

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
ALL DIVISIONS**BY: Reuben Amaro  
DEPUTY

HONORABLE KATHLEEN CARDONE     §  
   §     ALL PATENT CASES  
   §

**STANDING ORDER ON PATENT CASES**

This Standing Order on Patent Cases governs proceedings in all patent cases pending before United States District Court Judge Kathleen Cardone, regardless of the division in which the case is filed. For patent cases only, this Standing Order supersedes the Court’s December 14, 2015, Standing Order on Pretrial Deadlines.

**I.     PRELIMINARY INFRINGEMENT CONTENTIONS****A.     Preliminary Infringement Contentions**

Within thirty (30) days after the appearance of any defendant,<sup>1</sup> a party claiming patent infringement shall serve on all parties its Preliminary Infringement Contentions, which shall contain the following information:

- 1) Each claim of each patent in suit that is allegedly infringed by each opposing party.
- 2) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality (“Accused Instrumentality”) of each opposing party of which the party is aware. This identification shall be as specific as possible, utilizing names and model numbers, if known.
- 3) A chart identifying specifically where and how each element of each asserted claim is found within each Accused Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(f), the identity of the structure(s),

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<sup>1</sup> An “appearance,” as used throughout this Standing Order, shall include the serving of an answer, the filing of a notice of removal, the filing of a motion to dismiss, and the transfer of an action from another judicial district.

act(s), or material(s) in the Accused Instrumentality that performs the claimed function.

- 4) Whether each element of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality.
- 5) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled.
- 6) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own or its licensee's apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party shall identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

**B. Accompanying Document Production**

Accompanying the Preliminary Infringement Contentions, the party claiming patent infringement shall produce to each opposing party or make available for inspection and copying:

- 1) Documents (e.g., contracts, purchase orders, invoices, advertisements, marketing materials, offer letters, beta site testing agreements, and third party or joint development agreements) sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third party, or sale of or offer to sell, the claimed invention prior to the date of application for the patent in suit. A party's production of a document as required herein shall not constitute an admission that such document evidences or is prior art under 35 U.S.C. § 102.

- 2) All documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to Section I(A)(5), *supra*, whichever is earlier.
- 3) A copy of the file history for each patent in suit.

## **II. REPORT OF PARTIES' PLANNING MEETING**

Pursuant to Local Rule CV-16(a), the parties shall meet, confer, and jointly submit a Report of Parties' Planning Meeting ("RPPM"), in the form prescribed by Appendix A to this Order within forty-five (45) days after the appearance of any defendant. The RPPM shall satisfy the requirements of Federal Rule of Civil Procedure 26(f). Based upon the RPPM, the Court shall issue the Scheduling Order in the case as required by Federal Rule of Civil Procedure 16(b) and Local Rule CV-16.

The parties shall endeavor to agree concerning the contents of the RPPM, but in the event they are unable to do so, each party shall set out its position and the reasons for the disagreement in the RPPM. Further, the parties may request a modification of the Court's exemplary deadlines set forth in Appendix A, which the Court may grant only upon a showing of good cause. The good cause standard requires a particularized showing that the exemplary deadlines set forth in Appendix A cannot reasonably be met despite the diligence of the party seeking the extension. Unless specifically ordered by the Court, an extension of time to comply with any one of the time limits in the Scheduling Order does not extend the time to comply with subsequent time limits.

The Court prefers to manage separate cases that are filed concurrently by the same plaintiff and involve allegations of infringement of the same patent, as a group. Barring

exceptional circumstances, the Court will order parallel scheduling deadlines and hold a single, joint *Markman* hearing, for all such related cases.

### **III. PRELIMINARY INVALIDITY CONTENTIONS**

#### **A. Preliminary Invalidity Contentions**

On or before the deadline set in the Scheduling Order, each party opposing a claim of patent infringement shall serve on all parties its Preliminary Invalidity Contentions, which shall contain the following information:

- 1) The identity of each item of prior art that allegedly anticipates each asserted claim or renders it obvious. Each prior art patent shall be identified by its number, country of origin, and date of issue. Each prior art publication must be identified by its title, date of publication, and where feasible, author and publisher. Each alleged sale or public use shall be identified by specifying the item offered for sale or publicly used or the information known, the date the offer or use took place or the information became known, and the identity of the person or entity which made the use or which made and received the offer, or the person or entity which made the information known or to whom it was made known. For pre-AIA claims, prior art under 35 U.S.C. § 102(f) shall be identified by providing the name of the persons from whom and the circumstances under which the invention or any part of it was derived. For pre-AIA claims, prior art under 35 U.S.C. § 102(g) shall be identified by providing the identities of the persons or entities involved in and the circumstances surrounding the making of the invention before the patent applicant(s). For post-AIA claims, prior art references showing that the claimed invention was otherwise available to the public under 35 U.S.C. § 102(a)(1) shall be identified by specifying the form and nature of

the reference, the manner in which the reference was made public, and the date on which the reference was made public.

