

WEBINAR

*WilmerHale Webinar:  
Patent Litigation in the  
Western District of Texas*

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December 2, 2020

Speakers: Greg Lantier, Ben Ernst, George Manley, Wenbo Zhang

Attorney Advertising



## *Webinar Guidelines*

- Participants are in listen-only mode
- Submit questions via the Q&A feature
- Questions will be answered as time permits
- Offering 1 CLE credit in California and New York\*
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- For additional help with common technical issues, click on the question mark icon at the bottom of your screen

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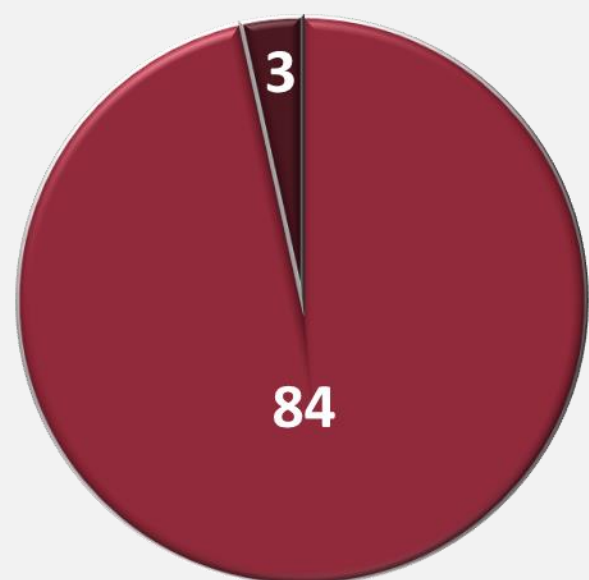


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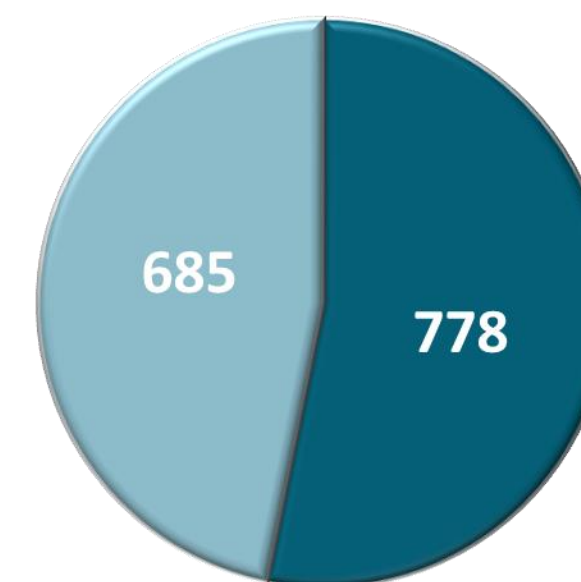
# *U.S. District Court for the Western District of Texas, Waco Division – Patent Infringement Actions Filed*

