

**UNITED STATES DISTRICT COURT  
DISTRICT OF MINNESOTA**

In re: VEHICLE TRACKING AND  
SECURITY SYSTEM ('844) PATENT  
LITIGATION

MDL No. 11-2249 (DWF/SER)

This Document Relates to All Actions

**PRETRIAL SCHEDULING ORDER**

Pursuant to Rule 16 of the Federal Rules of Civil Procedure and the Local Rules of this Court, and in order to secure the just, speedy and inexpensive determination of this action, the following schedule shall govern these proceedings. The schedule may be modified only upon formal motion and a showing of good cause as required by Local Rule 16.3.

The case schedule, as detailed below, is attached as Exhibit A.

**(a) Pleadings**

- (1) Defendants do not contest service and do not presently intend to amend their pleadings or add additional parties to the action. To the extent necessary, Plaintiff was able to add additional defendants by **November 9, 2012**.
- (2) Any motion by Defendants which seeks to amend the pleadings to add a claim for inequitable conduct must be served and filed on or before **July 2, 2013**.

**(b) Discovery and Pleading of Additional Claims and Defenses**

- (1) Discovery is permitted with respect to claims of willful infringement and defenses of patent invalidity or unenforceability not pleaded by a party, where the evidence needed to support these claims or defenses is in whole or in part in the hands of another party.
- (2) Once a party has given the necessary discovery, the opposing party may seek leave of Court to add claims or defenses for which it alleges, consistent with Fed. R. Civ. P. 11, that it has support, and such support shall be explained in the motion seeking leave. Leave shall be liberally

given where prima facie support is present, provided that the party seeks leave as soon as reasonably possible following the opposing party providing the necessary discovery.

(c) **Fact Discovery**

The Court establishes the following fact discovery deadlines and limitations:

- (1) All pre-discovery disclosures required by Fed. R. Civ. P. 26(a)(1) were to have been completed on or before **November 2, 2012**.
- (2) Fact discovery shall be commenced in time to be completed by **September 6, 2013**.
- (3) Discovery limitations and procedures are as follows:
  - (A) Defendants may serve 20 common interrogatories shared by all Defendants and 10 individual interrogatories per Defendant, provided such individual interrogatories are not duplicative of interrogatories already served on the receiving party and provided that an answer by Plaintiff to any Defendant's individual discovery is binding on Plaintiff as to all Defendants. Plaintiff may serve 20 common interrogatories to all Defendants and 10 individual interrogatories per Defendant. Any individual interrogatories served by or on any party, shall not be on matters that relate exclusively to a party other than the serving and/or served party. The parties will count interrogatories in accordance with Rule 33(a) of the Federal Rules of Civil Procedure.
  - (B) No limit on document requests.
  - (C) Unless leave of the Court is obtained in accordance with Rules 30 or 31 of the Federal Rules of Civil Procedure, PJC gets no more than two factual depositions per Defendant (Plaintiff expects to seek one technical and one damages deposition per Defendant, but reserves the right if warranted to seek a second technical deposition of a particular Defendant if needed); Defendants as a group get five days of depositions of Plaintiff (i.e., a combined total of 35 hours of 30(b)(6) and 30(b)(1) time); Plaintiff and each Defendant get up to 20 third-party depositions (excluding expert depositions).
  - (D) Limit of 50 requests for admissions per side with the Defendants getting 35 common requests and 15 individual (per Defendant)

requests, provided such individual requests are not duplicative of requests already served on the receiving party and provided that an answer by Plaintiff to any Defendant's individual discovery is binding on Plaintiff as to all Defendants. Plaintiff may serve 35 common requests to all Defendants and 15 individual requests per Defendant. Any individual requests served by or on any party, shall not be on matters that relate exclusively to a party other than the serving and/or served party.

- (E) The Court adopts the Federal Circuit's e-discovery rules for this case, attached as Exhibit B, "Model Order Regarding E-Discovery in Patent Cases."

**(d) Expert Discovery**

The parties anticipate that they will require expert witnesses at time of trial.

- (1) The Plaintiff anticipates calling two technical or industry experts and one damages expert.
- (2) Defendants anticipate calling two technical or industry experts and one damages expert. It is unclear at this early stage whether Defendants will each retain their own individual experts or retain commonly shared experts. Conflicts may arise amongst Defendants on certain technical issues or damages theories necessitating the use of separate experts. In addition, there may be logistical issues with multiple cases being sent back for trial in multiple jurisdictions with varying groups of Defendants being joined for trial, and this could necessitate various arrangements for sharing or nonsharing of experts.
- (3) By the close of fact discovery (**September 6, 2013**), the parties shall identify to the opposing party the experts who will provide a report that deals with the issues on which that party has the burden of persuasion.
- (4) By **October 8, 2013**, the parties shall exchange initial expert reports, which reports shall be in accordance with Fed. R. Civ. P. 26(a)(2)(B). The initial expert reports from each party shall deal with the issues on which that party has the burden of persuasion.
- (5) By **November 7, 2013**, the parties shall exchange rebuttal expert reports. Rebuttal expert reports shall also be in accordance with Fed. R. Civ. P. 26(a)(2)(B).

