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Gina M. Bassi is a Director and Senior Counsel in the Litigation group at Boehringer Ingelheim USA. Her practice focuses primarily on patent litigations involving BI's pharmaceutical products. Prior to joining BI, Gina was in-house counsel at another pharmaceutical company as well as in private practice in New York, where she represented both brand and generic companies in pharmaceutical patent litigations. Gina has a bachelor's degree in chemical engineering from Massachusetts Institute of Technology, and a law degree from American University Washington College of Law.

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Jeff Mills is a senior patent litigator at King & Spalding with more than twenty-five years of experience. He has led many patent litigation and enforcement matters in various venues, including U.S. district courts, the United States International Trade Commission, and the United States Court of Appeals for the Federal Circuit. Jeff is currently representing clients in numerous cases pending in the United States District Court for the Western District of Texas, and presented arguments in the first in-person hearing in the Waco Division after the Covid-19 court closure.

Jeff's Intellectual Property, Patent, Trademark and Copyright Litigation practice spans a broad spectrum of technologies, including semiconductors, satellite imaging, automotive technologies, advanced polymer technologies, Internet technologies (financial service products and online gaming), medical devices, and consumer products.

Jeff has been frequently invited to speak to practitioners and industry groups in the U.S. and Europe on recent developments in U.S. patent law.

Credentials

ADMISSIONS

U.S. Supreme Court
U.S. Court of Appeals for the Federal Circuit
U.S. Patent and Trademark Office
U.S. District Court for the Eastern District of Texas
U.S. District Court for the Northern District of Texas
U.S. District Court for the Southern District of Texas
U.S. District Court for the Western District of Texas
U.S. District Court for the Northern District of Illinois

CLERKSHIPS

Judicial Clerk, Honorable Helen W. Nies, U.S. Court of Appeals for the Federal Circuit

EDUCATION

B.A. History, University of Michigan, with honors

B.S. Chemical Engineering, University of Michigan, with distinction

J.D., University of Michigan, cum laude



John T. Moehringer

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John Moehringer handles complex patent litigation, primarily in the electrical engineering, telecommunications, and computer science fields. In addition to representing clients in patent infringement suits in the U.S. district courts, John also has substantial experience representing clients in the U.S. International Trade Commission. He also counsels clients with respect to various Intellectual Property issues, including IP licensing and transactions, and rendering non-infringement and invalidity opinions, and advises clients on issues related to data protection and usage, data privacy and licensing of data assets.

Prior to joining Cadwalader, John was a partner with Morgan & Finnegan. Before graduating from law school, he worked as an electrical engineer for Grumman Aerospace Corporation. John is currently a Board Member of the New York Intellectual Property Law Association (NYIPLA) and has served as Co-Chair of the NYIPLA Trade Secrets Committee, and is a member of the New York State Bar Association and the Conner Inn of Court.

John received his J.D. from Fordham University School of Law, where he was a member of the *Intellectual Property Law Journal*. He received his Bachelor's Degree in Electrical Engineering, *cum laude*, and his Master's Degree in Engineering Management from Polytechnic University (now NYU-Poly).

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Steven Rizzi is a trial lawyer focused on high stakes patent litigation. He has first-chaired five jury and bench patent trials in numerous district courts and the ITC since 2015 and has repeatedly been recognized for patent litigation by Best Lawyers in America, IAM Patent 1000, Legal 500, and SuperLawyers. Steven's practice is focused on technology-related patent litigation involving semiconductors, software, and telecommunications, but has also litigated patent cases in the life sciences space. Steven's additional patent litigation experience includes white LEDs, confectionary products, wireless telephony, interactive television, television/Internet convergence, on-line games, pay television, magnetic and optical disk storage technology and packaging designs, electronic program guides, sports equipment, fiber optic communications devices and financial products.

NYIPLA FALL PATENT CLE SERIES
November 12, 2020

“Litigating Patent Cases in the COVID Era”

Moderator: Steven Rizzi, *Partner*, King & Spalding

Speakers: Gina Bassi, *Senior Counsel*, Boehringer Ingelheim
Jeffrey Mills, *Counsel*, King & Spalding
John Moehringer, *Partner*, Cadwalader

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- (2) Optis Wireless Tech., LLC v. Apple Inc., No. 2:19-cv-00066-JRG (E.D. Tex. July 21, 2020).
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Preparing for Patent Jury Trials in the Midst of the COVID-19 Pandemic

By John T. Moehringer, Danielle V. Tully and Michael B. Powell¹

Courts handling patent litigation have responded to the COVID-19 pandemic by taking advantage of remote technology to allow discovery, claim construction and other hearings, and even a few bench trials, to proceed. The greatest struggle, however, has been how and when courts will be able to proceed with jury trials in patent cases in a manner that is both effective and safe for the jurors, the parties, counsel and the entire court staff.

Courts are facing significant uncertainties, and an increasing backlog of cases, causing stress on docket management. In addition to the congestion being caused by the delay of many civil jury cases, there is a backlog of criminal cases that will need to be given priority as courts are able to proceed.² Some courts have tried to encourage parties to consider alternative dispute resolution, or the possibility of settlement, to avoid unnecessary, prolonged litigation during the pandemic.³ Other courts have inquired as to whether the parties might consider proceeding with a bench trial instead of a jury trial, and even questioned whether the parties are entitled to a jury trial.⁴ In *Shire ViroPharma Inc. v. CSL Behring LLC*, Judge Mitchell S. Goldberg of the Eastern District of Pennsylvania, but sitting by designation in the District of Delaware, specifically considered the issue of a right to a jury trial, ultimately concluding that the defendant was entitled to a jury trial on patent invalidity and might even have such a right with respect to inequitable conduct, depending on how much this issue overlapped with other jury issues.⁵ Despite these efforts to find alternatives to in-person jury trials and subtly nudge parties towards non-jury proceedings, in most cases, parties seem intent on jury trials, leaving courts to grapple with how best to manage their dockets while also balancing public safety and the right to a trial by jury.

Enter the patent hotspots of the Eastern District of Texas, Western District of Texas, and District of Delaware. These courts have provided a glimpse of the various measures that may be employed to allow jury trials to begin again around the nation. While it is impossible to know how long these new procedures will remain in place, they are here to stay at least for the foreseeable future, and some may continue post-pandemic. In light of these new procedures, it is crucial that attorneys consider modifications to their approach to litigation and implement trial strategies that accommodate these new realities.

Safety Precautions Proposed by District Courts

In *Optis Wireless Technology, LLC v. Apple Inc.*—the first patent case to proceed to an in-person jury trial since the beginning of the pandemic—Chief Judge Rodney Gilstrap of the Eastern District of Texas implemented a number of precautions that might serve as a model for other courts. In advance of the pretrial conference, chambers emailed “precise instructions” to counsel, indicating that it intended “to provide additional guidance to counsel for the parties as part of the pretrial conference [] including limiting the number of persons seated at counsel tables to three persons per table during *voir dire* and during trial; directing trial counsel and the jury—once the trial begins—to wear face shields which will allow for a full view of the lawyers’ and jurors’ faces and expressions while providing substantial protection from projection of breath droplets; and encouraging all participants to follow the CDC’s community mitigation-guidelines.”⁶ The court also implemented procedures to

permit certain witnesses to testify via real-time live video where international travel restrictions prevented in-person testimony.⁷ The *Optis* trial ended in a jury verdict for the patentee of over \$500 million.⁸

In *Innovation Sciences, LLC v. Amazon.Com, Inc.*, over which Judge Amos L. Mazzant III of the Eastern District of Texas presided, counsel were required to wear masks during the eight-day jury trial except when questioning the witnesses.⁹ The court provided face shields and lunch each day to jurors who were selected.¹⁰ Counsel table was limited to five individuals, and the court advised attorneys to maintain social distancing and remain at the podium during questioning, although the court did permit attorneys to walk to the exhibit easel.¹¹ The *Innovation Sciences* case ended in a jury verdict of non-infringement, invalidity and patent ineligibility.¹²

In *MV3 Partners LLC v. Roku, Inc.*, the first patent jury trial to proceed during the pandemic in the Western District of Texas, Judge Alan D. Albright ordered witnesses to testify from behind plexiglass and only permitted three people at counsel table.¹³ Judge Albright also ruled that physical exhibits would not be permitted except for those that could be displayed using an ELMO, requiring all other exhibits be made electronically available to the jury.¹⁴ The court also indicated that bench conferences would be limited to one counsel per side.¹⁵ The *MV3* case ended in a jury verdict of non-infringement.¹⁶

During a fully-remote pretrial conference held before the *VirnetX Inc. v. Apple Inc.* trial, Judge Robert W. Schroeder III of the Eastern District of Texas clarified certain precautions for the *voir dire* process.¹⁷ For example, the potential juror pool were ordered to be split in half alphabetically and brought in as two groups during morning and afternoon sessions. The court limited each side to four attorneys at counsel table during *voir dire* and granted each side three peremptory strikes and 30 minutes for *voir dire*.¹⁸ Additionally, Judge Schroeder held that during trial, each side was limited to eight individuals in the court room, indicating that there would be no sidebars during trial, meaning that all objections would have to be made in front of the jury.¹⁹ The jury returned a verdict in the *VirnetX* matter determining that the plaintiff was entitled to a royalty rate of \$0.84 per infringing unit, amounting to a total royalty amount of \$502,848.847.20.²⁰

While the Eastern and Western Districts of Texas have overseen the first patent jury trials,²¹ a number of other courts have undertaken efforts to develop protocols aimed at protecting the health and safety of those participating in future trials. For example, in contemplating whether *Sunoco Partners Marketing & Terminals v. Powder Springs Logistics, LLC* could proceed to trial on August 3, 2020 (it did not)²², the District of Delaware laid out its vision for a safe trial. Chief Judge Leonard P. Stark, writing for the court, indicated that safety precautions would include entirely remote witness testimony, limitations on the number of individuals permitted in the courtroom, including limiting plaintiff to four representatives and each defendant to three, and the elimination of all paper copies of exhibits.²³ To further limit the number of individuals in the courtroom, the court indicated its intention to permit spectators to view the trial via video feed from another room where social distancing and face coverings would be required.²⁴ Beyond these concerns, Judge Stark's Order stated he was working with a District-wide committee to address other issues relating to "how *voir dire* will be conducted, where the jury will be seated, where the jury will go during breaks and for deliberations, where counsel tables will be placed, how to ensure that exhibits needed for cross-examination are kept secure until needed, whether counsel will be permitted to be present in the same room with witnesses who are being examined remotely, face covering and any other PPE requirements for those of us in the courtroom, etc."²⁵ Subsequently, the Jury Trial Restart Guidelines For the United States District Court of Delaware, provided guidance regarding identifying and assembling the venire, conducting *voir dire* and jury selection, PPE requirements, evidence handling, courtroom configuration, sidebars during trial and jury deliberations during the pandemic.²⁶

What Do These Proposed Precautions Mean for Practitioners?

The precautions that the district courts have undertaken are not only necessary to protect the health and safety of all trial participants and the public, but are also necessary to protect the sanctity of the trial itself. Were any member of a jury to contract COVID-19, the result would be significant disruption to the trial and court docket—and possibly even a mistrial—because the remaining jurors, attorneys, and court personnel would likely be required to self-quarantine based on public health guidance. Accordingly, precautions aimed at preventing the spread of COVID-19 are likely to persist for quite some time. Understanding the new procedural guidelines that have emerged from the various district courts provides some insight as to how practitioners might want to modify their trial preparation in order to present a case in an organized, compelling and effective manner. Below, we provide some tips for practitioners to consider while preparing for a jury trial in light of the precautions being implemented.

Additional Witness Preparation

The prevalence of travel restrictions and quarantine requirements across the globe, along with the categories of individuals that have been classified as being at high risk for contracting COVID-19 and experiencing dangerous symptoms if infected, have significantly limited the ability of many witnesses to be able to testify in person. The reality of having to present witnesses remotely is likely something that will be with us for the foreseeable future, and for at least as long as the virus remains a threat.

Whether witnesses are testifying in person, wearing masks and shields, or testifying remotely, practitioners will face the challenge of keeping jurors engaged. Clarity of presentation will be key. In-person witnesses should be instructed to speak clearly and distinctly because protective gear will muffle sounds and may be distracting. Witnesses being presented remotely should also speak slowly and try to be succinct, avoiding long or duplicative answers. A witness who speaks quickly or softly can be frustrating for a jury or a court reporter, even when a witness is testifying live. These issues can be exacerbated when the testimony is being remotely transmitted over wireless technology. Additionally, remote witnesses will likely be required to be completely separated from anyone²⁷ (except possibly someone to assist with any technical issues), creating a sense of isolation for witnesses and requiring them to pay careful attention throughout direct and cross examination. Without the benefit of non-verbal cues—such as standing for objections or other gestures that an attorney or judge may make—remote witnesses should be instructed to listen carefully before answering.

Beyond these concerns, effective integration of remote witness testimony into a trial presentation comes with challenges, especially since remote witness questioning is not necessarily routine for many attorneys, and is even less likely to be routine for most witnesses. In light of this, attorneys and witnesses should consider taking advantage of the public access to patent trials being provided by some courts during the pandemic.²⁸ Listening, and, in some cases, even viewing the questioning can provide important lessons regarding what is effective and, more importantly, the pitfalls to avoid during remote testimony. Although most courts have provided remote public access to patent trials held during the pandemic, there are rules against recording the proceedings in any way, so an interested member of the public must listen closely while the testimony is actually happening.²⁹

Another important consideration is the potential for juror bias toward remote witnesses. During the pretrial conference in the *VirmetX* matter, Apple argued that it would be prejudiced because certain of its witnesses needed to testify remotely.³⁰ Potential prejudice could result if any juror had a bias against a witness who appeared to be unwilling or reluctant to testify in person. In response, the court asked the parties to consider whether they would agree to an all-remote trial.³¹ Similarly, in the *Guardant Health, Inc. v. Foundation Medicine, Inc.* case, Judge Stark said he would require all witnesses to testify remotely to avoid the “risk of unfair prejudice to one side, should more of its witnesses (or a more ‘important’ witness) not be able to come to the courtroom

than is the case for the other side.”³² In the *Finjan Inc. v. Cisco Systems Inc.* case, Judge Freeman rejected this fairness argument, instead leaving it to the “complete discretion” of each party, noting that “[v]ideo testimony has long been used when witnesses are not available for in court testimony and it has proved effective.”³³ If an agreement isn’t possible or practical and the presentation is mixed, attorneys may want to consider asking the court for a jury instruction making clear that the court itself is implementing certain safety measures and scheduling restrictions that necessitate certain witnesses having to testify remotely, through no fault of their own, in an effort to avoid any potential bias.

Effective Use of Exhibits

Beyond coordinating the use of trial exhibits across remote locations, practitioners will also need to be creative to deal with restricted use of physical and paper exhibits in the courtroom. A well-coordinated exhibit presentation can both help the witness and guide the jury’s understanding of the testimony.

The use of prepared materials with witnesses will take on even more importance, whether remote or in person, as exhibits and demonstratives may help overcome some of the impact of the pandemic restrictions on spoken testimony. Remote witness testimony that is highly technical, for example, may benefit from prepared slides being shown contemporaneously in the courtroom while the testimony is broadcast. Counsel, the witness and graphics specialists—who may each be in different locations—will need to coordinate well in advance to ensure the presentation runs smoothly. Both counsel and the witness should try to remain composed when the inevitable technical glitch occurs.

The inability to pass around physical exhibits to the jury presents challenges for patentees and accused infringers alike looking to give the jury a real-world sense of the products at issue—including embodying products, infringing devices and prior art devices. Practitioners should embrace a combination of displaying products using an ELMO and depicting the products and any attendant functionality using demonstrative video to convey this information to the jury in a safe and interesting way.

Parties will need to come to an agreement as to the types and format of media that will be used, with disputes clearly defined and presented to the judge early for resolution. Careful attention will also need to be given to the exhibit exchange, which will now primarily be an electronic exchange between the parties with a hard copy delivered to the court.³⁴ Unnecessary exhibits or missing exhibits can be devastating to an attempt to provide an effective presentation under trying circumstances.

Modified Team Roles and Court Room Decorum

With limitations in place on the number of representatives in the courtroom, defining the role of each individual on the trial team and determining whether they will be remote or in the courtroom at an early stage is crucial.³⁵ Among the individuals who are essential in the courtroom are the attorneys who will be presenting and cross-examining witnesses, attorneys arguing motions and handling objections, local counsel, and those team members who will be handling exhibits. Assembling a diverse team will be critical to ensure a wide range of opinions and different ways of thinking from a limited number of people.

Many of the proposed safety protocols will also directly impact how attorneys interact with the court and the jury. The use of masks or shields will obscure many facial expressions, including smiles, further complicating an attorney’s ability to connect with the jury. Attorneys, whether remote or in person wearing masks or face shields, will want to be mindful to speak slowly and use intonation to overcome the obstacles presented by technology or protective gear. The limitations on movement beyond standing at the podium may seem unnatural to attorneys whose style includes moving about the courtroom, making connecting with the jury that much more difficult.

Additionally, with many courts limiting or doing away with sidebars altogether, attorneys will want to be mindful of their objections. Morning sessions with the judge outside of the presence of the jury will be a limited resource and should be used for thorough, mindful objections. Attorneys will need to anticipate potentially harmful subjects that they will not want discussed in the presence of the jury. These issues should be reserved for morning arguments. For example, in the *MV3* case overseen by Judge Albright of the Western District of Texas, patent owner MV3 moved for a new trial because, *inter alia*, it was forced to object repeatedly to evidence and testimony MV3 believed were in violation of the Court's claim construction and *in limine* rulings.³⁶ In particular, MV3 complained that continually objecting within earshot of the jury—*i.e.*, outside the relative anonymity of sidebars—“creat[ed] the impression that MV3 was being disruptive and attempting to hide something.”³⁷ To the extent other courts adopt Judge Albright's limitation on sidebars, which would force more objections to be aired in open court, practitioners must pay extra care to the interplay between preserving grounds for appeal and creating a good impression with the jury.

Attorneys and team members should be respectful of the restrictions that are being placed on everyone, such as being required to wear masks or facial coverings, obey social-distancing guidelines, and follow good hygiene procedures. Jurors, who themselves may find these restrictions onerous, will not likely appreciate others who are seen as flouting the rules in any way. Likewise, to the degree the court is asking attorneys to implement certain procedures, such as cleaning the podium after questioning, these tasks should be treated as being as important as the substantive questioning itself.³⁸

Strive for Early Resolution

With an aim toward streamlining a case for effective jury presentation, practitioners will want to focus on resolving issues early on during litigation, including seizing on opportunities for remote hearings. Parties should consider whether all or certain portions of their case—particularly invalidity and inequitable conduct—are amenable to a bench trial to eliminate certain issues entirely and make resolution without trial a possibility.

Claim construction hearings, which have been proceeding remotely during the pandemic,³⁹ provide an opportunity to narrow the case for potential early disposition. Attorneys should consider focusing claim construction arguments on claim interpretations that would be dispositive to validity or infringement to set the case up for resolution on summary judgment or position the case for early settlement. Practitioners may also want to consider filing summary judgment motions not just on dispositive issues like invalidity or infringement, but also on highly technical and detailed issues, including indirect infringement, willfulness, inequitable conduct and damages. As an example, in *Big Beings USA PTY Ltd. v. Nested Bean, Inc.*, the court granted the parties' Motion to Amend the Scheduling Order to Prioritize Claim Construction, Expedite Hearing and Stay Discovery, thereby moving up the *Markman* Hearing from December to September to construe three “prioritized” terms.⁴⁰ The parties indicated in their motion that “resolution of these ‘prioritized’ terms has a strong likelihood of resolving this case either through settlement discussions or focused summary judgement motions.”⁴¹ The possibility of eliminating complicated issues can significantly help streamline the case presented to a jury, or in some cases avoid the need for a trial altogether.⁴² Motions *in limine* will also take on more importance as another tool essential to whittling down issues, exhibits and witness testimony presented at trial.

Conclusion

As the COVID-19 pandemic persists, courts and practitioners will need to continue to monitor the situation and respond in order to balance safety with the right to a full and fair trial. With careful preparation, thoughtful early case positioning and attention to being organized, practitioners will find themselves well-equipped to take their case to trial.

¹ John Moehring is a partner, Danielle Tully is a special counsel and Michael Powell is an associate in the Intellectual Property Group at Cadwalader, Wickersham & Taft LLP in New York. They developed and maintain [Cadwalader's Patent Litigation Tracker](#), which identifies and summarizes recent U.S. District Court orders resulting from or impacted by the COVID-19 pandemic.

