

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

JAPAN DISPLAY INC., PANASONIC
LIQUID CRYSTAL DISPLAY CO., LTD.,

Plaintiffs,

v.

TIANMA MICROELECTRONICS CO.
LTD.,

Defendant.

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CIVIL ACTION NO. 2:20-CV-00283-JRG
(LEAD CASE)

CIVIL ACTION NO. 2:20-CV-00284-JRG
CIVIL ACTION NO. 2:20-CV-00285-JRG
(MEMBER CASES)

ORDER

The Court held a hearing in the above-captioned matter on Tuesday, October 26, 2021 regarding Plaintiffs Japan Display Inc. (“JDI”) and Panasonic Liquid Crystal Display Co., Ltd.’s (“Panasonic”) (collectively, “Plaintiffs”) Motion to Compel Production by Defendant of Information from Tianma Japan and Certain Customer Information (the “Motion”). (Dkt. No. 137). Additionally, the Court conducted a Status Conference to address issues related to case management, deadlines in the Docket Control Order, and narrowing of asserted claims and prior art references. (Dkt. No. 166 at 3–4; Dkt. No. 176 at 8:1–17).

This Order memorializes the Court’s rulings at the October 26th hearing and provides additional instructions to the parties in light of the parties’ Joint Notice (Dkt. No. 189) filed after the hearing. Accordingly, it is hereby **ORDERED** as follows:

I. Plaintiffs’ Motion to Compel Production by Defendant of Information from Tianma Japan and Certain Customer Information (Dkt. No. 137).

After meet-and-confer efforts, the parties reached an agreement resolving this Motion. In light of the parties’ agreement, which was noted in the record (Dkt. No. 176 at 5:2–19, 6:10–7:20)

and confirmed in the stipulation (Dkt. No. 174) subsequently filed on this Court's docket, the Motion is **DENIED AS MOOT**.

II. Deadline to Complete Expert Discovery as to Defendant's Technical Expert, Mr. Fred Schubert.

At the October 26th hearing, the Court noted that it had previously extended the deadline to complete expert discovery from October 25, 2021 to November 8, 2021. (Dkt. No. 176 at 8:10–17; *see also* Dkt. No. 166 at 3–4). However, the parties informed the Court that November 16, 2021 and November 17, 2021 were the only dates available for the deposition of Defendant's technical expert, Mr. Fred Schubert. (Dkt. No. 176 at 9:24–11:4). After considering the parties' joint request, the Court **ORDERED** that the parties were permitted to take the single deposition of Mr. Fred Schubert on November 16, 2021 and November 17, 2021, notwithstanding the November 8th deadline for all other expert discovery. (*Id.* at 11:5–10).

III. Narrowing of Asserted Claims and Prior Art References Following the Parties' Joint Notice (Dkt. No. 189).

During the Status Conference portion of the October 26th hearing, the Court instructed the parties to meet-and-confer regarding a path towards further narrowing of the case and instructed the parties to file a Joint Notice by Wednesday, November 10, 2021, informing the Court of their positions on such narrowing. (Dkt. No. 176 at 20:15–22). In their subsequent Joint Notice, the parties “agree that the case would benefit from further narrowing but disagree regarding the scope of that narrowing and whether multiple rounds of narrowing are necessary.” (Dkt. No. 189 at 1). Accordingly, the parties offer competing propositions for further narrowing of asserted claims and prior art references.

Having considered the parties' positions in the Joint Notice, the Court **ORDERS** the following schedule related to the narrowing of asserted claims and prior art references:

By **Monday, November 22, 2021**, Plaintiffs narrow to no more than seven patents and no more than twenty asserted claims, selected from the asserted claims which Plaintiffs elected on October 25, 2021.

By **Friday, November 29, 2021**, Defendant narrows to no more than twenty prior art references, selected from the references which Defendant elected on November 1, 2021. Each anticipation challenge and each obviousness combination or assertion counts as a separate prior art reference.¹

By **Monday, December 20, 2021**, Plaintiffs narrow to no more than four patents and no more than twelve asserted claims, selected from those asserted claims which Plaintiffs elected on November 22, 2021.

By **Wednesday, December 22, 2021**, Defendant narrows to no more than twelve prior art references, selected from the references which Defendant elected on November 29, 2021. Each anticipation challenge and each obviousness combination or assertion counts as a separate prior art reference.

So ORDERED and SIGNED this 18th day of November, 2021.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

¹ For example, an assertion that prior art A invalidates counts as one prior art reference. Likewise, an assertion that prior art B invalidates counts as a second prior art reference. Also, an assertion that the combination of prior art A and prior art B invalidates counts as a separate reference. Further, the assertion that a combination of prior art B and prior art C invalidates would count as a separate prior art reference. Such an assertion would *not* allow argument that prior art C alone invalidates, unless prior art C is elected as a separate reference. In short, each unique prior art reference or combination of prior art references counts as a separate reference for these purposes.