

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

TRUE CHEMICAL SOLUTIONS, LLC

Plaintiff/Counter-Defendant

-vs-

PERFORMANCE CHEMICAL COMPANY

Defendant/Counter-Plaintiff§
§
§
§
§
§
§
§
§
§

Civil Action No. 7:18-CV-78

JOINTLY PROPOSED TENTH AMENDED SCHEDULING ORDER

Pursuant to Rule 16, Federal Rules of Civil Procedure, the Court issues this TENTH AMENDED SCHEDULING ORDER. It is hereby **ORDERED** that the following schedule of deadlines is in effect until further Order of this Court:

| Proposed Date | Action |
|----------------------|--|
| N/A | Scheduling Conference. |
| N/A | <p>Disclosure of Asserted Claims and Infringement Contentions – (Comply with Patent Rules¹ (P.R.) 3-1). Parties to make disclosure of asserted claims and infringement contentions;</p> <p>Document Production Accompanying Disclosure of Infringement Contentions – (Comply with P.R. 3-2). After this date, it is necessary to obtain leave of court to add and/or amend infringement contentions, pursuant to P.R. 3-7. Add new patents and/or claims for patents-in-suit. It is not necessary to file a motion to add additional patents or claims before this date. Thereafter, it is necessary to obtain leave of court to add patents or claims.</p> |

¹ Patent Rules applied to the present case may be based on Model Patent Local Rules issued by the Federal Circuit Bar Association®, Local Patent Rules of the Federal District Court for the Eastern District of Texas, and/or the Local Patent Rules of the Federal District Court for the Southern District of Texas.

| | |
|-----|---|
| N/A | <p>Submit Report on Alternative Dispute Resolution in Compliance with Local Rule CV-88;</p> <p>Submit, by parties asserting claims for relief, written offer of settlement to opposing parties.</p> |
| N/A | Each party responds, in writing, to written offer of settlement from opposing party. |
| N/A | Join Additional Parties. It is not necessary to file a motion to join additional parties before this date. Thereafter, it is necessary to obtain leave of court to join additional parties. |
| N/A | Privilege Logs to be exchanged by parties (or a letter to the Court stating that there are no disputes as to claims of privileged documents). |
| N/A | <p>Invalidity Contentions. Parties to serve invalidity contentions (Comply with P.R. 3-3);</p> <p>Document Production Accompanying Invalidity Contentions – (Comply with P.R. 3-4). Thereafter, it is necessary to obtain leave of Court to add and/or amend invalidity contentions pursuant to P.R. 3-7;</p> <p>Add any inequitable conduct allegations to pleadings. Before this date, it is not necessary to file a motion for leave to add inequitable conduct allegations to pleadings. Thereafter, it is necessary to obtain leave of court to add inequitable conduct allegations to pleadings.</p> |
| N/A | Parties’ exchange of proposed claim terms and claim elements – (Compliance with P.R. 4-1). |
| N/A | Parties’ exchange of preliminary claim construction and extrinsic evidence – (Comply with P.R. 4-2). |
| N/A | <p>Filing of Joint Claim Construction and Prehearing Statement – (Comply with P.R. 4-3);</p> <p>Disclosure of parties' claim construction experts & Service of FED. R. Civ. P. 26(a)(2) materials.</p> |

| | |
|-----|--|
| N/A | <p>Deadline for all parties to file amended pleading (pre-claim construction). It is not necessary to file a Motion for Leave to Amend before the deadline to amend pleadings. (It will be necessary to file a Motion for Leave to Amend after this deadline);</p> <p>NOTE: If the amendment would affect infringement contentions or invalidity contentions, a motion must be made pursuant to P.R. 3-7 irrespective of whether the amendment is made prior to this deadline.</p> |
| N/A | <p>Each party to provide name, address, phone number, and curriculum vitae for up to three (3) candidates for a court-appointed special master (see FED. R. Civ. P. 53) or court-nominee's availability for <i>Markman</i> hearing</p> <p>appointed expert (see FED. R. Ev. 706), with information regarding the r other assignments as deemed necessary by the court. The parties shall indicate if they agree on any of the nominees;</p> <p>Deadline for parties to provide Court with written tutorials concerning technology involved in patent in issue. If a special master or court-appointed expert is hereafter selected, the parties will provide each tutorial to the master or expert.</p> |
| N/A | Responses to Amended Pleading due. |
| N/A | Discovery deadline on claim construction issues. (Comply with P.R. 4-4). |
| N/A | <p><i>Markman</i> Brief - The party claiming patent infringement shall serve and file an opening brief and any evidence supporting its claim construction. Comply with P.R. 4-5(a);</p> <p>If a technical advisor has been appointed, the moving party must provide their <i>Markman</i> Brief on electronic storage along with a hard copy, tabbed and bound in notebook format with exhibits to the advisor. Briefing shall comply with Local Rules.</p> |