² See, e.g., Standing Order re: Criminal and Civil Jury Selections; Jury Trials; and Transition to Phase 2 (D. Del. Sept. 1, 2020); Notice to Parties, *Pierce Mfg., Inc. v. E-One, Inc.*, No. 8:18-cv-00617-TPB-TGW (M.D. Fla. Aug. 20, 2020), ECF No. 375 (encouraging parties to consider short, in-person civil jury trials not to exceed two days, noting “[o]nce jury trials resume, it is anticipated that criminal cases will consume most, if not all, available trial time for several months.”); Memorandum Order, *Guardant Health, Inc. v. Foundation Medicine, Inc.*, No. 1:17-cv-01616-LPS-CJB (D. Del. Oct. 16, 2020), ECF No. 487 at 2-3 (indicating there are at least 200 civil jury trials scheduled for 2021 in the District of Delaware, and due to current restrictions only one jury trial can proceed at a time).

³ On May 18, 2020, the U.S. District Court for the Northern District of California in San Francisco *sua sponte* issued a General Order For All Pending Civil Cases Before Judge Richard Seeborg stating that due to the high uncertainty created by the COVID-19 pandemic “it would seem to be an optimal time for the parties to initiate or renew an exploration of possible settlement or some other form of alternative dispute resolution.” E.g., *Linn v. Doordash, Inc.*, No. 3:20-cv-00666-RS (N.D. Cal. May 18, 2020), ECF No. 38 at 1. On October 9, 2020, the Middle District of Florida issued an order reminding the parties that they “may not unilaterally reschedule the mediation conference”, after they failed to mediate as scheduled even though the Court had previously extended the dates in the Case Management and Scheduling Order due to the COVID-19 pandemic, but did not alter the date of the scheduled second mediation conference. *Delta T, LLC v. Dan's Fan City, Inc.*, No. 8:19-cv-01731-VMC-SPF (M.D. Fla. October 9, 2020), ECF No. 117.

⁴ See Scheduling Order, *Baxalta Inc. v. Bayer Healthcare LLC*, No. 1:17-cv-01316-RGA-SRF (D. Del. Aug. 12, 2020), ECF No. 529 at 1 n.1; Memorandum Order, *Sunoco Partners Mktg. & Terminals v. Powder Springs Logistics, LLC*, No. 1:17-cv-01390-LPS-CJB (D. Del. June 9, 2020), ECF No. 547 at 17; Minute Entry, *Acceleron, LLC v. Dell, Inc.*, No. 1:12-cv-04123-TCB (N.D. Ga. June 9, 2020), ECF No. 570; Minute Entry, *NeuroGrafix v. Brainlab, Inc.*, No. 1:12-cv-06075 (N.D. Ill. May 7, 2020), ECF No. 286.

⁵ Order, *Shire ViroPharma Inc. v. CSL Behring LLC*, No. 1:17-cv-00414-MSG (D. Del. July 29, 2020), ECF No. 317 at 2-7. After reviewing the parties’ submissions, the Court found “that there is a risk of overlapping factual issues on the inequitable conduct and invalidity claims such that a bench trial on equitable conduct should not proceed before a jury trial on the other two claims.” Order, *Shire ViroPharma Inc. v. CSL Behring LLC*, No. 1:17-cv-00414-MSG (D. Del. Sept. 17, 2020), ECF No. 327 at 3.

⁶ Order, *Optis Wireless Tech., LLC v. Apple Inc.*, No. 2:19-cv-00066-JRG (E.D. Tex. July 21, 2020), ECF No. 387 at 4-5.

⁷ *Id.* at 6-7.

⁸ Jury Verdict, *Optis Wireless Tech., LLC v. Apple Inc.*, No. 2:19-cv-00066-JRG (E.D. Tex. Aug. 11, 2020), ECF No. 483.

⁹ Minute Entry, *Innovation Scis., LLC v. Amazon.Com, Inc.*, No. 4:18-cv-00474-ALM (E.D. Tex. Aug. 13, 2020), ECF No. 797 at 1.

¹⁰ *Id.*

¹¹ *Id.*

¹² Jury Verdict, *Innovation Scis., LLC v. Amazon.Com, Inc.*, No. 4:18-cv-00474-ALM (E.D. Tex. Sept. 2, 2020), ECF No. 853.

¹³ Minute Entry, *MV3 Partners LLC v. Roku, Inc.*, No. 6:18-cv-00308-ADA (W.D. Tex. June 4, 2020), ECF No. 288 (docket text).

¹⁴ *Id.*

¹⁵ *Id.*

¹⁶ Jury Verdict, *MV3 Partners LLC v. Roku, Inc.*, No. 6:18-cv-00308-ADA (W.D. Tex. Oct. 14, 2020), ECF No. 387.

¹⁷ Amended Minute Entry, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855-RWS (E.D. Tex. Aug. 5, 2020), ECF No. 931 at 1.

¹⁸ *Id.* at 1-2.

¹⁹ *Id.* at 1-2.

²⁰ Verdict Form, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855-RWS (E.D. Tex. October 30, 2020), ECF No. 978.

²¹ The third in-person patent trial began on September 10, 2020 in the Eastern District of Texas, after Judge Gilstrap denied defendant's Renewed Motion for a Trial Continuance in View of the Concerns Presented by the COVID-19 Virus. Order, *GREE, INC v. Supercell Oy*, No. 2:19-cv-00070-JRG-RSP, -00071-JRG-RSP (E.D. Tex. Sept. 9, 2020), ECF Nos. 453 and 333, respectively. On September 18, 2020, the jury returned its verdict, finding that the patents were not proven invalid and that they were willfully infringed, and that plaintiff was entitled to lump-sum damages of \$8,500,000 for past and future sales. Jury Verdict, *GREE, Inc. v. Supercell Oy*, No. 2:19-cv-00070-JRG-RSP, -00071-JRG-RSP (E.D. Tex. Sept. 18, 2020), ECF Nos. 475 and 350, respectively. Another in-person patent jury trial was held in the Eastern District of Texas beginning on October 1, 2020, in which a verdict was returned finding that the patents were infringed and not proven invalid, and that the plaintiff was entitled to lump sum damages of \$5,000,000. Jury Verdict, *Vocalife LLC v. Amazon.com Inc.*, No. 2:19-cv-00123-JRG (E.D. Tex. Oct. 8, 2020), ECF No. 323.

²² The trial has been continued until a date to be determined, "most likely in 2021 (and certainly NOT in 2020)." Oral Order, *Sunoco Partners Mktg. & Terminals v. Powder Springs Logistics, LLC*, No. 1:17-cv-01390-LPS-CJB (D. Del. October 13, 2020), ECF No. 616.

²³ Memorandum Order, *Sunoco Partners Mktg. & Terminals v. Powder Springs Logistics, LLC*, No. 1:17-cv-01390-LPS-CJB (D. Del. July 17, 2020), ECF No. 583 at 3-5.

²⁴ *Id.* at 5.

²⁵ *Id.* at 5-6.

²⁶ United States District Court of Delaware Jury Trial Restart Guidelines (October 7, 2020).

²⁷ See, e.g., Amended Final Pretrial Order, *Centripetal Networks, Inc. v. Cisco Sys., Inc.*, No. 2:18-cv-00094-HCM-LRL (E.D. Va. Apr. 27, 2020), ECF No. 411 at 10-11 (requiring testifying witnesses to testify in a location remote from attorneys during bench trial).

²⁸ Some courts, including the Southern District of New York, the Eastern District of Virginia and the District of Delaware, have been making their proceedings available for the public to attend during the pandemic. Remote Public Access Information for Trial, *Ferring Pharm. Inc v. Serenity Pharm. LLC*, No. 1:17-cv-09922-CM-SDA (S.D.N.Y. July 6, 2020), ECF No. 695 (telephonic access provided); Scott Graham, *The Trouble With Conducting a Virtual Patent Trial During the COVID-19 Pandemic*, Law.com (May 6, 2020, 9:44 PM), <https://www.law.com/nationallawjournal/2020/05/06/the-trouble-with-conducting-a-virtual-patent-trial-during-the-covid-19-pandemic/> (telephonic access provided for the public); General Order 2020-11 – Public Access to Remote Hearing (E.D. Va. Apr. 6, 2020)(authorizing public access to proceedings conducted remotely during the COVID-19 pandemic); Oral Order, *A. O. Smith Corp. v. Bradford White Corp.*, No. 1:18-cv-00412-LPS (D. Del. Aug. 17, 2020), ECF No. 180 (telephonic and video access provided) (docket text).

²⁹ See, e.g., General Order 2020-11 – Public Access to Remote Hearing (E.D. Va. Apr. 6, 2020) (prohibiting the operation of any video or audio recording device by any lawyer, litigant, participant, or observing member of the press or public during remote proceedings); Remote Public Access Information for Trial, *Ferring Pharm. Inc v. Serenity Pharm. LLC*, No. 1:17-cv-09922-CM-SDA (S.D.N.Y. July 6, 2020), ECF No. 695 (audio and video

recording prohibited); Oral Order, *A. O. Smith Corp. v. Bradford White Corp.*, No. 1:18-cv-00412-LPS (D. Del. Aug. 17, 2020), ECF No. 180 (“Audio or video reproduction of the proceeding is strictly prohibited.”) (docket text).

³⁰ Apple Inc.’s Motion to Continue Trial, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855-RWS (E.D. Tex. Aug. 5, 2020), ECF No. 918 at 13-14.

³¹ Amended Minute Entry, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855-RWS (E.D. Tex. Aug. 5, 2020), ECF No. 931 at 6.

³² Memorandum Order, *Guardant Health, Inc. v. Foundation Medicine, Inc.*, No. 1:17-cv-01616-LPS-CJB (D. Del. Oct. 16, 2020), ECF No. 487 at 3. *See also* Memorandum Order, *Sunoco Partners Mktg. & Terminals v. Powder Springs Logistics, LLC*, No. 0 1:17-cv-01390-LPS-CJB (D. Del. July 17, 2020), ECF No. 583 at 3-4.

³³ *Finjan Inc. v. Cisco Systems Inc.*, No. 5:17-cv-00072-BLF (N.D. Cal. Oct. 8, 2020), ECF No. 730.

³⁴ *See, e.g.*, Minute Entry, *MV3 Partners LLC v. Roku, Inc.*, No. 6:18-cv-00308-ADA (W.D. Tex. June 4, 2020), ECF No. 288 (docket text).

³⁵ *See, e.g.*, Order, *Sprint Communications Company L.P. v. Charter Communications, Inc. et al.*, No. 1:17-cv-01734-RGA (D. Del. Sept. 2, 2020), ECF No. 545 at 2 (the Court indicated that if the trial were held on October 5th it would only allow two attorneys per side in the Courtroom, further stating that it “may insist on this practice for some time.”); Memorandum Order, *Guardant Health, Inc. v. Foundation Medicine, Inc.*, No. 1:17-cv-01616-LPS-CJB (D. Del. Oct. 16, 2020), ECF No. 487 at 4 (The Court limited each side to a maximum of five representatives physically present in the courtroom at any one time, with one slot reserved for Delaware counsel, but did not require that each slot be occupied by the same person each day.); Amended Minute Entry, *VirnetX Inc. v. Apple Inc.*, No. 6:12-cv-00855-RWS (E.D. Tex. Aug. 5, 2020), ECF No. 931 (limiting representatives to eight per side).

³⁶ *See* Motion for New Trial, *MV3 Partners LLC v. Roku, Inc.*, No. 6:18-cv-00308-ADA (W.D. Tex. Oct. 26, 2020), ECF No. 395.

³⁷ *Id.* at 1.

³⁸ *See, e.g.*, Minute Entry, *Innovation Scis., LLC v. Amazon.Com, Inc.*, No. 4:18-cv-00474-ALM (E.D. Tex. Aug. 13, 2020), ECF No. 797 at 1 (encouraging attorneys to wipe down podium after questioning).

³⁹ *See* Memorandum Opinion, *IPA Techs. Inc. v. Amazon.com, Inc.*, No. 1:16-cv-01266-RGA (D. Del. May 21, 2020), ECF No. 126.

⁴⁰ Consent Order Amending Scheduling Order to Prioritize Claim Construction, Expedite Hearing and Stay Discovery, *Big Beings USA PTY Ltd. v. Nested Bean, Inc.*, No. 1:20-cv-10101-IT (D. Mass. July 24, 2020), ECF No. 49.

⁴¹ Joint Motion to Amend Scheduling Order to Prioritize Claim Construction, Expedite Hearing and Stay Discovery, *Big Beings USA PTY Ltd. v. Nested Bean, Inc.*, No. 1:20-cv-10101-IT (D. Mass. July 23, 2020), ECF No. 48.

⁴² *See* Order Granting Plaintiff’s Ex Parte Motion To Extend Pretrial Motion Deadline, *Golden Eye Media USA, Inc. v. Trolley Bags UK Ltd.*, No. 3:18-cv-02109-BEN-LL (S.D. Cal. Sept. 8, 2020), ECF No. 79 at 8-9 (finding good cause to extend the pretrial motions filing deadline to allow both parties the opportunity to file motions for summary judgment, the benefit of which “could be a resolution of claims before trial and possibly settlement.”).

JURY TRIAL RESTART GUIDELINES FOR USDC-DELAWARE¹

IDENTIFYING AND ASSEMBLING THE VENIRE

1. To account for the potential of a smaller than usual yield from the mailing of jury summonses, approximately 250 summonses should be sent out (for a criminal trial, with a similarly-proportionate excess for a civil trial).
2. Each summons should include a COVID-19-specific questionnaire.
3. The COVID-specific questionnaire will be distributed and completed through E-Juror or by emailed fillable pdfs to allow sufficient time for the results of the questionnaire, with a certification as to the answers, to be received and distributed to the parties no later than two weeks prior to trial.
4. In criminal cases, a hearing with the defendant present will be conducted no later than one week prior to trial to allow the parties and the Court to discuss courtroom configuration issues and striking jurors for cause based on responses to the questionnaire. The hearing may be combined with the pretrial conference. The Court will encourage the parties to arrive at agreement regarding those COVID-19-related responses that automatically result in a strike for cause.
5. Between 50 and 100 individuals should serve in the venire.
6. A message should be sent to the venire the night before trial informing the venire members that they must call the jury administrator prior to reporting if they meet certain COVID-19

¹ This document only provides guidance; it does not have the force of law. Likewise, it is not intended to create or confer rights, privileges, or benefits to any party. Moreover, the parties to a case may object to any of the procedures set forth here, and the Court may modify same in the exercise of its discretion.

criteria (e.g., they become symptomatic, etc.) and reemphasizing the requirement that they must wear masks in the courthouse.

7. Court jury staff will randomize the ordering of the venire via the Jury Management System (JMS) before the venire members report to the courthouse. The first 25 members of the venire will be designated as Group One. The second 25 will be designated as Group Two. Additional venire groups of no more than 25 people may be designated as necessary. Groups will be instructed to report to the Courthouse at staggered times. No more than two groups shall be in the Courthouse at any given time.
8. Upon arrival at the Courthouse, venire members will report to the jury assembly room on the third floor. At check-in, each venire member will be asked COVID-19 screening questions and provided with a face mask and other items for the duration of their service. Staff will remind the venire that all individuals are required to wear masks while in the Courthouse.
9. Each venire group should be placed in a separate large room/courtroom to allow the individuals in that group to congregate in a socially-distanced manner. Each venire group will be supervised by Court personnel throughout its time in the Courthouse.

VOIR DIRE AND JURY SELECTION

1. In criminal cases, defense counsel may use a Court-supplied two-way electronic transceiver system that will allow for private communications with clients when speaking in a quiet voice during voir dire and trial while social distancing. The Court will purchase sufficient equipment for use not only for defense counsel during voir dire, but also for counsel for all parties to converse with the Court in virtual side-bar conversations, and for the court reporter to record those conversations. Defense counsel may choose not to use

the Court-provided equipment for client conversations during the trial and, in that case, are to supply their own. Attorneys are encouraged to bring their own ear buds with microphone when using the Court-supplied transceivers. Court staff will seek industry guidance regarding sterilization of Court-supplied transceivers during trial and between trials.

2. Voir dire should be conducted in stages, one venire group at a time, to select a Final Jury Pool, from which the jury will be impaneled using peremptory strikes. The Final Jury Pool shall consist of at least 32 persons in a criminal case and 14 persons in a civil case.
3. To begin the voir dire process, venire Group One will be seated in a socially-distanced fashion using the gallery, jury box, and additional seating in the well of the presiding judge's courtroom. The Deputy Clerk will administer the oath and the presiding judge may offer welcoming remarks, give preliminary instructions, and read or summarize the questions for voir dire. At the conclusion of this session, Group One will be escorted back to its pre-designated room where it will be supervised by Court personnel while members of the group are questioned individually.
4. Individuals in Group One will be called to the presiding judge's courtroom in numerical order (using the numbers assigned to them randomly by JMS) for questioning. Upon completion of questioning, the individual will be asked to wait outside the courtroom and either party may make a motion to strike the individual for cause. The presiding judge may call the individual back into the Courtroom for further questioning or rule or defer ruling on the motion to strike. Any person struck for cause shall immediately be excused and asked to leave the building directly. Venire members not struck for cause shall be directed either to return to the room designated for their venire group or to leave the Courthouse until the Court is ready to proceed with the next stage of jury selection.

5. When the presiding judge has ruled on all motions to strike members of Group One, the members of Group One not struck for cause shall either (1) be asked to wait in their designated room until the Final Jury Pool has been selected or (2) be excused for the day and instructed to contact the Clerk's Office to learn when they should return to the Courthouse to complete the jury selection process.
6. This same process shall be followed with respect to Group Two and additional venire groups as necessary to obtain the minimum number of persons required for the Final Jury Pool.
7. All members of the Final Jury Pool shall be seated in the presiding judge's courtroom for the peremptory strike process. The presiding judge or a designated court employee may hold and pass a clipboard containing the juror list between counsel for the parties, who will strike out the names of prospective jurors on whom peremptory strikes are used.
8. Petit jury assembly during breaks and deliberations will occur in a courtroom adjacent to the presiding judge's courtroom. The space will be cleaned frequently, on a schedule to be determined by the Court consistent with GSA guidelines. The jurors will come and go from the jury deliberation room via utilization of the private hallway. Protocols for the presiding judge to consider include locking the courtroom door, placing paper over the windows, ensuring coordination with the judge whose courtroom is being used, turning off sound systems from the courtroom into chambers, and use of jury room bathrooms.

PPE REQUIREMENTS

1. All individuals present in the courtroom, including counsel, parties, witnesses, and court staff, shall be required to wear face masks, unless another prophylactic measure is in place

at the time, e.g., counsel speaking from a socially-distanced location within the courtroom that can be readily cleaned prior to use by another. Witnesses shall remove masks while testifying. Disposable microphone covers will be provided by the Court and will be changed out during the lunch break and before each day's trial session.

EVIDENCE/DOCUMENT HANDLING

1. To the extent possible, parties should exchange exhibits in advance of trial in an effort to stipulate to the authenticity of potential exhibits, to facilitate trial proceedings, and to avoid passing out or touching paper.
2. The parties should have all hardcopy paper exhibits pre-loaded onto a computer to be shown digitally to opposing counsel, the witness, the Court, and the jury as necessary.
3. The Court will provide each side its own podium and microphone, with disposable microphone covers. Parties are prohibited from utilizing the other side's microphone or podium for questioning witnesses or presenting evidence or argument, unless technical difficulties preclude use of their own. Counsel are responsible for cleaning the microphone and podium, as necessary, in between presentations by attorneys representing the same party.
4. The parties will have access to a jointly-used document camera, to be utilized in the event that a piece of evidence cannot be published digitally. In the event a party requires use of the document camera, counsel is expected to clean the device after each use. The Court will provide cleaning supplies for mid-presentation cleaning by counsel.
5. Witnesses waiting to testify shall observe proper social distancing and wear masks.
6. The witness and/or courtroom or chambers staff is responsible for cleaning the witness

chair and table after the witness has testified. The Court will provide cleaning supplies.

