating

a Broadcom or Qualcomm chip, the potentially relevant Apple witnesses can testify to [REDACTED]

[REDACTED] (Jaynes Decl. ¶¶22–24, 26.)

2. Broadcom’s and Qualcomm’s Relevant Witnesses and Documents are Concentrated in California

[REDACTED] the accused

Bluetooth EDR functionality [REDACTED] (Jaynes Decl. ¶¶11–

12; Broadcom Decl. ¶¶8–9.) Broadcom is headquartered in San Jose, Ca. with offices throughout California. (Ex. C ¶8; Ex. E; Broadcom Decl. ¶5.) [REDACTED]

[REDACTED] (Broadcom Decl. ¶¶6–7.)

[REDACTED] (*Id.* ¶10.) [REDACTED]

[REDACTED] (*Id.* ¶12.) To the extent

Broadcom is required to produce any witnesses in connection with this litigation, [REDACTED]

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would most likely be located in or near the CDCA. (*Id.* ¶16.) [REDACTED]

[REDACTED]. (*Id.* ¶13.) [REDACTED]

[REDACTED] (*Id.* ¶¶17–18.)

Qualcomm is headquartered in San Diego, Ca., with offices throughout California, including in the CDCA. (Ex. D ¶7; Ex. F.) [REDACTED]

[REDACTED] (Jaynes Decl. ¶¶14, 23.)

Apple is not currently aware of any relevant Qualcomm documents or witnesses in this District.

3. Additional Relevant Non-Party Witnesses are in California

In addition to Broadcom and Qualcomm— [REDACTED]

[REDACTED]—additional relevant non-parties reside near the CDCA and are within the subpoena power of the CDCA for trial.

Zhone Technologies. Gordon Bremer, the sole named inventor, purportedly conceived of the alleged invention of the patents-in-suit while working at Paradyne Networks, Inc. (“Paradyne”) in 1997. (Ex. G, 2.) Paradyne was acquired by Zhone Technologies, Inc. (“Zhone”) in 2005. *In re Rembrandt Techs. LP Patent Litig.*, 899 F.3d 1254, 1261-62 (Fed. Cir. 2018). Zhone destroyed approximately 3,200 documents between 2005 and 2006 relating to, *inter alia*, conception and reduction to practice of various alleged inventions from Paradyne’s portfolio, royalty and licensing agreements, and prior art.¹ *Id.* Zhone is headquartered in Oakland, Ca. (Exs. H and I.)

Paul Castor. Paul Castor, Zhone’s former general counsel, was involved in the destruction of Paradyne documents at Zhone and is located near San Diego, Ca. (Ex. J.; 899 F.3d at 1268.)

Steven Hall. Steven Hall, [REDACTED]

¹ This spoliation of evidence resulted in an exceptional case finding under § 285 and an award of attorneys’ fees. *In re Rembrandt*, 899 F.3d at 1280.

[REDACTED] and participated in the development of EDR in the Bluetooth standard, is currently located near San Diego, Ca. (Broadcom Decl. ¶14; Exs. K and L.)

B. The Parties in this Action

1. Apple's Relevant Witnesses and Documents are in California

Apple is incorporated in California and has its worldwide headquarters in Cupertino, Ca. (Jaynes Decl. ¶5.) The primary research, design and development activities, facilities and engineers for the Accused Products are located in Cupertino, Ca. and surrounding cities. (Jaynes Decl. ¶¶6, 16–17.) Apple also has facilities located in Culver City, Los Angeles, and Santa Monica, Ca. which are all within the CDCA. (*Id.* ¶6.) [REDACTED]

[REDACTED] (*Id.*, ¶23.)

The primary operation, marketing, sales, and finance decisions for Apple occur in or near Cupertino, Ca. (Jaynes Decl. ¶6.) [REDACTED]

[REDACTED] (*Id.* ¶¶2, 26.) Apple's employees knowledgeable about the design and operation of the Accused Products using the Accused Functionality, including research and development, also work at facilities in or near Cupertino, and Culver City, Ca. (*Id.* ¶17.) [REDACTED]

[REDACTED] which is responsible for the incorporation of Bluetooth in many Accused Products. (*Id.* ¶22.)

[REDACTED] (*Id.* ¶23.) [REDACTED]

[REDACTED] (*Id.* ¶¶6, 22–23.) [REDACTED]

[REDACTED] (*Id.* ¶25.)

Similarly, [REDACTED]

[REDACTED] who works on marketing of the Accused Products using the Accused Functionality. (*Id.* ¶24.) [REDACTED]

[REDACTED] (*Id.*) [REDACTED]

[REDACTED] (*Id.* ¶24.)

[REDACTED]

[REDACTED]

[REDACTED]

(Jaynes Decl. ¶¶14, 22–23.) None of those communications was with engineers located in the EDTX. (*Id.*) Indeed, Apple has no unique, relevant sources of proof in the EDTX. Apple does not maintain any facilities or corporate offices in this District. (*Id.* ¶20.) Nor does Apple have any facilities elsewhere in Texas involved in the design, development or implementation of the Accused Functionality in the Accused Products. (*Id.* ¶21.) Apple also does not have any relevant employees in this District; nor does it maintain relevant documents in this District. (*Id.* ¶27.) While Apple had two retail stores in this District, those stores were closed on April 12, 2019, and Apple did not maintain any unique information relevant to this litigation at those stores. (*Id.*, ¶19.)

2. Plaintiff Rembrandt Has No Connection to this District

Rembrandt has not identified any relevant connection to this District. It is based in Bala Cynwyd, Pennsylvania. (Compl. 1 ¶1.) To the best of Apple’s knowledge, Rembrandt does not have any offices or employees in the District. Indeed, this Court has previously granted transfer to California in a case brought by Rembrandt entities against Apple, finding California “clearly more convenient” than this District. *Rembrandt Patent Innovations, LLC v. Apple, Inc.*, Case No. 2:14-cv-00015-JRG, Dkt. No. 88 (E.D. Tex. Oct. 27, 2014).

III. ARGUMENT

A civil action may be transferred “[f]or the convenience of parties and witnesses, in the interest[s] of justice” to “any other district or division where it might have been brought.” 28 U.S.C. § 1404(a). A party seeking transfer must show “good cause” and, if “the transferee venue is clearly more convenient,” a transfer should be ordered. *In re Volkswagen of Am., Inc.*, 545 F.3d 304, 315 (5th Cir. 2008) (*en banc*) (“*Volkswagen II*”). It is an abuse of discretion not to transfer a case to a transferee forum that is “clearly more convenient.” *Id.*; *In re TS Tech USA Corp.*, 551 F.3d 1315, 1320 (Fed. Cir. 2008).

To determine if another district is clearly more convenient, the Fifth Circuit weighs a number of private and public factors, none of which is dispositive. *In re TS Tech USA Corp.*, 551 F.3d at 1391. The private factors are: “(1) the relative ease of access to sources of proof; (2) the availability of compulsory process to secure the attendance of witnesses; (3) the cost of attendance for willing witnesses; and (4) all other practical problems that make trial easy, expeditious and inexpensive.” *Id.* The public factors are: “(1) the administrative difficulties flowing from court congestion; (2) the local interest in having localized interests decided at home; (3) the familiarity of the forum with the law that will govern the case; and (4) the avoidance of unnecessary problems of conflict of laws of the application of foreign law.” *Id.* (quoting *Volkswagen II*, 545 F.3d at 315).

A. Rembrandt Could Have Brought This Action in the Central District of California

The threshold determination for a § 1404(a) transfer analysis is whether the action could have been filed in the transferee district. *In re Horseshoe Entm’t*, 337 F.3d 429, 433 (5th Cir. 2003). “Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.” *TC Heartland LLC v. Kraft Food Grp. Brands LLC*, 137 S. Ct. 1514, 1516 (2017). Rembrandt could have sued Apple in the CDCA in this case because Apple

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has a physical place from which it steadily and uniformly conducts business in the CDCA, including facilities and offices in Culver City, Los Angeles, and Santa, Monica, Ca. *Supra* § II.A.1.

B. The Private Factors Weigh Strongly in Favor of Transfer

1. Judicial Economy—*i.e.*, Having a Single Court Manage Lawsuits Involving the Same Patents, the Same Claims, and the Same Accused Functionality—Strongly Favors Transfer

Rembrandt’s strategic decision to nearly simultaneously sue Apple, Broadcom, and Qualcomm in separate forums favors transferring the case against Apple to the CDCA. As noted above, [REDACTED]

[REDACTED] *Supra* §§ II.A.1-2. As such, the very same issues—*i.e.*, whether Broadcom’s and Qualcomm’s chips implement Bluetooth EDR in a manner that infringes the three asserted claims—are being litigated in both sets of cases. Thus, judicial economy favors transfer. *See In re Verizon Bus. Network Servs. Inc.*, 635 F.3d 559, 562 (Fed. Cir. 2011) (finding it proper to consider “co-pending litigation before the district court involving the same patent and underlying technology” in a transfer analysis); *In re Volkswagen of Am., Inc.*, 566 F.3d 1349, 1351 (Fed. Cir. 2009) (“To permit a situation in which two cases involving precisely the same issues are simultaneously pending in different District Courts leads to the wastefulness of time, energy and money that § 1404 was designed to prevent.”).

Moreover, Rembrandt is already availing itself of the CDCA to resolve its claims against Broadcom and Qualcomm and, in so doing, acknowledges that the court in that district is capable of handling these overlapping issues. It is appropriate to transfer this case to the CDCA to allow that same court to manage co-pending related cases in a coordinated manner. *See In re Morgan Stanley*, 417 F. App’x 947, 950 (Fed. Cir. 2011) (finding consolidation of cases a factor in granting transfer) (non-precedential); *see also In re Verizon*, 635 F.3d at 562; *In re Volkswagen*, 566 F.3d at 1351. This will avoid the practical difficulties stemming from having multiple courts handle

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For example, [REDACTED]

[REDACTED] (Jaynes Decl. ¶¶11–12.) For those devices incorporating a Broadcom or Qualcomm chip, the most relevant evidence will likely come directly from Broadcom and Qualcomm, both of whom are located in the CDCA and are already litigating these issues in (and therefore will likely make this evidence available to) the CDCA.

(Exs. C–F.) Indeed, [REDACTED] (Broadcom Decl. ¶7.)

[REDACTED] (*Id.* ¶¶7, 12.) In contrast, Broadcom does not have any relevant documents or anticipated witnesses in this District. (*Id.* ¶¶17–18.)

Likewise, Mr. Hall was previously involved in [REDACTED] [REDACTED] the very Bluetooth standard to which Rembrandt points in its infringement claims. (Broadcom Decl. ¶14; Ex. L) Mr. Hall is [REDACTED] and cannot be counted on to travel from his home near San Diego, Ca. to the EDTX. (Broadcom Decl. ¶14.) The same is true for Mr. Castor, a former employee of Zhone who was involved in the destruction of thousands of boxes of Paradyne records that related to, *inter alia*, conception and reduction to practice of various Paradyne inventions, licenses and agreements to Paradyne inventions, and prior art to and prior sales of Paradyne inventions. *Supra*, § II.A.3. Given Rembrandt’s allegations that Mr. Bremer conceived of the alleged inventions while employed at Paradyne (Ex. G), Mr. Castor’s testimony—and Zhone’s evidence—regarding the destruction of Paradyne documents may be highly relevant to this case. Because Mr. Castor appears to be located near San Diego, Ca. (Ex. J) and Zhone is located in Oakland, Ca. (Exs. H and I), the CDCA is far more convenient than the EDTX for these non-party witnesses as well.

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Additionally, [REDACTED]

[REDACTED] (Jaynes Decl., ¶¶6, 13, 23.) [REDACTED]

[REDACTED] (*Id.*,

¶6.) Apple witnesses who can testify to [REDACTED]

[REDACTED] are also

located in or near Cupertino, Ca., a short plane ride from the CDCA. (*Id.*, ¶¶22–24, 26; Ex. M.;

supra § II.B.1.) Specifically, Apple has identified three witnesses— [REDACTED]

[REDACTED] (Jaynes

Decl., ¶¶22–24.) It would be inconvenient for these Apple witnesses to travel to Texas for trial.

Thus, “there are a substantial number of witnesses with material and relevant information residing

in either the transferee venue or the state of California who will be unnecessarily inconvenienced

in having to travel to Texas to testify.” *In re Genentech*, 566 F.3d 1338, 1348 (Fed. Cir. 2009)

(transferring case from the EDTX to California).²

Likewise, the majority of the relevant documents will be found in California. [REDACTED]

[REDACTED] (Jaynes Decl. ¶¶6, 24–26.) Indeed, there are no relevant Apple

documents in the EDTX. (*Id.* ¶¶21, 27.) Thus, the location of documents also favors transfer.

See, e.g., In re TS Tech, 551 F.3d at 1320-21.

In contrast, Rembrandt does not appear to have *any* witnesses located in the EDTX. The

² *See also In re Acer Am. Corp.*, 626 F.3d 1252, 1255 (Fed. Cir. 2010) (transferring from Texas to California because California-based witnesses would have faced substantially increased “personal costs associated with being away from work, family, and community” “as well as losses in productivity from time spent away from work”); *In re Microsoft Corp.*, 630 F.3d 1361, 1363 (Fed. Cir. 2011) (same).

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only named inventor, Mr. Bremer, appears to reside in Florida (Ex. K) and would therefore need to travel for trial in any event. In fact, Mr. Bremer can be expected to testify no matter where the trial is located as he previously signed a consulting agreement with Rembrandt requiring him to provide “[a]ssistance with . . . patent assertion programs” in exchange for an annual fee and “a stake in any litigation involving the Zhone patents, once acquired.” *In re Rembrandt*, 899 F.3d at 1261-62, 1267. Any inconvenience in bringing him to the CDCA is mitigated by the consulting agreement he signed and is greatly outweighed by the inconvenience to Apple and third-party witnesses if the case were tried in the EDTX. *In re Nintendo*, 589 F.3d at 1198 (“[I]n a case featuring most witnesses and evidence closer to the transferee venue with few or no convenience factors favoring the venue chosen by the plaintiff, the trial court should grant a motion to transfer.”).

3. The Availability of Compulsory Process to Secure the Attendance of Witnesses Strongly Favors Transfer

As noted above, there are significant third-party witnesses located in California. Though this District can compel the deposition testimony of these witnesses, only the CDCA can compel these witnesses to testify live at trial. *See* Fed. R. Civ. P. 45; *see also Capitol Records, LLC v. BlueBeat, Inc.*, No. CV 09-8030-JFW (JCX), 2010 WL 11549413, at *2 (C.D. Cal. Mar. 16, 2010). This factor weighs heavily towards transfer. *Genentech*, 566 F.3d at 1345 (“The fact that the transferee venue is a venue with usable subpoena power here weighs in favor of transfer, **and not only slightly.**”) (emphasis added); *In re Apple, Inc.*, 581 F. App’x 886, 889 (Fed. Cir. 2014) (mandating transfer based on, *inter alia*, the availability of compulsory process over non-party witnesses) (non-precedential).

As detailed above, the suppliers of third-party chips implementing Accused Functionality in Accused Products—Broadcom and Qualcomm—are headquartered in and have multiple offices throughout California, including in the CDCA, and the [REDACTED]

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(Jaynes Decl. ¶¶22–24.) Other potentially relevant nonparty witnesses include Paul Castor, former general counsel of Zhone. *Supra*, § II.A.3. Mr. Castor is currently located in San Diego, Ca., outside the trial subpoena power of the EDTX. (Ex. J.) Likewise, Zhone itself is located in Oakland, Ca., outside the trial subpoena power of the EDTX. (Exs. H and I.) And [REDACTED]

[REDACTED] like Steven Hall, who [REDACTED] and developed EDR for Bluetooth, are in California. (Broadcom Decl. ¶14; Ex. L.) Only a California court, such as the CDCA, can compel these relevant non-parties to appear for trial.