| | |
|-----|---|
| N/A | <p>Responsive Brief regarding <i>Markman</i> Brief and supporting evidence due to party claiming patent infringement. Comply with P.R. 4-5(b);</p> <p>Motion for Summary Judgement of Indefiniteness due (subsumed into Response Brief)</p> <p>If a technical advisor has been appointed, the moving party must provide their Responsive Brief on electronic storage along with a hard copy, tabbed and bound in notebook format with exhibits to the advisor. Briefing shall comply with Local Rules.</p> |
| N/A | <p>Reply Brief regarding <i>Markman</i> Brief and supporting evidence. The party claiming patent infringement shall serve and file any Reply Brief and any evidence directly rebutting the supporting evidence contained in an opposing party's Responsive Brief and supporting evidence due to party claiming patent infringement. Comply with P.R. 4-5(c);</p> <p>Response to Motion for Summary Judgement of Indefiniteness due (Subsumed into Reply Brief)</p> <p>If a technical advisor has been appointed, the moving party must provide their Reply Brief on electronic storage along with a hard copy, tabbed and bound in notebook format with exhibits to the advisor. Briefing shall comply with Local Rules;</p> <p>Parties to file a notice with the Court stating the estimated amount of time requested for the Claim Construction (<i>Markman</i>) Hearing. The Court will notify the parties if it is unable to accommodate this request;</p> |
| N/A | <p>Reply Brief regarding to Motion For Summary Judgement of Indefiniteness. If a technical advisor has been appointed, the moving party must provide their Motion on electronic storage along with a hard copy, tabbed and bound in notebook format with exhibits to the advisor. Briefing shall comply with Local Rules.</p> |
| N/A | <p>Parties to submit Claim Construction Chart. Comply with P.R. 4-5(d). Parties shall jointly submit the claim construction chart in such a format as the Court may direct.</p> |

| | |
|---------------------------|--|
| N/A | Claim Construction (<i>Markman</i>) Hearing at 9:00 a.m. at the United States District Court, Western District of Texas Midland/Odessa Division. |
| N/A | Court's Decision on Claim Construction (<i>Markman</i> Ruling); If the Court issues the <i>Markman Ruling</i> at a later date, parties may seek amendment of remaining dates in Scheduling Order. |
| December 6, 2019 | If a party claiming patent infringement believes in good faith that the Court's <i>Markman</i> Ruling so requires, not later than this date, that party may serve "Amended Infringement Contentions" without leave of Court that amend its "Infringement Contentions" with respect to the information required by Patent R. 3-1(c) and (d). It is necessary to file a Motion for Leave to Amend Infringement Contentions after this deadline. |
| January 17, 2020 | Each party opposing a claim of patent infringement may serve "Amended Invalidity Contentions" without leave of Court that amend its "Invalidity Contentions" with respect to the information required by P. R. 3-3 if: (A) a party claiming patent infringement has served Amended Infringement Contentions responsive to the <i>Markman</i> Ruling; or (B) the party opposing a claim of patent infringement believes in good faith that the Court's <i>Markman</i> Ruling so requires. It is necessary to file a Motion for Leave to Amend Invalidity Contentions after the deadline. |
| January 20, 2020 | All parties furnish documents and privilege logs pertaining to willful infringement. |
| July 17, 2020 | Close of Fact Discovery |
| September 22, 2020 | All parties asserting claims for relief shall file their preliminary designation of potential witnesses, testifying experts, and proposed exhibits, and shall serve on all parties. |
| September 30, 2020 | All parties resisting claims for relief shall file their preliminary designation of potential witnesses, testifying experts, and proposed exhibits, and shall serve on all parties. |