- 2) Whether each item of prior art anticipates each asserted claim or renders it obvious. If obviousness is alleged, an explanation of why the prior art renders the asserted claim obvious, including an identification of any combinations of prior art showing obviousness.
- 3) A chart identifying specifically where and how in each alleged item of prior art each limitation of each asserted claim is found, including for each limitation that such party contends is governed by 35 U.S.C. § 112(f), the identity of the structure(s), act(s), or material(s) in each item of prior art that performs the claimed function.
- 4) Any grounds of invalidity based on 35 U.S.C. § 101.
- 5) Any grounds of invalidity based on indefiniteness under 35 U.S.C. § 112(b) or enablement or written description under 35 U.S.C. § 112(a).

**B. Accompanying Document Production**

Accompanying the Preliminary Invalidity Contentions, the party opposing a claim of patent infringement shall produce to each opposing party or make available for inspection and copying:

- 1) Source code, specifications, schematics, flow charts, artwork, formulas, or other documentation sufficient to show the operation of any aspects or elements of an Accused Instrumentality identified by the patent claimant in its Preliminary Infringement Contentions.

- 2) A copy of each item of prior art identified pursuant to Section III(A)(1) which does not appear in the file history of the patent(s) at issue. To the extent any such item is not in English, an English translation of the portion(s) relied upon must be produced.

#### **IV. DISCOVERY**

Except with regard to venue, jurisdictional, and claim construction-related discovery, all other discovery shall be stayed until after the *Markman* hearing, unless the parties agree to conduct additional discovery. If the parties do not agree, the party seeking additional discovery prior to the *Markman* hearing must seek leave of Court.

#### **V. CLAIM CONSTRUCTION PROCEEDINGS**

##### **A. Exchange of Proposed Terms and Claim Elements**

On or before the Exchange of Proposed Terms and Claim Elements deadline set in the Scheduling Order, the parties shall simultaneously exchange a list of claim terms, phrases, or clauses which that party contends should be construed or found indefinite by the Court. The parties shall identify any claim element which that party contends should be governed by 35 U.S.C. § 112(f).

##### **B. Exchange of Preliminary Claim Constructions and Extrinsic Evidence**

On or before the Exchange of Preliminary Claim Constructions and Extrinsic Evidence deadline set in the Scheduling Order, the parties shall simultaneously exchange a preliminary proposed construction of each claim term, phrase, or clause which the parties collectively have identified for claim construction purposes. For each element which any party contends is governed by 35 U.S.C. § 112(f), the party shall also identify the structure(s), act(s), or material(s) corresponding to that element. The parties shall also provide a preliminary identification of extrinsic evidence, including without limitation, dictionary definitions, citations to learned

treatises and prior art, and testimony of percipient and expert witnesses they contend support their respective claim constructions or indefiniteness positions. The parties shall identify each such item of extrinsic evidence by Bates number or produce a copy of any such item not previously produced. With respect to any such witness, percipient or expert, the parties shall also provide the identity and a brief description of the substance of that witness' proposed testimony.

**C. Joint Claim Construction and Prehearing Statement**

On or before the Joint Claim Construction and Prehearing Statement deadline set in the Scheduling Order, the parties shall meet and confer and jointly file a Joint Claim Construction and Prehearing Statement with the Court, which shall contain the following information:

- 1) The construction of those claim terms, phrases, or clauses on which the parties agree.
- 2) Each party's proposed claim construction or indefiniteness position for each disputed claim term, phrase, or clause, together with an identification of all references from the specification or prosecution history that support that position, and an identification of any extrinsic evidence known to the party on which it intends to rely either to support its position or to oppose any other party's position, including, but not limited to, as permitted by law, dictionary definitions, citations to learned treatises and prior art, and testimony of percipient and expert witnesses.
- 3) The anticipated length of time necessary for the *Markman* hearing.
- 4) Whether any party proposes to call witnesses at the *Markman* hearing, and if so, the identity of each such witness, and whether each witness is an expert.

On or before the Joint Claim Construction and Prehearing Statement deadline, any party that intends to rely on any expert witness to support that party's proposed constructions shall

serve the other parties with a claim construction expert report for that witness, in compliance with Rule 26(a)(2)(B) or 26(a)(2)(C) of the Federal Rules of Civil Procedure.