Accordingly, given the number of key non-party witnesses who reside in California and the lack of any known witnesses in this District, this factor weighs heavily in favor of transfer.

4. Cost of Attendance for Willing Witnesses Favors Transfer

A transfer to California would substantially reduce the cost and burden of attendance at trial for party and non-party witnesses. *See Promote Innovation LLC v. Schering Corp.*, No. 2:10-cv-248-TJW, 2011 WL 665817, at *3 (E.D. Tex. Feb. 14, 2011). The convenience of these witnesses is one of the most important factors in the transfer analysis. *Genentech*, 566 F.3d at 1343; *In re Nintendo, Co.*, 589 F.3d at 1198–99 (weighing the travel burden and disruption to work and family for those who must attend trial). In assessing this factor, the Court in *Volkswagen II* instructed that, “[w]hen the distance between an existing venue for trial of a matter and a proposed venue under § 1404(a) is more than 100 miles, the factor of inconvenience to witnesses increases in direct relationship to the additional distance to be traveled.” 545 F.3d at 317 (quoting *In re Volkswagen AG*, 371 F.3d 201, 204-05 (5th Cir. 2004) (“*Volkswagen I*”).

Here, the majority of the likely trial witnesses—including Apple employees and third-party witnesses identified in this Motion—reside in California. These witnesses are a short plane or car ride from the courthouses in the CDCA (*e.g.*, 70-minute flight to Cupertino, 30 minutes by car to

Irvine), but more than 1,300 miles and at least a lengthy plane ride from, for example, the Marshall, Texas courthouse in the EDTX. (Exs. M–R.) Travel to the EDTX also imposes additional burdens beyond travel time, such as meal and lodging expenses. *See Volkswagen I*, 371 F.3d at 204–05. Thus, the cost of trial attendance for Apple and the many relevant California witnesses will be less and the ease with which they will be able to attend trial will be greater if the case is transferred.

C. Taken Together, The Public Factors Weigh in Favor of Transfer

1. California Has a Substantial Connection to and Local Interest in the Adjudication of This Case

If there are significant connections between a given venue and the events that gave rise to the suit, this factor should be weighed in favor of that venue. *See In re Hoffman-La Roche, Inc.*, 587 F.3d 1333, 1338 (Fed. Cir. 2009). This is because “[j]ury duty is a burden that ought not to be imposed upon the people of a community which has no relation to the litigation.”³ *Volkswagen I*, 371 F.3d at 206.

Here, the CDCA has significant factual connections to this case while the EDTX has none: Broadcom and Qualcomm each has a presence in the CDCA, and activity related to the allegedly infringing chips took place primarily in or around the CDCA. (Jaynes Decl. ¶¶14, 22–24; Broadcom Decl. ¶¶6, 9–10.) These connections create a strong local interest to this case because Rembrandt’s allegations call into question the “work and reputation” of these individuals. *See, e.g., In re Hoffman-La Roche*, 587 F.3d at 1336 (local interest strong if case “calls into question the work and reputation of several individuals residing in or near that district”). In contrast, the EDTX has no factual connection to this case. Thus, this factor heavily weighs in favor of transfer. *See In re TS Tech*, 551 F.3d at 1321 (finding that the local interest factor favored the transferee

³ The sale of the accused product in the transferor district is not considered a local interest of that district because this “rationale could apply virtually to any judicial district or division in the United States” and the interest is not unique to any venue. *Volkswagen II*, 545 F.3d at 318.

venue when “the vast majority of identified witnesses, evidence, and events leading to [the] case” were located in and around that venue).

2. The Administrative Difficulties Flowing From Court Congestion is Neutral

The CDCA and EDTX are both busy districts. The 2018 Federal Court Management Statistics show the CDCA as faster than the EDTX from filing to disposition for civil cases (5.1 months versus 8.0 months) and the EDTX has a slightly faster time to trial (19 months versus 21.5 months). (Exs. S and T.) Both districts have detailed local patent rules and scheduling orders to avoid congestion and keep patent actions on track. And, in any event, “when, as here, several relevant factors weigh in favor of transfer and others are neutral, then the speed of the transferee district court should not alone outweigh all of those factors.” *Genentech*, 566 F.3d at 1347.

3. The Familiarity of the Forum With the Law That Will Govern This Case and the Avoidance of Unnecessary Problems of Conflicts of Law Are Neutral Factors

The third and fourth public interest factors are both neutral here. This is a patent infringement case governed by federal law, so both districts are familiar with the law that will govern this case. *See In re Link_A_Media Devices Corp.*, 662 F.3d 1221, 1224 (Fed. Cir. 2011).

D. Rembrandt’s Choice of EDTX for this Litigation Merits Little Weight

A plaintiff’s choice of venue is *not* a factor in the transfer analysis. *See Volkswagen II*, 545 F.3d at 315. Likewise, the Fifth Circuit does not give special weight to the plaintiff’s choice of venue where it has no relationship to the parties or the case. *Nintendo*, 589 F.3d at 1200. Here, Rembrandt’s decision to sue Apple in the EDTX is entitled to little weight, particularly in view of its strategic decision to concurrently sue Apple’s third-party Bluetooth vendors in the CDCA.

IV. CONCLUSION

For the foregoing reasons, Defendant Apple respectfully requests that this Court transfer this action to the Central District of California pursuant to 28 U.S.C. § 1404(a).

Dated: May 22, 2019

Respectfully submitted,

By: /s/ Melissa R. Smith

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**COUNSEL FOR DEFENDANT
APPLE INC.**

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on May 22, 2019, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ Melissa R. Smith _____

Melissa R. Smith

[REDACTED]

[REDACTED]

CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that counsel for Apple has complied with the meet and confer requirement in Local Rule CV-7(h). This motion is opposed. The personal conference required by Local Rule CV-7(h) was conducted on May 17, 2019 via telephone conference. No agreement could be reached because the parties disagreed on the merits. Discussions have conclusively ended in an impasse, leaving an open issue for the court to resolve.

/s/ Melissa R. Smith

Melissa R. Smith

Rembrandt Wireless

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Apple Inc. v. Rembrandt Wireless Technologies, LP, IPR2020-00034

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 2:19-CV-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED



**DECLARATION OF MICHAEL JAYNES IN SUPPORT OF
DEFENDANT APPLE INC.'S MOTION TO TRANSFER VENUE**

Rembrandt Wireless
Ex. 2010

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED

**DECLARATION OF MICHAEL JAYNES IN SUPPORT OF
DEFENDANT APPLE INC.'S MOTION TO TRANSFER VENUE**

I, Michael Jaynes, hereby declare and state as follows:

1. I am over 18 years of age and competent to make this declaration. If called to testify as a witness in this matter, I could and would testify truthfully to each of the statements in this declaration.

2. I am employed as a Senior Finance Manager at Apple Inc. ("Apple") in Sunnyvale, California. I have been employed by Apple since January 2015.

3. I provide this declaration in support of Apple's Motion to Transfer Venue Under 28 U.S.C. § 1404(a) to the Central District of California ("CDCA") filed in the above-captioned case. Unless otherwise indicated below, the statements in this declaration are based upon my personal knowledge, my review of corporate records maintained by Apple in the ordinary course of business, and/or my discussions with Apple employees. If called to testify as a witness, I could and would competently do so under oath.

4. I understand that the Central District of California includes San Luis Obispo, Santa Barbara, Ventura, Los Angeles, Orange, San Bernardino, and Riverside Counties.

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5. Apple is a California corporation and was founded in 1976. Apple is a global business headquartered in Cupertino, California.

6. Apple's management and primary research and development, and marketing facilities are located in or near Cupertino, California, including surrounding cities such as Sunnyvale. The primary operation, marketing, sales, and finance decisions for Apple also occur in or near Cupertino, and Apple business records related to product revenue are located there. As of May 2019, Apple has more than 30,000 employees who work in or near its Cupertino headquarters. Apple also has facilities located in Culver City, Los Angeles, and Santa Monica, which are within the CDCA. Apple acquired Beats Electronics in 2014 and [REDACTED]

[REDACTED]

[REDACTED]

7. I understand that Rembrandt Wireless Technologies, LP ("Rembrandt") filed the above captioned patent infringement lawsuit against Apple in the United States District Court for the Eastern District of Texas ("EDTX"). I understand in the Complaint filed in the above captioned lawsuit, Rembrandt identified the following products as allegedly infringing two United States patents identified in the Complaint: iPhone XR; iPhone XS; iPhone XS Max; iPhone X; iPhone 8, iPhone 8 Plus; iPhone 7; iPhone 7 Plus; iPhone SE; iPhone 6; iPhone 6 Plus; iPhone 5; iPhone 5S; iPhone 5C; iPhone 4; iPhone 4S; iPhone 3G; iPhone 3GS; iPad Pro (3rd Generation); iPad (2018); iPad Pro (2nd Generation, 10.5" and 12.9"); iPad (2017); iPad Pro (1st Generation, 9.7" and 12.9"); iPad Air 2; iPad Air; iPad 4th Generation; iPad 3rd Generation; iPad 2; iPad; iPad mini 4; iPad mini 3; iPad mini 2; iPad mini; iPod Touch 6th Generation; iPod Touch 5th Generation; iPod Touch 4th Generation; iPod Touch 3rd Generation; iPod Touch 2nd Generation; iPod Nano 7th Generation; Apple Watch, Series 4; Apple Watch Series 3; Apple

Watch Nike+; Apple Watch Hermes; Apple Watch Series 2; Apple Watch Series 1; Apple TV 5th Generation; Apple TV 4th Generation; Apple TV 3rd Generation; Apple TV 2nd Generation; Apple TV 4K; AirPort Extreme; MacBook; MacBook Pro; MacBook Air; iMac Pro; Mac Mini; iMac; Mac Pro; Beats Solo2 Wireless Headphones; Beats Studio Wireless Headphones; Beats PowerBeats3 Wireless In-Ear Headphones; Beats PowerBeats2 Wireless In-Ear Headphones; Air Pods; Beats Pill+ Wireless Speaker; Beats Pill Wireless Speaker; Beats Pill XL Wireless Speaker; Beats Studio3 Wireless; Beats Solo3 Wireless Headphones; BeatsX Earphones; Powerbeats3 Wireless Earphones; and Home Pod (the “Accused Products”). Dkt. 1, ¶¶ 28-30, 36-37.

8. I understand from the Complaint that Rembrandt alleges that the Accused Products infringe U.S. Patent Nos. 8,457,228 (“the ’228 patent”) and 8,023,580 (“the ’580 patent”) based on Rembrandt’s assertions that the Accused Products “support one or more of the Bluetooth EDR Specifications” and “practic[e] any of the following Bluetooth specifications that support Enhanced Data Rate (“EDR”): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5.” Dkt. 1, ¶ 28. Thus, it is my understanding from the Complaint that Rembrandt alleges that the Accused Products infringe certain patents due to certain Bluetooth EDR technology (“Accused Functionality”).

9. I understand that Rembrandt filed suit against Broadcom in the CDCA alleging infringement of the same two patents (the ’228 patent and the ’580 patent) based on Rembrandt’s identical assertions that Broadcom’s chips “support one or more of the Bluetooth EDR Specifications” and “practice[e] any of the following Bluetooth specifications that support Enhanced Data Rate (“EDR”): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5.” Case No. 8:19-cv-00708, Dkt. 1

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(“Broadcom Compl.”), ¶ 28. Moreover, I understand that Rembrandt explicitly accuses all of Broadcom’s “devices that use or permit use of Bluetooth EDR.” Broadcom Compl., ¶ 29.

10. I understand that Rembrandt also filed suit against Qualcomm in the CDCA alleging infringement of the same two patents based on Rembrandt’s identical assertions that Qualcomm’s chips “support one or more of the Bluetooth EDR Specifications” and “practice[e] any of the following Bluetooth specifications that support Enhanced Data Rate (“EDR”): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5.” Case No. 8:19-cv-00705, Dkt. 1 (“Qualcomm Compl.”), ¶ 27. Moreover, I understand that Rembrandt explicitly accuses all of Qualcomm’s “devices that use or permit use of Bluetooth EDR.” Qualcomm Compl., ¶ 29.

11. To the best of my knowledge after a reasonable investigation, the functionality relating to Bluetooth EDR [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

12. Additional Accused Products, [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

13. [REDACTED]
[REDACTED]

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[REDACTED]

[REDACTED]

14. I have been informed and understand the following: Based on Apple's current understanding of Rembrandt's infringement allegations, and to the extent Apple employees have been or are engaged in work relating to the Accused Functionality, their work [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] After reasonable investigation, I am not aware of any work related to the Accused Functionality that takes place in Texas.

15. Apple sells or has sold the Accused Products throughout the United States.

16. The primary research, design, development activities, facilities and engineers for the Accused Products are located in or near Cupertino and Culver City, California, and Apple records related to the research and design of the Accused Products are located there.

17. Apple's employees knowledgeable about the relevant design and operation of the Accused Products, including their research and development, work at facilities in or near Cupertino and Culver City, California.

18. As of the date of this declaration, Apple operates over 270 retail stores in the United States, more than 50 of which are in California, including 24 retail stores in CDCA.

19. Apple had two retail stores in EDTX, one in Plano and one in Frisco, Texas. Both stores were closed on April 12, 2019. After a reasonable investigation, I am not aware of Apple maintaining any unique information relevant to this case at those stores. After reasonable investigation, I am not aware of any employee in the EDTX who was ever involved in the

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research, design, development, or marketing of the Accused Functionality. To the extent that any of the Accused Products are or were sold or used in the EDTX, they are and were sold and used nationwide, and are not used in any manner or degree differently than they are used elsewhere.

20. Aside from the two retail stores that have closed, Apple has not otherwise maintained any facilities or corporate offices in the EDTX.

21. Apple has non-retail offices outside of the EDTX in Austin and Lockhart, Texas (the Western District of Texas) and Dallas and Garland, Texas (the Northern District of Texas). To the best of my knowledge and after a reasonable investigation, no employees in these offices have responsibilities for the design, development or implementation of the Accused Functionality based on Apple's current understanding of Rembrandt's infringement contentions or are likely to have unique documents or information relevant to this case.

■ [REDACTED]

[REDACTED]

[REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

■ [REDACTED]

[REDACTED]

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[REDACTED]

25. Based on my communications with the individuals identified above, technical documents in the possession, custody or control of Apple concerning the Accused Functionality in the United States are located in or near Cupertino and Culver City, California.

26. I am knowledgeable about Apple's sales and financial information concerning the Accused Products. Sales and financial documents in the possession, custody or control of Apple for the Accused Products are located in or near Cupertino, California. I work and live in the Bay Area, California.

27. After reasonable investigation, I am not aware of any relevant documents or anticipated witnesses of Apple located in the EDTX.

28. To my knowledge, after reasonable investigation, Apple does not have any employees in the EDTX with any unique information relevant to this case.

I declare under the penalty of perjury that the foregoing is true and correct to the best of my knowledge and that this declaration was executed this 20th day of May, 2019, in Sunnyvale, California.



Michael Jaynes

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 2:19-CV-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED



**DECLARATION OF BURHAN MASOOD IN SUPPORT OF
DEFENDANT APPLE INC.'S MOTION TO TRANSFER VENUE**

Rembrandt Wireless
Ex. 2010

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED

**DECLARATION OF BURHAN MASOOD IN SUPPORT OF
DEFENDANT APPLE INC.'S MOTION TO TRANSFER VENUE**

I, Burhan Masood, hereby declare as follows:

1. I am over 18 years of age and competent to make this declaration. If called to testify as a witness in this matter, I would testify truthfully under oath as to each of the statements in this declaration.
2. I am employed as an Engineer Program Manager 6 at Broadcom Corp. ("Broadcom") in Irvine, California. I have been employed by Broadcom and its predecessors since May 23, 2002.
3. I provide this declaration in support of Defendant Apple Inc.'s Motion to Transfer Venue Under 28 U.S.C. § 1404(a) to Central District of California filed in the above-captioned case. Unless otherwise indicated below, the statements in this declaration are based upon my personal knowledge, my review of corporate records maintained by Broadcom in the ordinary course of business, and/or information that I believe to be true after a reasonable investigation.

