

EXHIBIT A

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

**ROCKSTAR CONSORTIUM US LP
AND NETSTAR TECHNOLOGIES
LLC**

Plaintiffs,

v.

GOOGLE INC.

Defendant.

Case No. 2:13-cv-00893-JRG-RSP

JURY TRIAL DEMANDED

[PROPOSED] DISCOVERY ORDER

After a review of the pleaded claims and defenses in this action, in furtherance of the management of the Court's docket under Federal Rule of Civil Procedure 16, and after receiving the input of the parties to this action, it is ORDERED AS FOLLOWS:

- 1. Initial Disclosures.** In lieu of the disclosures required by Federal Rule of Civil Procedure 26(a)(1), each party shall disclose to every other party the following information:
 - (a) the correct names of the parties to the lawsuit;
 - (b) the name, address, and telephone number of any potential parties;
 - (c) the legal theories and, in general, the factual bases of the disclosing party's claims or defenses (the disclosing party need not marshal all evidence that may be offered at trial);
 - (d) the name, address, and telephone number of persons having knowledge of relevant facts, a brief statement of each identified person's connection with

the case, and a brief, fair summary of the substance of the information known by any such person;

- (e) any indemnity and insuring agreements under which any person or entity carrying on an insurance business may be liable to satisfy part or all of a judgment entered in this action or to indemnify or reimburse for payments made to satisfy the judgment;
- (f) any settlement agreements relevant to the subject matter of this action; and
- (g) any statement of any party to the litigation.

2. Disclosure of Expert Testimony. A party must disclose to the other parties the identity of any witness it may use at trial to present evidence under Federal Rule of Evidence 702, 703 or 705, and:

- (a) if the witness is one retained or specially employed to provide expert testimony in the case or one whose duties as the party's employee regularly involve giving expert testimony, provide the disclosures required by Federal Rule of Civil Procedure 26(a)(2)(B) and Local Rule CV-26; and
- (b) for all other such witnesses, provide the disclosure required by Federal Rule of Civil Procedure 26(a)(2)(C).

3. Additional Disclosures. Without awaiting a discovery request,¹ each party will make the following disclosures to every other party:

- (a) provide the disclosures required by the Patent Rules for the Eastern District of Texas with the following modifications to P.R. 3-1 and P.R. 3-3:

¹ The Court anticipates that this disclosure requirement will obviate the need for requests for production.

P.R. 3-1(g): If a party claiming patent infringement asserts that a claim element is a software limitation, the party need not comply with P.R. 3-1 for those claim elements until **[Plaintiff’s proposal: 45 days after the final source code for each Accused Instrumentality and the final source code for each component that interfaces with each Accused Instrumentality is produced by the opposing party]** **[Defendant’s proposal: 30 days after source code for each Accused Instrumentality is produced by the opposing party].**¹ Thereafter, the party claiming patent infringement shall identify, on an element-by-element basis for each asserted claim, what source code of each Accused Instrumentality allegedly satisfies the software limitations of the asserted claim elements.

P.R. 3-3(e): If a party claiming patent infringement exercises the provisions of P.R. 3-1(g), the party opposing a

¹ **Plaintiff’s position:** Plaintiffs’ addition to this portion of the Court’s Model Order seeks to address an inevitable issue, not create a dispute as Defendant suggests. In most patent cases, the first source code review is never the last. More often than not, the source code provided is incomplete or missing relevant portions, and a second, third, or fourth source code review is necessary. Also common is a dispute about whether certain source code should be produced in the first place. The Model Order can be read to impose an obligation to supplement P.R. 3-1 contentions after the first production of source code, regardless of completeness or sufficiency. Plaintiffs’ proposal addresses this issue. Plaintiffs’ proposal ties P.R. 3-1(g) disclosures to final production of source code. Contrary to Defendant’s argument, this is not vague and ambiguous. The parties will necessarily have to agree on what constitutes a final production of source code. Plaintiffs are amenable to alternative solutions to this inevitable issue. For example, during the meet and confer process, Plaintiffs proposed having the ability to supplement the contentions after each source code production. Defendant declined, and argues that this alternative allows Plaintiff to supplement its infringement contentions whenever it wants. To the contrary, it allows supplementation in response to piecemeal production of source code. Defendant should not be allowed to trickle out source code and expect a deluge of contentions in return. Plaintiffs’ proposal strikes a reasonable balance.

Defendant’s position: Defendant’s proposal comes from the Court’s model order. Particularly in this case, there is not sufficient time in the case schedule to give Plaintiff more than 30 days to supplement its infringement contentions. Further, the language Plaintiff proposes adding to the Court’s model order—“final source code for each component that interfaces with each Accused Instrumentality”—is vague and ambiguous. This ambiguity will likely cause problems and disputes later in the case because the parties may not agree on what is the “final” source code production. For example, to avoid motion practice, Defendant may agree to make certain source code requested by Plaintiff available for inspection, even if Defendant disagrees that it is relevant, but that should not give Plaintiff an excuse to delay in finalizing its infringement contentions. Similarly, Plaintiff should not be permitted to delay in finalizing its infringement contentions by making piecemeal requests for additional source code throughout discovery. To avoid disputes and unnecessary delay, the Court should adopt the language in its model order.