**D. Completion of Claim Construction Discovery**

On or before the Completion of Claim Construction Discovery deadline set in the Scheduling Order, the parties shall complete all discovery relating to claim construction, including any depositions with respect to claim construction of any witnesses, including experts, identified in the Joint Claim Construction and Prehearing Statement.

**E. Claim Construction Briefs**

The Court will require non-simultaneous *Markman* briefing. On or before the deadline set for Claim Construction Opening Briefs, each party claiming patent infringement shall file a brief and any evidence supporting its claim construction. All asserted patents shall be attached as exhibits to the opening claim construction brief in searchable PDF form.

On or before the deadline set for Claim Construction Response Briefs, each party resisting infringement claims shall file a brief and supporting evidence.

On or before the deadline set for Claim Construction Reply Briefs, each party claiming patent infringement shall file any reply brief and any evidence directly rebutting the supporting evidence contained in an opposing party's Response brief.

Parties must seek leave of Court to exceed the page limits established by the Local Civil Rules. Parties must also seek leave of Court to file any additional claim construction briefs, such as a sur-reply.

**F. *Markman* Hearing and Technology Tutorials**

The Court will hold a consolidated *Markman* hearing for all related cases, whenever feasible. Technology tutorials are optional, especially in cases where a technical advisor has



been appointed. If the parties submit one, the tutorial should be in electronic form, with voiceovers, and submitted at least ten days prior to the *Markman* hearing. To submit a technology tutorial, the parties should contact the clerk's office in the division in which their case is pending, for instructions on how to upload the tutorial files to a secure file-sharing platform:

**El Paso:** Call (915) 834-0528

**Waco:** Email [TXWDWacoDistrictClerksOffice@txwd.uscourts.gov](mailto:TXWDWacoDistrictClerksOffice@txwd.uscourts.gov)

## **VI. AMENDING CONTENTIONS**

The Scheduling Order will include a deadline for Final Contentions, after which leave of Court is required for any amendment to infringement or invalidity contentions. The Final Contentions deadline does not relieve the parties of their obligation to seasonably amend if new information is identified after initial contentions.

Prior to the Final Contentions deadline, the parties must seek leave of Court only to the extent that an amendment adds patent claims. So long as claims are not added, the parties may amend infringement and invalidity contentions prior to the Final Contentions deadline, without seeking leave of Court. Contentions must be promptly amended whenever a party determines the need for amendment.

## **VII. CONFIDENTIALITY**

Discovery may not be withheld on the basis of confidentiality absent a Court order. Because the Court finds that any patent case is likely to involve production of confidential, sensitive, or private information for which special protection from public disclosure and from use for any purpose other than prosecuting this litigation would be warranted, the Confidentiality and Protective Order available as Appendix H-1 to the Local Rules of the United States District

Court for the Western District of Texas shall govern discovery in such matters unless the Court enters a different protective order. Parties that wish to proceed under a different protective order may submit one via motion.

**SO ORDERED.**

**SIGNED this 14th day of September, 2022.**



**KATHLEEN CARDONE**  
**UNITED STATES DISTRICT JUDGE**

**APPENDIX A**

**IN THE UNITED STATES DISTRICT COURT  
FOR THE WESTERN DISTRICT OF TEXAS  
[EL PASO / WACO] DIVISION**

[]	§	
	§	
<b>Plaintiff,</b>	§	
	§	
v.	§	<b>CAUSE NO. []-[]-CV-[]-KC</b>
	§	
[],	§	
	§	
<b>Defendants.</b>	§	

**REPORT OF PARTIES' PLANNING MEETING**

Date Complaint Filed: [date]

Date Complaint Served: [date]

Date of first Defendant's Appearance: [date]

Cases filed by Plaintiff in the Western District of Texas alleging infringement of one or more of the same patents within the last two years: [list all cases, including names of parties, cause numbers, and presiding judges]

Pursuant to Federal Rules of Civil Procedure 16(b), 26(f), and Local Rule 16, a conference was held on [date]. The participants were:

\_\_\_\_\_ for Plaintiff(s) [party name(s)]

\_\_\_\_\_ for Defendant(s) [party name(s)]

**I. Certification**

Undersigned counsel certify that, after consultation with their clients, they have discussed the nature and basis of the parties' claims and defenses and any possibilities of achieving a prompt settlement or other resolution of the case and, in consultation with their clients, have developed

the following proposed case management plan. Counsel further certify that they have forwarded a copy of this report to their clients.