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4. I understand that the Central District of California includes San Luis Obispo, Santa Barbara, Ventura, Los Angeles, Orange, San Bernardino, and Riverside Counties.

5. Broadcom's headquarters is located in San Jose, California.

6. Broadcom has one large facility in Irvine, California in the Central District of California.

7. As of May 1, 2019, [REDACTED]

8. Defendant Apple Inc. ("Apple") sells products that contain Broadcom semiconductor chips [REDACTED]. I understand from the Complaint in this action that the plaintiff alleges that certain Apple products – products that contain Broadcom chips – infringe U.S. Patent Nos. 8,457,228 ("the '228 patent") and 8,023,580 ("the '580 patent"). In particular, plaintiff alleges that products that "support one or more of the Bluetooth EDR Specifications" and "practic[e] any of the following Bluetooth specifications that support Enhanced Data Rate ("EDR"): Version 2.0 + EDR, Version 2.1 + EDR, Version 3.0 + HS, Version 4.0 + LE, Version 4.1, Version 4.2, or version 5" (the "Bluetooth Accused Technology") infringe the asserted patents.

9. I have reviewed the list of Apple products identified in the Complaint. Many of those products contain Broadcom chips that provide Bluetooth Accused Technology. [REDACTED]

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10. [REDACTED]
[REDACTED]
[REDACTED]

11. [REDACTED]
[REDACTED]

12. [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

13. [REDACTED]
[REDACTED]
[REDACTED]

14. Steven Hall is [REDACTED]
[REDACTED]

[REDACTED] Upon information and belief, Mr. Hall is currently located in the San Diego, California area.

15. Within the United States, [REDACTED]
[REDACTED]
[REDACTED]

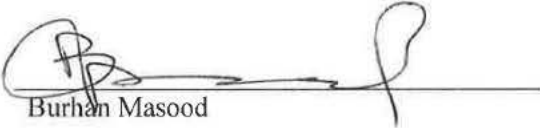
16. To the extent Broadcom is required to produce any witness in connection with this litigation, such witnesses would most likely be located in or near the Central District of California.

17. I am not aware of any relevant documents or anticipated witnesses of Broadcom located in Texas.

18. To my knowledge, Broadcom does not have any employees in Texas with any unique information relevant to this case.

I declare under the penalty of perjury that the foregoing is true and correct.

This declaration was executed this 19 day of May, 2019, in Irvine, California.


Burhan Masood

Case 2:19-cv-00025-JRG Document 31-9 Filed 05/22/19 Page 1 of 3 PageID #: 275

EXHIBIT H



Locations

DASAN Zhone Solutions, Inc. Corporate Headquarters

Corporate Headquarters

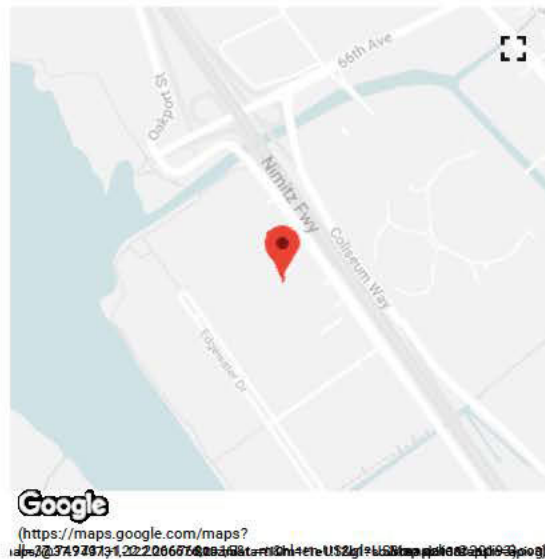
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EMAIL (/CONTACT/?E

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Europe	▼
Middle East, Africa & Pakistan	▼
Asia / Pacific Region	▼
Korea Corporate Headquarters / R&D Center	▼



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Case 2:19-cv-00025-JRG Document 31-11 Filed 05/22/19 Page 1 of 2 PageID #: 282

EXHIBIT J

Contact

www.linkedin.com/in/castor
(LinkedIn)

Top Skills

- Mergers
- Corporate Governance
- Joint Ventures

Paul Castor

Vice President - Chief Corporate Counsel at ViaSat, Inc.
Greater San Diego Area

Summary

- Specialties: • Mergers & Acquisitions
- Corporate Governance
 - SEC Reporting

Experience

ViaSat, Inc.
Vice President - Chief Corporate Counsel
November 2007 - Present

Zhone Technologies, Inc.
General Counsel
April 2004 - October 2007 (3 years 7 months)

Rutan & Tucker
Corporate Attorney
July 2002 - March 2004 (1 year 9 months)

Wilson Sonsini Goodrich & Rosati
Corporate Attorney
February 1999 - July 2002 (3 years 6 months)

Cadden, Fuller & Burkhalter
Attorney
December 1997 - February 1999 (1 year 3 months)
Irvine, CA

Education

University of California, Davis - School of Law

UC Irvine

Case 2:19-cv-00025-JRG Document 31-13 Filed 05/22/19 Page 1 of 20 PageID #: 286

EXHIBIT L

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Bluetooth SIG
Radio Working Group

Radio 1.0 Improvements:
Medium Rate Baseband Specification
proposal for version 0.7

Team BT1-MED

Version 0.665
2002-0107-0514

Prime Contact: Arto Palin (BT1-MED Team Leader)
Email: arto.palin@nokia.com

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Bluetooth Special Interest Group (SIG)

The following Promoter Companies are representatives in the Bluetooth Special Interest Group:

- Ericsson Technology Licensing AB *
- IBM Corporation *
- Intel Corporation *
- Nokia Corporation *
- Toshiba Corporation *
- 3Com Corporation *
- Agere Systems Inc *
- Microsoft Corporation *
- Motorola Inc *

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Revision History

Revision	Date	Comments
0.05	2001-12-21	First draft
0.10	2002-01-04	minor editions
0.20	2002-01-14	Working group review feedback, Version 0.5 proposal
0.21	2002-05-13	Working group feedback from San Diego Face to Face
0.22	2002-05-21	Changes to packet type table (SCO with MED as a one column)
0.23	2002-06-01	Removal of power definition in 4.4.1. Some edits regarding ptt
0.65	2002-07-04	Updates according to F2F and CC (3.7.) discussion
0.66	2002-08-09	Updates according to 8.8.2002 CC
0.67	2002-09-05	Modified synchronization sequence test for clarity

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LIST OF ABBREVIATIONS

AM_ADDR	Active Member Address
ARQ	Automatic Repeat Request
CRC	Cyclic Redundancy Check
DBPSK	Differential Binary Phase Shift Keying
DQPSK	Differential Quadrature Phase Shift Keying
FEC	Forward Error Correction
FH	Frequency Hopping
GFSK	Gaussian Frequency Shift Keying
HEC	Header Error Check
PSK	Phase Shift Keying
RF	Radio Frequency
8-DPSK	8-ary Differential Phase Shift Keying

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SCOPE

This document is the Medium Rate Baseband specification (~~version 0.5~~)-proposal for version 0.7.

It is envisioned that the final version (v1.0) of the Medium Rate Baseband specification will be text additions and modification of text in the Bluetooth 1.2 core specification - Part B. Until the status of v0.7 is reached the specification will be handled as a separate document. After reaching the v0.7 status the Medium Rate Baseband specification will be transferred into change requests (CR).

In referencing the features of the current Bluetooth 1.1 Specification [1] [2] the term BT1.1 is used and for the new version of the specification references to the basic 1 Mbps GFSK version of Bluetooth the term “basic rate” is used.

The following document sections are organized to parallel the section of the Bluetooth 1.1 Baseband Specification. The numbering in section 4 is modified by the addition of the subsection on Guard Time and Synchronization Sequence, which is unique to medium rate.

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1. GENERAL DESCRIPTION

The medium rate mode provides a straightforward extension of the Bluetooth specification by adding additional packet types. Medium rate provides a two-fold and optionally a three-fold increase in the data rate during the payload portion of certain packet types. Rather than generalize all the existing packet types or features in BT1.1 the additions were limited to be those with most benefit. The guiding principle was to minimize the complexity of Medium Rate.

A robust PSK scheme has been chosen to simplify the hardware integration of medium rate in the Bluetooth radios, addressing the low cost aspect. Narrow-band modulation, with RF channels of 1 MHz (3 dB bandwidth) has been chosen to be similar to the 1 MHz channel of BT1.1. Depending on propagation conditions, $\pi/4$ -DQPSK or 8DPSK can be applied with corresponding asymmetric ACL user data rates of up to 1.45 Mbps or 2.18 Mbps. For all of the medium rate packet types the user data rate is effectively 2x or 3x of the basic rate equivalents. Link adaptation can be applied to provide a link more resilient to errors at the expense of reduced user rate. Details of the RF layer are specified in the Medium Rate RF Specification [3].

Whether or not a device is capable of supporting medium rate is indicated in the *LMP_features* message. A medium rate capable device may support the 2Mbps mode only or both 2Mbps and 3Mbps. The master can enable the use of medium rate on ACL and/or SCO links separately for each of the medium rate capable slaves in the piconet.

Medium rate is an optional feature that can be used to complement the basic rate operation of a piconet (BT1.1) or in combination with the new Radio1 Improvements (BT1.2). Medium rate can also be used to complement high rate by augmenting the data rate and generalized SCO options of the FH piconet thereby allowing a large percentage of real time to be available in master or slaves for high rate subnet activities.

2. PHYSICAL CHANNEL

2.1. FREQUENCY BAND AND RF CHANNELS

Same as defined for basic rate.

2.2. CHANNEL DEFINITION

Same as defined for basic rate.

Note: If adaptive frequency hopping is to be applied to basic rate in future it would apply to medium rate in the same manner.

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2.3. TIME SLOTS

Same as defined for basic rate.

2.4. MODULATION AND BIT RATE

Medium rate has the same symbol rate as basic rate, namely 1 Ms/s. The payload modulation is either $\pi/4$ -DQPSK or 8DPSK corresponding to the gross bit rates of 2 Mbps or 3 Mbps.

3. PHYSICAL LINKS

--

4. PACKETS

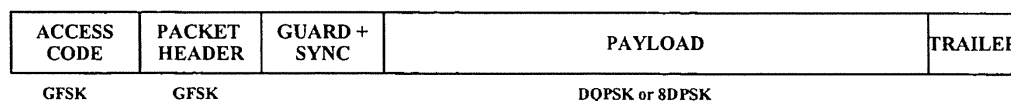
4.1. GENERAL FORMAT

The general format of the medium rate packet is shown in *Figure 1*. These are very similar to the basic rate packets. The maximum modulo-lengths (modulo the 625 usec slot grid) are no greater than the longest basic rate packet plus two microseconds (DM3 + two symbols)¹⁾²⁾. The access code and packet header are identical in format and modulation so that the acquisition and packet identification is the same as basic rate. The main difference in the formats when compared to the basic rate packets is the addition of the guard time and synchronization sequence following the packet header. The guard time allows for settling and switching in the hardware during the transition from one modulation scheme to the other. Following the guard time is a PSK-modulated synchronization sequence that is used to complete acquisition prior to demodulating the $\pi/4$ -DQPSK or 8DPSK of the payload. Following the payload and CRC (if present) there are also two trailer symbols.

There may or may not be a CRC at the end of the packet depending on the packet type.

Note 1): In case medium rate plus the robust SCO feature - which is adding a 16 bit CRC to the HV packet types - are concurrently supported, the 2-HV3 MED packet + eSCO exceeds the longest 1Mbps basic rate packet by 8usec

Note 2): With the addition of two microseconds of trailer symbols.



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Figure 1: medium rate packet format

4.2. ACCESS CODE

Same as defined for basic rate.

4.3. PACKET HEADER

The format of the packet header is the same as applied to basic rate packets. If there is an extended header (BT1.2 optional feature) this will follow the normal packet header and will also be in triple-repeat GFSK modulation. The normal, 54 usec duration of the packet header would be increased by the presence of the extended header.

The contents of the packet header for medium rate packets have two additional rules.

1. When the slave has multiple logical links based on AM_ADDRs using the header extension option, the master must choose the associated AM_ADDRs such that the base AM_ADDR (along with the TYPE field) uniquely defines whether the packet is in medium rate or not.
2. The meaning of the TYPE field is modified if the link is operating in medium rate. The options for this redefinition are explained in section 4.5.

4.4. GUARD TIME AND SYNCHRONIZATION SEQUENCE

Following the packet header medium rate packets have a guard time and synchronization sequence. Guard time and a synchronization sequence do not apply for the 1Mbps packet types.

4.4.1. Guard time

The guard time must not exceed 65 usec. The signal transmitted during the guard time must comply with the spectral requirements of the specifications

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4.4.2. Synchronization Sequence

The symbol timing at the start of the synchronization sequence must be within ¼ usec of the symbol timing of the last GFSK symbol of the BT1.1 header.

The synchronization sequence is identical for both $\pi/4$ -DQPSK and 8DPSK modulations.

The minimum length of the synchronization sequence must be 110usec (110 PSK symbols), and its content is identical for both $\pi/4$ -DQPSK and 8DPSK modulations. The synchronization sequence consists of a reference symbol (with arbitrary phase) followed by ten differential PSK symbols. The phase changes between the symbols (shown in Figure 2) are defined as: The following 10-symbol sequence, defined via the phase changes ϕ_k , must be used:

$$\{\phi_1, \phi_2, \phi_3, \phi_4, \phi_5, \phi_6, \phi_7, \phi_8, \phi_9, \phi_{10}\} = \{3\pi/4, -3\pi/4, 3\pi/4, -3\pi/4, 3\pi/4, -3\pi/4, -3\pi/4, 3\pi/4, 3\pi/4, 3\pi/4\}$$

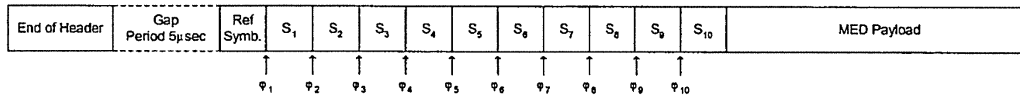


Figure 2: Synchronization Sequence

ϕ_1 is the phase change between the reference symbol and the first PSK symbol S₁. ϕ_k is the phase change between the k-1th symbol S_{k-1} and the kth symbol S_k

*Confidential Bluetooth SIG***4.5. PACKET TYPES**

Segment	TYPE code b ₃ b ₂ b ₁ b ₀	Slots	SCO link (1 Mbps)	SCO link (2/3 Mbps)	ACL link (1 Mbps) [ptt=0]	ACL link (2/3 Mbps) [ptt =1]
1	0000	1	NULL	NULL	NULL	NULL
	0001	1	POLL	POLL	POLL	POLL
	0010	1	FHS	FHS	FHS	FHS
	0011	1	DM1	DM1	DM1	DM1
2	0100	1	Undefined	Undefined	DH1	2-DH1
	0101	1	HV1	Reserved	Undefined	Undefined
	0110	1	HV2	2-HV3	Undefined	Undefined
	0111	1	HV3	3-HV3	Undefined	Undefined
	1000	1	DV	Undefined	Undefined	3-DH1
	1001	1	Undefined	Undefined	AUX1	AUX1
3	1010	3	Undefined	Undefined	DM3	2-DH3
	1011	3	Undefined	Undefined	DH3	3-DH3
	1100	3	HV4	2-HV5	Undefined	Undefined
	1101	3	HV5	3-HV5	Undefined	Undefined
4	1110	5	Undefined	Undefined	DM5	2-DH5
	1111	5	Undefined	Undefined	DH5	3-DH5

Table 4-1 – Replacement for Table 4.2

The access code and packet header (including optional extended packet header) are always transmitted at 1 Mbps (GFSK modulation scheme). The packet types contained in Segment 1 of the table (NULL, POLL, FHS and DM1) are always transmitted in 1Mbps. Segments 2, 3 and 4 may be transmitted either in 1Mbps, 2Mbps or 3Mbps over the air rates as configured through LMP commands. LMP messages shall always be sent using the DM1 packet type in 1 Mbps mode (even when medium rate is used for the other ACL packet types).