2017



■ WDTX ■ Waco Division

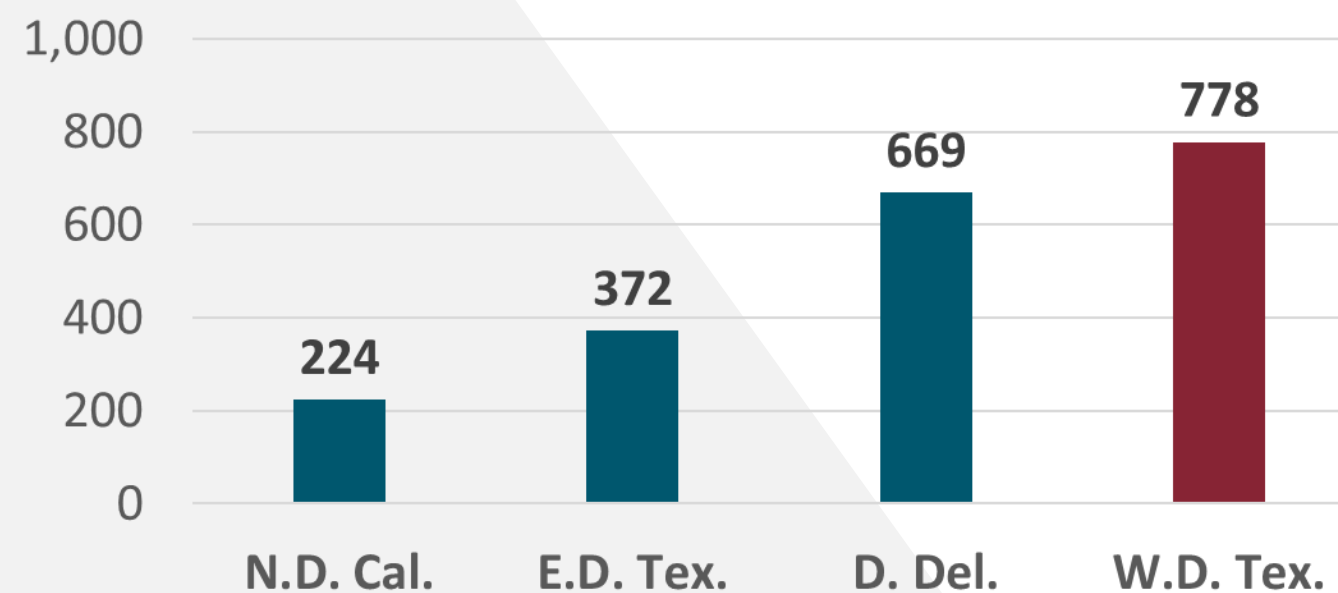
2020



■ WDTX ■ Waco

## Comparison with Other Jurisdictions

Actions Filed in District Courts



\* All data on this slide as of 11-30-2020



## *Honorable Alan D. Albright*

- Sworn in on September 24, 2018
- Former U.S. Magistrate Judge in Austin Division (1992-1999)





## *Judge Albright Standing Orders*

- [Standing Order Regarding Venue and Jurisdictional Discovery Limits for Patent Cases \(11/19/20\)](#)
- [Standing Order Regarding Updated Order Governing Proceedings for Patent Cases \(11/9/20\)](#)
- [Standing Order Regarding Patent Trademark Cases \(11/22/19\)](#)
- [Standing Order Regarding Notice of Readiness for Scheduling Conference in Patent Cases \(11/19/20\)](#)
- [Standing Order on Pretrial Procedures and Requirements in Civil Cases \(7/31/20\)](#)
- [Standing Order In Re: Trial Proceedings](#)
- [Standing Order – COVID 19](#)
- [Order Regarding Court Docket Management for Waco Division \(6/8/20\)](#)



# *Standing Order Regarding Notice of Readiness for Scheduling Conference (Version 2.0)*

- After all Defendants have responded to initial pleadings, parties must meet-and-confer within 7 days of the last response, to discuss any pre-Markman issues
- Parties shall jointly file Case Readiness Status Report

Plaintiff	Case No. 6:20-cv-00000-ADA
v.	JURY TRIAL DEMANDED
[Defendant],	
Defendant	

**CASE READINESS STATUS REPORT**

Plaintiff [name] and Defendant [name(s)], hereby provide the following status report in advance of the initial Case Management Conference (CMC).

**FILING AND EXTENSIONS**

Plaintiff's Complaint was filed on [filing date]. There have been [one/two] extension[s] for a total of \_\_ days.

**RESPONSE TO THE COMPLAINT**

[Indicate if/when the defendant(s) responded to the Complaint, whether it was an Answer or Motion, and whether any counterclaims were filed other than counterclaims for non-infringement or invalidity]

**PENDING MOTIONS**

[Identify all pending motions]

**RELATED CASES IN THIS JUDICIAL DISTRICT**

[Identify all related cases in this Judicial District, including any other cases where a common patent is asserted]



## *Order Governing Proceedings – Preliminary Obligations*

- Preliminary Infringement Contentions (No later than 7 days before CMC)
- Plaintiff's Initial Production
  - all documents evidencing conception and reduction to practice for each claimed invention
  - a copy of the file history for each patent in suit.
- Preliminary Invalidity Contentions (7 weeks after CMC)
- Defendant's Initial Production
  - all prior art referenced in the invalidity contentions
  - technical documents, including software where applicable, sufficient to show the operation of the accused product(s)
  - summary, annual sales information for the accused product(s) for the two years preceding the filing of the Complaint, unless the parties agree to some other timeframe