COURTROOM CONFIGURATION

1. Prior to the commencement of trial, the courtroom shall be configured in a manner that facilitates social distancing among the parties, witnesses, jurors, and court staff. The final configuration will be dependent on the space available in the courtroom and the presiding judge's discretion. The parties and the Court will work to ensure, to the extent feasible, unobstructed sight lines among all trial participants.
2. An example of such a configuration for criminal trials is as follows:
 - a. The jurors and alternates seated in an expanded jury box that extends into the well of the courtroom;
 - b. The parties seated directly across from the jury box backed against the opposite wall, with separate podiums configured with Plexiglass shields. Incarcerated defendants will be seated as near the door to the internal hallway as possible.
 - c. A witness box on an elevated stand in the gallery configured with a Plexiglass shield.
 - d. The Court will provide monitors as necessary to assist the jury with the review of digital evidence.
3. Jurors are not permitted to move from their assigned and marked spots without Court permission, which the Court will consider granting during the presentation of evidence for the purpose of more clearly seeing and/or hearing the evidence and testimony.
4. In certain circumstances, the presiding judge may consider permitting the witness to testify via videoteleconferencing, including videoteleconferencing from another room in the courthouse.

5. If seating is unavailable in the courtroom gallery due to jury placement or the presiding judge's decision to limit the number of individuals in the courtroom to preserve social distancing and other safety concerns, a closed-circuit livestream of at least the audio of the proceedings will be broadcast to a separate room in the courthouse. In consultation with the parties, the presiding judge may also consider use of an audio link to allow members of the public to call in and listen to the proceedings.

SIDEBARS DURING TRIAL

1. When necessary, counsel will rise and indicate the need for a sidebar. The presiding judge will halt proceedings and remain on the bench while employing an electronic transceiver and ensuring the court reporter does the same. Counsel, using Court-provided electronic transceivers, will address the Court quietly while seated at counsel table. Notwithstanding the use of noise-cancelling equipment, counsel may be required to move outside the courtroom into the public or private hallways to explain the sidebar request to the Court via transceiver, should it be necessary to avoid having the jury overhear counsel's discussion with the Court. At no point will the presiding judge leave the courtroom with the jury present.
2. In the alternative, once counsel indicates the need for a sidebar, the presiding judge will halt proceedings while counsel, using counsel-provided internet access, drafts an email to the Court and to opposing counsel, explaining the nature of the sidebar request. Opposing counsel will have the opportunity to email a response. After considering the original request and any response, the presiding judge will resolve the issue via email, if possible. If the matter is urgent and cannot be resolved via discussion via headset or email, the jury

will be removed from the courtroom so that the matter can be addressed. If the matter is not urgent, the presiding judge may address the matter at the next scheduled break in proceedings.

JURY DELIBERATIONS

1. Deliberations will occur in the adjacent courtroom. Social distancing will be ensured through seating placement and court instructions. Masks must be worn in the jury room unless social distancing (at least 6 feet between speakers) can be achieved.
2. All exhibits that can be digitized will be loaded into a laptop for use by the jury. The laptop contents will be projected onto a screen(s), so that the jury may see the exhibits while maintaining social distance. The jury will designate one juror to operate the laptop.
3. Physical exhibits which cannot be digitized will be provided to the jury, subject to a specific decision in a particular case. In no case will contraband or firearms be provided to the jury.
4. When jury deliberation is occurring in the adjacent courtroom, court deputies will be stationed at the door nearest the bathroom facilities.

October 7, 2020

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

BIG BEINGS USA PTY LTD AND LB
ONLINE & EXPORT PTY LTD (D/B/A
LOVE TO DREAM ONLINE AND
EXPORTS),

Plaintiffs,

v.

NESTED BEAN, INC.

Defendant.

Civil Action No. 1:20-cv-10101

**[PROPOSED] CONSENT ORDER AMENDING SCHEDULING ORDER [ECF NO. 41]
TO PRIORITIZE CLAIM CONSTRUCTION, EXPEDITE HEARING AND STAY
DISCOVERY**

Before the Court is the Parties' Joint Motion to Amend Scheduling Order (ECF No. 44) to Prioritize Claim Construction, Expedite Hearing, and Stay Discovery. For good cause shown, the Joint Motion is GRANTED. IT IS THEREFORE ORDERED that Claim Construction is initially limited to the three "prioritized" terms, with Opening Briefs due Friday August 7, 2020 and Response Briefs to be due Friday August 21, 2020. Opening Briefs shall be limited to no more than 25-pages, with Responsive Briefs being no more than 20-pages.

The current scheduling order sets the Claim Construction hearing for December 16, 2020 [ECF No. 41]. The claim construction hearing is scheduled for 9/2/20 @ 10AM, 2020.


The Claim Construction hearing will be a total of ninety (90) minutes of argument, with each side having a total of forty-five (45) minutes, proceeding on a term by term basis with Plaintiffs. No live witnesses will present testimony at the Claim Construction hearing. Upon stipulation and agreement of the Parties, absent material change in the health safety concerns raised by Covid, the hearing will proceed via video-conference.

Upon the Court's issuance of its claim construction ruling, the Parties will meet and confer within thirty (30) days to determine whether settlement is possible and, if not, to develop and propose to the Court a schedule for focused summary judgment motions.

Fact discovery is hereby stayed and all other deadlines set forth in the current Amended Scheduling Order [ECF No. 41] are suspended pending the above-mentioned proceedings. Such stay will not prejudice either Party regarding any outstanding issues, including discovery issues and potential amendments to pleadings, should the stay be lifted.

IT IS SO ORDERED.

Date: July 24, 2020


Indira Talwani
United States District Judge

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF WEST VIRGINIA

BIOGEN INTERNATIONAL GMBH and
BIOGEN MA, INC.,

Plaintiffs,

v.

CIVIL ACTION NO. 1:17CV116
(Judge Keeley)

MYLAN PHARMACEUTICALS INC.,

Defendant.

ORDER DENYING PLAINTIFFS' MOTION TO
CONTINUE CLOSING ARGUMENTS [DKT. NO. 380]

On April 16, 2020, the Plaintiffs, Biogen International GmbH and Biogen MA, Inc. (collectively "Biogen"), moved to continue the April 29, 2020 closing arguments because it prefers to proceed in person rather than by video (Dkt. No. 380). Preference alone, however, is not enough to establish good cause. Accordingly, the Court **DENIES** Biogen's motion (Dkt. No. 380). Because the closing arguments will proceed by video, all binders or physical exhibits must be delivered to Chambers on or before **Tuesday, April 28, 2020**.

It is so **ORDERED**.

The Court **DIRECTS** the Clerk to transmit copies of this Order to counsel of record.

DATED: April 17, 2020

/s/ Irene M. Keeley
IRENE M. KEELEY
UNITED STATES DISTRICT JUDGE

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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

FINJAN LLC,
Plaintiff,
v.
CISCO SYSTEMS INC.,
Defendant.

Case No. 17-cv-00072-BLF

**ORDER DENYING CISCO'S
ADMINISTRATIVE MOTION TO
IMPLEMENT PROCEDURES THAT
ENSURE A FAIR TRIAL**

[Re: ECF 720]

On September 29, 2020, Defendant Cisco filed an administrative motion to continue the October 19, 2020 jury trial or to implement procedures that ensure a fair trial. ECF 720. Cisco specifically sought to continue the trial to January 2021 or, at the very earliest, to November 2, 2020. ECF 720 at 1. Since the motion was filed, and based in part on COVID-related directives from the United States District Court of the Northern District of California, the Court reset the jury trial to commence on November 2, 2020. *See* ECF 727.

The Court thus focuses solely on Cisco's request that "the Court issue an Order requiring all fact witnesses to testify remotely and that neither party have a corporate representative at counsel table during trial." ECF 720 at 1. Plaintiff Finjan opposes this request, explaining that Finjan's corporate representative has a right to be present in the courtroom and that Cisco's concerns are remediable. *See* ECF 728.

The Court DENIES Cisco's motion. The Court rejects Cisco's argument that its proposal is necessary to ensure a fair trial. Video testimony has long been used when witnesses are not available for in court testimony and it has proved effective. The Court is granting both parties complete discretion to determine which of its witnesses will appear in court and which will appear remotely by video. Any party who wishes to present remote video testimony shall coordinate with

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the Court Room Deputy to minimize technical and logistical difficulties.

IT IS HEREBY ORDERED.

Dated: October 8, 2020



BETH LABSON FREEMAN
United States District Judge

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

GUARDANT HEALTH, INC.,	:	
	:	
Plaintiff,	:	
	:	
v.	:	C.A. No. 17-1616-LPS-CJB
	:	
FOUNDATION MEDICINE, INC.,	:	
	:	
Defendant.	:	

MEMORANDUM ORDER

A jury trial in this patent infringement dispute between competitors in the field of cancer testing was scheduled to begin on May 18, 2020. (*See* D.I. 24) It has been continued twice, in part due to the ongoing COVID-19 pandemic. (*See* D.I. 394, 476)

For reasons to be explained, IT IS HEREBY ORDERED THAT a jury trial, in the form described further below, will commence on November 30, 2020; the pretrial conference, to be conducted via videoconference technology with no counsel present in the courtroom, will be held on November 13, 2020 beginning at 2:00 p.m.; and the proposed final pretrial order is due on November 6, 2020. IT IS FURTHER ORDERED that the parties shall meet and confer and, no later than October 19, submit a proposed order setting any interim dates and deadlines.

The parties – Plaintiff Guardant Health, Inc. (“Guardant” or “Plaintiff”) and Defendant Foundation Medicine, Inc. (“FMI” or “Defendant”) – both wish to exercise their right to a jury trial. (*See, e.g.*, D.I. 480 at 3) While agreeing that the trial should not be converted to a bench trial, the parties disagree as to when the jury trial should occur. In the parties’ September 30,

2020 joint status report, Guardant requested that trial be held on the date on which it was at that point scheduled: November 6, 2020. (D.I. 473 at 1) FMI opposed a November 6 trial and requested that trial be continued to a date to be determined. (*Id.* at 2)

On October 2, 2020, the Court held a status teleconference during which it announced that trial would not begin on November 6 but (given space and personnel limitations in the courthouse, as well as the Court's other commitments) could potentially start as soon as November 30. (*See* D.I. 475, 476) The Court ordered the parties to consider the November 30 option and report back with their positions. (D.I. 476)

In an updated joint status report dated October 6, Guardant requested that trial be scheduled for November 30, while FMI asked the Court to “postpone the trial until a time in 2021 when the public health situation will permit a full, in-person jury trial.” (D.I. 480 at 1-2)

The Court has decided to hold trial on November 30 for multiple reasons, including those to be listed now. This is a patent infringement case between competitors that has been pending in this Court for almost precisely three years. It is ready for trial and the parties have adequate time to complete their pretrial preparations (and the Court has sufficient time to resolve the remaining pretrial motions). Trial has previously been scheduled twice and moved, due in part to the pandemic. The Court entered Phase II of its Reopening Guidelines on September 15, 2020, which permits jury trials, and the Court believes it can conduct a jury trial safely – by making certain modifications to its ordinary procedures – while also providing the parties a fair trial.¹ If trial were delayed once again, it is entirely unclear when it would occur. There are at least 200 civil jury trials scheduled for 2021 in the District of Delaware (a count which does not

¹ *See* <https://www.ded.uscourts.gov/news/phase-2-announcement>.

include criminal trials, which must take priority, and also does not include civil trials that have been continued and are still awaiting a new trial date), and due to current restrictions only one jury trial can proceed at a time.

Trial will be conducted in accordance with the following provisions:²

No witnesses will testify in the courtroom. It is clear that not all of the witnesses can travel to Delaware and testify in person. The Court is concerned that unless all witnesses do so, there is a risk of unfair prejudice to one side, should more of its witnesses (or a more “important” witness) not be able to come to the courtroom than is the case for the other side. The Court therefore adopts the parties’ suggestions that all witnesses testify remotely.³

Given this determination, the Court expects that the parties will be able to work out the scheduling conflict they identified with respect to FMI’s damages expert, Ms. Julie Davis. (*See* D.I. 480 at 2) Ms. Davis does not have to travel to Delaware and may instead be present in another court on or around November 30 should she be needed in that court for trial. She can observe this Court’s trial remotely and/or review trial transcripts to prepare for her testimony.

² *See also generally Sunoco Partners Mktg. & Terminals L.P. v. Powder Springs Logistics, LLC*, C.A. No. 17-1390 D.I. 583 (D. Del. July 2, 2020).

³ While Guardant’s preference is that witnesses who are able to testify in person be permitted to do so, Guardant also states: “To the extent that the Court deems the presence of live witnesses to be prejudicial, the Guardant witnesses can also appear via video.” (D.I. 480 at 1; *see also id.* at 2 (“Guardant is open to any reasonable set of safeguards”)) Given that at least three of FMI’s witnesses cannot travel to Delaware to testify, due to health and lockdown reasons (*see id.* at 4), the Court determines that the presence of live witnesses would be unfairly prejudicial to FMI. Thus, the Court is granting FMI’s alternative “request[] that the Court require all witnesses from both sides to testify via remote video conferencing technology.” (*Id.*)

Each side will be limited to a maximum of five representatives physically present in the courtroom at any one time. At least one of the five slots must be used by Delaware counsel. The other four slots may be used for out-of-state counsel, staff assistants, jury consultants, and/or corporate representatives.⁴

It is *not* required that each slot be occupied by the same person on each day. Additionally, at appropriate points during a trial day (e.g., during a break in the proceedings), a party may elect to “swap out” a representative physically present in the courtroom with another representative.

Any trial participant, including counsel, may also participate remotely (i.e., not within the courthouse) and their remote participation *does not count toward the maximum of five in-court participants*. In other words, counsel may make opening statements or closing arguments, or conduct a direct or cross-examination, or present objections and argument to the Court remotely, without travelling to Delaware. Those lawyers who should not be traveling at this time (*see, e.g., D.I. 480 at 3-4*) should avail themselves of this option.

Consistent with Guardant’s suggestion, a video feed of the trial will be transmitted through a closed circuit to another courtroom in the courthouse. (*See D.I. 480 at 2*) The Court will also require the parties to make arrangements with a third-party vendor to enable remote participation by the trial teams and to permit public access. (*See id.*)

⁴ The Court, of course, trusts that trial counsel will take all necessary and reasonable precautions in the weeks leading up to, and during, trial to maintain a safe environment. Trial counsel and all other representatives of a party must adhere to courthouse protocols related to screening, social distancing, and face coverings.

The Court is confident that the jury will be able to assess witnesses' credibility. The Federal Rules of Civil Procedure contemplate the use of remote witness testimony, even in jury trials. *See* Fed. R. Civ. P. 43(a) (“For good cause in compelling circumstances and with appropriate safeguards, the court may permit testimony in open court by contemporaneous transmission from a different location.”). Indeed, “[t]he most persuasive showings of good cause and compelling circumstances are likely to arise when a witness is unable to attend trial for unexpected reasons, such as accident or illness, but remains able to testify from a different place. Contemporaneous transmission may be better than an attempt to reschedule the trial” Fed. R. Civ. P. 43(a) Advisory Committee’s note to 1996 amendment. Courts, including this Court, are regularly determining that the ongoing COVID-19 pandemic constitutes good cause for remote testimony. *See Xcoal Energy & Res. v. Bluestone Energy Sales Corp.*, 2020 WL 4794533, at *2 (D. Del. Aug. 18, 2020); *Argonaut Ins. Co. v. Marietta Enters., Inc.*, 2020 WL 3104033, at *2 (E.D.N.Y. June 11, 2020); *Centripetal Net., Inc. v. Cisco Sys., Inc.*, 2020 WL 3411385 (E.D. Va. April 23, 2020). In light of the parties’ positions and the ongoing pandemic, the Court finds that the “good cause” requirements of Rule 43 are met.

The Court is not persuaded by FMI’s contention that “the unique circumstances of this case require live witnesses so the jury’s ability to make important credibility determinations will not be unduly impacted.” (D.I. 480 at 4) Skillful trial counsel will be able to conduct effective examinations, including cross-examinations, even without the witnesses (and even without examining counsel, if that occurs) being in the courtroom (or in the same room as the witness). To date, the undersigned Judge has presided over three fully remote “video” bench trials (including a patent trial), each one of which involved challenges to the credibility of one or more


witnesses. In each case, the undersigned Judge felt that the examinations provided the evidence necessary to assess credibility. There is every reason to believe that the jury will be equally (if not better) able to do the same at this trial.

The parties will need to work with the Court's staff to make all necessary arrangements to allow this trial to take place partially-remotely. Counsel shall contact chambers, and the Court's IT staff, as soon as possible, to determine which equipment the Court can supply, which equipment the parties will have to supply, and to take necessary steps to eliminate (to the greatest extent possible) paper exhibits.

The parties may state and preserve objections to the decisions reflected in this Order and with respect to any other details the Court considers as to how trial will be conducted. Thus, for example, FMI's "additional, serious concern[]" that "there is a risk the jury pool and jury will not be representative due to the situation that exists in Delaware (and several other states)" (D.I. 480 at 3) (suggesting that "potential jurors who are of older age and/or who fall into other high-risk categories are unlikely to attend"), is an issue FMI may continue to press, including during jury selection. The Court believes it will be able to seat a jury that represents a fair cross-section of the community and is consistent with both parties' rights, but should any party disagree it should feel free to make its argument.

The Court and the parties will have opportunities to further discuss the details of how trial will be conducted. The parties shall familiarize themselves with the Court's Jury Trial Restart Guidelines, which were issued on October 7, 2020.⁵ The Court will schedule a videoconference with the parties in the coming weeks to address further details about how the forthcoming partial-remote jury trial will proceed.

October 16, 2020
Wilmington, Delaware



HONORABLE LEONARD P. STARK
UNITED STATES DISTRICT JUDGE

⁵ Jury Restart Guidelines, <https://www.ded.uscourts.gov/sites/ded/files/news/10.7.20%20JURY%20RESTART%20GUIDELINES.pdf>

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8 UNITED STATES DISTRICT COURT
9 SOUTHERN DISTRICT OF CALIFORNIA
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11 GOLDEN EYE MEDIA USA, INC., a
12 California corporation,
13 Plaintiff,

14 v.

15 TROLLEY BAGS UK LTD, a
16 corporation of the United Kingdom; and
17 BERGHOFF INTERNATIONAL, INC., a
18 Florida corporation,
19 Defendants.

20 TROLLEY BAGS UK LTD; and
21 BERGHOFF INTERNATIONAL, INC.,
22 Counter Claimants,

23 v.

24 GOLDEN EYE MEDIA USA, INC.;
25 FARZAN DEHMOUBED; and
26 JENNIFER DUVALL,
27 Counter Defendants and
28 Third-Party Defendants.

Case No.: 18cv2109-BEN-LL

**ORDER GRANTING PLAINTIFF'S
EX PARTE MOTION TO EXTEND
PRETRIAL MOTION DEADLINE**

[ECF No. 77]

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1 Currently before the Court is Plaintiff’s ex parte motion to extend the deadline to
2 file pretrial motions—which passed on March 27, 2020—to September 18, 2020 [ECF No.
3 77-1 (“Motion” or “Mot.”)] and Defendant’s opposition [ECF No. 78 (“Opposition” or
4 “Oppo.”)]. For the reasons set forth below, the Court **GRANTS** Plaintiff’s ex parte motion.

5 **I. BACKGROUND**

6 On September 6, 2019, the Court issued an order granting the parties’ joint motion
7 to amend the scheduling order, setting, *inter alia*, March 27, 2020 as the deadline to file
8 pretrial motions and July 6, 2020 as the date of the final pretrial conference before the
9 district judge. ECF No. 41 at 2.

10 On March 20, 2020, counsel for the parties confirmed in emails to each other that
11 Plaintiff’s counsel had proposed that neither side would file dispositive motions and
12 Defendant’s counsel had agreed. *Oppo.* at 3; ECF No. 78-1 (*Oppo.*, Exhibit A) at 2–4;
13 *Mot.* at 2. Neither party filed a dispositive motion. See Docket.

14 On June 9, 2020, the United States Patent and Trademark Office (USPTO) issued a
15 non-final office action in the reexamination of Plaintiff’s ‘912 Patent that rejected
16 Plaintiff’s claim as invalid. *Oppo.* at 4; ECF No. 78-2 (*Oppo.*, Exhibit B) at 3–9;
17 ECF No. 77-4 (*Mot.*, Exhibit 2) at 2–9; *Mot.* at 2¹.

18 On July 2, 2020, the final pretrial conference was reset to August 3, 2020. ECF No.
19 70. At the final pretrial conference on August 3, 2020, the district judge set the following
20 dates: (1) motion in limine hearing on December 14, 2020, (2) filing of jury instructions
21 by January 13, 2021, and (3) jury trial on February 22, 2021. ECF No. 73; ECF No. 77-3
22 (*Mot.*, Exhibit 1) at 6–8; *Mot.* at 2–3; *Oppo.* at 4.