The selection of the packet type column in *Table 4-1 – Replacement for Table 4.2* is done independently for every base AM_ADDR a device is listening to. Also modes for ACL and SCO are selected independently. For ACL links the medium rate mode is explicitly selected via LMP using the *packet_type_table* (ptt) parameter.

For SCO links the medium rate mode is selected when the SCO link is established via LMP command.

The AUX1 packet will always be transmitted in 1Mbps.

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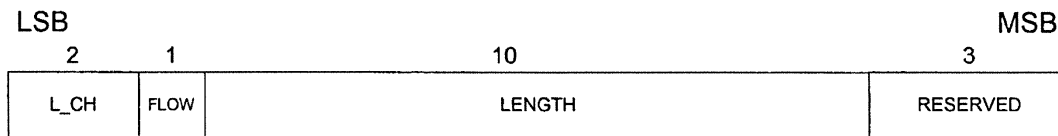
Note: Unused packet type codes are referred to as either "Undefined" or "Reserved". The "Undefined" entries represent cases where the code is not used. For example when a code is allocated to SCO it is not reused in an ACL link. This ensures that when these are intermixed on a given physical link the receiver can unambiguously determine the intended format. The "Reserved" entries represent cases where the packet type in the medium rate columns is available for future packet type definition. As can be seen from the PTT column for ACL in medium rate the packet type code used in BT1.1 for DV has been taken over to represent one of the 1 slot medium rate packet types. The Radio1 Improvements subgroup plans to recommend that the DV packet type will not be sent by any BT1.2 device (TBR). Devices will still receive the DV packet from legacy units during an HV1 connection. The DV packet type has marginal value in any context. It is intended for optional use in combination with HV1. The HV1 link consumes the entire radio channel. To send LMP packets during an HV1 connection the SCO can be interrupted by sending a DM1 packet in the SCO slot or alternatively if the LMP packet is short enough to fit into the data portion of the DV packet the HV1 can be replaced with a DV packet. In both cases there will be a potential degradation in audio quality. Using the DM1 will eliminate 1.5 msec of the CVSD data stream and using the DV will degrade the robustness of the CVSD by removing the triple repeat coding.

Even if the Radio1 Improvements recommendation to stop using the DV packet is not accepted, reusing this code for medium rate ACL is not a problem. The use of DV packets can always be prohibited when medium rate has been activated for ACL links. Further, if a 1 Mbps HV1 connection is active it does not appear to be a logical inconsistency to assume that ACL in medium rate will not be used, as there is no capacity left for any ACL traffic anyway.

The AUX1 packet type is shown here as always being sent in GFSK both in the basic rate (1 Mbps) and medium rate ACL packet type columns. This is subject to review with PAN-IPS with respect to the use of AUX1 in scattermode signaling.

4.6. PAYLOAD FORMAT

All medium rate ACL packets shall use the medium rate, 2 byte payload header.



Payload header format for medium rate packets

Note: The length fields in the payload headers for medium rate packets must be increased to handle the increased byte counts possible in these packets. At least one additional bit must be added to the multi-slot packet type payload header and at least two additional bits must be added to the single slot packet type payload header. A single format is proposed for all medium rate packets.

*Confidential Bluetooth SIG***4.7. PACKET SUMMARY**

Type	Payload Header (bytes)	User Payload (bytes)	FEC	CRC	Symmetric Max Rate (kb/s)	Asymmetric Max Rate (kb/s)	
						Forward	Reverse
DM1	1	0-17	2/3	Yes	108.8	108.8	108.8
DH1	1	0-27	No	Yes	172.8	172.8	172.8
DM3	2	0-121	2/3	Yes	258.1	387.2	54.4
DH3	2	0-183	No	Yes	390.4	585.6	86.4
DM5	2	0-224	2/3	Yes	286.7	477.8	36.3
DH5	2	0-339	No	Yes	433.9	723.2	57.6
AUX1	1	0-29	Optional	Optional	185.6	185.6	185.6
2-DH1	2	0-54	No	Yes	345.6	345.6	345.6
2-DH3	2	0-367	No	Yes	782.9	1174.4	172.8
2-DH5	2	0-679	No	Yes	869.1	1448.5	115.2
3-DH1	2	0-83	No	Yes	531.2	531.2	531.2
3-DH3	2	0-552	No	Yes	1177.6	1766.4	265.6
3-DH5	2	0-1021	No	Yes	1306.9	2178.1	177.1

Table 4-2 – Replacement for Table 4.10

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Type	Payload Header (bytes)	User Payload (bytes)	FEC	CRC	Symmetric Max Rate (kb/s)
HV1	N/A	10	1/3	No	64.0
HV2	N/A	20	2/3	No	64.0
HV3	N/A	30	N	Optional ¹	64.0
HV4 ²	N/A	120	2/3	Optional ¹	256.0
HV5 ²	N/A	180	N	Optional ¹	384.0
DV	1	10 + (0-9D)	2/3	Yes D	64.0 + 57.6D
2-HV3	N/A	60	N	Optional ¹	128.0
2-HV5 ²	N/A	360	N	Optional ¹	768.0
3-HV3	N/A	90	N	Optional ¹	192.0
3-HV5 ²	N/A	540	N	Optional ¹	1152.0

Table 4-3 – Replacement for Table 4.11

- 1) Note that a CRC on all of the HV3, HV4 and HV5 packet types for basic and medium rate has been proposed as part of generalized SCO enhancements.
- 2) The HV4 and HV5 packet types have been proposed by the SPE team.

4.8. TRAILER

After the payload two symbols trailer part will be added. The trailer bits will be all zero, i.e. {00, 00} for the $\pi/4$ -DQPSK and {000, 000} for the 8DPSK. The trailer symbols are used for receiver matched filter, without the trailing the last symbol would be distorted.

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5. ERROR CONTROL

Forward error correction (FEC) would provide limited benefit in medium rate. Given that the purpose of medium rate is to provide higher data rates and/or lower duty cycle over the radio link it is counterproductive to use FEC. If a medium rate packet type does not deliver adequate radio link performance a lower data rate option can be used.

Error detection for ACL and the enhanced SCO packets that use a CRC with the same 16 bit CRC that is used in basic rate. When there is a CRC on the packet a retransmit scheme can be used just as it is defined in basic rate.

5.1. FEC CODE: RATE 1/3

The rate 1/3 FEC is not used in medium rate.

5.2. FEC CODE: RATE 2/3

The rate 2/3 FEC is not used in medium rate.

Note: The rate 2/3 FEC does not correct 2 or more errors in a code word and because error pairing is more prevalent than for randomly distributed errors, there is less benefit provided by the rate 2/3 FEC than might be expected. Further the uncoded 2Mbps $\pi/4$ -DQPSK modulation scheme provides performance comparable to the uncoded 1Mbps GFSK. If the 3 Mbps uncoded performance is not adequate, the 2 Mbps format can be used since it will yield comparable performance to 3 Mbps with FEC and the same net data rate.

5.3. ARQ SCHEME

Same as defined for basic rate.

5.4. ERROR CHECKING

Same as defined for basic rate.

6. LOGICAL CHANNELS

Broadcast packets are sent on AM_ADDR = 0 and would always be sent in 1 Mbps.

LMP packets are sent via DM1 packets at 1 Mbps.

When an SCO link is being established the LMP commands define the parameters of the connection including modulation. Thus at the time of setting up any SCO connection the selection of 1, 2 or 3 Mbps rate is made.

For ACL links the mode selection can be left to real time packet type selections. The proposed packet type table (PTT) in section 4.5 allows the selection of basic rate or medium for each of the packet type codes. ACL traffic over this given physical or logical link would utilize the packet types in the given column of Table 4-1 – Replacement for Table 4.2.

Note: Multicast traffic as defined in the Radio1-Improvements will be sent on a separate logical channel (unique AM_ADDR). Since multicast traffic might have to be sent at 1 Mbps because of legacy slaves or other constraints, the AM_ADDR might be the only indication that a packet is in basic rate versus medium rate. As noted in section 4.3 the choice of AM_ADDR for such a logical channel is constrained.

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By restricting the signaling of the modulation scheme to the first two fields of the original packet header, the receiver is allowed to perform adequate switching (filters, demodulator etc.) within more than 30us (between the end of the TYPE field and the start of the guard and synchronization time). A guard time for receiver switching in the order of tens of usec is needed to allow for efficient receiver implementations.

7. DATA WHITENING

The whitening of packet headers for medium rate packets is the same as used in BT1.1.

No whitening is applied to the transmissions in the guard, ~~or~~ synchronization and trailer portion of the medium rate packets. ~~(What about the trailer?)~~

The packet header and the payload portion of medium rate packets are whitened as in BT1.1 by effectively pausing the LFSR during the guard and synchronization period. After the pause the LFSR will continue the operation starting with the phase where it was before pause.

8. TRANSMIT/RECEIVE ROUTINES

Same as defined for basic rate.

9. TRANSMIT/RECEIVE TIMING

Same as defined for basic rate.

10.CHANNEL CONTROL

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10.1. SCOPE

--

10.2. MASTER-SLAVE DEFINITION

--

10.3. BLUETOOTH CLOCK

--

10.4. OVERVIEW OF STATES

--

10.5. STANDBY STATE

--

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10.6. ACCESS PROCEDURES

--

10.7. INQUIRY PROCEDURES

--

10.8. CONNECTION STATE

--

10.9. MEDIUM RATE

Medium rate is enabled on ACL links by the selection of a packet type table (PTT) that defines the parameters of each packet type code. There are separate PTTs for ACL links over each physical (unicast, multicast or broadcast) connection. A PTT is effectively an index or pointer to the desired column in *Table 4-1 – Replacement for Table 4.2*.

The baseline packet type table is defined in BT 1.1. The new packet type options utilize combinations of the 1, 2 and 3 Mbps packet types. Other packet type tables may be defined in the future.

The upper TBD values of the PTT index are available for proprietary uses (TBR).

For SCO links medium rate is selected when the link is established.

10.10. SCATTERNET

Scatternet has no direct impact on medium rate or vice versa.

10.11. POWER MANAGEMENT

Medium rate provides power saving because of the ability to send a given amount of data in either fewer packets or with the same (or similar) number of packets but with shorter payloads.

The Bluetooth power saving modes such as park or sniff are unchanged when medium rate is used. The establishment and execution of park and sniff mode are based on LMP messages, which are unchanged by medium rate.

*Confidential Bluetooth SIG***10.12. LINK SUPERVISION**

Link supervision is unaffected by the use of medium rate. The criteria for resetting the link supervision timer are based solely on packet detection, HEC check and AM_ADDR checks and since they are the same for medium rate and basic rate packets all packets count towards the maintenance of the link status.

There is a secondary impact on link supervision in that medium rate will generally require the transmission of fewer data packets and thus the duty cycle of usage will be reduced when medium rate is used. This needs to be accounted for in the choice of Tpoll values for each link.

11.HOP SELECTION

Same as defined for basic rate.

12.BLUETOOTH AUDIO

Medium rate provides further options to create 64 kbps full duplex links to carry the CVSD encoded audio. The 2-HVx and 3-HVx packet types have payload segments with 2x or 3x the data content. The generalization of the SCO links will provide the LMP signaling to allow specification of the Tsc0 value. The most obvious extension that the medium rate HV packets provides is to use packet intervals (Tsc0) that are 2 or 3 times those of current SCO channels. This will allow 2 or 3 times as many simultaneous connections through a given BT radio. The power consumption to support a given link is also reduced because of the 2x or 3x lower packet rate over the air link. The penalty is that loss of a packet causes loss of more data and hence a longer real-time segment of the audio. Table 4-1 summarizes the audio options with medium rate.

Note: An alternative selection of generalized SCO parameters would specify shorter payload length in the HV packets. Using packets with 1/2 or 1/3 the payload contents will reduce power consumption (although not as much as using 1/2 or 1/3 the number of packets) and will also decrease the chances of interference collisions because the packets are shorter.

Packet Type	Packet Interval (msec)	Tsc0 (slots)	Maximum simultaneous calls	Maximum retransmissions (1 call active)
HV1	1.25	2	1	0
HV2	2.50	4	2	1
HV3	3.75	6	3	2
2-HV3	7.50	12	6	5
3-HV3	11.25	18	9	8

Table 12-1 – Summary of audio link options

13.BLUETOOTH ADDRESSING

Same as defined for basic rate.

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14. BLUETOOTH SECURITY

Same as defined for basic rate.

15. REFERENCE

[1] Specification of the Bluetooth System - Part A Radio Specification (version 1.1, February 2001)

[2] Specification of the Bluetooth System - Part B Baseband Specification (version 1.1, February 2001)

[3] Medium Rate RF Specification (version 0.5 proposal)

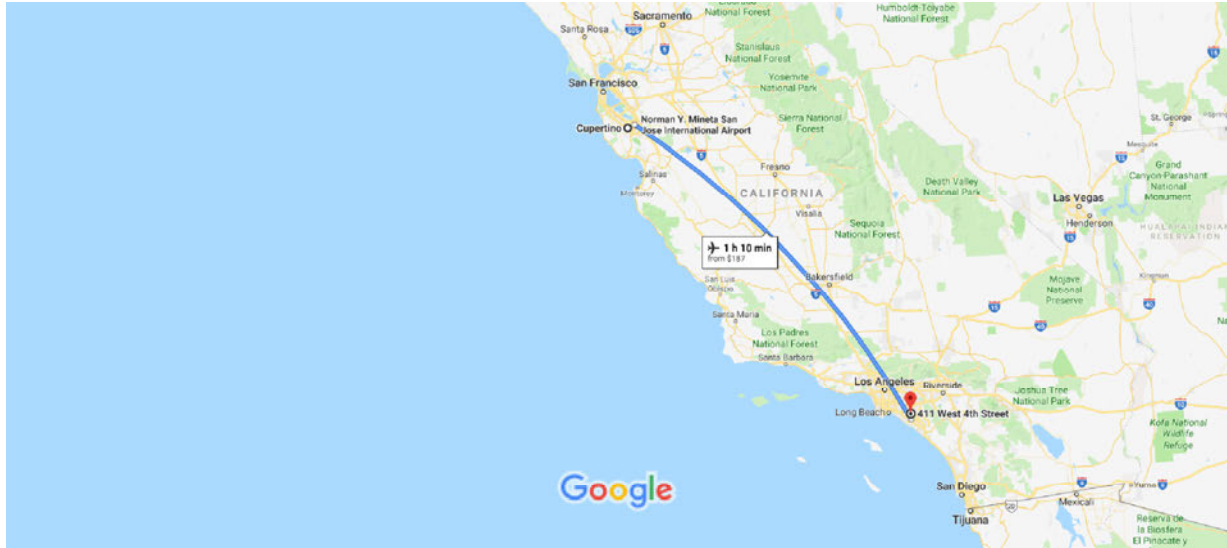
Case 2:19-cv-00025-JRG Document 31-14 Filed 05/22/19 Page 1 of 2 PageID #: 306

EXHIBIT M



Cupertino, CA to 411 W 4th St, Santa Ana, CA 92701

Flight from Cupertino, California to the Ronald Reagan Federal Building and United States Courthouse, 411 W. Fourth St., Santa Ana, CA, 92701 (CDCA)



Map data ©2019 Google, INEGI 50 mi

San Jose, CA—Santa Ana, CA

Nonstop (10–16 per day) 1 h 10 min

Connecting 3 h 15 min+

Round trip price, May 22 – 26 from \$187

Alaska, American, Delta...