- (6) Discovery of expert witness will be governed by Fed. R. Civ. P. 26(b)(4).
- (7) Any discovery of draft expert reports will be governed by Fed. R. Civ. P. 26(b)(4).
- (8) All expert discovery shall be commenced in time to be completed by **December 6, 2013**.

(e) **Discovery Relating to Claim Construction Hearing**

- (1) Effective deadline for Plaintiff's Claim Charts: **September 12, 2012** (per the parties' agreement and the Court's approval of that date during the September 12, 2012 status conference).

Plaintiff's Claim Chart shall identify: (1) which claim(s) of its patent(s) it alleges are being infringed; (2) which specific products or methods of defendant's it alleges literally infringe each claim; and (3) where each element of each claim listed in (1) is found in each product or method listed in (2), including the basis for each contention that the element is present. If there is a contention by Plaintiff that there is infringement of any claims under the doctrine of equivalents, Plaintiff shall separately indicate this on its Claim Chart and, in addition to the information required for literal infringement, Plaintiff shall also explain each function, way, and result that it contends are equivalent, and why it contends that any differences are not substantial.

- (2) Deadline for Defendant's Claim Chart: **December 6, 2012**.

Defendant's Claim Chart shall indicate with specificity which elements on Plaintiff's Claim Chart it admits are present in its accused device or process, and which it contends are absent. In the latter regard, Defendant will set forth in detail the basis for its contention that the element is absent. As to the doctrine of equivalents, Defendant shall indicate on its chart its contentions concerning any differences in function, way, and result, and why any differences are substantial.

- (3) By **February 1, 2013**, the parties shall simultaneously exchange a list of claim terms, phrases, or clauses that each party contends should be construed by the Court. By **February 13, 2013**, the parties shall meet and confer for the purpose of finalizing a list, narrowing or resolving differences, and facilitating the ultimate preparation of a joint claim construction statement. During the meet-and-confer process, the parties shall exchange their preliminary proposed construction of each claim term,

phrase, or clause which the parties collectively have identified for claim construction purposes.

At the same time the parties exchange their respective “preliminary claim constructions” they 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 that they contend support their respective claim constructions. The parties shall identify each such item of extrinsic evidence by production 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 a brief description of the substance of that witness’ proposed testimony.

- (4) Following the parties’ meet and confer described above, and no later than **March 5, 2013**, the parties shall notify the Court as to whether they request that the Court schedule a claim construction hearing to determine claim interpretation. If any party believes there is no reason for a claim construction hearing, the party shall provide the reason to the Court.

Also by **March 5, 2013**, the parties shall complete and file with the Court a joint claim construction statement that shall contain the following information:

- (A) The construction of those claim terms, phrases, or clauses on which the parties agree;
- (B) Each party’s proposed construction of each disputed claim term, phrase, or clause together with an identification of all references from the specification or prosecution history that support that construction, and an identification of any extrinsic evidence known to the party on which it intends to rely either in support of its proposed construction of the claim or to oppose any other party’s proposed construction of the claim, including, but not limited, as permitted by law, dictionary definitions, citation to learned treatises and prior art, and testimony of percipient and expert witnesses; however, any party may use additional extrinsic evidence not known to them at the time of the joint claim construction report, provided the party promptly notifies all other parties, within a reasonable period of time, of both the existence of such evidence and its intent to rely on such evidence, and provided such other parties are permitted the opportunity to respond to such evidence in written briefing to the Court;