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26 ¹ Plaintiff states that the date of the USPTO’s non-final office action was April 23, 2020,
27 but that appears to be an error because the USPTO action submitted by both parties as
28 exhibits shows the mail date of the action as June 9, 2020. See ECF Nos. 77-4 at 2;
78-2 at 2.

1 On August 14, 2020, counsel for both parties began meet-and-confer discussions
2 regarding Plaintiff’s proposal to file a joint motion for leave to file summary judgment
3 motions. ECF No. 77-2, Declaration of Cody R. LeJeune (“LeJeune Decl.”), ¶ 2; ECF
4 No. 78-4 (Oppo., Exhibit D) at 5. Defendant did not consent, and Plaintiff filed the instant
5 ex parte Motion. LeJeune Decl. ¶ 3; ECF No. 78-4 (Oppo., Exhibit D) at 2–4.

6 **II. LEGAL STANDARD**

7 Once a Rule 16² scheduling order is issued, dates set forth therein may be modified
8 only “for good cause and with the judge’s consent.” Fed. R. Civ. P. 16(b)(4); see also
9 ECF No. 24 at 7 (stating that dates and times will not be modified except for good cause
10 shown). The Rule 16 good cause standard focuses on the “reasonable diligence” of the
11 moving party. Noyes v. Kelly Servs., 488 F.3d 1163, 1174 n.6 (9th Cir. 2007); Coleman v.
12 Quaker Oats Co., 232 F.3d 1271, 1294-95 (9th Cir. 2000) (stating Rule 16(b) scheduling
13 order may be modified for “good cause” based primarily on diligence of moving party).
14 Essentially, “the focus of the inquiry is upon the moving party’s reasons for seeking
15 modification.” Johnson v. Mammoth Recreations, Inc., 975 F.2d 604, 609 (9th Cir. 1992).
16 If a deadline has passed, Rule 6(b) states that generally “[w]hen an act may or must be
17 done within a specified time, the court may, for good cause, extend the time . . . on motion
18 made after the time has expired if the party failed to act because of excusable neglect.”
19 Fed. R. Civ. P. 6(b)(1)(B). The Ninth Circuit has held that, for purposes of Rule 6(b),
20 “excusable neglect” is appropriately analyzed under the standard set forth in Pioneer
21 Investment Services Co. v. Brunswick Associates Ltd. Partnership, 507 U.S. 380 (1993).
22 See Briones v. Riviera Hotel & Casino, 116 F.3d 379, 381 (9th Cir. 1997) (“[T]his court
23 [has] held that the Supreme Court’s analysis of ‘excusable’ neglect in *Pioneer* is applicable
24 to Rule 6(b)” (citing Comm. for Idaho’s High Desert, Inc. v. Yost, 92 F.3d 814, 825
25 n.4 (9th Cir. 1996))). Under Pioneer, a “determination of whether neglect is excusable is

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28 ² Citations of rules in this order refer to the Federal Rules of Civil Procedure, unless otherwise stated.

1 an equitable one that depends on at least four factors: (1) the danger of prejudice to the
2 opposing party; (2) the length of the delay and its potential impact on the proceedings; (3)
3 the reason for the delay; and (4) whether the movant acted in good faith.” Bateman v. U.S.
4 Postal Serv., 231 F.3d 1220, 1223-24 (9th Cir. 2000) (citing Pioneer, 507 U.S. at 395).

5 **III. DISCUSSION**

6 **A. PARTIES’ POSITIONS**

7 Plaintiff argues that although the parties had agreed to “forego the submission of
8 summary judgment motions,” circumstances have changed since then. Mot. at 6. First, the
9 USPTO issued a non-final office action invalidating the sole claim of Plaintiff’s ‘912
10 patent, “which has seemed to affect the negotiations between the parties.” Id. Next, the trial
11 date was set on February 22, 2021, almost six months from now. See id. Plaintiff contends
12 that good cause and excusable neglect exist to extend the pretrial motions filing deadline.
13 Id. at 5–8. Plaintiff also argues that extending the deadline to allow the filing of summary
14 judgment motions will promote judicial efficiency by streamlining issues and “could
15 dispose of most, if not all, of this case without a trial—either by summary judgment orders
16 or a subsequent settlement.” Id. at 4.

17 Defendant argues that Plaintiff has failed to show good cause or excusable neglect
18 to extend the pretrial motions filing deadline.³ Oppo. at 5–7.

19 **B. EXCUSABLE NEGLIGENCE**

20 The Court will first address whether it is excusable that Plaintiff neglected to file a
21 motion to extend the pretrial motions filing deadline before the deadline passed by
22 _____

23
24 ³ Defendant also argues that Plaintiff’s Motion should be denied for not complying with
25 the undersigned magistrate judge’s Chambers Rules because Plaintiff’s declaration omits
26 (1) why the pretrial motions filing deadline could not be met and (2) Defendant’s position
27 regarding the continuance. Oppo. at 5–6. The Court finds that the Motion sufficiently
28 complies with Chambers Rules because (1) Plaintiff explained in the Motion brief that the
parties had originally agreed not to file dispositive motions but circumstances changed after
the deadline, and (2) Plaintiff attested that Defendant did not consent to Plaintiff’s Motion.
See Mot. at 2, 5–8; LeJeune Decl. ¶ 3.

1 considering the Pioneer factors: (1) the danger of prejudice to the opposing party; (2) the
2 length of the delay and its potential impact on the proceedings; (3) the reason for the delay;
3 and (4) whether the movant acted in good faith.” Bateman v. U.S. Postal Serv., 231 F.3d
4 at 1223-24.

5 **1. Danger of Prejudice to the Opposing Party**

6 Plaintiff argues that there is very minimal prejudice to Defendant because (1) if
7 Plaintiff’s Motion is granted, both parties will be afforded an opportunity to file motions
8 for summary judgment; and (2) the parties had originally agreed not to file dispositive
9 motions after the close of fact and expert discovery, so discovery was not affected by the
10 original agreement. Mot. at 7. Defendant argues that granting Plaintiff’s Motion will
11 severely prejudice Defendant by allowing little time to prepare a summary judgment
12 motion, and impeding Defendant’s motions in limine preparations and trial preparations
13 because Defendant will not know which claims will actually proceed to trial until a ruling
14 is issued on any summary judgment motions. Oppo. at 7–8.

15 The Court finds that if the Motion is granted, both parties will be subjected to the
16 same deadline to file motions for summary judgment. Similarly, the parties will also face
17 the same deadlines to file motions in limine and conduct trial preparation. Both parties will
18 face uncertainty of which claims will proceed to trial while motions for summary judgment
19 are still pending. In that respect, Defendant would not be held at a disadvantage as to
20 Plaintiff. With discovery and the final pretrial conference already completed and trial set
21 almost six months from now, the Court finds that allowing dispositive motions to be filed
22 now is only slightly prejudicial to Defendant because it would perhaps have to prepare for
23 certain claims that may end up getting resolved before trial. There is no guarantee that a
24 dispositive motion would be ruled on before a final pretrial conference, so the uncertainty
25 that Defendant claims will be prejudicial during the time between the final pretrial
26 conference and the trial is a possibility in any civil case. Thus, the Court finds that this
27 factor weighs slightly against granting Plaintiff’s Motion.

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1 **2. Length of Delay and Potential Impact on the Proceedings**

2 Plaintiff argues that although the pretrial motions filing deadline was about five
3 months ago, the potential impact of granting the Motion could be positive because it “could
4 completely eliminate the need to bring numerous citizens, attorneys and court staff to the
5 courthouse for a jury trial.” Mot. at 7. Defendant argues that the delay is substantial and
6 there is a high risk that granting the Motion will “have a significant impact on the remainder
7 of the judicial proceedings, including the deadlines for motions in limine, jury instructions,
8 and trial.” Oppo. at 9.

9 The Court finds that although the past delay was not minimal, the possibility of
10 future delay due to granting the Motion is minimal because the trial date is almost six
11 months from now. Therefore, the Court finds that this factor is neutral.

12 **3. Reason for the Delay**

13 Plaintiff argues that it “attempted to litigate this case in an efficient manner and thus
14 agreed not to file dispositive motions,” but that circumstances were “drastically altered”
15 by the USPTO action invalidating the sole claim of Plaintiff’s ‘912 patent and by the
16 COVID pandemic, which “resulted in unanticipated circumstances” such as the trial date
17 being set almost six months from now. Mot. at 8, 5–6. Defendant argues this is not
18 excusable neglect because the delay was within “the reasonable control” of Plaintiff
19 because it was Plaintiff who proposed and agreed in writing to not file dispositive motions.
20 Oppo. at 9. Defendant also argues that settlement leverage does not establish excusable
21 neglect. See id.

22 The Court finds that Plaintiff’s argument for the delay due to altered circumstances
23 is compelling. Plaintiff had been hopeful that the parties could work out any differences
24 without court intervention, but that the USPTO action “seemed to affect the negotiations
25 between the parties.” Mot. at 6. Moreover, setting the trial date almost six months out from
26 the final pretrial conference is a generous amount of time that would allow for filing and
27 resolving motions for summary judgment prior to trial, which could lessen the issues to be
28 litigated at trial or lead to settlement. It appears that Plaintiff had anticipated that the parties

1 would be able to reach a settlement, but found that the USPTO action hampered effective
2 negotiations, which could then be revived with the filing of motions for summary judgment
3 during the six month period until trial starts. The Court finds that to be significant changed
4 circumstances to warrant a delay in filing this Motion, which weighs in favor of granting
5 Plaintiff's Motion.

6 **4. Acting in Good Faith**

7 Plaintiff argues that it acted in good faith because it proposed foregoing the filing of
8 dispositive motions "in an effort to conserve the resources of all parties," but that based on
9 the unforeseen changed circumstances described above, it now feels that dispositive
10 motions will promote judicial efficiency and conserve the judicial resources of a trial. Mot.
11 at 8. Defendant argues that Plaintiff's behavior is the "opposite of 'good faith'" because it
12 "induced" Defendant to agree not to file dispositive motions "when it believed such
13 agreement was to its strategic advantage" and now seeks to "renege on that agreement"
14 when Plaintiffs feels its position is weakening. Oppo. at 9.

15 The Court does not find that Plaintiff's delay was intentional or not made in good
16 faith because it was made due to unforeseen events. Defendant and Plaintiff had voluntarily
17 agreed to not file dispositive motions, but both benefited equally from the agreement by
18 conserving effort and resources. When circumstances changed unexpectedly, Plaintiff filed
19 this Motion, which, if granted, will allow both parties to file motions for summary
20 judgment and could resolve some claims prior to trial or even induce settlement. Thus, the
21 Court finds that this factor weighs in favor of granting Plaintiff's Motion.

22 After considering the four Pioneer factors concerning excusable neglect, the Court
23 finds that Plaintiff's late filing of the motion to extend the pretrial motions filing deadline
24 was neglectful, but not intentional nor made in bad faith, and thus may be excusable. See
25 Perez-Denison v. Kaiser Found. Health Plan of the Nw., 868 F. Supp. 2d 1065, 1079
26 (D. Or. 2012) ("Even 'when an actor *knowingly* misses a deadline but acts in good faith
27 without any intention to prejudice the opposing party, manipulate the legal process, or
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1 interfere with judicial-making, the actor's delay is neglectful, but not intentional, and thus
2 may be excusable.” (citation omitted)).

3 C. GOOD CAUSE

4 Having found excusable neglect, the Court turns to whether good cause exists to
5 grant Plaintiff’s Motion to extend the pretrial motions filing deadline.

6 Plaintiff argues that it could not have anticipated the changed circumstances
7 described above and that it acted diligently after the trial date was set on February 22, 2021.
8 Mot. at 5–6. Plaintiff argues that due to the pandemic, settlement conferences were
9 converted to telephonic conferences, which decreased the likelihood of success, the pretrial
10 conference was delayed about a month, and trial was set six months out. Id. Plaintiff claims
11 the USPTO action also hampered settlement negotiations. Id. Plaintiff notified Defendant
12 of its intention to seek leave to file summary judgment motions approximately ten days
13 after the trial date was set. Id. at 6. Plaintiff contends that granting its Motion “is likely to
14 resolve the majority of the issues to be tried in this case” and a ruling will “substantially
15 increase the likelihood that the parties will be able to resolve their differences before trial.”

16 Defendant argues that the USPTO action and the setting of the trial date do not
17 constitute good cause for Plaintiff’s Motion because (1) Plaintiff is seeking to counteract
18 its perceived weakness by “forcing [Defendant] to spend time and resources on summary
19 judgment briefing that would otherwise be spent on trial and settlement discussions”; and
20 (2) the six-month trial setting “delay” is not a changed circumstance. Oppo. at 6–7.

21 The Court finds that the parties agreed to not file dispositive motions to conserve
22 resources, but that the pandemic, the USPTO action, and the trial date six months out were
23 unexpected events that caused Plaintiff to change its position and decide that dispositive
24 motions could resolve some claims and lead to settlement before trial. Plaintiff adhered to
25 its agreement and did not seek to change it until the trial date was set with enough time to
26 allow for dispositive motions to be filed and ruled on. The Court finds that once the
27 circumstances changed, Plaintiff acted reasonably diligently in seeking to file this Motion.
28 If the Motion is granted, both parties will have an opportunity to file motions for summary

1 judgment and both will spend time and resources on doing so. However, the benefit could
2 be a resolution of claims before trial and possibly settlement. Accordingly, the Court finds
3 good cause to **GRANT** Plaintiff's Motion.

4 **IV. CONCLUSION**

5 For the reasons set forth above, and after consulting with District Judge Benitez's
6 chambers, the Court **GRANTS** Plaintiff's Motion to extend the pretrial motions filing
7 deadline to **September 18, 2020**. The parties are **ORDERED** to contact Judge Benitez's
8 chambers to obtain a motion hearing date before filing any dispositive motion.

9 **IT IS SO ORDERED.**

10 Dated: September 8, 2020



Honorable Linda Lopez
United States Magistrate Judge

United States District Court
Northern District of California

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

**GENERAL ORDER FOR
ALL PENDING CIVIL CASES
BEFORE JUDGE RICHARD SEEBORG**

You are receiving this Order because you have a civil case pending before the undersigned. As a result of the current pandemic, the scheduling of civil matters in this Court going forward remains highly uncertain. At this juncture, no assurances can be given as to when civil trials can be resumed, and if so, whether a further suspension due to public health developments will be necessary. Accordingly, it would seem to be an optimal time for the parties to initiate or renew an exploration of possible settlement or some other form of alternative dispute resolution. To that end, the parties are instructed to meet and confer telephonically within 30 days of the date of this Order to discuss the prospect of case resolution and by that date to file a joint report regarding the status of the case. The joint report should conform to the template below.

* * *

Pursuant to the Court's Order instructing all civil litigants to engage in an additional meet and confer to discuss the possibility of settlement, the parties submit this joint report. The parties engaged in a meet and confer on [DATE] to discuss the possibility of settlement. The result of the meet and confer was as follows:

[Check one]

United States District Court
Northern District of California

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_____ The case settled, and the parties will submit a filing to this effect within the next 30 days.

_____ Although the case did not settle, the parties made meaningful progress toward settlement and therefore request the opportunity to engage in additional ADR. Specifically, the parties request the following:


_____ Despite a good-faith effort to reach a settlement at the meet and confer, the case did not settle.

[Only if applicable] In addition, the parties wish to advise the Court of the following:

* * *

IT IS SO ORDERED.

Dated: May 18, 2020



RICHARD SEEBORG
United States District Judge

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

OPTIS WIRELESS TECHNOLOGY, LLC,	§	
OPTIS CELLULAR TECHNOLOGY,	§	
LLC, PANOPTIS PATENT	§	
MANAGEMENT, LLC, UNWIRED	§	
PLANET, LLC, UNWIRED PLANET	§	
INTERNATIONAL LIMITED,	§	CIVIL ACTION NO. 2:19-CV-00066-JRG
	§	
<i>Plaintiffs,</i>	§	
	§	
v.	§	
	§	
APPLE INC.,	§	
	§	
	§	
<i>Defendant.</i>	§	

ORDER

Before the Court is Defendant Apple Inc.’s (“Apple”) Motion to Continue Trial (the “Motion”). (Dkt. No. 341.) Also before the Court is Apple’s Further Response to the Court’s Questions at Status Conference (Dkt. No. 352), as well as the Opposition to Apple’s Motion to Continue Trial (Dkt. No. 352) filed by Plaintiffs Optis Wireless Technology, LLC; Optis Cellular Technology, LLC; PanOptis Patent Management, LLC; Unwired Planet, LLC; and Unwired Planet International Limited (collectively, “Plaintiffs” or “Optis”). In the Motion, Apple moves to continue jury selection in light of the COVID-19 pandemic, from August 3, 2020 until October 5, 2020. Apple argues that continuing the trial would be in the best interests of the health and safety of trial participants and the local community, as well as the parties’ abilities to present a full and fair case. Plaintiffs oppose the Motion, arguing that the parties and the Court have taken appropriate precautions to limit public health risks and accommodate any barriers to a full and fair trial, and that trial should proceed because there is no evidence that the state of the public health

will be more favorable, and not less favorable, in October. Having considered the Motion and the related briefing, and for the reasons set forth below, the Court is of the opinion that the Motion should be and hereby is **DENIED**.

In light of this conclusion, the Court's July 15, 2020 Order (Dkt. No. 342)¹ and the imminent pretrial conference on July 27, 2020, Apple's Unopposed Motion for Leave to File Reply in Support of Motion to Continue Trial (Dkt. No. 361) is **DENIED**, and, absent such leave, Apple's reply (Dkt. No. 362) is **ORDERED** removed from the record.

I. The Risk of the COVID-19 Pandemic and the Public Health.

The crux of Apple's argument is that proceeding with an August 3, 2020 jury trial would jeopardize the health and safety of all involved as well as the local community. (Dkt. No. 341 at 3.) Apple states that the number of COVID-19 cases is rising throughout the United States, and in Texas in particular. (*Id.*) Apple points to guidance from the Centers for Disease Control and Prevention ("CDC"), as well as Texas Governor Greg Abbott's Executive Orders regarding precautions that public spaces and members of the public must take in order to limit the spread of the disease. (*Id.* at 3–4, 8.) Apple further points to rising case numbers of the disease in Harrison County. (*Id.* at 5–7.) Apple attaches the declaration of Dr. Robert Haley, Professor of Internal Medicine at UT Southwestern Medical Center. (Dkt. No. 341-1.) Dr. Haley identifies generic challenges associated with conducting an in-person trial during the COVID-19 pandemic. (*Id.* at ¶¶ 20, 21.) His opinions are not so much tied to this location as they seem to convey that no in-person jury trial should be undertaken—anywhere. What Dr. Haley does not do is project when

¹ Apple's Motion was filed on July 14, 2020—one week ago. The next day the Court expedited a response from Optis and made it clear that neither a reply nor sur-reply should be filed without prior leave of the Court. This is usually understood by the parties to mean that the Court only wants a single response and not a litany of dueling briefs. By filing its Motion when it did, Apple put the Court on a very short timeline with the pretrial conference, jury selection, and trial on its doorstep.

in the future his ultimate conclusion might change. When Dr. Haley believes an in-person jury trial might be able to go forward is strikingly absent. The Court assumes he does not know and has no way to know.

Optis argues that the Court and the parties have proposed appropriate safety measures to address the dangers of COVID-19. (Dkt. No. 352 at 8–10 (laying out the precautions the Court has stated it is taking and will continue to take in order to ensure the safety and health of trial participants).) Optis views the Motion as a further attempt by Apple to “indefinitely delay this case,” despite having been aware of the challenges presented by COVID-19 for months, and having secured earlier relief in order to accommodate the challenges of the pandemic.² Optis points out that there is no evidence of impending public health improvement, and asserts that “Apple, by failing to provide crucial independent information regarding the projected course of the virus, is asking the Court to make decisions based upon incomplete and inaccurate information.” (*Id.* at 5.) Further, Optis points to various precautions it has taken in order to minimize the risk of COVID-19, including safety training regarding COVID-19 prevention; hiring an industrial hygienist to provide properly distanced work areas in Marshall and appropriate personal protective equipment; temperature monitoring; and daily health self-screenings. (*Id.* at 14; Dkt. No. 352-1 at ¶¶ 8–11.)

While the COVID-19 pandemic presents serious public health concerns, the Court has diligently undertaken to put in place reasonable precautions in order to facilitate a full and fair trial, while maintaining the health and safety of those involved. The Court abides by the recommendations of the CDC, both in spirit and in substance. In particular, the Court has

² The Parties have previously sought—and been granted—relief in accordance with the need to take precautions in light of COVID-19, including various scheduling extensions. (*See, e.g.*, Dkt. Nos. 158, 159.) Notably, Apple did not file this Motion until July 14, 2020—less than two weeks prior to the pretrial conference when a myriad of motions and disputes will be argued to the Court.

circulated instructions and appropriate reassurances to the venire panel by means of the attached letter which the Court caused to be served on each citizen summonsed for jury duty on August 3, 2020 by instructing the Clerk to attach an original version of such letter to every summons served in regard to this jury trial. (*See* Exhibit A.)