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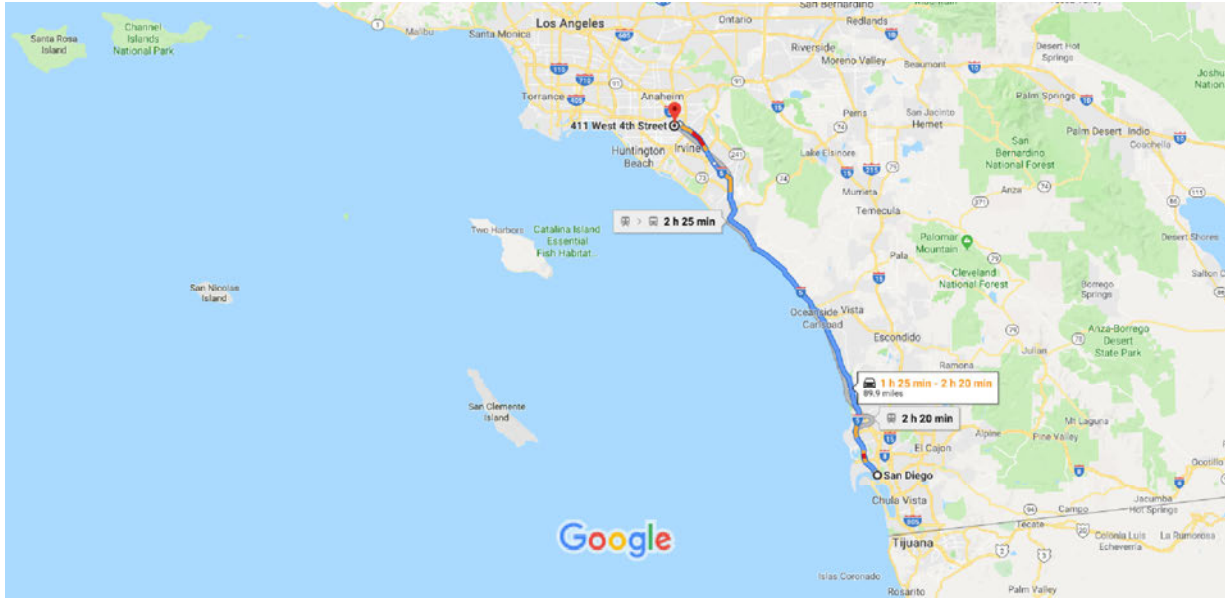
Case 2:19-cv-00025-JRG Document 31-16 Filed 05/22/19 Page 1 of 2 PageID #: 310

EXHIBIT O



San Diego, CA to 411 West 4th Street, Santa Ana, CA 92701 Drive 89.9 miles, 1 h 25 min - 2 h 20 min

Drive from San Diego, California to the Ronald Reagan Federal Building and United States Courthouse, 411 W. Fourth St., Santa Ana, CA, 92701 (CDCA)



Map data ©2019 Google, INEGI 10 mi

via I-5 N typically 1 h 25 min - 2 h 20 min

Arrive around 9:05 AM
89.9 miles

6:57 AM (Wednesday) — 9:22 AM 2 h 25 min

Pacific Surfliner 83

6:57 AM (Wednesday) — 9:17 AM 2 h 20 min

Pacific Surfliner

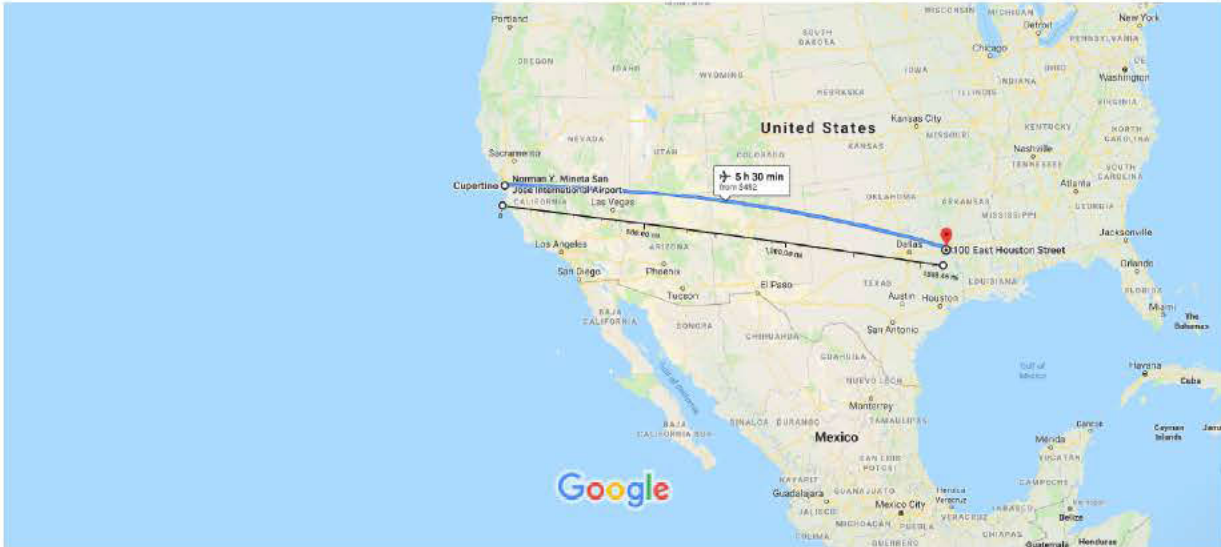
Case 2:19-cv-00025-JRG Document 31-17 Filed 05/22/19 Page 1 of 2 PageID #: 312

EXHIBIT P



Cupertino, CA to 100 East Houston Street, Marshall, TX

Flight from Cupertino, California to the Sam B. Hall, Jr. Federal Building and United States Courthouse, 100 East Houston Street, Marshall, Texas, 75670 (EDTX)



Map data ©2019 Google, INEGI 200 mi

San Jose, CA—Shreveport, LA

Connecting (1 or more stops)	5 h 30 min+
Round trip price, May 22 – 26	from \$452
United, American, Delta...	
See results on Google Flights	Sponsored

Measure distance
 Total distance: 1,588.46 mi (2,556.38 km)

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

EXHIBIT P

**[FILED UNDER SEAL PURSUANT TO
PROTECTIVE ORDER]**

Rembrandt Wireless
Ex. 2010

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

[REDACTED]

[REDACTED]

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

EXHIBIT M

Rembrandt Wireless
Ex. 2010

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

REMBRANDT WIRELESS)	
TECHNOLOGIES, LP,)	
)	Case No. 2:19-cv-00025-JRG
Plaintiff,)	
)	Hon. Rodney Gilstrap
v.)	
)	JURY TRIAL DEMANDED
APPLE INC.,)	
)	
Defendant.)	
_____)	

APPLE INC.’S INITIAL DISCLOSURES

Defendant Apple Inc. (“Apple”) hereby provides the following Initial Disclosures in accordance with Rule 26(a)(1) of the Federal Rules of Civil Procedure and Paragraph 1 of the Court’s Agreed Discovery Order entered on June 4, 2019 (Dkt. 40). These Initial Disclosures are based upon information that is currently and reasonably available to Apple and are based on Apple’s current understanding of the nature of the claims and defenses in this case. Apple’s investigation, research, and analysis of the claims and defenses in this case are ongoing, and, as contemplated by Fed. R. Civ. P. 26(e), Apple reserves the right to amend, modify, supplement, or update its Initial Disclosures.

Further, Apple does not, by submitting its Initial Disclosures, waive its right to object to the production of documents or the testimony of witnesses, on any ground including, without limitation: (1) any claim of privilege, work product, or trade secret status; (2) on the ground that the documents are not relevant to the claims or defenses in this case or are not reasonably calculated to lead to the discovery of admissible evidence; or (3) on the ground that the documents are not sufficiently relevant to justify the expense of production.

I. CORRECT NAMES OF THE PARTIES TO THE LAWSUIT

Plaintiff: Upon information and belief, Rembrandt Wireless Technologies, LP (“Rembrandt”) is the correct name of the Plaintiff in this action.

Defendant: Apple Inc. is the correct name of the Defendant in this action.

II. NAME, ADDRESS, TELEPHONE NUMBER OF ANY POTENTIAL PARTIES

Apple is unaware of any other potential parties to this action. Apple reserves the right to identify any potential parties should such parties become known through discovery.

III. LEGAL THEORIES AND GENERAL BASIS FOR CLAIMS AND DEFENSES

A. Apple’s Defenses/Counterclaims of Noninfringement Against Rembrandt

In its Disclosure of Asserted Claims and Infringement Contentions (“Infringement Contentions”), served on April 26, 2019, Rembrandt accuses Apple of infringing the following claims of the following patents: claims 2 and 59 of U.S. Patent No. 8,023,580 and claim 21 of U.S. Patent No. 8,457,228. These asserted claims and these patents will be referred to as the “Asserted Claims” and the “Asserted Patents,” respectively.

As set forth in Rembrandt’s Infringement Contentions, Rembrandt has accused the following Apple products of infringement one more of the Asserted Claims of the Asserted Patents: iPhone XR; iPhone XS; iPhone XS Max; iPhone X; iPhone 8, iPhone 8 Plus; iPhone 7; iPhone 7 Plus; iPhone SE; iPhone 6; iPhone 6 Plus; iPhone 6s; iPhone 6S Plus; iPhone 5; iPhone 5S; iPhone 5C; iPhone 4; iPhone 4S; iPhone 3G; iPhone 3GS; iPad Pro (3rd Generation, 11” and 12.9”); iPad (2018); iPad Pro (2nd Generation, 10.5” and 12.9”); iPad (5th Generation, 2017); iPad Pro (1st Generation, 9.7” and 12.9”); iPad Air 2; iPad Air; iPad (4th Generation); iPad (3rd Generation); iPad 2; iPad; iPad mini 4; iPad mini 3; iPad mini 2; iPad mini; iPod Touch 6th Generation; iPod Touch 5th Generation; iPod Touch 4th Generation; iPod Touch 3rd Generation;

iPod Touch 2nd Generation; iPod Nano 7th Generation; Apple Watch, Series 4; Apple Watch Series 3; Apple Watch Nike+; Apple Watch Hermes; Apple Watch Series 2; Apple Watch Series 1; Apple TV 5th Generation; Apple TV 4th Generation (Apple TV HD); Apple TV 3rd Generation; Apple TV 2nd Generation; Apple TV 4K; AirPort Extreme; MacBook; MacBook Pro; MacBook Air; iMac Pro; Mac Mini; iMac; Mac Pro; Beats Solo2 Wireless Headphones; Beats Studio Wireless Headphones; Beats PowerBeats3 Wireless In-Ear Headphones; Beats PowerBeats2 Wireless In-Ear Headphones; Air Pods; Beats Pill+ Wireless Speaker; Beats Pill Wireless Speaker; Beats Pill XL Wireless Speaker; Beats Studio3 Wireless; Beats Solo3 Wireless Headphones; BeatsX Earphones; Powerbeats3 Wireless Earphones; Home Pod; Apple Pencil; Apple TV 4th Gen Remote; Magic Keyboard with Numeric Keypad; Magic Mouse; Magic Mouse 2; Magic Trackpad; Magic Trackpad 2; Magic Wireless Bluetooth Keyboard 2; and Siri Remote (the “Accused Products”).

Rembrandt has accused Apple of directly and indirectly infringing the Asserted Claims. Apple has not directly or indirectly infringed, either literally or under the doctrine of equivalents, or otherwise, any Asserted Claim of the Asserted Patents.

The Asserted Claims all include elements that are lacking from Apple’s Accused Products, and Apple continues to develop its contentions and evidence demonstrating noninfringement of each asserted claim. Facts and evidence relating to these defenses include the Asserted Patents, their file histories and post-issuance prosecution records, and the software and hardware of the Accused Products.

B. Apple’s Defenses/Counterclaims of Invalidity Against Rembrandt

The Asserted Claims are invalid on various grounds. They are invalid under 35 U.S.C. § 101 including for failure to claim patent eligible subject matter. They are invalid under 35 U.S.C.

§ 112 for failure to meet the requirements of definiteness, enablement and adequate written description. They are invalid under 35 U.S.C. §§ 102 and 103. Apple is in the process of identifying and developing further evidence underlying these contentions and will disclose them pursuant to the schedule set by the Court and by the local Patent Rules.

C. Other Claims and Defenses

Rembrandt's claims are also unenforceable including due to the doctrines of equitable estoppel, laches, waiver, license, implied license and unclean hands. Rembrandt's claims are also barred by the doctrine of prosecution history estoppel due to statements the patentees made to the USPTO. Rembrandt's claims for relief, remedies and damages are also limited under 35 U.S.C. §§ 252, 253, 286, 287 and 288 as well as 28 U.S.C. § 1498.

IV. INDIVIDUALS LIKELY TO HAVE RELEVANT INFORMATION

Apple believes that the following individuals may have knowledge of facts relevant to a claim or defense. Apple does not consent to or authorize other parties' communications with Apple's employees or former employees and does not consent to or authorize any communications otherwise prohibited by any applicable rules of professional conduct. Other parties' contact with Apple's employees should take place through Apple's counsel of record. Since Apple is continuing its investigation of the case, it is possible that some of the individuals listed herein may not, in fact, possess knowledge of facts relevant to a claim or defense or may only have knowledge that is duplicative of knowledge possessed by others.

Name	Contact Information	Connection	Substance
Jason Giles	1 Infinite Loop Cupertino, CA 95014 To be contacted through Counsel for Apple Inc.	Apple employee	Apple's use of Bluetooth technology in certain of the Accused Products

Name	Contact Information	Connection	Substance
Ryan Schmidt	1 Infinite Loop Cupertino, CA 95014 To be contacted through Counsel for Apple Inc.	Apple employee	Apple's use of Bluetooth technology in certain of the Accused Products
Vivek Bhardwaj	1 Infinite Loop Cupertino, CA 95014 To be contacted through Counsel for Apple Inc.	Apple employee	Marketing of the Accused Products
Michael Jaynes	250 S Mathilda Ave. Sunnyvale, CA 94086 To be contacted through Counsel for Apple Inc.	Apple employee	Apple's sales and financials related to the Accused Products
Gordon Bremer	On information and belief: 1930 Cove Lane Clearwater, FL 33764	Named inventor on patents-in suit	The patents-in-suit and all topics related thereto, including damages, invalidity, noninfringement and claim interpretation, and the destruction of documents related to Paradyne patents
Qualcomm/CSR	5775 Morehouse Drive San Diego, CA 92121	Apple component supplier	Knowledge and information regarding the accused technology
Broadcom	1320 Ridder Park Drive San Jose, CA 95131	Apple component supplier	Knowledge and information regarding the accused technology
Burhan Masood	Broadcom 15101 Alton Parkway Irvine, CA 92618	Broadcom employee	Broadcom declarant regarding venue
Steven Hall	On information and belief: San Diego, CA area	Former employee Broadcom	Knowledge and information regarding the accused technology and development of prior art Bluetooth EDR standard
Samsung	Seochodon 1320 Seoul, South Korea	Licensee of the patents-in-suit	License to the patents-in- suit
BlackBerry	2200 University Avenue East Waterloo, ON N2K OA7 Canada	Licensee of the patents-in-suit	License to the patents-in- suit

Rembrandt Wireless

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Name	Contact Information	Connection	Substance
Bluetooth SIG	5209 Lake Washington Blvd NE Suite 350 Kirkland, WA 98033	Bluetooth SIG	Bluetooth Membership Agreement
DASAN Zhone Solutions, Inc. f/k/a Zhone Technologies, Inc. (“Zhone”)	7195 Oakport Street Oakland, CA 94621	Assignee and licensee of the patents-in-suit	Sale of patents-in-suit, license to the patents-in-suit, custodian of documents related to Paradyne patents including the patents-in-suit and prior art
Paul Castor	On information and belief: San Diego, CA area	General Counsel to Zhone	Sale of patents-in-suit, license to the patents-in-suit, and destruction of documents related to Paradyne patents
Condo Roccia Koptiw, LLP	1800 John F Kennedy Blvd #1700 Philadelphia, PA 19103	Prosecuting firm for the patents-in-suit	Prosecution of the patent-in-suit
Larry Yamano	On information and belief: Broadcom 270 Innovation Drive San Jose, CA 95134	Prior art to the patents-in-suit	Knowledge and information regarding the invalidity of the patents-in-suit

V. INDEMNITY AND INSURANCE AGREEMENTS

Apple states that it is presently unaware of any insurance business that has liability to satisfy part or all of a judgment entered in this action or to indemnify or reimburse for payments made to satisfy the judgment.