- (C) Whether any party proposes to call one or more witnesses, including experts at the claim construction hearing, the identity of each such witness and for each expert, a summary of each opinion to be offered in sufficient detail to permit a meaningful deposition of that expert.
- (5) Subsequent to the March 5, 2013 notification (described in section (e)(4) above), if the Court schedules a claim construction hearing, the Court will also issue an order discussing:
  - (A) A briefing schedule; and
  - (B) A pre-Markman hearing and tutorial.
- (f) Discovery Relating to Validity/Prior Art**
  - (1) By **November 13, 2012**, Defendants shall serve on Plaintiff a list of all of the prior art on which it relies, and a complete and detailed explanation of what it alleges the prior art shows and how that prior art invalidates the claim(s) asserted by Plaintiff (“Defendants’ Prior Art Statement”).
  - (2) By **January 21, 2013**, Plaintiff shall serve on Defendants “Plaintiff’s Prior Art Statement,” in which it will state in detail its position on what the prior art relied upon by Defendants shows, if its interpretation differs from Defendants’, and its position on why the prior art does not invalidate the asserted patent claims.
  - (3) Plaintiff’s and Defendants’ Prior Art Statements can be, but need not be, in the form of expert reports.
  - (4) Defendants may add prior art to their Prior Art Statements after the November 13, 2012 deadline only with leave of the Court.
- (g) Other Discovery Issues**
  - (1) Defendants may postpone the waiver of any applicable attorney-client privilege on topics relevant to claims of willful infringement, if any, until **August 6, 2013**, provided that all relevant privileged documents are produced no later than a month before the close of fact discovery. All additional discovery regarding the waiver will take place after **August 6, 2013**, and shall be completed by **September 6, 2013**.

- (2) Damages/willfulness discovery shall not commence until **April 1, 2013**. Limited damages/willfulness discovery, however, shall be permitted in accordance with the parties' discussions during the September 12, 2012 status conference. Such limited damages/willfulness discovery is limited to: (i) discovery related to the average selling price of Defendants' alleged infringing units; (ii) the number of alleged infringing units sold by Defendants; and (iii) Plaintiff's license or settlement agreements concerning the '844 patent. The receiving party of any damages/willfulness discovery produced before the April 1, 2013 date agrees to view such discovery on a "Highly Confidential - Outside Counsel Only" basis unless another designation is mutually agreed upon by the parties.
- (3) A Protective Order was entered on October 15, 2012 (Doc. No. 200).

**(h) Discovery Definitions**

In responding to discovery requests, each party shall construe broadly terms of art used in the patent field (e.g., "prior art," "best mode," "on sale"), and read them as requesting discovery relating to the issue as opposed to a particular definition of the term used. Compliance with this provision is not satisfied by the respondent including a specific definition of the term of art in its response, and limiting its response to that definition.

**(i) Motion Schedule**

- (1) All nondispositive motions shall be filed and served on or before the following dates:
  - (A) All motions that seek to amend the pleadings in order to add parties were to have been served by **November 9, 2012**.
  - (B) All other nondispositive motions and supporting documents shall be served and filed by **December 18, 2013**.
  - (C) All nondispositive motions shall be scheduled, filed and served in compliance with the Local Rules.
- (2) All dispositive motions be filed and served so they can be heard by the following dates:
  - (A) All dispositive motions shall be served and filed by the parties by **February 4, 2014**.

(B) All dispositive motions shall be scheduled, filed, and served in compliance with the Local Rules.

(3) The Court's May 31, 2012 Order (Doc. No. 139 ¶ 6) governs informal motion practice, which incorporates language and procedures set forth in *In re: Guidant Corp. Implantable Defibrillators Products Liability Litigation*, Pretrial Order No. 2 (Doc. No. 11 in Case No. 05-md-1708) at ¶ 21.

**(j) Trial-Ready Date**

(1) The parties agree that MDL No. 11-2249 (DWF/SER) will be ready for trial, on or before **July 14, 2014**.

(2) A final pretrial conference will be scheduled in the future.

**(k) Settlement**

The parties have been discussing settlement and a large number of cases have been settled. Those communications are ongoing. The parties will raise with the Court at the regularly scheduled status conferences the current status of individual settlement efforts. The parties understand that Magistrate Judge Steven Rau has scheduled the following mediation dates: January 28, 2013 through January 31, 2013.

**(l) Trial by Magistrate Judge**

The parties have not agreed to consent to jurisdiction by the Magistrate Judge under 28 U.S.C. § 636(c).

**(m) Tutorial Describing the Technology and Matters in Issue**

At the present time, the parties are unable to determine whether a tutorial would be helpful to the Court, given the early procedural posture of the case, and therefore do not currently request to provide one. If the parties subsequently believe that a tutorial would be helpful to the Court, the parties shall so advise the Court during a regularly-scheduled status conference, asking whether the Court wishes to schedule a tutorial and proposing the timing and format of the tutorial.

**(n) Patent Procedure Tutorial**

The parties agree the video “An Introduction to the Patent System,” distributed by the Federal Judicial Center, should be shown to the jurors in connection with its preliminary jury instructions.

Dated: November 21, 2012

s/Donovan W. Frank  
DONOVAN W. FRANK  
United States District Judge