## *Order Governing Proceedings – Claim Construction Briefing*

- November 9, 2020 Standing Order
  - OGP Version 3.2 *Markman* briefing limits apply to all cases in which opening *Markman* brief is due November 17, 2020 or later
- Presumed limits on number of claim terms to be construed:
  - “Presumed Limit” = Maximum # of terms Court will construe without further leave of Court
  - If grants leave for additional terms to be construed, Court may split the *Markman* hearing into multiple hearings

### Limits for Number of Claim Terms to be Construed

<b>1-2 Patents</b>	<b>3-5 Patents</b>	<b>More than 5 Patents</b>
8 terms	10 terms	12 terms



## *Order Governing Proceedings – Claim Construction Briefing*

- All filings will take place at 5pm CT
- Default order of terms:
  - the patent number (lowest to highest),
  - the claim number (lowest to highest), and
  - order of appearance within the lowest number patent and claim
- Same or similar terms appear in multiple claims:
  - lowest patent number, lowest claim number, and order of appearance within the patent and claim

- Page Limits:

Page Limits for Markman Briefs

Brief	1-2 Patents	3-5 Patents	More than 5 Patents
Opening (Plaintiff)	20 pages	30 pages	30 pages, plus 5 additional pages for each patent over 5 up to a maximum of 45 pages
Response (Defendant)	20 pages	30 pages	30 pages, plus 5 additional pages for each patent over 5 up to a maximum of 45 pages
Reply (Plaintiff)	10 pages	15 pages	15 pages, plus 2 additional pages for each patent over 5 up to a maximum of 21 pages
Sur-Reply (Defendant)	10 pages	15 pages	15 pages, plus 2 additional pages for each patent over 5 up to a maximum of 21 pages



## *Order Governing Proceedings – Claim Construction Hearing*

- Generally one ½ day for the Markman hearing
- The party opposing the Court’s preliminary construction shall go first
  - If both unwilling to accept the Court’s preliminary construction, the Plaintiff shall typically go first
- Technology Tutorials (optional):
  - Electronic form, with voiceovers, and submitted at least one week before the Markman hearing
  - Live tutorials: by Zoom or telephone, at least a week before *Markman*
  - <https://www.txwd.uscourts.gov/judges-information/exemplary-tutorials/>



## *Order Governing Proceedings – Post-Markman Schedule*

<b>Deadline</b>	<b>Item</b>
1 business day after <i>Markman</i> hearing	Fact Discovery opens; deadline to serve Initial Disclosures per Rule 26(a).
6 weeks after <i>Markman</i> hearing	Deadline to add parties.
8 weeks after <i>Markman</i> hearing	Deadline to serve Final Infringement and Invalidity Contentions. After this date, leave of Court is required for any amendment to Infringement or Invalidity contentions. This deadline does not relieve the Parties of their obligation to seasonably amend if new information is identified after initial contentions.
16 weeks after <i>Markman</i> hearing	Deadline to amend pleadings. A motion is not required unless the amendment adds patents or patent claims. (Note: This includes amendments in response to a 12(c) motion.)
26 weeks after <i>Markman</i> hearing	Deadline for the first of two meet and confers to discuss significantly narrowing the number of claims asserted and prior art references at issue. Unless the parties agree to the narrowing, they are ordered to contact the Court's Law Clerk to arrange a teleconference with the Court to resolve the disputed issues.
30 weeks after <i>Markman</i> hearing	Close of Fact Discovery.
31 weeks after <i>Markman</i> hearing	Opening Expert Reports.
35 weeks after <i>Markman</i> hearing	Rebuttal Expert Reports.
38 weeks after <i>Markman</i> hearing	Close of Expert Discovery.
39 weeks after <i>Markman</i> hearing	Deadline for the second of two meet and confer to discuss narrowing the number of claims asserted and prior art references at issue to triable limits. To the extent it helps the parties determine these limits, the parties are encouraged to contact the Court's Law Clerk for an estimate of the amount of trial time anticipated per side. The parties shall file a Joint Report within 5 business days regarding the results of the meet and confer.
40 weeks after <i>Markman</i> hearing	Dispositive motion deadline and Daubert motion deadline.