In addition, the Court has undertaken extensive measures to ensure a full and fair trial in which the litigants may preserve social distancing and minimize contact with tight spaces or common surfaces. The Court has heretofore e-mailed counsel for the parties precise instructions in advance of the pretrial hearing set for July 27, 2020, which is also attached, and precludes entrance to the Courthouse to those:

- Persons who have traveled to or from any of the following countries listed on the Centers for Disease Control and Prevention website [<https://www.cdc.gov/coronavirus/2019-ncov/travelers/from-other-countries.html>] as “Travelers Prohibited from Entry to the United States” within the preceding 14 days;
- Persons who have had close contact with someone who has traveled to or from one of the countries referenced above within the preceding 14 days;
- Persons who a medical doctor, doctor of osteopathy, hospital or public health agency has directed to self-quarantine, and such period of self-quarantining is ongoing;
- Persons who have been diagnosed with COVID-19 and who have not obtained express medical verification as now being non-communicative/non-contagious from a medical doctor, doctor of osteopathy, hospital or public health agency; and/or
- Persons who exhibit fever, cough or shortness of breath.

(*See* Exhibit B.) Further, the Court intends to provide additional guidance to counsel for the parties as part of the pretrial conference set for July 27, 2020 including limiting the number of persons seated at counsel tables to three persons per table during voir dire and during trial; directing trial counsel and the jury—once the trial begins—to wear face shields which will allow for a full view of the lawyers’ and jurors’ faces and expressions while providing substantial protection from

projection of breath droplets; and encouraging all participants to follow the CDC's community-mitigation guidelines.³ The Court has arranged for daily sanitization of Courthouse facilities, including the Courtroom and all public bathrooms, as well as daily deep cleaning of the jury room, jury box, and juror restrooms.

These precautions will help assure that the trial can go forward to produce a just, speedy resolution to the parties' disputes while reasonably safeguarding the public health. This is especially challenging given the ever-changing state of the COVID-19 pandemic and the lack of any reliable assurances as to if and when the pandemic will subside. The unpredictability of the state of the pandemic in the future means that a continuance now will result in a delay of many months or even years. Nothing in Apple's request assures the Court of anything more than a lengthy, protracted delay, which will simply guarantee material prejudice to all parties.

The Court therefore finds that, on balance, in light of the precautions to be undertaken by the Court and the trial participants, the August 3, 2020 date for jury selection should be maintained.

II. Due Process Concerns Can be Alleviated by the Presentation of Live Video Testimony at Trial.

Apple further raises concerns as to the parties' rights to due process related to three European witnesses who will be precluded from testifying in-person at trial due to international travel restrictions. (Dkt. No. 341 at 14–15; Dkt. No. 347 at 1–2.) In particular, Apple argues that three witnesses will be unable to testify in-person at trial:

- Mr. Rodermund, Apple's expert on standards organization rules and their applications to the patents in this case, who lives in Germany;
- Mr. Borghetti, Optis's expert on French law, who lives in France; and

³ Such mitigation strategies include: washing hands often; avoiding close contact with people who are sick; practicing social distancing; covering mouth and nose with a cloth face cover when around others; covering coughs and sneezes; and cleaning and disinfecting frequently touched services daily.

- Dr. Viridis, Optis’s witness on testing for ’833 Patent-related issues, who lives in Italy.

(Dkt. No. 347 at 2, 4.) Apple believes that its inability to present its witness or cross examine Optis’s witnesses in-person would impinge Apple’s due process rights. (Dkt. No. 341 at 15.)

Optis counters that it has agreed that witnesses in Canada or Europe should testify live via video, but says that Apple has refused to agree to such an accommodation. (Dkt. No. 352 at 5–6.) Further, Optis argues that only Mr. Rodermund would actually testify during the jury trial. (*Id.* at 6.) Mr. Borghetti, a French law expert, will testify at the bench portion of the trial, if he testifies at all.⁴ (*Id.*) Dr. Viridis “is a consultant who assisted testifying expert Dr. Madisetti by running simulations,” and “will not be called at trial.” (*Id.*) Finally, Optis points out that “there is no indication that delaying trial for another 60 days will enable the three E.U. witnesses to come to trial live.” (*Id.* at 7.)

The Court believes that it is always preferable to have witnesses present testimony in-person from the witness stand in the physical presence of the jury. However, these are unprecedented times, which call for unprecedented measures. Real time live video testimony from these witnesses presented via monitors in the courtroom will enable the jury to make instantaneous deductions about each such witness and his testimony. This will allow counsel to direct and cross examine the witnesses in real time so that the jury can hear their answers, as well as observe the non-verbal responses and body language that informs any jury in making its critical judgments as to credibility and believability. In light of the acquiescence amongst the parties and the

⁴ Optis states that it anticipates “this Court will simply read the reports of the French law experts. Mr. Borghetti will certainly not be testifying before the jury.” (Dkt. No. 352 at 6.)

unprecedented nature of current events, the Court **ORDERS** that the testimony of Mr. Rodermund et al.⁵ may be presented by live video at trial.

III. A Continuance Would Prejudice the Parties.

Finally, Optis points to the prejudice it will suffer by a continuance of the trial date. Specifically, Optis argues it is ready to vindicate its rights. (Dkt. No. 352 at 13.) Optis further highlights the prejudice it would suffer from having “expended extraordinary amounts of time and resources to be prepared to try this case as scheduled and in a safe manner,” including preparation for pretrial and trial, as well as organizing COVID-19 precautions, many of which were likely spent and committed before Apple brought its Motion on July 14, 2020. (*Id.* at 13–14.)

Apple argues that a continuance will not prejudice the parties because Optis only seeks monetary damages, which will not be impacted by a short continuance. (Dkt. No. 341 at 14.) Apple further asserts that the requested two-month continuance will not create unreasonable delay, and that such a delay would certainly not be “undue” in light of “the extraordinary nature of this unfolding pandemic.” (*Id.*)

While a short continuance may arguably cause limited prejudice, Apple has failed to provide any assurances that a delay would indeed be brief. As mentioned *supra*, the effect of the current pandemic has drastically compacted and complicated the Court’s trial schedule well into the next year. Thus, the two-month continuance requested by Apple is likely to, in reality, result in a delay of many months, pushing this trial well into 2021 or 2022. Such a lengthy delay would clearly cause prejudice to Optis, placing both sides in a posture of limbo where they would languish unduly without the vindication of a public trial or a final resolution.

⁵ Should the parties determine that the testimonies of either Mr. Borghetti or Dr. Viridis are required at trial, the testimonies of these witnesses may also be presented by live video at trial. The Court expects that upon any such decision, the parties will meet and confer and present the Court with a joint outline as to both the ways and means of presenting such testimony.

IV. Conclusion

The Court faces a conundrum of first impression. The task of balancing very real public health concerns against the right of the parties to resolve their far-reaching disputes is a challenge this Court has not sought and does not relish. However, as Robert Frost admonished in *A Servant to Servants*, “the best way out is always through.”⁶ When weighing the precautions crafted, the absolute lack of any reliable information as to when the current pandemic may abate, and the global struggle between these sophisticated parties which only worsens while a resolution is delayed, the Court is persuaded, on balance, that moving forward with the trial as scheduled is the better choice.⁷ Consequently, the Court finds that Apple’s Motion to Continue Trial (Dkt. No. 341) should be and hereby is **DENIED**.

It is further **ORDERED** that each parties’ actual trial counsel (who have entered an appearance of record) and who will physically appear before the jury arrive and be in Marshall, Texas by Friday, July 24, 2020, in advance of the pretrial conference Monday, July 27, 2020, and remain in Marshall through the end of trial.⁸

It is also **ORDERED** that counsel forthwith contact the Deputy in Charge for the Marshall Division and through her coordinate with the Information Technology Department of the United

⁶ Robert Frost, *A Servant to Servants, North of Boston* ln.56 (1914).

⁷ “A schedule may be modified only for good cause and with the judge’s consent.” Fed. R. Civ. P. 16(b)(4); *see also Fontenot v. Upjohn Co.*:

A motion for continuance is addressed to the discretion of the trial court and its denial of such a motion will be reversed on appeal only when the action is, to use the conventional term, ‘an abuse of discretion.’ . . . When the question for the trial court is a scheduling decision, such as whether a continuance should be granted, the judgment range is exceedingly wide, for, in handling its calendar and determining when matters should be considered, the district court must consider not only the facts of the particular case but also all of the demands on counsel’s time and the court’s.

780 F.2d 1190, 1193 (5th Cir. 1986).

⁸ This is intended to mitigate the risk of repeated travel through more pervasive areas of COVID-19 infection such as DFW Airport and similar places.

States District Court for the Eastern District of Texas to arrange for the smooth deliverance of any testimony that will be presented by video.

So ORDERED and SIGNED this 21st day of July, 2020.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

Exhibit A



UNITED STATES DISTRICT COURT

EASTERN DISTRICT OF TEXAS

100 EAST HOUSTON STREET

MARSHALL, TX 75670

CHAMBERS OF
Rodney Gilstrap
CHIEF JUDGE

July 13, 2020

TELEPHONE
(903) 935-3868
Fax
(903) 935-2295

To All Prospective Jurors
Summoned to Appear for
Jury Selection at the
U. S. District Court
in Marshall, Texas
on Monday August 3, 2020

RE: Your Upcoming Jury Service

Dear Prospective Jurors:

This letter is attached to the Summons directing you to appear for Jury Service at 7:45 a.m. on Monday, August 3, 2020 at the Sam B. Hall, Jr. Federal Building and United States Courthouse at 100 East Houston Street in downtown Marshall.

This will be one of the first jury trials which I have undertaken since the advent of the Coronavirus pandemic. I want to assure you that every reasonable precaution will be taken to enhance the health and safety of the jury, the parties, the lawyers and the Court staff during jury selection and the jury trial to follow.

So that you won't be surprised when you arrive, please be aware of the following:

1. Each prospective juror will have their temperature taken via a hand-held thermometer as they enter the Courthouse, to ensure that no one with fever or an elevated temperature is admitted;
2. Once you enter the building and pass through the initial security screening, you will be separately escorted by Court Staff to the Courtroom and seated to achieve the maximum distancing possible;
3. Masks will be distributed, or you may wear your own when you enter the Courthouse. Until the eight (8) person jury is actually selected, seated and

sworn, everyone appearing as a prospective juror will be required to wear a mask, unless the Court directs otherwise;

4. Latex gloves will be available for those who wish to wear them, but gloves are not required. If you would like gloves, ask the Court staff for them when you are seated in the Courtroom;
5. Smartphones, iPads or similar electronic devices should be left outside the Courthouse. You may certainly leave them in your vehicle rather than at home, if you choose, but do not bring them into the Courthouse;
6. Hand sanitizer (alcohol based) will be available to you at multiple locations inside the Courthouse, and you may ask Court Security Officers to make it available at your seat, once you are seated in the Courtroom;
7. Those selected for this jury should know that the eight (8) jurors will be spaced in the fourteen (14) seat jury box to achieve maximum distancing between jurors during the trial;
8. The jury box, jury room and jury room bathrooms will be deep cleaned each evening when the Court recesses, and this will continue throughout the trial;
9. Individual lunches will be provided by the Court to the eight (8) selected jurors during each day of the trial, to minimize any travel in and out of the Courthouse and to minimize juror's interaction at local restaurants.

If you:

- a) have been diagnosed by a licensed physician as having Coronavirus anytime within the past 30 days; or
- b) are actively caring for a family member or loved one who has tested positive for the Coronavirus; or
- c) are now in self-quarantine status and that status will continue on August 3rd;

then, in any of these situations: you should immediately advise Mrs. Kecia Clendening, the Court's Deputy in Charge, at her phone number in the attached summons. Her phone number is also listed at the conclusion of this letter. She may ask you to furnish documentation regarding such from your physician, for the Court.

There is more than one case now scheduled to begin trial on August 3rd. At this time, I am not sure which of these cases will actually begin trial on the 3rd. However, my best estimate is that any of these trials should last from Monday, August 3rd through Friday, August 7th. That being the case, if you have a scheduled surgical procedure for yourself or a dependent that can't be rescheduled, or if you have some other pre-existing obligation that would make it extremely difficult and create a real hardship on you to be here each day during the week of August 3rd, then you should immediately advise Mrs. Kecia Clendening, the

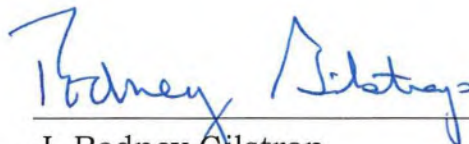
Court's Deputy in Charge, at her phone number. Again, her phone number is listed at the conclusion of this letter.

Please be aware that the right to trial by jury is one of the cornerstones of our democracy, and jury trials necessarily involve sacrifice from those citizens called upon to serve. This has always been true, but it is especially true during these unique and trying times. It is my personal conviction that jury service is the second highest form of public service that any American can perform (second only to service in the Armed Forces). The right to trial by jury has been enshrined within the Seventh Amendment to our U. S. Constitution since 1791, and it was one of the stated principles in the Declaration of Independence which fueled our struggle to become an independent nation. Only those with extreme hardships should seek to be excused based on pre-existing obligations.

It is vital that you appear and present yourself for jury service on August 3rd; however, the Court wants you to know that we are mindful of these challenging times and we will take every reasonable precaution to maintain your health as well as that of the parties, lawyers and Court staff during this upcoming trial.

I hope this personal letter is helpful and informative. I look forward to seeing you in Marshall on August 3rd.

Respectfully,

A handwritten signature in blue ink that reads "Rodney Gilstrap". The signature is written in a cursive style and is positioned above a horizontal line.

J. Rodney Gilstrap
Chief United States District Judge

cc: Mrs. Kecia Clendening
Deputy Clerk in Charge
Phone: 903.935.2912

Exhibit B

Taylor Mauze

From: Taylor Mauze
Sent: Monday, July 20, 2020 5:01 PM
To: Amy.Pearlman@wilmerhale.com; astrabone@irell.com; Ben.Ernst@wilmerhale.com; bstevens@wscylaw.com; brittany.amadi@wilmerhale.com; cwoodin@mckoolsmith.com; cmcnett@mckoolsmith.com; Dan.Wewers@wilmerhale.com; ddezern@grayreed.com; echen@irell.com; etaufest@grayreed.com; efountain@mckoolsmith.com; hcannom@wscylaw.com; hengelmann@mckoolsmith.com; hzhong@irell.com; ipetersen@irell.com; jhoggan@grayreed.com; jsheasby@irell.com; Jennifer.John@wilmerhale.com; jtruelove_mckoolsmith.com; jjim@mckoolsmith.com; Nina.Garcia@wilmerhale.com; joseph.haag@wilmerhale.com; joseph.mueller@wilmerhale.com; kathryn.zalewski@wilmerhale.com; kevin.o'brien@wilmerhale.com; jbindler_grayreed.com; mark.selwyn@wilmerhale.com; mindy.sooter@wilmerhale.com; melissa@gillamsmithlaw.com; michael.summersgill@wilmerhale.com; michaela.sewall@wilmerhale.com; mmckool@mckoolsmith.com; sbaxter_mckoolsmith.com; shasenour@mckoolsmith.com; spollinger@mckoolsmith.com; timothy.syrett@wilmerhale.com
Subject: 2:19-cv-66 - Optis Wireless Tech., LLC et al. v. Apple Inc. - Pretrial Conference Monday, July 27, 2020

Counsel,

The above-captioned case (2:19-cv-66) is set for an in-person pretrial conference on Monday, July 27, 2020 at 9:00 am central. To facilitate such and assuage any public health concerns, the Court has put into place various mitigation protocols. During the pretrial conference, you and all persons attending with you are required to comply with the following:

- First, the Court will continue to adhere to the following specific visitor restrictions:
 - Persons who have traveled to or from any of the following countries listed on the Centers for Disease Control and Prevention website [<https://www.cdc.gov/coronavirus/2019-ncov/travelers/from-other-countries.html>] as “Travelers Prohibited from Entry to the United States” within the preceding 14 days;
 - Persons who have had close contact with someone who has traveled to or from one of the countries referenced above within the preceding 14 days;
 - Persons who a medical doctor, doctor of osteopathy, hospital or public health agency has directed to self-quarantine, and such period of self-quarantining is ongoing;
 - Persons who have been diagnosed with COVID-19 and who have not obtained express medical verification as now being non-communicative/non-contagious from a medical doctor, doctor of osteopathy, hospital or public health agency;
 - Persons who exhibit fever, cough or shortness of breath;
 - If you or anyone attending court with you falls within one or more of the above restricted categories, you must advise the Court by email (copying all counsel of record) within 24 hours. All such persons will not be granted admission to the courthouse.
- Second, the Court will be enforcing social distancing protocols among parties, counsel, and court staff. To the greatest extent reasonably possible, the Court will strive to maintain a six-foot distance between all those present. The Court will also be implementing various mitigation strategies in the courtroom, including limiting the number of persons seated at counsel tables to three persons per party per table. The parties are each responsible for determining which persons are to sit at their respective counsel tables; all other party representatives, counsel, consultants, and observers should sit in the gallery. Those not at counsel table are encouraged to wear a face covering while inside the courtroom, but the Court will neither require nor provide one.
- Third, the Court encourages all participants to follow the CDC’s community-mitigation guidelines before attending the proceeding. That includes washing hands often; avoiding close contact with people who are sick

and practicing social distancing; covering mouth and nose with a cloth face cover when around others; covering coughs and sneezes; and cleaning and disinfecting frequently touched surfaces daily.

In further advance of the pretrial conference set for Monday, July 27, 2020, the Court requests that the Parties e-mail me (Taylor_Mauze@txed.uscourts.gov) by **5:00 pm central on Tuesday, July 21, 2020** the following information:

- An agreed suggested order in which to address pretrial motions. Please include any relevant groupings of categories of related disputes, to the extent grouping is appropriate. Please include name(s) of counsel who will argue each motion;
- An agreed suggested order of motions *in limine* (“MILs”) that are grouped into categories of related disputes, to the extent grouping is appropriate. Please also include name(s) of counsel who will argue each MIL; and
- An agreed suggested order of disputed exhibits that are grouped into categories of related disputes (“buckets”) and that identifies representative exhibit(s) for said category. Please also include name(s) of counsel who will argue each disputed exhibit.

Please use the following template in your response:

Group #	Group Name	MIL #s OR Exhibits OR Motion	Plaintiffs’ Arguing Attorney	Defendant’s Arguing Attorney

If you have questions as to the above, please let the Court know.

Sincerely,

Taylor Mauze
Law Clerk to Chief Judge Rodney Gilstrap
 U.S. District Court for the Eastern District of Texas
 100 E. Houston Street
 Marshall, Texas 75670
Taylor_Mauze@txed.uscourts.gov

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MINNESOTA**

GRUPO PETROTEMEX, S.A. DE C.V. and
DAK AMERICAS LLC,

Plaintiffs,

Civil Action No. 16-cv-02401 SRN-HB

v.

POLYMETRIX AG,

**ORDER FOR REMOTE
DEPOSITION PROTOCOL**

Defendant.

Pursuant to input from Plaintiffs Grupo Petrotemex, S.A. de C.V. and DAK Americas LLC (collectively, “GPT/DAK”) and Defendant Polymetrix AG (“Polymetrix”), and in view of this Court’s Order [ECF No. 653] requiring that certain depositions be conducted remotely, the following protocol will govern the conduct of remote depositions in this case, unless otherwise ordered by the Court or agreed to by the parties:

1. Except as set forth in this Order, the procedures for noticing and conducting depositions will be as set forth in the applicable Federal Rules of Civil Procedure. Nothing in this Order is intended to or will prevent a deposition from proceeding in person if counsel for GPT/DAK, counsel for Polymetrix, and the witness so agree, but in all cases, the desire of the witness to be physically distant from counsel, the court reporter, and any videographer will control.