II. Jurisdiction & Venue

A. Subject Matter Jurisdiction

[Provide a brief statement of the basis for subject matter jurisdiction with appropriate statutory citations. If Plaintiff's allegation of subject matter jurisdiction is contested, specify the basis for such challenge.]

B. Personal Jurisdiction

[State whether personal jurisdiction is contested and, if it is, summarize the parties' competing positions.]

C. Venue

[State whether venue is contested and, if it is, summarize the parties' competing positions.]

III. Brief Description of Case

[Briefly summarize the claims and defenses of all parties and describe the relief sought. If agreement cannot be reached on a joint statement, each party must provide a short separate statement. The requirement that the parties briefly summarize their claims and defenses is not intended to be unduly burdensome. The parties are obliged to discuss and consider the nature of their claims and defenses at the planning conference in order to formulate a meaningful case management plan. Moreover, the presiding judge needs to be informed of the nature of the claims and defenses in order to evaluate the reasonableness of the parties' proposed plan. The statement of the parties' claims and defenses, whether set forth jointly or separately, does not preclude any party from raising new claims and defenses as permitted by other applicable law.]

A. Claims of Plaintiff(s)

B. Defenses and Claims (Counterclaims, Third Party Claims, Cross Claims) of Defendant(s)

C. Defenses and Claims of Third-Party Defendant(s)

IV. Statement of Undisputed Facts

Counsel certify that they have made a good faith attempt to determine whether there are any material facts that are not in dispute. The parties state that the following material facts are undisputed:

[undisputed facts]

V. Case Management Plan

A. Preliminary Infringement Contentions

All parties claiming patent infringement certify that they served their Preliminary Infringement Contentions on [list all other parties and specify the date on which each was served].

B. Discovery

[Discovery in patent cases ordinarily proceeds in phases, as described throughout the Court's Standing Order on Patent Cases and this Appendix. If requesting a different discovery procedure, describe the procedure and explain why it is warranted, here.]

[Indicate whether the parties agree on limits for written discovery and depositions. If the parties do not agree, state the parties' respective positions.]

[Indicate whether any other discovery disputes are anticipated at this time.]

C. Early Settlement Conference

The parties acknowledge that the Court will order them to participate in an alternative dispute resolution proceeding prior to trial. The parties certify that they have considered the desirability of attempting to settle this case prior to the *Markman* hearing. Settlement [is likely] [is unlikely] at this time and [may be enhanced by use of the following procedure].

D. Modification of Deadlines and Proposed Schedule

The parties [request] [do not request] modification of the deadlines in the Court's Standing Order on Patent Cases.

[If requesting modification of the standard deadlines, specify which deadlines, and explain why there is good cause to modify.]

**Motions to Transfer:** [ordinarily, 30 days from filing RPPM]

**Preliminary Invalidity Contentions:** [ordinarily, 35 days from filing RPPM]

**Exchange of Proposed Terms and Claim Elements:** [ordinarily, 45 days from filing RPPM]

**Exchange of Preliminary Claim Constructions and Extrinsic Evidence:** [ordinarily, 65 days from filing RPPM]

**Joint Claim Construction and Prehearing Statement:** [ordinarily, 95 days from filing RPPM]

**Claim Construction Discovery Closes:** [ordinarily, 125 days from filing RPPM]

**Claim Construction Opening Brief:** [ordinarily, 140 days from filing RPPM]

**Claim Construction Response Brief:** [ordinarily, 154 days from filing RPPM]

**Claim Construction Reply Brief:** [ordinarily, 161 days from filing RPPM]

**Optional Technology Tutorials:** [10 days before *Markman* hearing]

**Markman Hearing:** [ordinarily, approximately 182 days from filing RPPM, subject to the Court's schedule]

**Fact Discovery Opens:** [1 business day after *Markman* hearing]

**Final Contentions:** [ordinarily, 60 days after *Markman* hearing]

**Amended Pleadings:** [ordinarily, 90 days after *Markman* hearing]

**Fact Discovery Closes:** [ordinarily, 6 months after *Markman* hearing]

**Opening Expert Reports:** [ordinarily, 1 week after close of fact discovery]

**Rebuttal Expert Reports:** [ordinarily, 3 weeks after opening expert reports]

**Expert Discovery Closes:** [ordinarily, 2 months after close of fact discovery]

**Dispositive Motions / Daubert Motions:** [ordinarily, 1 month after close of expert discovery]

**[Jury Selection and] Trial:** [ordinarily, approximately 4 months after dispositive motions deadline, subject to the Court's schedule]

As officers of the Court, undersigned counsel agree to cooperate with each other and the Court to promote the just, speedy, and efficient determination of this action.

[signature of counsel for all parties]