VI. SETTLEMENT AGREEMENTS

Apple has not been provided with any settlement agreements relevant to the subject matter of this action.

VII. STATEMENT OF ANY PARTY TO THE LITIGATION

Apple may use Rembrandt's statements during prosecution of the patents-in-suit, the litigations, reexaminations, and *inter partes* review proceedings for the patents-in-suit as admissions against Rembrandt's interest in this litigation. Apple reserves the right to identify additional statements in the future.

Dated: June 10, 2019

Respectfully submitted,

By: /s/ Gabrielle E. Higgins
Melissa R. Smith
State Bar No. 24001351
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Marshall, Texas 75670
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(CA Bar No. 136347)
(Eastern District of Texas Member)
Mark D. Rowland
(CA Bar No. 157862)
(Eastern District of Texas Member)
Gabrielle E. Higgins
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East Palo Alto, CA 94303-2284
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(Eastern District of Texas Member)
Jolene L. Wang
(NY Bar No. 5462619)
(Eastern District of Texas Member)

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Josef.Schenker@ropesgray.com

Jolene.Wang@ropesgray.com

COUNSEL FOR DEFENDANT

APPLE INC.

Rembrandt Wireless

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on June 10, 2019, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ Drago N. Gregov
Drago N. Gregov

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 2:19-CV-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED

**CONFIDENTIAL
FILED UNDER SEAL**

**SUPPLEMENTAL DECLARATION OF BURHAN MASOOD
IN SUPPORT OF DEFENDANT APPLE INC.'S
MOTION TO TRANSFER VENUE**

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED

**SUPPLEMENTAL DECLARATION OF BURHAN MASOOD IN SUPPORT OF
DEFENDANT APPLE INC.'S MOTION TO TRANSFER VENUE**

I, Burhan Masood, hereby declare as follows:

1. I am over 18 years of age and competent to make this declaration. If called to testify as a witness in this matter, I would testify truthfully under oath as to each of the statements in this declaration.

2. I am employed as an Engineer Program Manager 6 at Broadcom Corp. ("Broadcom") in Irvine, California. I have been employed by Broadcom and its predecessors since May 23, 2002.

3. I provide this supplemental declaration in further support of Defendant Apple Inc.'s Motion to Transfer Venue Under 28 U.S.C. § 1404(a) to Central District of California filed in the above-captioned case, and specifically to respond to Plaintiff Rembrandt Wireless Technologies, LP's ("Rembrandt") challenges in its Response brief concerning my credibility and knowledge of relevant facts. *See* Dkt. No. 56 at 6.

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4. The statements in this declaration are based upon my personal knowledge, my review of corporate records maintained by Broadcom in the ordinary course of business, and/or information that I believe to be true after a reasonable investigation.

5. [REDACTED]

6. [REDACTED]

7. [REDACTED]

8. [REDACTED]

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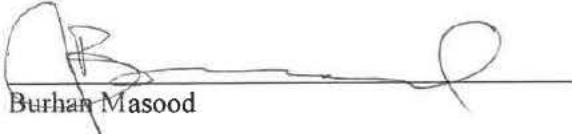
[REDACTED]

9. I have reviewed the 62 names in Exhibit H to Rembrandt's Response in Opposition to Defendant Apple's Motion to Transfer Venue, [REDACTED]. I have compared those names to Broadcom's employment records to review each person's job title, location, and business unit with which each person is affiliated. To the best of my knowledge and after a reasonable investigation:

- | [REDACTED]
- | [REDACTED]
 - | [REDACTED]
 - | [REDACTED]
 - | [REDACTED]

I declare under penalty of perjury that the foregoing is true and correct.

This declaration was executed this 12 day of August 2019, in Irvine, California.


Burhan Masood

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 2:19-CV-00025-JRG

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**SUPPLEMENTAL DECLARATION OF MICHAEL JAYNES
IN SUPPORT OF DEFENDANT APPLE INC.'S
MOTION TO TRANSFER VENUE**

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney Gilstrap

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**SUPPLEMENTAL DECLARATION OF MICHAEL JAYNES IN SUPPORT OF
DEFENDANT APPLE INC.’S MOTION TO TRANSFER VENUE**

I, Michael Jaynes, hereby declare and state as follows:

1. I am employed as a Senior Finance Manager at Apple Inc. (“Apple”) in Sunnyvale, California. I have been employed by Apple since January 2015.

2. I provide this supplemental declaration in support of Apple’s Motion to Transfer Venue Under 28 U.S.C. § 1404(a) to the Central District of California (“CDCA”) filed in the above-captioned case. Unless otherwise indicated below, the statements in this declaration are based upon my personal knowledge, my review of corporate records maintained by Apple in the ordinary course of business, and/or my discussions with Apple employees. If called to testify as a witness, I could and would competently do so under oath. I have also reviewed Plaintiff’s Response in Opposition to Defendant Apple’s Motion to Transfer Venue (Dkt. 30) (“Plaintiff’s Response”), and certain exhibits submitted with that brief, including those referenced herein.

3. As stated in my initial Declaration executed on May 20, 2019 (Dkt. 30-1), I am not aware of any Apple employees with unique information relevant to this case who reside in Texas. [REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] I am also not aware of any relevant documents or anticipated witnesses of Apple located in the EDTX.

4. I have reviewed the 121 names of persons provided by Rembrandt in Exhibit F to its Response in Opposition to Defendant Apple’s Motion to Transfer Venue, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] I have compared those names to internal Apple employee information to review each person’s job title, location, and the Apple organization with which each person is affiliated. To the best of my knowledge and after a reasonable investigation:

| [REDACTED]

[REDACTED]

| [REDACTED]

[REDACTED]

[REDACTED]

| [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

7. The three remaining persons in Exhibit F work in the Corporate Finance organization. As stated in my initial Declaration, I am employed as a Senior Finance Manager at Apple and am knowledgeable about Apple's sales and financial information concerning the Accused Products. I work and live in the Bay Area, California.

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█ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

█ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

█ [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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[REDACTED]

12. I understand that Rembrandt alleges based on LinkedIn profiles that Apple employs in Israel “at least 41 individuals with technical Bluetooth experience” and “who work on Bluetooth.” Plaintiff’s Response, pp. 5, 12; Exhibit C. [REDACTED]

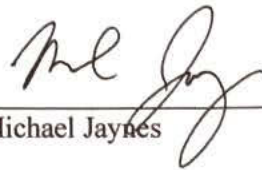
[REDACTED]

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[REDACTED]

[REDACTED]

I declare under the penalty of perjury that the foregoing is true and correct to the best of my knowledge and that this declaration was executed this 12th day of August, 2019, in *Cupertino*, California.



Michael Jaynes

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney R. Gilstrap

JURY TRIAL DEMANDED

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**DEFENDANT APPLE’S MOTION TO STAY BASED ON
CUSTOMER-SUIT EXCEPTION**

I. INTRODUCTION

In January and April 2019, Rembrandt filed three nearly identical cases alleging infringement of the same three claims from two related patents: this case against Apple in the Eastern District of Texas, and two cases in the Central District of California against Broadcom and Qualcomm, respectively.¹ In each, Rembrandt’s infringement contentions are the same – that chipsets which provide “Bluetooth Enhanced Data Rate” functionality (“EDR” or the “Accused Functionality”) infringe the two patents-in-suit. Rembrandt alleges that Apple (and Broadcom and Qualcomm) infringe by including the Accused Functionality in chipsets as well as through any products (e.g., iPhones) incorporating such chipsets. [REDACTED]

In connection with this Motion, Apple is prepared to stipulate to be bound in this action by the final outcome of the C.D. California actions against Broadcom and Qualcomm. [REDACTED]

¹ *Rembrandt Wireless Technologies, LP v. Broadcom Inc. and Broadcom Corp.*, No. 8:19-cv-00708-JLS-JDE (hereinafter “Broadcom Case”); *Rembrandt Wireless Technologies, LP v. Qualcomm Inc.*, No. 8:19-cv-00705-JLS-JDE (hereinafter “Qualcomm Case”).

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[REDACTED], final resolution of Rembrandt’s later-filed suits against the manufacturer defendants, Broadcom and Qualcomm, will resolve all issues of liability in this case. As such, under the “customer-suit exception,” Apple moves to stay this action pending resolution of the later-filed Broadcom and Qualcomm cases.²

II. STATEMENT OF FACTS

A. The Parties and Procedural History

Rembrandt, a Pennsylvania company, sued Apple, a California company, on January 24, 2019. (Dkt. No. 1). Apple has answered, and on May 22, 2019, Apple moved to transfer venue to the Central District of California. (Dkt. No. 30). Briefing is now complete on that motion, and it is pending a hearing and a decision from the Court. This Court has transferred previous Rembrandt cases against Apple. *See Rembrandt Patent Innovations, LLC v. Apple, Inc.*, No. 2:14-cv-00867-JRG, Dkt. No. 17 (E.D. Tex. Oct. 27, 2014); *Rembrandt Patent Innovations, LLC v. Apple, Inc.*, No. 2:14-cv-00015-JRG, Dkt. No. 88 (E.D. Tex. Oct. 27, 2014). Discovery is in early stages (no depositions noticed or taken other than venue-related), and trial is set for June 1, 2020.

On April 15, 2019, Rembrandt filed separate complaints against Broadcom and Qualcomm in the Central District of California alleging infringement of the same three claims of the patents at issue in this action. The parties there are proceeding through the claim construction process, and the court has set a final pretrial conference for October 30, 2020.

B. [REDACTED]

By its complaint and P.R. 3-1 contentions, Rembrandt accuses Apple of infringement based on the nature of *any* Bluetooth EDR product. (Dkt. No. 1, ¶ 28) Rembrandt identifies numerous Apple products that allegedly support Bluetooth EDR. (Dkt. No. 1, ¶ 29)

² In so moving, Apple does not intend to forego the relief requested in its pending Motion to Transfer (Dkt. No. 30).

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In its complaints against Broadcom and Qualcomm, Rembrandt acknowledges that the Accused Functionality is enabled by chipsets housed within the Apple products. (Broadcom Case, Dkt. No. 1, ¶¶ 28-29, 36 (Ex. 1); Qualcomm Case, Dkt. No. 1, ¶¶ 28-29, 36. (Ex. 2)).³ Rembrandt’s infringement allegations are word-for-word identical across the three complaints. (¶¶ 28, 36 in each of the complaints against Apple, Broadcom, and Qualcomm).

[REDACTED]

[REDACTED] (Declaration of Michael Jaynes (“Jaynes Decl.”), ¶ 4). [REDACTED]

[REDACTED]

[REDACTED] (Jaynes Decl., ¶ 5). [REDACTED]

(Jaynes Decl., ¶ 5). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (Jaynes Decl., ¶ 5).

C. Rembrandt Has Subpoenaed Non-Parties Broadcom and Qualcomm, Seeking Their Confidential Information for This Case.

On September 16, 2019, Rembrandt subpoenaed California-based chip designer companies Broadcom and Qualcomm seeking their confidential information for Rembrandt’s use in this case. (Ex. 3; Ex. 4). Rembrandt did this, even though, as mentioned above, it separately sued Broadcom and Qualcomm in cases pending in the Central District of California. In its subpoenas, Rembrandt demands that Broadcom and Qualcomm produce to Rembrandt, among other things, their highly confidential source code relating to the Accused Functionality. (Ex. 3 at 8; Ex. 4 at 7-8). The parties best positioned to address an infringement case based on such code are Broadcom and Qualcomm, not Apple, as discussed further below.

³ Exhibits are attached to the Declaration of Edward J. Mayle.

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D. Apple Agrees to Be Bound by the Broadcom and Qualcomm Cases

In connection with this motion, Apple agrees to be bound by the outcomes of the Central District of California cases as follows: (1) For accused Apple products in which the Accused Functionality is implemented [REDACTED], Apple agrees to be bound in this case by the final outcome in the litigation between Rembrandt and Broadcom in the Central District of California suit (No. 8:19-cv-708) on issues of infringement and validity, subject to a final determination in any action or proceeding, before final resolution of this case, that the asserted patent claims are invalid or unpatentable; (2) For accused Apple products in which the Accused Functionality is implemented [REDACTED], Apple agrees to be bound in this case by the final outcome in the litigation between Rembrandt and Qualcomm in the Central District of California suit (No. 8:19-cv-705) on issues of infringement and validity, subject to a final determination in any action or proceeding, before final resolution of this case, that the asserted patent claims are invalid or unpatentable. A stipulation to this effect is attached. (Ex. 5). This stipulation accounts for all of the Accused Products in this case.

III. ARGUMENT

Applying the customer-suit exception and the general stay factors compel the conclusion that a stay is in the interest of efficiency, judicial economy, and will secure the just, speedy, and inexpensive resolution of this action.

A. Legal Standard – The Customer-Suit Exception

“Under the first-to-file rule, a district court may choose to stay, transfer, or dismiss a duplicative later-filed action.” *Glob. Equity Mgmt. (SA) Pty. Ltd. v. Ericsson, Inc.*, 2017 WL 365398, at *7 (E.D. Tex. Jan. 25, 2017) (internal quotes omitted). The “customer-suit exception” is an exception to the first-to-file rule. *Id.* at *7. Under the customer-suit exception, “litigation against or brought by the manufacturer of infringing goods takes precedence over a suit by the patent owner against customers of the manufacturer.” *Katz v. Lier Siegler, Inc.*, 909 F.2d 1459,

Rembrandt Wireless

1464 (Fed. Cir. 1990). The exception is “based on the manufacturer’s presumed greater interest in defending its actions against charges of patent infringement; and to guard against possibility of abuse.” *Glob. Equity*, 2017 WL 365398, at *7 (quoting *Spread Spectrum Screenings LLC v. Eastman Kodak Co.*, 657 F.3d 1349, 1357 (Fed. Cir. 2011)). As the Federal Circuit explained in *Katz*, “it is a simple fact of life that a manufacturer must protect its customers, either as a matter of contract, or good business, or in order to avoid the damaging impact of an adverse ruling against its products.” 909 F.2d at 1464 (quoting *Codex Corp. v. Milgo Elecs. Corp.*, 553 F.2d 735, 738 (1st Cir. 1977)).

In evaluating the customer-suit exception, courts consider three factors: “(1) whether the consumers in the first-filed action are mere resellers of products manufactured by the party in the second-filed action; (2) whether the customers in the first-filed action have agreed to be bound by any decision in the second-filed action, and; (3) whether the manufacturers in the second-filed action are the only source of the allegedly infringing activity or product.” *Glob. Equity*, 2017 WL 365398, at *5 n.3 (internal quotes omitted). However, the “guiding principles in the customer suit exception cases are efficiency and judicial economy,” *Spectrum Screenings*, 657 F.3d at 1357 (internal quotes omitted), and courts weigh “overall judicial efficiency” more than the three factors. *Glob. Equity*, 2017 WL 365398, at *5 n.3.

Additionally, in considering a motion to stay, courts evaluate: “(1) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party; (2) whether a stay will simplify the issues in question and the trial of the case; and (3) whether discovery is complete and whether a trial date has been set.” *Id.* at *10 (internal quotes omitted).