2. Subject to complying with the Protective Order issued in this case regarding Confidential or Attorney’s-Eyes-Only information or documents, any Party (as further

described below), counsel of record, Swiss counsel for any Party, and any staff assisting counsel of record may attend any deposition remotely. Persons in attendance may have technical support to assist with the technical aspect of the deposition and/or with the exhibits, including displaying the exhibits. Any person attending the deposition or supporting someone attending the deposition is bound by the Protective Order. Only an expert and a Party representative (meaning legal counsel and any member of senior management of a Party) may attend any deposition, except that a former management person and/or a technical person may attend as needed to assist questioning counsel for any Party during the deposition. Counsel for any Party must advise in advance that a Party will be in attendance, and precautions must be taken to absent the Party when any Confidential or Attorney's-Eyes-Only information or documents under the Protective Order will be discussed. Notwithstanding the foregoing, a witness for a Party, whether an individual capacity witness or a Rule 30(b)(6) witness (including an attorney who will be serving as a Rule 30(b)(6) witness), may not attend any deposition before that witness's noted deposition is completed. Specifically as to Mr. Wilming, who is anticipated to be a corporate designee for Polymetrix as to Topic 24, the parties agree that he may attend the Rule 30(b)(6) deposition of Polymetrix, and all of the individual depositions of Polymetrix witnesses, by videoconference after his testimony on Topic 24 is complete.

3. As it relates to the Rule 30(b)(6) deposition of Polymetrix and the individual depositions of the three Polymetrix witnesses, only counsel who are commissioned by the applicable Swiss authority may conduct the questioning and/or lodge objections. The questioning attorney for the Rule 30(b)(6) deposition may change with the deposition topic.

4. Pursuant to this Court's prior Order [ECF No. 653], GPT/DAK have designated the following sequence for the remote depositions of Polymetrix: The Rule 30(b)(6) deposition (with the witnesses testifying to the 38 noticed topics, subject to the prior agreement of the parties as to the scope of the topics) will take place first. Thereafter, the deposition order is as follows: (a) Danil Polyakov; (b) Andreas Christel; and (c) Martin Müller.

5. As previously ordered by this Court [ECF No. 653], the Rule 30(b)(6) deposition of Polymetrix and the depositions of the three individual Polymetrix deponents will begin on August 3, 2020, and continue on successive weekdays thereafter until they are concluded. They will begin each day at 7:30 a.m. EDT and will conclude at 2:00 p.m. EDT, unless the witness elects to have the deposition continue that evening for an additional thirty minutes *on the record*, or until completed, whichever comes first. Furthermore, if the deposing counsel, in good faith, represents that the deposition can conclude with an additional thirty minutes *on the record*, the Parties agree that the deposition shall continue for an additional thirty minutes *on the record*. If it is not completed in that time, the deposition will resume on the next business day or at another agreed upon time.

6. The only time to be counted toward the fourteen total hours allotted for the Rule 30(b)(6) deposition of Polymetrix or the seven hours allotted for each personal deposition is the time spent on the record. Therefore, the time spent in changing witnesses, reasonable meal and comfort breaks, etc., and time spent addressing technical issues (as described more fully in Paragraph 14 below) will not count toward the deposition time

limits. Reasonable breaks may be taken for meals, restroom use, and other legitimate needs. The parties will endeavor in good faith to limit meal breaks to no more than 30 minutes, but no meal break shall last more than forty-five minutes absent agreement of counsel. Time spent seeking Court intervention and addressing any issues with the Court also will not count against the allotted deposition time limits.

7. With respect to the Rule 30(b)(6) deposition of Polymetrix, GPT/DAK reserve the right to attempt to resolve any outstanding issues with any Rule 30(b)(6) topic (*e.g.*, seeking court relief, having the witness answer the question(s), or obtaining agreement with opposing counsel) before proceeding to the next topic; provided, however, that if the parties are not able to resolve the issue and the Court is not immediately available, GPT/DAK will consider good faith and reasonable steps to question the witness on other topics for which he or she has been designated to avoid an unnecessary waste of time. In the event that any outstanding issue with any Rule 30(b)(6) topic is not resolved by one of the means set forth above within a reasonable time, and GPT/DAK nevertheless proceeds with the deposition, it shall be without prejudice to GPT/DAK's right to seek court relief at a later time.

8. Further with respect to the Rule 30(b)(6) deposition of Polymetrix and the individual depositions of Polymetrix witnesses, if GPT/DAK counsel represents that he or she has completed a topic (whether a Rule 30(b)(6) topic or a topic for questioning of an individual witness) after 1:40 p.m. EDT but prior to 2:00 p.m. EDT, and the witness does not elect to proceed past 2:00 p.m. EDT (as described in Paragraph 5 above), GPT/DAK may elect to stop for the day if it determines that is a good breaking point before proceeding

to the next topic. In such case, any time remaining before 2:00 p.m. will not count toward the time limit for the deposition.

9. The parties have agreed that the court reporter can administer the oath to each deponent remotely and such oaths shall have full legal effect under Fed. R. Civ. P. 28.

10. The deposition may be recorded by stenographic means and by video. For use in any court proceeding, the video may be only of the witness, but this is in addition to and does not supplant the video recording of others as described later in this Order. The Parties may use a videoconferencing service, and such video may be recorded for later use in this litigation, including at trial. The Parties also agree that, pursuant to Fed. R. Civ. P. 29(a), the recorded video may be used as if it were a recording prepared by a certified videographer and each side waives any objections based on authenticity. The Parties will cooperate on technical issues regarding the digital file (*e.g.*, assuring audio and visual quality, displaying exhibits, removing segments that were off the record or otherwise not part of the agreed deposition time as set forth in this Order, and affixing time stamps, if applicable/available).

11. Counsel for the Parties will use the videoconferencing service designated by the deposing counsel to conduct the depositions noticed by that Party. In the case of the depositions of Polymetrix itself and the three individual Polymetrix deponents that will start on August 3, 2020, counsel for GPT/DAK has designated Gregory Edwards as the vendor and Zoom as the deposition platform.

12. Should any Party (including Polymetrix) subsequently notice depositions that are covered by this Order, that Party will similarly designate a videoconferencing

service, and videos may be similarly recorded for later use in proceedings in this case, including trial.

13. The Parties will cooperate to ensure that each witness has proper software, hardware, and other relevant equipment to attend a deposition by videoconference, but the obligation to ensure that the remote process works for the witness is on the Party whose witness is being deposed, meaning that the counsel defending the deponent will have the obligation to ensure that the deponent has the proper software, hardware, and other relevant equipment to attend the deposition remotely. The videoconferencing software selected by the deposing counsel must have sufficient security features in place to prevent public disclosure of the protected information under the Protective Order in this litigation. However, no party is responsible for any disclosure of confidential or attorney's-eyes-only material due to any security breaches of Zoom or any other remote deposition platform.

14. The Parties will cooperate in doing a "test run" of the videoconferencing process, including the platform and devices that will be used, an information technology specialist standing in for the witness, and applicable counsel (*i.e.*, deposing counsel, defending counsel, and, in the case of a non-party witness, that witness's counsel). Unless the parties agree otherwise, any such test should be conducted at least three (3) business days before the scheduled date of the noticed deposition date so as to allow time to identify and address any issues so that the depositions can proceed as scheduled. In addition, the participating attorneys, court reporter, and witnesses will connect to the deposition platform each day by at least 15 minutes prior to the start of the first deposition (presumably 7:15 a.m. EDT) in order to identify and resolve any technical issues and ensure to the extent

practicable that the depositions will begin promptly as scheduled.

15. If the video feed or audio connection of the deponent, court reporter, or other participants is interrupted or becomes distorted or disrupted to the extent that it interferes with the ability of the court reporter, the deposing counsel, the defending counsel, or other necessary participants attending the deposition to hear, see, present and view exhibits, or fairly, cleanly, and accurately obtain and record sworn testimony, the deposition shall be suspended, and the parties will go back on the record only when the technical issue is resolved or the Parties agree or the Court orders that the deposition can proceed. Any downtime or time on the video that is spent trying to address and resolve such technical issues will not count against the time allotted for the deposition. The Parties will work together in good faith to resolve any issues so that the deposition can proceed or be resumed. If the technical issues affect the time set aside for any deposition, the Parties will work together in good faith to adjust the schedule. The Parties will act in good faith to account for any time lost on the record due to any technical issue so that the deposing Party will be able to use the full time allotted for the deposition.

16. The witness shall not wear a mask or face covering of any kind during his/her deposition testimony. The head, shoulders, arms, and hands of the witness should be displayed on the screen at all times, as should any and all documents and/or other items that are on the table or in front of the witness, to the extent practicable given the limitations of the equipment and software used for the videoconference deposition.

17. To the extent practicable, the videoconferencing service shall simultaneously display, in addition to the witness, the attorney who is questioning the witness on behalf of

the Party who noticed the deposition, the attorney who is defending the witness, and the attorney who would be objecting and/or asking questions of the witness on behalf of the non-noticing Party (in the case of a remote deposition of a non-Party witness). All other persons attending the deposition must note their appearances on the record but may appear by audio only. Under no circumstances may a person attend the deposition in any manner without identifying himself or herself on the record.

18. No person may be physically located in the same room as the witness during the taking of a remote deposition except for a non-attorney who may be present solely for the purpose of providing technical assistance as needed.

19. While the deposition is on the record, the witness will have no electronic communications systems on or functioning except the deposition platform software. No deponent may engage, nor may any other person attempt to engage with the deponent, in a private communication, including through text message, electronic mail, instant message, or any chat or breakout feature in the deposition platform, while the deposition is on the record. In the event counsel intends to initiate a private communication with a deponent for the purpose of determining whether a privilege should be asserted, counsel shall state their intention on the record before initiating such communication.

20. During breaks in the deposition, the Parties may use a breakout room feature provided by the software used for the deposition which simulates a live breakout room through videoconference. The breakout rooms shall be established by the deposition services vendor prior to the deposition and operated by the deposition services vendor pursuant to the instructions of the Party that uses each such room. Conversations that take

place in the virtual breakout rooms will not be recorded or transcribed.

21. The parties have agreed that counsel defending the deposition may discuss the content of the deposition with the witness during breaks; however, the questioning attorney may inquire of the witness about the content of any such discussion and the witness must disclose the content of the discussion unless the break was taken solely for the purpose of determining whether a privilege should be asserted and the discussion was confined to that purpose.

22. A witness may not claim confidentiality as a basis for not answering any question, as the Protective Order protects the purported confidential information and related testimony.

23. Witnesses will be asked to testify on the record that they do not have any notes, other documents, or other information available to them in hard copy or electronically while the deposition is on the record, other than any that are disclosed and provided to all counsel present. Any document reviewed or notes made by a witness while on the record must be preserved, made available to all counsel in attendance at the deposition, and made a deposition exhibit if requested by deposing counsel.

24. Counsel may at their sole election, but are not required to, provide some or all anticipated exhibits in advance of a remote deposition. If they choose to provide exhibits in advance, they may employ any of the following methods, alone or in combination:

- a. Counsel may mail physical copies of exhibits that may be used during the deposition to the deponent, the deponent's counsel, all other

counsel of record, and the court reporter. Counsel noticing the deposition must inform all intended recipients of the mailing and shall provide tracking information for the package. If counsel intends that some or all of the exhibits not be opened until the deposition begins, the exhibits shall be sealed in envelope(s) clearly marked to indicate that they should not be opened until advised to do so by the counsel who transmitted them. In such case, anyone receiving such sealed exhibit(s) must not open them until instructed to do so by the deposing counsel. Any unused sealed exhibit(s) may not be opened and must be discarded with certification of their destruction or, if requested by the counsel who transmitted them, returned unopened at the expense of that counsel.

- b. Counsel may provide electronic copies of exhibits in advance of a deposition to the deponent, the deponent's counsel, all other counsel of record, and the court reporter by email or a prearranged FTP or file sharing site. Counsel noticing the deposition must inform all intended recipients of when such transmission is planned and by what means. Transmission of electronic exhibits shall take account of security precautions appropriate to the confidentiality of the documents being transmitted, and transmission by email shall take account of likely file size limitations. If deposing counsel intends that some or all of the exhibits not be opened until the deposition begins, counsel shall

clearly communicated that to the recipients. In such case, anyone receiving such sealed exhibit(s) must not open them until instructed to do so by the deposing counsel. Any such exhibits not used during the deposition may not be opened and must be discarded with certification of their destruction.

- c. Counsel shall meet and confer on a reasonable deadline in advance of a given deposition or set of depositions by which “advance” copies will be provided, if at all, and shall further meet and confer on expectations regarding whether or not the witness will be expected to have hard copies of such exhibits with him or her during the deposition.
- d. Any failure of the witness or other recipients to receive exhibits transmitted in advance shall not be a basis for postponing the deposition.
- e. If exhibits are provided in advance and are not sealed, deposing counsel may, at their election, identify particular exhibits (particularly as to lengthy exhibits) on which they anticipate questioning the witness and request that the witness read those documents in advance. Should the witness nevertheless not read the documents in advance, thereby prolonging the deposition, counsel shall confer in good faith regarding whether the time spent reviewing the exhibit during the deposition will count toward the time limit for the deposition. If

counsel are not able to resolve the matter through a good faith meet and confer, the Court may consider the witness's failure to read the exhibit in advance a reason for not counting the time spent by the witness reading the exhibit toward the time limit for the deposition, or for extending the time limit. *See* Advisory Committee Notes to the 2000 amendments to Fed. R. Civ. P. 30.

25. Deposing counsel may use any exhibit during the deposition that he or she deems fit, whether or not provided in advance of the deposition. Except as provided herein, or as agreed by counsel pursuant to Paragraph 24(c), exhibits may be presented to the witness during the deposition by using a remote "screen sharing" functionality within the videoconference platform or other similar electronic application that allows the witness and all attendees to see the exhibit while the witness is being questioned about it; or by any other means to which counsel for the Parties and counsel defending the witness (in the case of a non-Party witness deposition) agree. Notwithstanding the foregoing, any exhibit that has not been provided sufficiently in advance of the deposition as described in Paragraph 24 must first be posted in the "chat box" of the platform so that the witness and all other participants (subject to the Protective Order) can open and access the exhibit locally, separate and apart from any screen share functionality of the videoconference deposition platform software, before the exhibit is presented to the witness on the screen share function of the videoconference platform. A witness may not be questioned concerning an exhibit until the exhibit has been received and successfully opened by the witness and by counsel defending the witness.

26. If the deposition platform software used does not permit marking of any exhibit remotely, deposing counsel will identify how the exhibit is to be marked (with the assistance of the court reporter) and will work with the court reporter to ensure the proper subsequent marking. The court reporter will be responsible for marking each exhibit officially for later identification of the exhibit in connection with the official transcript and record of the deposition, unless the Parties agree in advance in writing to some other procedure. Upon conclusion of the deposition and when the court reporter renders the final transcript, the court reporter shall provide the stamped deposition exhibits with the final transcript by electronic or hard copy means.

27. The court reporter (and any videographer or deposition vendor service, as applicable) will maintain the official record of the deposition (including the transcript and exhibits) and will provide it in the ordinary course as would happen with a deposition taken in person.

28. If any counsel says “off the record,” and seeks to have a discussion that is not part of the official record, the deposing counsel, the opposing counsel, and any counsel for the witness (if different from the opposing counsel) must agree that the matter is “off the record,” and the court reporter must then so treat the matter as “off the record.” If counsel for the Parties cannot agree, then the deposing counsel’s position will control.

29. Realtime (or other immediate transcription software) transcription may be used. The transcripts may be time-stamped and the time will be set according to EDT. The time shown on the transcript and video shall be EDT. The official transcript will be the court-reporter certified transcript and not any Realtime or other version, but the Realtime

or other version may be used if it is necessary for a Party to seek expedited relief from the Court.

30. If a Realtime feed is available, any counsel in attendance may use the Realtime feed for any legitimate reason during the deposition and as indicated in the immediately preceding paragraph. However, absent a special need, the witness will not have access to or use of the Realtime feed at any time during the deposition.

31. Counsel for the Parties may not make speaking objections or unnecessarily repeat objections already preserved. Any objection made to suggest an answer to the deponent is improper.

32. The Parties agree to raise any issues regarding the deposition process to the Court as promptly as possible, but issues regarding the questions, objections, and answers may be raised at the time of the deposition, subject to the Court's availability, or in the ordinary course after the deposition pursuant to the applicable Federal Rules of Civil Procedure and this Court's orders and Practice Pointers.

33. This Order may be modified at any time by agreement of the Parties or by order of the Court. The Parties reserve all rights to seek relief from the Court from any provision for good cause.

IT IS SO ORDERED.

Dated: August 1, 2020

s/ Hildy Bowbeer

HILDY BOWBEER

United States Magistrate Judge

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

IPA TECHNOLOGIES, INC.,

Plaintiff,

v.

AMAZON.COM, INC., and AMAZON
DIGITAL SERVICES, LLC,

Defendants.

C.A. No. 16-1266-RGA

ADDENDUM TO PROTECTIVE ORDER

In light of the COVID-19 pandemic, and the resulting Federal, State, and local travel restrictions and shelter-in-place orders (collectively, “COVID-19 Restrictions”), the parties agree to the following additional terms governing review of Source Code. All source code related terms in the Protective Order (*see* Dkt. 92, ¶¶ 9(a)-(p)) continue to govern to the extent they are not addressed by this Addendum.

The terms in this Addendum shall remain in effect only so long as COVID-19 Restrictions are in effect at the locations of respective relevant parties, such as the location of the parties’ respective counsel and source code review consultants and experts. Once the COVID-19 Restrictions in those locations are lifted, however, the Producing Party can, at its sole discretion, continue (or resume) providing Source Code pursuant to the terms of this Addendum at any time or provide Source Code pursuant to the relevant provisions of the Protective Order (*see* Dkt. 92, ¶¶ 9(a)-(p)).

The Parties’ acknowledge that while the terms below may not reflect the Producing Party’s normal security protocols, they represent an accommodation in the interest of moving the case forward during the unprecedented COVID-19 pandemic and in light of applicable COVID-

19 Restrictions and related office closures and travel restrictions. A Party's agreement to make Source Code available pursuant to this Addendum shall not be construed as an admission that the provisions of the Addendum are appropriate in any other case or that these provisions provide an acceptable level of security for the Producing Party's Source Code at any other time not affected by the COVID-19 pandemic. The Addendum may not be cited as an appropriate practice to follow once the COVID-19 pandemic has passed even if the Producing Party decides to follow the terms of this Addendum after the COVID-19 Restrictions are lifted because other pandemic-related issues such as delayed office re-openings may still be experienced.

1. To the extent a Party elects to make Source Code available for inspection, the Producing Party shall notify the Receiving Party once any of Producing Party's Source Code is available for inspection. Thereafter, the Receiving Party shall provide fourteen (14) days' notice that it wishes to inspect Source Code.

2. Source Code shall be loaded to a computer maintained by the Producing Party or its outside counsel (the "Source Code Host Machine").

3. No later than fourteen (14) days after a request for Source Code inspection, the Producing Party shall send to the Receiving Party two computers capable of remotely accessing the Producing Party's Source Code (the "Remote Review Computers"). The Receiving Party may specify whether each Remote Review Computer shall be sent to the Receiving Party's outside counsel or instead directly to one or two of the Receiving Party's source code reviewers who are authorized to review source code under the Protective Order. The Remote Review Computers shall be delivered via overnight delivery service (*e.g.*, FedEx, UPS, etc.).

4. Each Remote Review Computer shall be a Windows-based laptop computer having at least 8 gigabytes of memory and a screen with a minimum size of thirteen inches.

Each Remote Review Computer shall be capable of connecting to the Source Code Host Machine via a restricted virtual private network (VPN).

5. The producing Party shall provide the receiving Party with information explaining how to start, log on to, and operate each Remote Review Computer. The Producing Party shall also provide the Receiving Party with any required credentials to connect to the Source Code Host Machine via VPN. Only one VPN session will be allowed at a time. Only one Remote Review Computer shall be connected to the Source Code Host Machine at a time.

6. Each Remote Review Computer shall have disk encryption and be password protected. Each Remote Review Computer will either have no peripheral device connectors or such connectors will be disabled. The use or possession of any electronic input/output device (*e.g.*, USB memory stick, mobile phone, tablet, personal digital assistants (PDAs), Blackberries, Dictaphones, voice recorders, external or portable telephone jack, camera or any camera-enabled device, CD, floppy disk, portable hard drive, laptop, or any device that can access the Internet or any other network or external system, etc.) is prohibited while accessing Source Code via each Remote Review Computer. The Producing Party may take appropriate measures, either through physical modification of the Remote Review Computers, or through modification of software on the Remote Review Computers, to prevent the use of such electronic input/output devices in conjunction with the Remote Review Computers and to prevent copying, duplicating, pasting, printing or any other duplication of the source code.