## *Order Governing Proceedings – Post-Markman Schedule*

<b>Deadline</b>	<b>Item</b>
42 weeks after <i>Markman</i> hearing	Serve Pretrial Disclosures (jury instructions, exhibits lists, witness lists, discovery and deposition designations).
44 weeks after <i>Markman</i> hearing	Serve objections to pretrial disclosures/rebuttal disclosures.
45 weeks after <i>Markman</i> hearing	Serve objections to rebuttal disclosures and File Motions in limine.
46 weeks after <i>Markman</i> hearing	File Joint Pretrial Order and Pretrial Submissions (jury instructions, exhibits lists, witness lists, discovery and deposition designations); file oppositions to motions in limine
47 weeks after <i>Markman</i> hearing	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, Kristie Davis at <a href="mailto:kmdaviscsr@yahoo.com">kmdaviscsr@yahoo.com</a> Deadline to meet and confer regarding remaining objections and disputes on motions in limine.
3 business days before Final Pretrial Conference.	File joint notice identifying remaining objections to pretrial disclosures and disputes on motions in limine.
49 weeks after <i>Markman</i> hearing (or as soon as practicable)	Final Pretrial Conference. The Court expects to set this date at the conclusion of the Markman Hearing.
52 weeks after <i>Markman</i> hearing (or as soon as practicable)	Jury Selection/Trial. The Court expects to set these dates at the conclusion of the Markman Hearing.



## *Order Governing Proceedings – Discovery Disputes*

- Before filing any Motion to Compel:
  - Lead counsel meet-and-confer
  - If good-faith attempt to resolve the dispute fails, then contact Court's law clerk to arrange a telephone conference with the Court



## *Order Governing Proceedings – Discovery Disputes*

- At telephone conference, parties summarize the dispute for the Court and provide respective positions
  - Summaries “shall be neutral and non-argumentative”
- After hearing from parties, Court will rule or determine if further briefing is required



## *Standing Order on Pre-Trial Procedures and Requirements in Civil Cases*

- Content of Joint Pretrial Order:
  - Appearance of counsel
  - Joint statement of the case
  - Parties' contentions
  - Exhibit and witness lists
  - Jury charge
  - Proposed voir dire
  - Motions in limine
  - *If applicable*: Memoranda on disputed issues; proposed findings of fact and conclusions of law





## *Standing Order on Pre-Trial Procedures and Requirements in Civil Cases*

- Digital submissions
  - Exhibit and witness lists and objections; jury charge; proposed findings of fact and conclusions of law (bench trials)
- Exhibits:
  - Courtesy copy to the Court by Final PTC
  - Court will rule on objections at Final PTC
  - All exhibits not objected to will be admitted into evidence at Final PTC
- Demonstratives:
  - Contact law clerk to determine logistics



## *Juror Questionnaire*

- Example from *MV3 v. Roku* trial available on Court's website
- Topics: education; employment; familiarity with parties and accused products; hardships
- Court may ask parties to draft
  - Expect to exchange drafts with opposing party and make joint submission



## *Standing Order on Trial Proceedings*

- July 17, 2019 Standing Order In re: Trial Proceedings
  - Trial day generally begins at 9:00 AM, and counsel required to be in the courtroom no later than 8:00 AM
  - Sets forth process for using technology to present evidence during trial
  - Must bring physical copies of transcripts of any depositions take of trial witnesses
  - Directs counsel to contact Court Security Officers to obtain access to the courtroom



## *Pandemic-Related Standing Order*

- March 12, 2020 Standing Order Regarding Coronavirus (COVID-19) and Court Proceedings
  - Invites parties to work together to jointly request continuances and modifications to hearings in light of COVID-19
  - Indicates Court's intention to continue holding in-person *Markman* hearings (as of March)
  - Signals that *Markman* hearings will only be postponed if Court determines that no other alternative arrangement is satisfactory



## *Standing Order Regarding Venue and Jurisdictional Discovery Limits for Patent Cases*

- November 19, 2020 Standing Order Regarding Venue and Jurisdictional Discovery Limits for Patent Cases
  - Lifts all limits other than Rule 26(b)(1) on discovery related to venue and jurisdiction in patent cases
  - Venue or jurisdictional discovery must be completed no later than six months after the filing of the initial motion
  - Deadline for Plaintiff's response to motion is two weeks after the completion of venue or jurisdictional discovery



## Questions



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