| | |
|---------------------------|---|
| August 7, 2020 | Date for designation of expert witness (non-constructive issues on which parties have burden of proof); Service of Expert Witness Reports due. Refer to Local Rules for required information. |
| August 28, 2020 | Date for designation of rebuttal expert witness (non-constructive issues on which parties does not have burden of proof); Service of Responsive Expert Witness Reports due. Refer to Local Rules for required information. |
| September 18, 2020 | Close of Expert Discovery. |
| November 9, 2020 | Parties to Identify Trial Witnesses. |
| November 11, 2020 | Parties to Identify Rebuttal Trial Witnesses. |
| October 2, 2020 | Dispositive Motions due from all parties; Any other motions that may require a Hearing (including Daubert motions) due. Motions shall be filed according to Local Rules. |
| October 23, 2020 | Response to Dispositive Motions (including Daubert motions) due. Motions shall be filed according to Local Rules. |
| November 6, 2020 | Court's Ruling on all motions. |
| November 13, 2020 | Submit Proposed Joint Pretrial Order; Submit Joint Proposed Jury Instructions with citation to authority; Submit Form of the Verdict for jury trials; Submit Proposed Findings of Fact and Conclusions of Law with citation to authority for issues tried to the bench; Submit written notice for request for daily transcript or real time reporting of trial proceeding. |

| | |
|--|---|
| November 20, 2020 | Pretrial Disclosures Due. Video and Deposition Designations due. Each party who proposes to offer a deposition by video must file a disclosure identifying the line and page numbers to be offered. All other parties will have one (1) week to file a response requesting cross designation line and page numbers to be included. Each party is responsible for preparation of the final edited video in accordance with their parties' designations and the Court's rulings on objections. |
| December 11, 2020 | Motions in Limine due |
| December 22, 2020 | Submit Objections to opponents' proposed witnesses, proposed exhibits, designated deposition testimony, and any other matters. |
| January 25, 2020 (or a date soon thereafter as the Court deems appropriate) | Jury Selection at 9:00am at the United States District Court; Jury Trial commences |

OTHER REQUIREMENTS AND LIMITATIONS:

DISCOVERY

Except with regard to discovery necessary for claim construction, all other discovery is stayed until after the Markman hearing. Notwithstanding this general stay of discovery, the Court will permit limited discovery by agreement of the parties, or upon request, where exceptional circumstances warrant.

Following the Markman hearing, the following discovery limits will apply to this case. The Court will consider reasonable requests to increase these limits should circumstances warrant.

1. Interrogatories: 30 per side
2. Requests for admission: 45 per side
3. Requests for Production: 75 per side
4. Fact Depositions: 70 hours per side (for both party and non-party witnesses combined)
5. Expert Depositions: 7 hours per report

Electronically Stored Information. The Parties agree to cooperate regarding ESI. The Parties agree for performing a general search and production of email and/or other electronically stored information (ESI). The Parties will cooperate on a procedure identifying custodians and search terms it believes the opposing party should search. If the parties cannot agree, they shall contact chambers to schedule a call with the Court to discuss their respective positions.

DISCOVERY DISPUTES

A party may not file a Motion to Compel discovery unless: (1) lead counsel have met and conferred in good faith to try to resolve the dispute, and (2) the party has contacted the Court (with opposing counsel) to arrange a telephone conference to summarize the dispute and the parties respective positions. After hearing from the parties, the Court will determine if further briefing is required.

MEDIATION

The Court has ordered parties to mediate by May 25, 2020. ECF No. 82. Due to extenuating circumstances created by the novel coronavirus outbreak, the Court hereby extends the deadline for the parties to mediate by at least an additional 90 days. The parties shall contact Magistrate Judge Jeffrey C. Manske on or before June 19, 2020 to schedule a mediation conference to occur prior to September 21, 2020. All parties and their counsel, as well as persons with ultimate settlement authority for each party, must be personally present at the mediation.

GENERAL ISSUES

1. The Court does not have a limit on the number of motions for summary judgment (MSJs); however, the cumulative page limit for Opening Briefs for all MSJs is 50 pages per side.
2. The Court encourages the submission of briefs longer than 10 pages via audio file so that the Court can listen to the arguments. The recordings shall be made in a neutral fashion, citations

need not be read as part of the recording, and each such file shall be served on opposing counsel. Counsel should contact chambers for procedures to submit audio files.