7. The Producing Party may log all connections to the Source Code Host Machine. The Producing Party may also terminate the secure connection to the Source Code Host Machine after 30 minutes of inactivity on the Remote Review Computer connected to the Source Code Host Machine.

8. The Receiving Party shall provide to the Producing Party a list of any individuals who access Source Code via each Remote Review Computer and the date and approximate time(s) of such review.

9. The receiving Party may request paper copies (“Source Code Printouts”) of limited portions of the Source Code. The Source Code Printouts, including any applicable printing limits, shall be governed by the provisions of the Protective Order, except as expressly modified herein. To ensure the proper pages requested by the Receiving Party are printed, the Producing Party shall provide the ability for the Receiving Party to save relevant files for printing as PDFs (preserving the line numbers and formatting using a program such as Notepad++) to a folder located on the Source Code Host Computer.

10. At the conclusion of any Source Code Review, the Receiving Party shall notify the Producing Party of the existence of Source Code Printouts that it requests to be produced. Thereafter, Source Code Printouts shall be produced in accordance with the provisions of the Protective Order.

11. The Producing Party shall install tools on each Remote Review Computer and/or Source Code Host Computer that are sufficient for viewing and searching Source Code produced, if such tools exist and are presently used in the ordinary course of the Producing Party’s business. The Receiving Party may request that other mutually-agreeable commercially available software tools for viewing and searching Source Code be installed on each Remote Review Computer and/or Source Code Host Computer, provided, however, that such other software tools are reasonably necessary for the Receiving Party to perform its review of the Source Code consistent with all of the protections herein. The Receiving Party must provide the Producing Party with a licensed copy of the relevant software, whether using a CD, DVD, or in

the case of software accessible over the internet, relevant keys or information to legally access reasonably in advance of any scheduled Source Code Review.

JOINTLY SUBMITTED BY:

BAYARD, P.A.

/s/ Stephen B. Brauerman

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and Amazon Digital Services, LLC*

IT IS SO ORDERED this 22 day of June, 2020

/s/ Richard G. Andrews

Hon. Richard G. Andrews
United States District Court Judge

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SHIRE VIROPHARMA INCORPORATED	:	
	:	CIVIL ACTION
Plaintiff,	:	
	:	
v.	:	
	:	NO. 17-414
CSL BEHRING LLC and CSL BEHRING GMBH	:	
	:	
Defendants.	:	

ORDER

AND NOW, this 17th day of September, 2020, upon consideration of whether I may proceed with a bench trial on the issue of alleged inequitable conduct, and upon review of the parties’ letter submissions regarding whether there are “common factual issues” between the invalidity counterclaim and the inequitable conduct counterclaim (D.I. 318, 322, 323, 325), I find as follows:

1. Plaintiff maintains several patents for products designed for the treatment of a rare genetic disorder known as hereditary angioedema (“HAE”). In 2017, Plaintiffs brought suit alleging that Defendants’ U.S. sales of their product HAEGARDA, which is likewise designed for the prophylactic treatment of HAE, infringes on Plaintiffs’ patents. Defendants responded with counterclaims for (a) the invalidity of Plaintiff’s patents-in-suit, and (b) inequitable conduct.
2. Claim construction, fact discovery, and expert discovery are completed. Chief Magistrate Judge Mary Pay Thyngge has also engaged in efforts to settle this matter. Aside from pending Daubert motions, this case is trial ready on the three essential issues in this case— infringement, invalidity, and inequitable conduct.
3. In an effort to move this case forward, I sought the parties’ input regarding how to proceed in light of the current COVID-19 pandemic. The latest standing order for the United States

District Court for the District of Delaware, dated September 1, 2020, states that “all civil and criminal jury selections and jury trials in the District of Delaware scheduled to begin before September 15, 2020, are continued pending further Order of the Court.” This order also notes that, when jury trials recommence, criminal matters will be given priority.

4. In response to my inquiries, Defendants have indicated that they are willing to proceed with a bench trial on all issues. Plaintiff has declined to waive its right to a jury trial. By way of order dated July 29, 2020, I noted that, under the Seventh Amendment and prevailing Federal Circuit law, Plaintiff is indeed entitled, as a matter of right, to a jury trial on both the infringement and invalidity claims. In re Lockwood, 50 F.3d 966 (Fed. Cir. 1995), vacated sub nom., American Airlines, Inc. v. Lockwood, 515 U.S. 1182 (1995).
5. Given that both Plaintiff’s infringement claim and Defendants’ invalidity counterclaim must be tried before a jury, and in light of the current limitation on jury trials, I explored with counsel whether a bench trial could proceed solely on Defendants’ counterclaim for inequitable conduct.
6. As noted in my July 29, 2020 order, a bench trial on inequitable conduct may proceed prior to a jury trial on infringement/invalidity only if the legal and equitable claims do not share “common factual issues.” See Shum v. Intel Corp., 499 F.3d 1272 (Fed. Cir. 2007); Celgene Corp. v. Barr Labs., Inc., No. 07-286, 2008 WL 2447354, at *2 (D.N.J. June 13, 2008).
7. Accordingly, I directed the parties to each file a no more than two-page letter that would concisely set forth a summary of evidence each party intended to introduce regarding the inequitable conduct and invalidity claims.
8. The parties each filed two letters, and also chose to attach approximately 1,000 pages of exhibits (836 from Plaintiff and 140 from Defendants). Because there was no context given

for any of these documents and because their submission was in violation of my Order, I have not considered these exhibits.

9. Nonetheless, having reviewed the parties' letters, I find that there is a risk of overlapping factual issues on the inequitable conduct and invalidity claims such that a bench trial on equitable conduct should not proceed before a jury trial on the other two claims. While it is difficult to fully understand the proofs to be presented for each claim without actually hearing the evidence in a courtroom, both the inequitable conduct and the invalidity claims appear to involve issues as to whether certain C1-INH research performed by others existed prior to Plaintiff's patents and whether Plaintiff's inventors should have disclosed that research to the PTO.
10. I have spoken with Chief Judge Leonard Stark regarding trial scheduling. Counsel are advised that once Delaware courtrooms are cleared for civil trials, a trial date will be selected forthwith.

WHEREFORE, it is hereby **ORDERED** that a trial date will not presently be set. In the interim, the previously-filed Daubert motions will be reviewed and resolved.

BY THE COURT:

/s/ Mitchell S. Goldberg
MITCHELL S. GOLDBERG, J.

**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

COVID-19 ADDENDUM TO PROTECTIVE ORDER

WHEREAS, Plaintiff Maxell, Ltd. and Defendant Apple Inc., hereafter referred to as “the Parties,” have worked together to reconcile the needs of this case with the exigencies of the ongoing public health emergency;

WHEREAS, the Court entered an Agreed Protective Order on July 2, 2019 (Dkt. No. 45) (“the Protective Order”);

WHEREAS, since the Parties entered into the Protective Order, the outbreak of the novel coronavirus (COVID-19) has been declared a global pandemic by the World Health Organization, and the Centers for Disease Control and Prevention has described the outbreak of COVID-19 in the United States as a “rapidly evolving situation” and has recommended social distancing to limit further community spread of COVID-19;

WHEREAS, in response to the COVID-19 pandemic, virtually every state has issued a “shelter-in-place” or “stay-at-home” order to limit the spread of the disease, including those

currently in place in Texas and California, which vary in scope and duration but generally require businesses not considered “essential” to close their physical offices and continue their operations remotely;

WHEREAS, in addition to these orders and advisories, numerous state and federal courts, including the U.S. District Court for the Eastern District of Texas, have issued Orders restricting or preventing public access to courthouses given the severity of risk to persons by the spread of COVID-19;

WHEREAS, Apple’s normal and necessary security procedures, memorialized in the existing agreed-to Protective Order, for the treatment of computer source code used as part of litigation are not possible given the public health orders and advisories;

WHEREAS, Chief District Judge Rodney Gilstrap issued a Standing Order Regarding Pretrial Procedures in Civil Cases Assigned to Chief District Judge Rodney Gilstrap During the Present Covid-19 Pandemic on April 20, 2020 that expressly recognizes that: “[t]rying to keep cases moving forward while prioritizing the health of individuals” may require “unconventional practices and accommodations that would not normally be accepted as appropriate,” such as “the production of computer source code that are not consistent with the producing party’s normal security protocols” (§2); to encourage parties “to be willing to make special accommodations during the health emergency,” that “those special accommodations will not be used against them in the future” (§3); and that with respect to source code production, the “the use of . . . temporary code-review procedures during the pandemic will not be citable as evidence of appropriate code-review procedures after the pandemic” and that “[a]fter the pandemic, parties producing source code can return to advocating all their normal security protocols” (§20 (emphasis in original));

WHEREAS, solely in this period of national—and international—public health emergency, Apple has developed, as a special accommodation, a temporary alternative to the inspection protocols set forth in the Protective Order that uses dedicated, specially-configured source code discovery laptops (“Remote Review Laptop”) that can be shipped to reviewers who are sheltering in place and enable the recipient of each such Remote Review Laptop to review code in an environment designed to approximate the security precautions set forth in the Protective Order to allow discovery of source code in this action to continue while the public health restrictions are in place; and

WHEREAS, Plaintiff acknowledges the exceptional exigencies presented by the international health emergency and will not later argue that Apple’s accommodations during this emergency constitute a proper approach in any other circumstances;

NOW THEREFORE, it is hereby stipulated among the Parties and **ORDERED** that:

1. This COVID-19 Addendum to the Protective Order shall be effective immediately upon entry and shall continue in effect until September 1, 2020, unless extended by agreement of the Parties or further order of the Court. Except as modified herein, all other provisions of the Protective Order shall remain in full force and effect.

2. Defined terms in this Addendum have the meaning established in the Protective Order entered in this action (i.e., Dkt. No. 45). In addition, “Authorized Reviewer,” in the context of this Addendum, shall mean any person who (a) is authorized under the Protective Order (i.e., Dkt. No. 45) to access materials designated as “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” and “INTEL CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE” and (b) has agreed to be bound by the provisions of this Addendum by signing a copy of Exhibit B.

3. Notwithstanding anything to the contrary in the Protective Order:
- (a) Any Remote Review Laptop made available by Defendant may be used as follows:
- (i) The Remote Review Laptop must be kept, at all times when not in use in accordance herewith, within a locked safe or a locked room (including a secure closet or cabinet) within the office or home of the Authorized Reviewers when not in use;
- (ii) Any Authorized Reviewer who is to receive a Remote Review Laptop shall, prior to receipt thereof, and upon Defendant's request, provide Defendants with details regarding the location at which such computer will be used for reviewing ("Source Code Review Room") and the location at which such computer will be stored when not being used for reviewing, for the sole purposes of ensuring compliance with the requirements of this Addendum regarding the location in which such computer is to be stored;
- (iii) No recordable media or recordable devices, including without limitation sound recorders, computers, cell phones, smart watches, peripheral equipment, cameras, devices containing unobstructed cameras (e.g., webcams, unless entirely shielded with an opaque material), CDs, DVDs, or drives of any kind, may be in the Source Code Review Room when the Remote Review Laptop is powered on; however, to the extent such devices are unable to be removed without substantial burden (e.g. desktop computer) such devices shall be powered off and remain off during the review of the source code;
- (iv) Upon the completion of each review session, Authorized Reviewer shall provide, at Defendant's request, a declaration confirming under penalty of perjury that no unauthorized electronic records of the Source Code were created or transmitted in any way;
- (v) While any Remote Review Laptop is in use, its screen shall be positioned in such a way that it is not visible from any external window of the room in which it is stored, or such window shall be covered with blinds, shades, or a similar covering;
- (vi) Before the Remote Review Laptop is turned on, the Authorized Reviewer who intends to review the Source Code shall provide a least one hour's notice to Defendant via email at vzhou@omm.com, dsilverman@omm.com, and kgodfrey@omm.com that they are beginning a review session;
- (vii) Upon receiving such notification, Defendant's counsel shall provide the Authorized Reviewer with a single-use password to access the Remote Review Laptop;

(viii) During the review session and at all other times, the Authorized Reviewers shall not copy, remove, or otherwise transfer any Source Code from the Remote Review Laptop including, without limitation, copying, removing, or transferring the Source Code onto any recordable media or recordable device;

(ix) The Remote Review Laptop must be turned off when not in active use;

(x) Immediately after the Remote Review Laptop is turned off, the Plaintiff's Authorized Reviewers shall notify Defendant via email at vzhou@omm.com, dsilverman@omm.com, and kgodfrey@omm.com that they are ending a review session;

(xi) At all times, all network and USB ports and wireless transmitters of each Remote Review Laptop shall be and remain disabled, and the Remote Review Laptop shall not be connected to a printer in any way;

(xii) Authorized Reviewers shall maintain a log of the time that they spend reviewing materials on the Remote Review Laptop during each review session in the form attached as Exhibit A, which shall be made available to Defendant upon request.

(b) Any Remote Review Laptop made available by Defendant may be transported as follows:

(i) Via hand carry, Federal Express, or other similarly reliable courier by Defendant to a location mutually agreed upon by the Parties; and

(ii) Each Remote Review Laptop may not be removed from said location, except to be returned to the location requested by the Defendant via hand carry, Federal Express, or other similarly reliable courier, after providing notice to Defendant of the intended shipment and receiving confirmation from Defendant that such shipment can be securely received.

(c) Defendant will endeavor to accommodate reasonable print requests from Plaintiff according to the following procedures:

(i) After completion of a review session (i.e., not during a review session), Plaintiff's Authorized Reviewer may inform Plaintiff's outside counsel of record via phone call of the precise file path, file name, and line number range to print;

(ii) Then, Plaintiff's outside counsel of record may provide the precise file path, file name, and line number range to print to Defendant's outside counsel of record by sending that information in formal letter correspondence, encrypted,

and designated as “CONFIDENTIAL - OUTSIDE ATTORNEYS’ EYES ONLY - SOURCE CODE”;

(iii) Upon receipt of such correspondence described in ¶ 3(c)(ii) above, Defendant’s counsel may have two (2) business days to print the source code lines identified by Plaintiff’s outside counsel of record. Then, Defendant will follow the normal procedures regarding providing printed source code pages set forth in the Protective Order at Dkt. No. 45, ¶ 11(c)(v);

(iv) Such printed source code pages described in ¶ 3(c)(iii) above apply to Plaintiff’s total printing page limit that the Parties have otherwise agreed to. *See* Dkt. 45, ¶ 11(c)(v).

(d) The Authorized Reviewers may keep paper Source Code printouts in a secured locked area in their offices or homes. At all times when not being actively reviewed, all Source Code printouts must be stored within a safe or locked drawer or file cabinet in a dedicated room within the office or home of the Authorized Reviewers that is locked when not in use;

(e) Paper Source Code printouts may only be transported or transmitted by at the direction of a person authorized to receive the printouts to another person authorized to receive the printouts on paper via hand carry, Federal Express or other similarly reliable courier;

(f) Any Authorized Reviewer in possession of a Remote Review Laptop under the terms of this Addendum shall return such computer to Defendant following the procedure described in Paragraph 3(b)(ii) above (i) on September 1, 2020, unless extended by the Court, or (ii) upon Defendant’s request after the occurrence of any one of the following: (1) the entry of an order dismissing or entering final judgment in this matter; (2) the entry of an order staying or administratively closing the case; (3) the conclusion of the Authorized Reviewer’s engagement with any party to this matter or involvement in this matter; (4) review via the method contemplated by the Protective

Orders is again feasible consistent with court, federal, state, and local guidance or orders relevant to the parties' ability to conduct in-person review of source code; or (5) the entry of a subsequent protective order that contemplates the return of Source Code Computers;

(g) Each Authorized Reviewer shall sign a copy of this Addendum acknowledging agreement to be bound to the conditions hereof.

So ORDERED and SIGNED this 25th day of June, 2020.

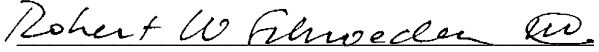

ROBERT W. SCHROEDER III
UNITED STATES DISTRICT JUDGE

EXHIBIT A

**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

AUTHORIZED REVIEWER LOG FOR

I, _____, certify under the pains and penalties of perjury that, on the dates and times listed below, I reviewed the Source Code Computer provided to me by Apple pursuant to the Covid-19 Addendum to Protective Order. I have listed below the start time and end time for each review session.

<u>DATE OF REVIEW SESSION</u>	<u>START TIME</u>	<u>END TIME</u>

[SIGNATURE]

EXHIBIT B

I, _____, acknowledge and declare that I have received a copy of the Covid-19 Addendum to Protective Order (“Order”) in *Maxell, Ltd. v. Apple Inc.*, United States District Court, Eastern District of Texas, Texarkana Division, Civil Action No. 5:19-cv-00036-RWS. Having read and understood the terms of the Order, I agree to be bound by the terms of the Order and consent to the jurisdiction of said Court for the purpose of any proceeding to enforce the terms of the Order.

Name of individual: _____

Present occupation/job description: _____

Name of Company or Firm: _____

Address: _____

Dated: _____

[Signature]

SAUL EWING
ARNSTEIN
& LEHR ^{LLP}

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April 22, 2020

VIA ECF

The Honorable Freda L. Wolfson, U.S.D.J.
Chief Judge, United States District Court
Clarkson S. Fisher Building & U.S. Courthouse
402 East State Street
Trenton, NJ 08608

Re: *Mitsubishi Tanabe Pharma Corp., et al. v. Sandoz Inc., et al.*
Civil Action No. 17-5319 (consolidated) (FLW)(DEA)

Dear Chief Judge Wolfson:

This firm, together with Paul Hastings LLP and Quinn Emanuel Urquhart & Sullivan, LLP, represents plaintiffs Mitsubishi Tanabe Pharma Corporation, Janssen Pharmaceuticals, Inc., Janssen Pharmaceutica NV, Janssen Research and Development, LLC, and Cilag GmbH International (collectively, "Plaintiffs") in the above-captioned consolidated matter.

Following on the parties' discussion during the March 31, 2020 final pretrial conference regarding the potential impact of the COVID-19 pandemic on the commencement of trial, defendant Zydus Pharmaceuticals (USA) Inc. ("Zydus") has agreed to an extension of the regulatory stay for 120-days from the conclusion of the trial. Further, the parties jointly request that Your Honor set the commencement of a six-day trial in this matter for some time in July 2020, or as soon as practicable thereafter in light of the COVID-19 pandemic, subject to the Court's availability and approval.¹

Enclosed is a Stipulation between Plaintiffs and Zydus memorializing the agreement to extend the stay and clarifying certain rights of Plaintiffs and Zydus in the context of this agreement. (Plaintiffs and Zydus had been working on this stipulation since the final pretrial conference.) If this Stipulation meets with Your Honor's approval, we have also enclosed a proposed form of Order that would formally extend the regulatory stay in accordance with the Stipulation. If this proposed Order meets with the Court's approval, we respectfully request that Your Honor sign and have it entered on the docket. If Your Honor has any questions regarding the Stipulation or the Order, we can be available for a telephone conference at the Court's convenience.

Thank you for Your Honor's kind attention to this matter.

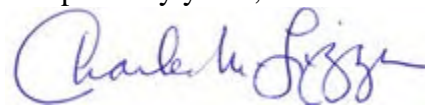
¹ We also received word from Your Honor's Courtroom Deputy today that the trial will not commence in May, and we are mindful of the Court's need to give priority to criminal cases.

Hon. Freda L. Wolfson, U.S.D.J.

April 22, 2020

Page 2

Respectfully yours,

A handwritten signature in blue ink that reads "Charles M. Lizza". The signature is written in a cursive style with a large initial "C" and a long horizontal stroke at the end.

Charles M. Lizza

Enclosures

cc: The Honorable Douglas E. Arpert, U.S.M.J.

All Counsel (via e-mail)

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**UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY**

MITSUBISHI TANABE PHARMA
CORPORATION, JANSSEN
PHARMACEUTICALS, INC., JANSSEN
PHARMACEUTICA NV, JANSSEN
RESEARCH AND DEVELOPMENT, LLC, and
CILAG GMBH INTERNATIONAL,

Plaintiffs,

v.

SANDOZ INC., *et al.*,

Defendants.