B. The Customer-Suit Exception Factors Weigh in Favor of a Stay

1. Rembrandt's Cases Against Broadcom and Qualcomm Will Resolve the Issues in This Case Against Apple

The first factor in the customer-suit analysis is whether a customer is a “mere reseller[]” of the manufacturer’s products. *Glob. Equity*, 2017 WL 365398, at *5 n.3 (internal quotes omitted). When analyzing this factor, courts should assess whether the customer and manufacturer suits are “so closely related that substantial savings of litigation resources can be expected.” *Id.* at *10 (quoting *In re Google Inc.*, 588 F. App’x 988, 991 (Fed. Cir. 2014)). Courts should apply “a ‘flexible approach’... regardless of whether a customer Defendant is *really* a reseller of another Defendant’s technology.” *Id.* (emphasis added) (quoting *In re Google*, 588 F. App’x at 991).

In doing so, they should consider whether the manufacturer case will moot or advance resolution of the “major premises” being litigated in the customer case. *Katz*, 909 F.2d at 1464 (“Although there may be additional issues involving the defendants in the [customer] action, their prosecution will be advanced if [the patentee] is successful on the major premises being litigated in [the manufacturer case], and may well be mooted if he is unsuccessful.”); *Glob. Equity*, 2017 WL 365398, at *10 (quoting *Katz* and staying the customer case despite patentee’s argument that the customer was not a reseller); *Cellular Commc’ns Equip., LLC v. Apple Inc.*, No. 6:14-CV-251, 2016 WL 6884648, at *2 (E.D. Tex. Aug. 26, 2016) (rejecting argument that the customers did “more than merely resell” even though the customers had to “configure the device in a way that [was] compatible with their network” and took “the extra step of bundling” the accused devices “with service plans and imposing standards which must be maintained in order to use the device” because it did not “change the fact that they [did] not modify or alter the patented technology at issue”).

For this factor, courts should consider the burden imposed on the customer, for “the ‘first-to-file’ rule exists to avoid, if possible, imposing the burdens of trial on the customer, for it is the

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manufacturer who is generally the ‘true defendant’ in the dispute.” *In re Nintendo of Am., Inc.*, 756 F.3d 1363, 1365 (Fed. Cir. 2014); *see also Glob. Equity*, 2017 WL 365398, at *10; *Saint Lawrence Commc’ns, LLC v. Apple Inc.*, No. 2:16-cv-82-JRG, 2017 WL 3712912, at *1 (E.D. Tex. July 12, 2017) (severing and staying case against customer and reasoning that “the burdens of litigation should not be imposed on the customer.”); *Opticurrent, LLC v. Power Integrations, Inc.*, No. 2:16-CV-325-JRG, 2016 WL 9275395 (E.D. Tex. Oct. 19, 2016) (severing and staying case against customer and reasoning that “the burdens of trial should not be unnecessarily imposed upon its customer.”)

Here, the resolution of the cases against Broadcom and Qualcomm will moot or at least materially advance the major premises being litigated in the case against Apple. Rembrandt uses identical language to accuse all three Defendants of infringing its patents that allegedly cover any and all Bluetooth EDR specifications. (Compare ¶¶ 28, 36 in all three Complaints). Rembrandt does not make a more specific infringement allegation than this, other than naming particular Bluetooth EDR products, in any of the complaints. Accordingly, and particularly in view of Apple’s proposed stipulation, there should be no dispute that resolution of infringement allegations in the Broadcom and Qualcomm cases will resolve the infringement allegations in the Apple case and a substantial savings of litigation resources can be expected if the case against Apple is stayed. Indeed, as mentioned, Apple is prepared to stipulate to be bound in this action by the final outcome of the C.D. California actions against Broadcom and Qualcomm.

A stay will also alleviate the burden imposed on Apple because Broadcom and Qualcomm are the “true defendant[s]” in this dispute, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Dkt. No. 30, p. 25 (Jaynes Decl. ¶ 11)

([REDACTED]); *id.*

Rembrandt Wireless

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(Jaynes Decl. ¶ 12) ([REDACTED]); Dkt. No. 30, p. 36 (Masood Decl. ¶ 11) ([REDACTED]).

[REDACTED] and that Broadcom and Apple have common counsel in-part do not change this; indeed, these facts serve as further proof that Broadcom and Qualcomm are the “true defendants” here. Rembrandt’s decision to subpoena Broadcom and Qualcomm in connection with this suit—despite having parallel actions currently proceeding in the Central District of California—proves that even Rembrandt knows [REDACTED]. Proceeding with this action would [REDACTED].

[REDACTED]. This is an unnecessary burden on Apple given that Rembrandt has actually sued Broadcom and Qualcomm in the forum of *Rembrandt’s* own choosing (*i.e.*, the Central District of California), and resolution of those cases will resolve infringement claims against Apple. Thus, this factor favors the application of the customer-suit exception.

2. Apple Has Agreed to Be Bound by the Outcomes of the Broadcom and Qualcomm Cases, [REDACTED]

Courts also consider “whether the consumers in the first-filed action have agreed to be bound by any decision in the second-filed action.” *Glob. Equity*, 2017 WL 365398, at *5 n.3 (internal quotes omitted). Here, Apple has agreed to be bound in the attached stipulation. (Ex. 5). This stipulation [REDACTED] in this case.

Given Apple’s agreement, this factor also favors the application of the customer-suit exception. *See CyWee Group Ltd. v. Huawei Device Co. Ltd.*, No. 2:17-CV-495, 2018 WL 4002776, at *4 (E.D. Tex. Aug. 22, 2018) (“Importantly, Huawei has agreed to be bound by the

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infringement determination in the Delaware action. Therefore, once the Delaware action is resolved, there presumably will be nothing left for this Court to adjudicate as to whether the Nexus 6P infringes the '438 and '978 patents.”) (internal citation omitted).

3. **Rembrandt ██████████ Accuses Broadcom and Qualcomm Devices of Infringing**

The final factor asks “whether the manufacturers in the second-filed action are the only source of the allegedly infringing activity or product.” *Glob. Equity*, 2017 WL 365398, at *5 n.3 (internal quotes omitted). Rembrandt asserts claims ██████████ against Broadcom and Qualcomm ██████████). (Jaynes Decl., ¶ 5). While ██████████ ██████████, this factor is not dispositive, particularly in light of Apple’s stipulation to be bound ██████████ ██████████.

Rembrandt’s infringement contentions against Apple rely *entirely* on allegations about generic “Bluetooth Specifications” that Rembrandt asserts apply equally to all accused chips: Broadcom’s, Qualcomm’s, and Apple’s. *See, e.g.*, Dkt. No. 1, ¶ 28; *compare* both other Complaints, ¶ 28. Thus, it is not surprising that Rembrandt made the exact same infringement allegations against Broadcom and Qualcomm in the respective pending cases in the Central District of California as it did against Apple in this case. Rembrandt does not make any separate infringement argument depending on what type of chip allegedly performs the infringing activity inside of, for example, an accused iPhone. Therefore, at least according to Rembrandt’s infringement contentions, ██████████ ██████████. It would be a waste of judicial and party resources to litigate Rembrandt’s generic infringement claims in three different cases across two different District Courts. This is especially so because, as discussed above, ██████████

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[REDACTED]

[REDACTED]. (Jaynes Decl. ¶ 5).

C. Staying the Case Against Apple is Consistent with the General Stay Factors

1. A Stay Will Not Unduly Prejudice Rembrandt or Present a Clear Tactical Disadvantage

The first stay factor asks “whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party.” *Glob. Equity*, 2017 WL 365398, at *10 (internal quotes omitted). This factor weighs in favor of a stay because Rembrandt has already sued Broadcom and Qualcomm separately, and the issues relevant to the Apple suit will be heard in the Broadcom and Qualcomm suits, namely, infringement and validity. *Id.* Moreover, if Rembrandt prevails in the Broadcom and Qualcomm actions, it “will still be able to pursue the customer patent suits[]” against Apple, which has agreed to be bound by the decisions in those actions. *Id.*

Rembrandt will not be disadvantaged from an evidentiary perspective because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Further, Rembrandt can seek discovery from Apple in the California cases, if it desires, under Federal Rule of Civil Procedure 45.

Finally, this factor favors a stay because the Patents-in-Suit have expired and Rembrandt therefore cannot obtain injunctive relief against Apple (or Broadcom or Qualcomm) even if Rembrandt were to prevail in any of its cases. In any event, Rembrandt “does not directly compete against [Apple]” and a stay will only “delay any remedies that it may be entitled to.” *Advanced Mktg. Sys., LLC v. CVS Pharmacy, Inc.*, No. 6:15-CV-134-JRG-KNM, 2016 WL 3277258, at *2 (E.D. Tex. June 14, 2016).

2. A Stay Will Simplify the Issues in Question Because the Broadcom and Qualcomm Actions Will Resolve the Liability Allegations Against Apple

The second factor considers “whether a stay will simplify the issues in question and trial of the case.” *Glob. Equity*, 2017 WL 365398, at *10 (internal quotes omitted). A stay will simplify the issues in this case because it will resolve infringement and invalidity. As explained above in Section II(D), in connection with this motion, Apple agrees to be bound by the outcomes of the Central District of California cases in relation to infringement and invalidity. As such, a stay would also reduce the burden on all parties and the Court. Rembrandt could resolve all of its disputes with Broadcom, Qualcomm, and Apple in two proceedings instead of three, and in a single district instead of two, saving voluminous litigation expenses for both Rembrandt and Apple. Additionally, the burden on the Court’s limited resources is reduced by eliminating unnecessary hearings and a liability trial for Apple. Accordingly, this factor also favors a stay.

3. Discovery Is Not Complete and Final Pretrial Conference Dates Have Been Set in the C.D. California Actions

The final stay factor evaluates “whether discovery is complete and whether a trial date has been set.” *Glob. Equity*, 2017 WL 365398, at *10 (internal quotes omitted). Here, this case is procedurally in its early stages with a pending motion to transfer venue. Discovery is far from complete (indeed, the only depositions taken to date relate to Apple’s pending motion to transfer venue) and a *Markman* hearing has not yet been held. While a jury selection date has been set (June 1, 2020), in the parallel C.D. California actions, final pretrial conferences are now scheduled just a few months later on October 30, 2020. *See* Exhs. 6 and 7. Hence, this final factor also weighs in favor of staying this action.

IV. CONCLUSION

For the foregoing reasons, Apple respectfully submits that this action should be stayed pending the resolution of Rembrandt's claims against third-party Bluetooth chip designers Broadcom and Qualcomm, in cases Rembrandt filed in the Central District of California.

Dated: November 1, 2019

Respectfully submitted,

/s/ David E Sipiora

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(Eastern District of Texas Member)

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Counsel for Defendant Apple, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on November 1, 2019, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Local Rule CV-5(a)(3).

/s/ Melissa R. Smith

CERTIFICATE OF AUTHORIZATION TO FILE UNDER SEAL

I certify that a motion to seal this document is being filed pursuant to pursuant to the Protective Order entered in this case.

/s/ Melissa R. Smith

CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that counsel for Apple has complied with the meet and confer requirement in Local Rule CV-7(h). This motion is opposed. The personal conference required by Local Rule CV-7(h) was conducted on October 23, 2019 via telephone conference. No agreement could be reached because the parties disagreed on the merits. Discussions have conclusively ended in an impasse, leaving an open issue for the court to resolve.

/s/ Melissa R. Smith

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED

FILED UNDER SEAL

**DECLARATION OF MICHAEL JAYNES IN SUPPORT OF DEFENDANT APPLE’S
MOTION TO STAY BASED ON CUSTOMER-SUIT EXCEPTION**

I, Michael Jaynes, hereby declare and state as follows:

1. I am over 18 years of age and competent to make this declaration. If called to testify as a witness in this matter, I could and would testify truthfully to each of the statements in this declaration.

2. I am employed as a Senior Finance Manager at Apple Inc. (“Apple”) in Sunnyvale, California. I have been employed by Apple since January 2015.

3. I provide this declaration in support Apple’s Motion to Stay filed in the above-captioned case. Unless otherwise indicated below, the statements in this declaration are based upon my personal knowledge, my review of corporate records maintained by Apple in the ordinary course or business, and/or my discussions with Apple employees. If called to testify as a witness, I could and would competently do so under oath.

4. I previously submitted a declaration signed on May 20, 2019 in support of Apple’s motion to transfer venue in the above captioned matter (“First Declaration”). My First Declaration listed the products I understand are accused of infringing the patents asserted by Rembrandt

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Wireless Technologies, LP (“Rembrandt”) in this matter (“Accused Products”). My First Declaration explained that the Accused Products implement Bluetooth chips that allegedly incorporate the Accused Functionality, as defined in my First Declaration. My First Declaration also set forth my understanding that [REDACTED]

5. Based on the foregoing understanding, Apple’s response to Rembrandt’s Interrogatory No. 1 (setting forth [REDACTED] [REDACTED]), and units sold data produced at APL-REMBR_01037443 through APL-REMBR_01037658, I calculated the percentage of Accused Products sold in the United States, from Apple’s fiscal period Q3FY2013 (March 31, 2013) through Q4FY2018 (September 29, 2018), [REDACTED]:¹

- | [REDACTED]
- | [REDACTED]
- | [REDACTED]
- | [REDACTED]
- | [REDACTED]
- | [REDACTED]

I declare under the penalty of perjury that the foregoing is true and correct.

This declaration was executed this 30th day of October, 2019, in Sunnyvale, CA.

¹ Calculations use the data contained in APL-REMBR_01037443-APL-REMBR_01037658, which excludes Accused Product models sold exclusively outside the alleged damages period of June 4, 2013 to August 27, 2018, such as iPhone XS which was first offered for sale on approximately September 14, 2018.

EXHIBIT 5

CONFIDENTIAL MATERIAL OMITTED

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

REMBRANDT WIRELESS
TECHNOLOGIES, LP,

Plaintiff,

v.

APPLE INC.,

Defendant.

Case No. 2:19-cv-00025-JRG

Hon. Rodney Gilstrap

JURY TRIAL DEMANDED

**PROPOSED STIPULATION IN SUPPORT OF APPLE’S MOTION TO STAY
BASED ON CUSTOMER-SUIT EXCEPTION**

Subject to and without waiving the relief sought in Defendant Apple Inc.’s Motion To Transfer Venue (Dkt. 30), Apple Inc. (“Apple”), through its undersigned attorneys, hereby stipulates and agrees as follows:

For accused Apple products in which the accused Bluetooth EDR functionality is implemented [REDACTED], Apple agrees to be bound in this case by the final outcome in the litigation between Rembrandt and Broadcom in the Central District of California suit (No. 8:19-cv-708) on issues of infringement and validity, subject to a final determination in any action or proceeding, before final resolution of this case, that the asserted patent claims are invalid or unpatentable.

For accused Apple products in which the accused Bluetooth EDR functionality is implemented [REDACTED], Apple agrees to be bound in this case by the final outcome in the litigation between Rembrandt and Qualcomm in the Central District of California suit (No. 8:19-cv-705) on issues of infringement and validity, subject to a final

determination in any action or proceeding, before final resolution of this case, that the asserted patent claims are invalid or unpatentable.

Apple submits this stipulation on the condition that the Court stay the case against it until issues of infringement and validity in the above-referenced Broadcom and Qualcomm litigations have been finally resolved.

EXHIBIT 6

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SACV 19-00708 JLS (JDE) Date: July 31, 2019

Title: Rembrandt Wireless Technologies, LP et al v. Broadcom Incorporated, et al

Present: **HONORABLE JOSEPHINE L. STATON, UNITED STATES DISTRICT JUDGE**

Terry Guerrero
Deputy Clerk

N/A
Court Reporter

Attorneys Present for Plaintiff:

Attorneys Present for Defendant:

Not Present

Not Present

Proceedings: (In Chambers) SCHEDULING ORDER IN A PATENT CASE

The present case alleges that Defendant infringed Plaintiff’s utility patent. The Court has reviewed the Joint Rule 26(f) Report (Doc. 57) and VACATES the Scheduling Conference set for August 2, 2019.

