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

MAXELL, LTD., *Plaintiff*, v. APPLE INC., *Defendant*.	Case No. 5:19-cv-0036-RWS **JURY TRIAL DEMANDED**

DISCOVERY ORDER FOR PATENT CASES

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,[1] 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:

> **P.R. 3-1(g)**: 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 asserted claim, what source code of each Accused Instrumentality allegedly satisfies the software limitations of the asserted claim elements.

[1] The Court anticipates that this disclosure requirement will obviate the need for requests for production.

> **P.R. 3-3(e)**: If a party claiming patent infringement exercises the provisions of P.R. 3-1(g), the party opposing a claim of patent infringement may serve, not later than 30 days after receipt of a P.R. 3-1(g) 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 the following discovery propounded or proffered by each party:

(a) Written Discovery:

(i) 25 interrogatories per side;

(ii) 60 requests for admissions per side;

(iii) An unlimited number of requests for admission may be served to establish the authenticity of documents or the business records exception to the hearsay rule under Fed. R. Evid. 803(6); and,

(iv) Document subpoenas and depositions on written questions. The parties may serve as many document subpoenas and depositions on written questions of custodians of business records as needed.

(b) Depositions (non expert):

(i) 60 hours for the depositions of another party (excluding inventor depositions);

(ii) 84 hours of nonparty depositions;

(iii) Defendant shall be entitled to take a deposition of any inventor of the patents in suit according to Rule 30 of the Federal Rules, which deposition time shall not count against the above time limits;

(iv) Maxell agrees to make any inventors it intends to call at trial available for deposition in the United States. If Apple asks to depose an inventor who Maxell does not intend to present as a witness at trial, Maxell agrees to make reasonable efforts to make such inventor witnesses available for deposition in the United States, including to work with Apple to facilitate such travel. If any inventors are unwilling to travel to the United States for deposition, Maxell agrees to make reasonable efforts to work with Apple to facilitate the deposition of that inventor in Japan or another mutually convenient country.

(v) Any deposition time requiring the use of a translator shall be counted in an amount equal to 66% of the actual time incurred (e.g., three (3) hours of deposition time requiring the use of a translator shall count as two (2) hours).

(c) Experts: Expert depositions shall be conducted in accordance with the Federal Rules of Civil Procedure except as set forth herein. If one technical expert witness's report addresses infringement or invalidity issues for more than one subject matter,[2] then that expert may be deposed for an additional three (3) hours for each additional subject matter covered by his/her report(s), but in no case may a technical expert witness be deposed for more than 14 hours. The limitations in this sub-paragraph shall not apply to depositions of expert witnesses as part of claim construction discovery.

- Any party may later move to modify these limitations for good cause.
- All discovery shall be proportional to the needs of the case pursuant to Fed. R. Civ. P. 26(b)(1).

6. Privileged Information. There is no duty to disclose privileged documents or information. However, the parties are directed to meet and confer concerning privileged documents or information after the Status Conference. By the deadline set in the Docket Control Order, the parties shall exchange privilege logs identifying the documents or information and the basis for any disputed claim of privilege in a manner that, without revealing information itself privileged or protected, will enable the other parties to assess

[2] For purposes of Paragraph 5(c), each of the following groupings of asserted patents is treated as a separate "subject matter:" 1) U.S. Patent No. 6,748,317, U.S. Patent No. 6,580,999, and U.S. Patent No. 6,430,498; 2) U.S. Patent No. 8,339,493; 3) U.S. Patent No. 7,116,438; 4) U.S. Patent No. 6,408,193; 5) U.S. Patent No. 10,084,991; 6) U.S. Patent No. 6,928,306; 7) U.S. Patent No. 6,329,794; and 8) U.S. Patent No. 6,430,498.

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