Civil Action No. 17-5319 (FLW)(DEA)
Civil Action No. 17-6375 (FLW)(DEA)
Civil Action No. 17-12082 (FLW)(DEA)
Civil Action No. 18-6112 (FLW)(DEA)
(consolidated)

Document Filed Electronically

STIPULATION TO EXTEND REGULATORY STAY

WHEREAS, Plaintiffs Mitsubishi Tanabe Pharma Corp., Janssen Pharmaceuticals, Inc., Janssen Pharmaceutica NV, Janssen Research and Development, LLC, and Cilag GmbH International (collectively, "Plaintiffs") have asserted that Defendant Zydus Pharmaceuticals (USA) Inc. ("Zydus"), by submitting Abbreviated New Drug Application ("ANDA") Nos. 210541 and 210542 seeking approval to engage in the commercial manufacture, use, offer for sale, sale, and/or importation of generic versions of canagliflozin tablets (100 mg and 300 mg) ("Zydus's ANDA No. 210541 Products") and generic versions of canagliflozin and metformin

hydrochloride tablets (50 mg/500 mg, 50 mg/1 g, 150 mg/500 mg, and 150 mg/1 g) (“Zydus’s ANDA No. 210542 Products”) (collectively, “Zydus’s ANDA Products”), infringes U.S. Patent No. 7,943,788 (“the ’788 patent”), U.S. Patent No. 8,222,219 (“the ’219 patent”), and U.S. Patent No. 8,785,403 (“the ’403 patent”);

WHEREAS, a trial was scheduled to commence in the above-captioned action on May 18, 2020, which Zydus and Plaintiffs anticipated would last six trial days;

WHEREAS, Zydus and Plaintiffs participated in a final pretrial conference with Judge Arpert on March 31, 2020, during which the impact of the COVID-19 pandemic on the commencement of trial was discussed;

WHEREAS, Zydus proposed (and Plaintiffs did not object to, subject to Zydus’s agreement to this stipulation) an adjournment of the commencement of trial for as short a time as reasonable and necessary given the COVID-19 pandemic, with a target date for the re-scheduled commencement of trial in July 2020 or the earliest date thereafter, subject to the Court’s approval and availability;

WHEREAS, the statutory stay of the Food and Drug Administration’s (“FDA”) approval of Zydus’s ANDA Nos. 210541 and 210542 will expire on September 29, 2020 (the “Statutory Stay”);

WHEREAS, as originally scheduled, there were approximately one-hundred and twenty (120) days between the anticipated conclusion of the trial and the expiration of the Statutory Stay;

NOW THEREFORE, Zydus and Plaintiffs, by their undersigned counsel, STIPULATE as follows:

1. Plaintiffs and Zydus agree that this Court should enter an order extending the statutory stay of the FDA approval of Zydus’s ANDA Nos. 210541 and 210542 until

one-hundred and twenty (120) days from the conclusion of the re-scheduled trial in the above-captioned action (the “120-Day Extension”). Zydus agrees to notify the FDA of this Order within five business days after being entered by the Court, and the conclusion date of the re-scheduled trial within five business days after said conclusion date.

2. Zydus agrees to refrain from engaging in the commercial manufacture, use, offer for sale, sale, and/or importation of Zydus’s ANDA Products within the United States during the 120-Day Extension, and Plaintiffs and Zydus further agree that nothing herein shall prevent or preclude Zydus from engaging in the commercial manufacture, use, offer for sale, sale, and/or importation of Zydus’s ANDA Products within the United States after the expiration of the 120-Day Extension. For the avoidance of the doubt, this Stipulation does not apply to the commercial manufacture, use, offer for sale, and/or sale of Zydus’s ANDA Products outside of the United States.

3. Plaintiffs and Zydus further agree that nothing herein shall prevent or preclude Plaintiffs from filing a motion for an injunction (or seeking any other relief from the Court, as appropriate) to prevent Zydus from engaging in the commercial manufacture, use, offer for sale, sale, and/or importation of Zydus’s ANDA Products within the United States after the expiration of the 120-Day Extension.

IT IS HEREBY STIPULATED:

Dated: April 22, 2020

s/ Charles M. Lizza

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Pharmaceutica NV, Janssen Research
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**UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY**

MITSUBISHI TANABE PHARMA
CORPORATION, JANSSEN
PHARMACEUTICALS, INC., JANSSEN
PHARMACEUTICA NV, JANSSEN
RESEARCH AND DEVELOPMENT, LLC,
and CILAG GMBH INTERNATIONAL,

Plaintiffs,

v.

SANDOZ INC., *et al.*,

Defendants.

**Civil Action No. 17-5319 (FLW)(DEA)
(consolidated)**

ORDER

(Filed Electronically)

This matter having come before the Court by a stipulation between Plaintiffs Mitsubishi Tanabe Pharma Corp., Janssen Pharmaceuticals, Inc., Janssen Pharmaceutica NV, Janssen Research and Development, LLC, and Cilag GmbH International (collectively, "Plaintiffs") and Defendant Zydus Pharmaceuticals (USA) Inc. ("Zydus"); and the Court having considered the stipulation and the provisions set forth therein; and for good cause shown,

IT IS ON THIS _____ day of _____, 2020,

ORDERED that the statutory stay of U.S. Food and Drug Administration (“FDA”) approval of Zydus’s ANDA Nos. 210541 and 210542 is hereby extended from September 29, 2020, until one-hundred and twenty (120) days from the conclusion date of the trial in the above-captioned action. Zydus shall notify the FDA of this Order within five business days after its entry by the Court. Zydus shall further notify the FDA of the conclusion of the trial within five business days after the conclusion date.

Hon. Freda L. Wolfson, U.S.D.J.

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**UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY**

MITSUBISHI TANABE PHARMA
CORPORATION, JANSSEN
PHARMACEUTICALS, INC., JANSSEN
PHARMACEUTICA NV, JANSSEN
RESEARCH AND DEVELOPMENT, LLC,
and CILAG GMBH INTERNATIONAL,

Plaintiffs,

v.

SANDOZ INC., *et al.*,

Defendants.

**Civil Action No. 17-5319 (FLW)(DEA)
(consolidated)**

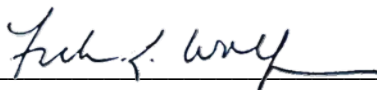
ORDER

(Filed Electronically)

This matter having come before the Court by a stipulation between Plaintiffs Mitsubishi Tanabe Pharma Corp., Janssen Pharmaceuticals, Inc., Janssen Pharmaceutica NV, Janssen Research and Development, LLC, and Cilag GmbH International (collectively, "Plaintiffs") and Defendant Zydus Pharmaceuticals (USA) Inc. ("Zydus"); and the Court having considered the stipulation and the provisions set forth therein; and for good cause shown,

IT IS ON THIS 24th day of April, 2020,

ORDERED that the statutory stay of U.S. Food and Drug Administration (“FDA”) approval of Zydus’s ANDA Nos. 210541 and 210542 is hereby extended from September 29, 2020, until one-hundred and twenty (120) days from the conclusion date of the trial in the above-captioned action. Zydus shall notify the FDA of this Order within five business days after its entry by the Court. Zydus shall further notify the FDA of the conclusion of the trial within five business days after the conclusion date.



Hon. Freda L. Wolfson, U.S.D.J.

**IN THE UNITED STATES DISTRICT COURT FOR THE
NORTHERN DISTRICT OF ILLINOIS**

NeuroGrafix, et al)	Case No: 12 C 6075
)	
v.)	
)	Judge: Matthew F. Kennelly
Brainlab, Inc. et al)	

ORDER

Counsel held a court-ordered meeting in the courtroom today for the purpose of providing a witness list as directed by the Court at the telephone status hearing held on 10/8/2020. The Court advised that it needs the list for planning purposes. The required list was to include the names and locations of the witnesses; whether the party intended to present the testimony of each in person, remotely by video, or by way of deposition; and a brief summary of any objections to the calling of each. The Court advised that it would accept a handwritten list. The meeting appears to have taken over two hours. The product was a handwritten list. A copy of the list accompanies this entry. It is utterly incomprehensible and partially illegible. The parties are directed to provide by no later than 6:00 PM today a legible list identifying for each side: (1) the witnesses it intends to call; (2) the city and state where the witness resides; (3) whether the witness's testimony will be presented in person, by remote video, or by deposition; and (4) any objections by the other side to the calling of the witness. The list is not to include responses to any such objections. Those may be addressed in the final pretrial order.

Date: October 9, 2020

/s/ Judge Matthew F. Kennelly

OBT - MOSELEY

- MSL
- Cannot testify to inventory as Ogzezean was designated and the sole person responsible for researching prior art.

Michael Moseley, PhD	X	CA	In person
Robert Bras, EPA/CF		FL	In person
Robert Young, MD	OBT	NY	By deposition
George Ogzezean		Germany	By video
Andrew Tsung		IL	By video

- Report based on sanctionable evidence and unsubstantiated numbers
- Did not draft his own report (portions) as to the portion

- Unqualified opinion as to validity as he was not a researcher and not practicing for lack of knowledge

OBT - MOSELEY

- Cannot agree **infringement** because **JOSEPH BOYLE** was designated during Brainlab's **infringement** as an expert and not Brainlab's as to infringement -

- WITNESSES TAMPERING - Failed to prepare use Brainlab as to infringement -
- Irrelevant - ~~confusing~~ - Does NOT use Brainlab as TTS

Does NOT use Brainlab and was NOT deposed

- Irrelevant
- Not experts in field
- **OUTSIDE SUBROGATA POWER**

- CAFC Court noted also object that it appears = **PECULIAR**
All their reports seem to be written by the same person
- presumably tampered reports

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

SHIRE VIROPHARMA INCORPORATED	:	
	:	CIVIL ACTION
Plaintiff,	:	
	:	
v.	:	
	:	NO. 17-414
CSL BEHRING LLC and CSL BEHRING GMBH	:	
	:	
Defendants.	:	

ORDER

AND NOW, this 29th day of July, 2020, upon consideration of the parties’ letter submissions regarding both summary judgment motions (D.I. 281, 283, 288) and the structure of a trial (D.I. 309, 311, 312, 314, 315), and following the June 4, 2020 and June 10, 2020 conferences with the parties on these issues, I find as follows:

1. Plaintiff maintains several patents for products designed for the treatment of a rare genetic disorder known as hereditary angioedema (“HAE”). In 2017, Plaintiffs brought suit alleging that Defendants’ U.S. sales of their product HAEGARDA, which is likewise designed for the prophylactic treatment of HAE, infringes on Plaintiffs’ patents. Defendants responded with counterclaims for (a) the invalidity of Plaintiff’s patents-in-suit, and (b) inequitable conduct. The parties have proceeded through and completed claim construction, fact discovery, and expert discovery.
2. On March 25, 2020, Plaintiff submitted a letter request seeking leave to file a motion for summary judgment on its infringement claim, as well as on Defendants’ counterclaims for inequitable conduct and invalidity for obviousness under 35 U.S.C. § 103. Defendants’ responded that such issues were not appropriate for summary judgment.

3. On June 4, 2020, I held a telephone conference with the parties to address Plaintiff's letter request, at which time I indicated that summary judgment briefing on the identified issues would be rife with factual disputes and, as such, it would not be in the interests of judicial economy to allow the filing of summary judgment motions.
4. In an effort to move this otherwise trial-ready case forward, I sought the parties' input regarding how to proceed. I noted that the current COVID-19 pandemic has currently rendered the scheduling of jury trials difficult if not impossible. Indeed, under the latest standing order for the United States District Court for the District of Delaware, "all civil and criminal jury selections and jury trials in the District of Delaware scheduled to begin before August 31, 2020, are continued pending further Order of the Court." Although the logistics of a bench trial could also be difficult in a pandemic, I suggested to counsel that it seemed much more realistic to attempt to proceed with testimony where I, as opposed to a jury, would find facts. Against this backdrop, and in an effort to resolve this matter, I proposed that the parties consider proceeding with a bench trial on all claims.
5. In a joint letter dated June 9, 2020, Defendants indicated that they were willing to proceed with a bench trial on all issues, but Plaintiff declined to waive its right to a jury trial. I held another telephone conference with the parties on June 10, 2020, and proposed a bench trial solely on Defendants' counterclaims of invalidity and inequitable conduct. Plaintiff agreed that the inequitable conduct claim could be resolved via a bench trial, but pressed that (a) it is entitled to a jury trial on Defendants' counterclaim of invalidity, and (b) any bench trial on inequitable conduct should not proceed until after the jury trial on infringement and invalidity.
6. Regarding a determination on the invalidity counterclaims, I find that, under prevailing Federal Circuit law, Plaintiff is entitled as a matter of right to a jury trial. In In re Lockwood,

50 F.3d 966 (Fed. Cir. 1995), vacated sub nom., American Airlines, Inc. v. Lockwood, 515 U.S. 1182 (1995), the plaintiff-patentee sued the defendant for patent infringement, and the defendant counterclaimed for a declaration that its activities were non-infringing and that the patents were invalid and unenforceable. Id. at 968. After the plaintiff-patentee requested a jury trial on the validity issue, the district court struck the plaintiff's demand, holding that the plaintiff was not entitled to a jury trial as a matter of right. Id.

7. The Federal Circuit reversed, finding that the patentee had a right to a jury trial on the declaratory judgment counterclaim regarding patent validity. Id. at 976. In doing so, the court explained that, in the 18th century, patent invalidity as a claim did not exist; rather the only way patent invalidity could be raised was through an action for patent infringement by the patentee. Id. at 973–74. The Court reasoned that the advent of the Declaratory Judgment Act in 1934 did not mean that an alleged infringer could suddenly deprive the patentee of that right to a jury trial merely by raising invalidity in a declaratory judgment action filed before the infringement action. Id. at 976 (“[T]he Seventh Amendment preserves to Lockwood the same right to a jury trial on the factual questions relating to validity in a declaratory judgment action that he would have enjoyed had the validity of his patents been adjudicated in a suit for patent infringement according to eighteenth-century English practice.”). Emphasizing the importance of the nature of the remedy sought, the Federal Circuit concluded that “[b]ecause patent validity is not purely an equitable issue, and because the pending declaratory judgment action is most comparable to an inversion of a patent infringement lawsuit,” a patentee pursuing legal remedies for infringement is entitled, under the Seventh Amendment, to trial by jury of a declaratory judgment action to determine the validity of the patent-in-suit. Id. at 980.

8. Although Lockwood has been vacated by the United States Supreme Court on other grounds, the prevailing Federal Circuit rule remains that “the remedy the patentee seeks determines the nature of the action.” Trustees of Univ. of Pa. v. St. Jude Children’s Research Hosp., 982 F. Supp. 2d 518, 540 (E.D. Pa. 2013) (citing Lockwood with approval and holding that where alleged infringer filed action seeking declaration of non-infringement and invalidity, and patentee filed counterclaim for infringement seeking damages, both the declaratory judgment action and the infringement action had to be tried to a jury); see also Kao Corp. v. Unilever U.S., Inc., No. 01-680, 2003 WL 1905635, at *3 (D. Del. April 17, 2003) (citing Lockwood and holding that “the patentee’s infringement case is the linchpin of the Federal Circuit’s Seventh Amendment analysis”).
9. Here, Plaintiff initiated this suit as an infringement action seeking legal damages. Under the reasoning of Lockwood, Plaintiff’s request for a legal remedy determines the nature of the action, and Plaintiff retains the right to a jury trial on Defendant’s counterclaim to declare Plaintiff’s patent invalid.
10. Given that I must try both Plaintiff’s infringement claim and Defendants’ invalidity counterclaim before a jury, and in light of the current limitation on jury trials, the question still remains as to whether a bench trial can proceed solely on Defendants’ counterclaim for inequitable conduct prior to the jury trial on infringement/invalidity.
11. In Beacon Theatres, Inc. v. Westover, 359 U.S. 500 (1959), the United States Supreme Court held that a trial court could not conduct a bench trial on equitable declaratory relief where that trial would resolve issues common to another claim subject to jury resolution. Id. at 510–11. The Court emphasized that, except under “the most imperative circumstances,” the right to a jury trial of legal issues cannot be lost through prior determination of equitable claims. Id. at 511. Because both the petitioner’s claim in that case and the declaratory relief

claim involved “a common issue,” the bench trial of the declaratory relief claim prior to the jury trial on the legal claim violated the Seventh Amendment to the United States Constitution. Id. at 503.

12. Two cases from the Federal Circuit have applied Beacon’s holding to patent cases involving circumstances similar to those before me here. First, in Agfa Corp. v. Creo Prods. Inc., 451 F.3d 1366 (Fed. Cir. 2006), the plaintiff-patentee sued the defendant on grounds of infringement. Id. at 1370–71. “As a defense, as well as a counterclaim, [the defendant] asserted that all of [the plaintiff’s] patents [were] unenforceable due to [the plaintiff’s] inequitable conduct before the United States Patent and Trademark Office . . . [because the plaintiff] wrongfully declined to disclose material prior art to the PTO during prosecution of [the plaintiff’s] asserted patents.” Id. The Federal Circuit did not find that the Beacon Theatres rule applied because “[w]hile the inequitable conduct and validity questions in [that] case overlap[ped] in the consideration of some aspects of the same relevant evidence, they [did] not involve a common issue.” Id. at 1372. In turn, the Federal Circuit found no error in the trial court’s decision to hold a bench trial on the issue of the patentee’s alleged inequitable conduct followed by a later jury trial on the issue of the patent’s validity. Id.
13. Subsequently, in Shum v. Intel Corp., 499 F.3d 1272 (Fed. Cir. 2007), the Federal Circuit again applied Beacon Theatres in the patent context, but reached the opposite outcome. Plaintiff brought claims for fraud, unjust enrichment, and other state law theories, as well as a cause of action for correction of inventorship under 35 U.S.C. § 256. Id. at 1275. The trial court proceeded to a bench trial on the inventorship cause of action before the state law claims were tried to a jury. Id. at 1275–76. The plaintiff appealed, arguing that the district court’s decision to bifurcate the claims and conduct a bench trial on the inventorship issue prior to a jury trial on the state law claims violated his constitutional rights because the

inventorship claim and state law claims shared common factual issues. Id. at 1276. Distinguishing Agfa, the Federal Circuit found that, given the presence of common factual issues, the trial court’s “decision to try the inventorship claim before a jury trial on the state law claim ran afoul of the Seventh Amendment, and thus was an abuse of discretion.” Id. at 1279.

14. Following Shum, district courts have established a case-specific, two-step analysis to determine whether trial of a legal claim may be bifurcated from an equitable claim. “First, the Court must determine whether the movant seeks to bifurcate the case such that resolution of an equitable claim precedes resolution of a legal claim. If this is the case, then the Court must determine whether the equitable and legal claims share common factual issues.” Celgene Corp. v. Barr Labs., Inc., No. 07-286, 2008 WL 2447354, at *2 (D.N.J. June 13, 2008) (citing Shum); see also Duhn Oil Tool, Inc. v. Cooper Cameron Corp., 818 F. Supp. 2d 1193, 1204 (E.D. Cal. 2011) (holding that where “substantial commonality” exists between the factual questions presented by infringement/invalidity issues and inequitable conduct issues, the legal claims must be determined by the jury prior to any final court determination of the equitable claims); Bard Peripheral Vascular, Inc. v. W.L. Gore & Assoc., Inc., No. 03-597, 2007 WL 3208540, at *5–6 (D. Ariz. Oct. 30, 2007) (discussing Agfa and declining to hold a bench trial on inequitable conduct claim prior to jury trial on infringement and invalidity claims because of the risk of making factual findings that bore on patent invalidity or infringement).

15. Against this legal landscape, I am attempting to determine whether there are “common factual issues” between Defendant’s counterclaim for invalidity and Defendant’s counterclaim for inequitable conduct, such that a bifurcated bench trial on inequitable conduct prior to a jury trial on infringement/invalidity would violate Plaintiff’s Seventh

Amendment rights. Generally stated, Defendant's invalidity counterclaim alleges that Plaintiff's patents are invalid for failing to satisfy the requirements of 35 U.S.C. §§ 101, 102, 103, and/or 112. The invalidity argument under § 102 appears to be premised, in part, on whether a third party conceived of the claimed inventions before Plaintiff. The inequitable conduct counterclaim alleges, in part, that Plaintiff engaged in fraudulent conduct before the PTO by failing to list the same third party as an inventor on the patents. While, it appears that there is some overlap in the factual issues for these two claims, the filings of record do provide sufficient information to allow me to definitively conclude whether or not "common factual issues" exist.

WHEREFORE, it is hereby **ORDERED** that,

a. Within **seven (7) days** from the date of this Order, Plaintiff shall file a letter of no more than two pages setting forth with specificity what facts it intends to introduce regarding the invalidity and inequitable conduct counterclaims.

b. Within **seven (7) days** from receipt of Plaintiff's letter, Defendants shall file a letter of no more than two pages setting forth with specificity what facts they intend to introduce to prove the inequitable conduct and invalidity counterclaims.

BY THE COURT:

/s/ Mitchell S. Goldberg
MITCHELL S. GOLDBERG, J.