The Court has reviewed and considered the proposed pretrial dates set forth in Exhibit B to the parties’ Joint Rule 26(f) Report. As the parties recognize, the Court follows a modified version of the schedule for utility patent cases contemplated by the Patent Local Rules for the Northern District of California. The parties state that their jointly proposed schedule comports with the Court’s default deadlines, with minor variations to account for Thanksgiving and Christmas federal holidays (which the Court has adopted). (See Doc. 57, Jt. Rpt., Ex. B n.1.) To the extent the parties’ schedule deviated from the Court’s default deadlines without explanation, the Court modified the schedule.

In addition to the dates and deadlines proposed by the parties, the Court has set deadlines in conformity with Northern District Patent Local Rules 3-8 and 3-9, related to damages contentions.

The Court sets the date for the filing of the Joint Claim Construction Prehearing Statement at one week after the close of Claim Construction Discovery.

The briefs filed in advance of the claim construction hearing consist of simultaneously filed opening briefs and simultaneously filed responsive briefs. No reply briefs are to be filed absent invitation by the Court.

The Court sets the schedule in this case as set forth below. These dates and deadlines will not be continued except upon a showing of good cause, which generally requires

Rembrandt Wireless

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SACV 19-00708 JLS (JDE)

Date: July 31, 2019

Title: Rembrandt Wireless Technologies, LP et al v. Broadcom Incorporated, et al

unforeseeable circumstances. See Fed. R. Civ. P. 16(b)(4). Failure to conduct discovery diligently or a desire to engage in settlement discussions will not constitute good cause.

The Court will set a trial date and an exhibit conference date at the Final Pretrial Conference. The parties are directed to confer before the Final Pretrial Conference and to identify in the Proposed Final Pretrial Conference Order mutually agreeable trial dates within the 90 days following the Final Pretrial Conference. Where the Court’s trial calendar permits, the Court will set the trial for a date agreed upon by the parties.

Counsel’s attention is directed to the Court’s Civil Trial Order filed concurrently with this Minute Order. Generally, motions should be set for hearing on the Court’s first available date.

Disclosures of Asserted Claims and Infringement Contentions, and Document Production Accompanying Disclosure:	August 16, 2019
Last Day to File a Motion to Add Parties and Amend Pleadings:	October 1, 2019
Invalidity Contentions and Accompanying Document Production:	October 4, 2019
Exchange of Proposed Terms for Claim Construction:	October 18, 2019
Exchange of Proposed Claim Constructions and Extrinsic Evidence:	November 1, 2019
Damages Contentions and Accompanying Document Production:	November 15, 2019
Joint Status Report Regarding Technology Tutorial:	November 15, 2019
Completion of Claim Construction Discovery:	November 15, 2019
Joint Claim Construction Prehearing Statement:	November 22, 2019
Last Day to File Simultaneous Opening Claim Construction Briefs:	December 6, 2019
Responsive Damages Contentions:	December 13, 2019
Last Date to File Simultaneous Responsive Claim Construction Briefs:	December 20, 2019

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SACV 19-00708 JLS (JDE) Date: July 31, 2019

Title: Rembrandt Wireless Technologies, LP et al v. Broadcom Incorporated, et al

Claim Construction Hearing (Tuesday 9:00 a.m.)	January 21, 2020
Advice of Counsel-Related Production:	May 26, 2020
Fact Discovery Cut-off:	June 26, 2020
Last Day to File Dispositive Motions:	July 10, 2020
Last Day to Serve Initial Expert Reports:	July 10, 2020
Last Day to Serve Rebuttal Expert Reports:	August 7, 2020
Last Day to Conduct Settlement Proceedings:	August 28, 2020
Expert Discovery Cut-off:	September 4, 2020
Last Day to File <i>Daubert</i> Motions:	September 11, 2020
Last Day to File Motions in Limine (excluding <i>Daubert</i> motions):	October 2, 2020
Final Pretrial Conference (10:30 a.m.):	October 30, 2020
Preliminary Trial Estimate:	7 days

IT IS SO ORDERED.

Initials of Preparer: tg

EXHIBIT 7

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SACV 19-00705 JLS (JDE) Date: August 7, 2019
Title: Rembrandt Wireless Technologies, LP v. Qualcomm Inc.

Present: **HONORABLE JOSEPHINE L. STATON, UNITED STATES DISTRICT JUDGE**

Terry Guerrero
Deputy Clerk

N/A
Court Reporter

Attorneys Present for Plaintiff:

Attorneys Present for Defendant:

Not Present

Not Present

Proceedings: (In Chambers) SCHEDULING ORDER IN A PATENT CASE

The present case alleges that Defendant infringed Plaintiff’s utility patent. The Court has reviewed the Joint Rule 26(f) Report (Doc. 57) and VACATES the Scheduling Conference set for August 9, 2019.

The Court has reviewed and considered the proposed pretrial dates set forth in Exhibit B to the parties’ Joint Rule 26(f) Report. As the parties recognize, the Court follows a modified version of the schedule for utility patent cases contemplated by the Patent Local Rules for the Northern District of California. The parties state that their jointly proposed schedule comports with the Court’s default deadlines, with minor variations to account for Thanksgiving and Christmas federal holidays (which the Court has adopted). (See Doc. 57, Jt. Rpt., Ex. B n.1.) To the extent the parties’ schedule deviated from the Court’s default deadlines without explanation, the Court modified the schedule.

In addition to the dates and deadlines proposed by the parties, the Court has set deadlines in conformity with Northern District Patent Local Rules 3-8 and 3-9, related to damages contentions.

The Court sets the date for the filing of the Joint Claim Construction Prehearing Statement at one week after the close of Claim Construction Discovery.

The briefs filed in advance of the claim construction hearing consist of simultaneously filed opening briefs and simultaneously filed responsive briefs. No reply briefs are to be filed absent invitation by the Court.

The Court sets the schedule in this case as set forth below. These dates and deadlines will not be continued except upon a showing of good cause, which generally requires

Rembrandt Wireless

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SACV 19-00705 JLS (JDE)

Date: August 7, 2019

Title: Rembrandt Wireless Technologies, LP v. Qualcomm Inc.

unforeseeable circumstances. See Fed. R. Civ. P. 16(b)(4). Failure to conduct discovery diligently or a desire to engage in settlement discussions will not constitute good cause.

The Court will set a trial date and an exhibit conference date at the Final Pretrial Conference. The parties are directed to confer before the Final Pretrial Conference and to identify in the Proposed Final Pretrial Conference Order mutually agreeable trial dates within the 90 days following the Final Pretrial Conference. Where the Court's trial calendar permits, the Court will set the trial for a date agreed upon by the parties.

Counsel's attention is directed to the Court's Civil Trial Order filed concurrently with this Minute Order. Generally, motions should be set for hearing on the Court's first available date.

Disclosures of Asserted Claims and Infringement Contentions, and Document Production Accompanying Disclosure:	August 16, 2019
Last Day to File a Motion to Add Parties and Amend Pleadings:	October 1, 2019
Invalidity Contentions and Accompanying Document Production:	October 4, 2019
Exchange of Proposed Terms for Claim Construction:	October 18, 2019
Exchange of Proposed Claim Constructions and Extrinsic Evidence:	November 1, 2019
Damages Contentions and Accompanying Document Production:	November 15, 2019
Joint Status Report Regarding Technology Tutorial:	November 15, 2019
Completion of Claim Construction Discovery:	November 15, 2019
Joint Claim Construction Prehearing Statement:	November 22, 2019
Last Day to File Simultaneous Opening Claim Construction Briefs:	December 6, 2019
Responsive Damages Contentions:	December 13, 2019
Last Date to File Simultaneous Responsive Claim Construction Briefs:	December 20, 2019

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UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES – GENERAL

Case No. SACV 19-00705 JLS (JDE) Date: August 7, 2019
Title: Rembrandt Wireless Technologies, LP v. Qualcomm Inc.

Claim Construction Hearing (Tuesday 9:00 a.m.)	January 21, 2020
Advice of Counsel-Related Production:	May 26, 2020
Fact Discovery Cut-off:	June 26, 2020
Last Day to File Dispositive Motions:	July 10, 2020
Last Day to Serve Initial Expert Reports:	July 10, 2020
Last Day to Serve Rebuttal Expert Reports:	August 7, 2020
Last Day to Conduct Settlement Proceedings:	August 28, 2020
Expert Discovery Cut-off:	September 4, 2020
Last Day to File <i>Daubert</i> Motions:	September 11, 2020
Last Day to File Motions in Limine (excluding <i>Daubert</i> motions):	October 2, 2020
Final Pretrial Conference (10:30 a.m.):	October 30, 2020
Preliminary Trial Estimate:	7 days

IT IS SO ORDERED.

Initials of Preparer: tg

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

REMBRANDT WIRELESS TECHNOLOGIES, LP,	§	
	§	
Plaintiff,	§	Case No. 2:19-cv-00025-JRG
	§	
v.	§	
	§	
APPLE INC.,	§	Jury Trial Requested
	§	
Defendant.	§	
	§	
	§	
	§	

THIRD AMENDED DOCKET CONTROL ORDER

Having considered the Parties’ Joint Motion To Amend The Docket Control Order, the Court hereby **GRANTS** the motion and **ORDERS** the following schedule of deadlines:

Current Deadline	New Deadline	Event
June 1, 2020	June 1, 2020 (No Change)	*Jury Selection – 9:00 a.m. in Marshall, Texas before Judge Rodney Gilstrap
April 27, 2020	April 27, 2020 (No Change)	*Pretrial Conference – 9:00 a.m. in Marshall, Texas before Judge Rodney Gilstrap
April 20, 2020	April 20, 2020 (No Change)	*Notify Deputy Clerk in Charge regarding the date and time by which juror questionnaires shall be presented to accompany by jury summons if the Parties desire to avail themselves the benefit of using juror questionnaires. ¹
April 20, 2020	April 20, 2020 (No Change)	*Notify Court of Agreements Reached During Meet and Confer The parties are ordered to meet and confer on any outstanding objections or motions <i>in limine</i> . The parties shall advise the Court of

¹ The Parties are directed to the Court’s Standing Order Regarding Use of Juror Questionnaires in Advance of *Voir Dire*.

		any agreements reached no later than 1:00 p.m. three (3) business days before the pretrial conference.
April 20, 2020	April 20, 2020 (No Change)	*File Joint Pretrial Order, Joint Proposed Jury Instructions, Joint Proposed Verdict Form, Responses to Motions <i>in Limine</i> , Updated Exhibit Lists, Updated Witness Lists, and Updated Deposition Designations.
April 13, 2020	April 13, 2020 (No Change)	*File Notice of Request for Daily Transcript or Real Time Reporting. If a daily transcript or real time reporting of court proceedings is requested for trial, the party or parties making said request shall file a notice with the Court and e-mail the Court Reporter, Shelly Holmes, at shelly_holmes@txed.uscourts.gov.
April 6, 2020	April 6, 2020 (No Change)	File Motions <i>in Limine</i> The parties shall limit their motions <i>in limine</i> to issues that if improperly introduced at trial would be so prejudicial that the Court could not alleviate the prejudice by giving appropriate instructions to the jury.
April 6, 2020	April 6, 2020 (No Change)	Serve Objections to Rebuttal Pretrial Disclosures
March 23, 2020	March 30, 2020 (1 Week Extension)	Serve Objections to Pretrial Disclosures; and Serve Rebuttal Pretrial Disclosures
March 16, 2020	March 23, 2020 (1 Week Extension)	Serve Pretrial Disclosures (Witness List, Deposition Designations, and Exhibit List) by the Party with the Burden of Proof
March 9, 2020	March 16, 2020 (1 Week Extension)	*Response to Dispositive Motions (including <i>Daubert</i> Motions). Responses to dispositive motions that were filed <u>prior</u> to the dispositive motion deadline, including <i>Daubert</i> Motions, shall be due in accordance with Local Rule CV-7(e), not to exceed the deadline as set forth in this Docket Control Order. ² Motions

² The parties are directed to Local Rule CV-7(d), which provides in part that “[a] party’s failure to oppose a motion in the manner prescribed herein creates a presumption that the party does not controvert the facts set out by movant and has no evidence to offer in opposition to the motion .” If the deadline under Local Rule CV 7(e) exceeds the deadline for Response to Dispositive Motions, the deadline for Response to Dispositive Motions controls.

		for Summary Judgment shall comply with Local Rule CV-56
February 24, 2020	March 2, 2020 (1 Week Extension)	*File Motions to Strike Expert Testimony (including <i>Daubert</i> Motions) No motion to strike expert testimony (including <i>Daubert</i> motion) may be filed after this date without leave of the Court.
February 24, 2020	March 2, 2020 (1 Week Extension)	*File Dispositive Motions No dispositive motion may be filed after this date without leave of the Court. Motions shall comply with Local Rule CV-56 and Local Rule CV-7. Motions to extend page limits will only be granted in exceptional circumstances. Exceptional circumstances require more than agreement among parties.
February 24, 2020	March 2, 2020 (1 Week Extension)	Deadline to Complete Expert Discovery
February 3, 2020	February 17, 2020 (2 Week Extension)	Serve Disclosures for Rebuttal Expert Witnesses
January 13, 2020	January 27, 2020 (2 Week Extension)	Deadline to Complete Fact Discovery and File Motions to Compel Discovery
January 13, 2020	January 27, 2020 (2 Week Extension)	Serve Disclosures for Expert Witnesses by the Party with the Burden of Proof
December 30, 2019	February 20, 2020 (7 Week Extension)	Deadline to Complete Mediation. The parties are responsible for ensuring that a mediation report is filed no later than 5 days after the conclusion of the mediation.

(*) indicates a deadline that cannot be changed without showing good cause. Good cause is not shown merely by indicating that the parties agree that the deadline should be changed.

ADDITIONAL REQUIREMENTS

Notice of Mediator: The parties are to jointly file a notice that identifies the agreed upon mediator or indicates that no agreement was reached. If the parties do not reach an agreement, the Court will appoint a mediator. The parties should not file a list of mediators to be considered by the Court.

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Summary Judgment Motions, Motions to Strike Expert Testimony, and Daubert Motions: For each motion, the moving party shall provide the Court with two (2) copies of the completed briefing (opening motion, response, reply, and if applicable, surreply), excluding exhibits, in D-three-ring binders, appropriately tabbed. All documents shall be single-sided and must include the CM/ECF header. For expert-related motions, complete digital copies of the relevant expert report(s) and accompanying exhibits shall be submitted on a single flash drive. These copies shall be delivered as soon as briefing has completed.

Indefiniteness: In lieu of early motions for summary judgment, the parties are directed to include any arguments related to the issue of indefiniteness in their *Markman* briefing, subject to the local rules' normal page limits.

Motions for Continuance: The following excuses will not warrant a continuance nor justify a failure to comply with the discovery deadline:

- (a) The fact that there are motions for summary judgment or motions to dismiss pending;
- (b) The fact that one or more of the attorneys is set for trial in another court on the same day, unless the other setting was made prior to the date of this order or was made as a special provision for the parties in the other case;
- (c) The failure to complete discovery prior to trial, unless the parties can demonstrate that it was impossible to complete discovery despite their good faith effort to do so.

Amendments to the Docket Control Order ("DCO"): Any motion to alter any date on the DCO shall take the form of a motion to amend the DCO. The motion to amend the DCO shall include a proposed order that lists all of the remaining dates in one column (as above) and the proposed changes to each date in an additional adjacent column (if there is no change for a date the proposed date column should remain blank or indicate that it is unchanged). In other words, the DCO in the proposed order should be complete such that one can clearly see all the remaining deadlines and the changes, if any, to those deadlines, rather than needing to also refer to an earlier version of the DCO.

Proposed DCO: The Parties' Proposed DCO should also follow the format described above under "Amendments to the Docket Control Order ('DCO')."

So ORDERED and SIGNED this 17th day of December, 2019.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

Rembrandt Wireless

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