3. The Court will entertain reasonable requests to streamline the case schedule and discovery and encourages the parties to contact the Court (with opposing counsel) when such interaction might help streamline the case.
4. Each party must provide the Court with a courtesy copy of exhibits and exhibit lists.
5. If exhibits are voluminous, provide only specific pages that pertain to the issues on the two courtesy copies. The original exhibits that are agreed upon by the parties should be ready to be tendered to the Clerk of the Court at the beginning of trial. Other exhibits that are admitted during trial should be tendered to the Clerk of the Court immediately after admission.
6. The parties are to label all proposed exhibits with the following information on each label:

Designation of Plaintiffs or Defendant's Exhibit Number and Case Number.

SO ORDERED and SIGNED this ____ day of _____, 2020.

ALAN ALBRIGHT
UNITED STATES DISTRICT JUDGE

**U.S. District Court [LIVE]
Western District of Texas (Midland)
CIVIL DOCKET FOR CASE #: 7:18-cv-00078-ADA**

True Chemical Solutions, LLC v. Performance Chemical
Company
Assigned to: Judge Alan D Albright
Cause: 28:1338 Patent Infringement

Date Filed: 04/27/2018
Jury Demand: Both
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

True Chemical Solutions, LLC

represented by **Jaison C. John**
John & Morgan, P.C.
6464 Savoy Dr.
Suite 600
Houston, TX 77036
713-934-4069
Fax: 713-934-7011
Email: jjohn@johnandmorganlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Miles R. Nelson
Shafer, Davis, O'Leary & Stoker
700 North Grant, Ste. 201
P.O. Drawer 1552
Odessa, TX 79760-1552
(432) 332-0893
Fax: (432) 335-8329
Email: mnelson@shaferfirm.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Terry D. Morgan
John and Morgan, P.C.
6464 Savoy Drive, Suite 600
Houston, TX 77036
713-934-4050
Fax: 713-934-7011
Email: tmorgan@johnandmorganlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

James W. Essman
Shafer Davis O'Leary & Stoker
P.O. Drawer 1552
Odessa, TX 79760-1552
(432)332-0893
Fax: 432/333-5002
Email: jessman@shaferfirm.com
ATTORNEY TO BE NOTICED

V.

Defendant

Performance Chemical Company

represented by **Daniel Scardino**
Scardino LLP
501 Congress Avenue
Suite 150
Austin, TX 78701
(512) 443-1667
Fax: (512) 487-7606

Email: daniel@scardinollp.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Lisa K. Hooper
Lynch, Chappell & Alsup, P.C.
300 N. Marienfeld, Suite 700
Midland, TX 79701
(432)683-3351
Fax: (432)683-2587
Email: lhooper@lcalawfirm.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Randall L. Rouse
Lynch, Chappell & Alsup
300 North Marienfeld
Suite 700
Midland, TX 79701
(432) 683-3351
Fax: 432/683-2587
Email: rrouse@lcalawfirm.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Kenneth Matticks
Lynch Chappell & Alsup PC
300 N. Marienfeld
Suite 700
Midland, TX 79701
(432) 683-3351
Email: kmatticks@lcalawfirm.com
ATTORNEY TO BE NOTICED

Counter Plaintiff

Performance Chemical Company

represented by **Daniel Scardino**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Lisa K. Hooper
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Randall L. Rouse
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Kenneth Matticks
(See above for address)
ATTORNEY TO BE NOTICED

V.

Counter Defendant

True Chemical Solutions, LLC

represented by **Jaison C. John**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Miles R. Nelson SMIC Ex. 1026
IPR2020-01003
Page 11 of 12

(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Terry D. Morgan
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

James W. Essman
(See above for address)
ATTORNEY TO BE NOTICED

| Date Filed | # | Docket Text |
|------------|-----------|---|
| 08/12/2019 | <u>63</u> | Minute Entry for proceedings held before Judge Alan D Albright: Markman Hearing held on 8/12/2019 (Minute entry documents are not available electronically.). (Court Reporter Kristie Davis.)(se) (Entered: 08/12/2019) |