

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

JAWBONE INNOVATIONS, LLC,	§	
	§	
	§	
<i>Plaintiff,</i>	§	
	§	
v.	§	Case No. 2:21-cv-00186-JRG-RSP
	§	
SAMSUNG ELECTRONICS CO. LTD. and	§	
SAMSUNG ELECTRONICS AMERICA,	§	
INC.,	§	
	§	
<i>Defendants.</i>	§	

**DISCOVERY ORDER**

Before the Court is the Joint Motion for Entry of Agreed Discovery Order. Dkt. No. 36. After a review of the pleaded claims and defenses in this action, in furtherance of the management of the Court’s docket under Federal Rule of Civil Procedure 16, and after receiving the input of the parties to this action, it is **ORDERED AS FOLLOWS:**

1. **Initial Disclosures.** In lieu of the disclosures required by Federal Rule of Civil Procedure 26(a)(1), each party shall disclose to every other party the following information:
  - (a) the correct names of the parties to the lawsuit;
  - (b) the name, address, and telephone number of any potential parties;
  - (c) the legal theories and, in general, the factual bases of the disclosing party’s claims or defenses (the disclosing party need not marshal all evidence that may be offered at trial);
  - (d) the name, address, and telephone number of persons having knowledge of relevant facts, a brief statement of each identified person’s connection with the case, and a brief, fair summary of the substance of the information known by any such person;
  - (e) any indemnity and insuring agreements under which any person or entity carrying

on an insurance business may be liable to satisfy part or all of a judgment entered in this action or to indemnify or reimburse for payments made to satisfy the judgment;

- (f) any settlement agreements relevant to the subject matter of this action; and
- (g) any statement of any party to the litigation.

**2. Disclosure of Expert Testimony.** A party must disclose to the other parties the identity of any witness it may use at trial to present evidence under Federal Rule of Evidence 702, 703 or 705, and:

- (a) if the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party's employee regularly involve giving expert testimony, provide the disclosures required by Federal Rule of Civil Procedure 26(a)(2)(B) and Local Rule CV-26; and
- (b) for all other such witnesses, provide the disclosure required by Federal Rule of Civil Procedure 26(a)(2)(C).

**3. Additional Disclosures.** Without awaiting a discovery request,<sup>1</sup> each party will make the following disclosures to every other party:

- (a) provide the disclosures required by the Patent Rules for the Eastern District of Texas with the following modifications to P.R. 3-1 and P.R. 3-3:
  - i If a party claiming patent infringement asserts that a claim element is a software limitation, the party need not comply with P.R. 3-1 for those claim elements until 30 days after source code for each Accused Instrumentality is produced by the opposing party. Thereafter, the party claiming patent infringement shall identify, on an element-by-element basis for each

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<sup>1</sup> The Court anticipates that this disclosure requirement will obviate the need for requests for

asserted claim, what source code of each Accused Instrumentality allegedly satisfies the software limitations of the asserted claim elements.

- ii. If a party claiming patent infringement exercises the provisions of Paragraph 3(a)(i) of this Discovery Order, the party opposing a claim of patent infringement may serve, not later than 30 days after receipt of a Paragraph 3(a)(i) disclosure, supplemental “Invalidity Contentions” that amend only those claim elements identified as software limitations by the party claiming patent infringement.
- (b) produce or permit the inspection of all documents, electronically stored information, and tangible things in the possession, custody, or control of the party that are relevant to the pleaded claims or defenses involved in this action, except to the extent these disclosures are affected by the time limits set forth in the Patent Rules for the Eastern District of Texas; and
- (c) provide a complete computation of any category of damages claimed by any party to the action and produce or permit the inspection of documents or other evidentiary material on which such computation is based, including materials bearing on the nature and extent of injuries suffered, except that the disclosure of the computation of damages may be deferred until the time for Expert Disclosures if a party will rely on a damages expert.

**4. Protective Orders.** The Court will enter the parties’ Agreed Protective Order.

**5. Discovery Limitations.** The discovery in this cause is limited to the disclosures described in Paragraphs 1-3 together with:

- (a) For purposes of this section (Section 5 – Discovery Limitations), Defendants Samsung Electronics Co. Ltd. and Samsung Electronics America, Inc. shall count

as a single “Defendant Group.”

- (b) Interrogatories: Plaintiff may serve thirty (30) interrogatories on each Defendant Group, and each Defendant Group may serve thirty (30) interrogatories on Plaintiff.
- (c) Requests for Admission: Plaintiff may serve forty (40) requests for admissions on each Defendant Group, and each Defendant Group may serve forty (40) requests for admissions on Plaintiff. In addition, the parties will be permitted to serve a reasonable number of requests for admission that seek an admission as to (a) the authenticity of a particular document or thing, (b) the admissibility of a particular document or thing, and/or (c) whether a document qualifies as a “printed publication” or other prior art as of a certain date under 35 U.S.C. § 102. The parties shall work together in good faith to agree on a stipulation as to the authenticity of their own documents to avoid the service of large numbers of requests for admission relating to authenticity, admissibility, and/or qualification as a “printed publication”.
- (d) Depositions of Parties and Party-Affiliated Witnesses: Plaintiff may take up to fifty (50) total hours of deposition testimony of each Defendant Group (inclusive of both 30(b)(1) and 30(b)(6) depositions). Defendant Group may take up to fifty (50) hours of deposition testimony of Plaintiff (inclusive of both 30(b)(1) and 30(b)(6) deposition). Depositions of experts, inventors, and third parties do not count against these limits. Absent a showing of good cause, each deposition will be limited to no more than seven (7) hours pursuant to Rule 30(d)(1). Should a single witness be designated pursuant to Rule 30(b)(6) to address voluminous noticed deposition topics, the seven-hour time limit under 30(d)(1) will not apply to such witness, but such deposition may still not exceed seven hours in one day, absent agreement of

the parties. In-person depositions of witnesses shall be taken in the city where the witness resides or has a principal place of employment, or at a mutually agreed-upon location; virtual depositions (*e.g.*, Zoom) shall be taken during regular business hours of the witness.

- (e) Inventor Depositions: Separate and in addition to the time provided for the depositions of the parties and party-affiliated witnesses, Plaintiff and each Defendant Group may take up to seven (7) hours of deposition of each inventor, in their personal capacity, who are named on the face of the Asserted Patents.<sup>2</sup> The parties will work together in good faith to agree on an appropriate time limit for the personal deposition of Gregory Burnett, with a minimum of seven (7) hours and a maximum of fourteen (14) hours.
- (f) Non-Party, Non-Inventor Fact Depositions: The Plaintiff may take up to seventy (70) hours of non-party, non-inventor fact depositions and each Defendant Group may take up to seventy (70) hours of non-party, non-inventor fact depositions.
- (g) Discovery of Expert Materials: The parties agree to the limitations of Rule 26 of the Federal Rules of Civil Procedure (“Rule 26”) with regard to the discovery of expert materials. To the extent not already covered by Rule 26, the parties further agree to the following limitations regarding the discovery of expert material.
  - i. Testifying experts shall not be subject to discovery on any draft of their report or declarations in this case and such draft reports, declarations, notes, outlines, or any other writings leading up to an issued report or filed declaration in this litigation are exempt from discovery.
  - ii. In addition, all communications to and from a testifying expert, and all materials

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<sup>2</sup> The Asserted Patents are U.S. Patent Nos. 8,019,091, 8,280,072, 8,503,691, 11,122,357, 10,770,880, 8,467,512, 17,016,050.

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