Plaintiff argues that it proposed an alternative solution that gives it the ability to supplement its contentions after each source code production. But, Plaintiff’s proposed alternative would allow Plaintiff to supplement its infringement contentions whenever it wants, contrary to the purpose of the Patent Local Rules. Further, the Patent Local Rules already allow for supplementation “upon a showing of good cause,” and that should be sufficient to address Plaintiff’s concerns. Patent Local Rule 3-6(b).

claim of patent infringement may serve, not later than **[Plaintiff's proposal: 45] [Defendant's proposal: 30]**² days after receipt of a P.R. 3-1(g) disclosure, supplemental "Invalidity Contentions" that amend only those claim elements identified as software limitations by the party claiming patent infringement.

- (b) produce or permit the inspection of all documents, electronically stored information, and tangible things in the possession, custody, or control of the party that are relevant to the pleaded claims or defenses involved in this action, except to the extent these disclosures are affected by the time limits set forth in the Patent Rules for the Eastern District of Texas; and
- (c) provide a complete computation of any category of damages claimed by any party to the action, and produce or permit the inspection of documents or other evidentiary material on which such computation is based, including materials bearing on the nature and extent of injuries suffered, except that the disclosure of the computation of damages may be deferred until the time for Expert Disclosures if a party will rely on a damages expert.

- 4. **Protective Orders.** The Court will enter the parties' Agreed Protective Order.
- 5. **Discovery Limitations.** The discovery in this cause is limited to the disclosures described in Paragraphs 1-3 together with: 30 interrogatories per side, 40 requests for admissions per side (excluding requests solely for authentication of documents, which shall be unlimited), the fact depositions of the parties and third parties, as

² **Plaintiffs' position:** Plaintiffs propose the same length of time for Defendant to serve supplemental invalidity contentions. If this Court orders Plaintiff to supplement infringement contentions within 30 days; Plaintiffs respectfully request the same deadline be applied to Defendant's invalidity contentions.

Defendant's position: Defendant's proposal again comes from Court's model order. Defendant is not opposed, however, to having 45 days to supplement its invalidity contentions, as Plaintiff proposes, provided that Plaintiff supplements its infringement contentions within 30 days as set forth in P.R. 3-1(g).

many document subpoenas of third parties as needed, five expert witnesses per side, and **[Plaintiff's proposal: 175] [Defendant's proposal: 115]**³ hours per side for depositions of fact witnesses. Depositions of expert witnesses shall not count toward this **[Plaintiff's proposal: 175] [Defendant's proposal: 115]**-hour limit. "Side" means a party or a group of parties with a common interest. All individual depositions shall be limited to seven hours in accordance with the Federal Rules of Civil Procedure except that:

³ **Plaintiff's position:** As Defendant has repeatedly reminded this Court, this will be a "complex" and "lengthy" case. That is not disputed. The seven patents-in-suit go to the heart of Defendant's business. This complexity will necessitate extensive discovery, especially deposition discovery. Accordingly, Plaintiffs propose 175 hours of deposition time, excluding expert depositions. All non-expert depositions, including those of Rule 30(b)(6) witnesses and non-party witnesses, will count against that limit. Defendant's proposed 115 hours undoubtedly will be less than necessary to depose the necessary fact witnesses, Rule 30(b)(6) witnesses, and non-party witnesses in this case. Defendant looks to the Federal Rules' deposition limits, but even this Court's Model Order goes beyond those limits and recognizes that the Federal Rules are not a one-size fits all set of guidelines. In the alternative, Plaintiffs' would be amenable to 115 hours of deposition time provided that Rule 30(b)(6) depositions as well as expert depositions are not counted in that total. Plaintiffs' proposals are in line with deposition hour limits imposed by this Court in other cases. *See, e.g., SimpleAir, Inc. v. Microsoft Corp. et al.*, 2:11-cv-416 (E.D. Tex. Aug. 6, 2012)(allowing 120 hours *exclusive* of Rule 30(b)(6) and expert depositions); *U.S. Ethernet Innovations, LLC v. Acer, Inc. et al.*, 6:09-cv-448 (E.D. Tex. Apr. 7, 2010) (allowing 150 hours total).

Defendant's position: Defendant proposes 115 hours for all fact depositions. The Federal Rules of Civil Procedure limit parties to 10 depositions per side, and each deposition may not exceed 7 hours on the record. Fed. R. Civ. P. 30. Nothing in the Court's Model Order suggests that this is not the default rule. Defendant's proposal expands the limit in the Federal Rules in a reasonable manner. In contrast, Plaintiff's proposal is that it be permitted to take over 100 more deposition hours than permitted by the Rules, or up to 25 depositions. There is no basis for such a large number of depositions in this case. Plaintiff cites *SimpleAir, Inc. v. Microsoft Corp. et al.*, 2:11-cv-416 (E.D. Tex. Aug. 6, 2012) and *U.S. Ethernet Innovations, LLC v. Acer, Inc. et al.*, 6:09-cv-448 (E.D. Tex. Apr. 7, 2010) but omits that both were multi-defendant cases. Thus, there were likely witnesses from the many different defendants that needed to be deposed, warranting a higher number of deposition hours. That is not the case here. 115 hours is more than enough time for Plaintiff to take discovery from the single defendant in this case, Google, and third parties. Plaintiff's alternative proposal of 115 hours for fact depositions, excluding Rule 30(b)(6) depositions should also be rejected. It is not at all reasonable to allow the parties to take an unlimited number of depositions simply by serving 30(b)(6) notice after 30(b)(6) notice. Indeed, even in *SimpleAir*, cited by Plaintiff, 30(b)(6) depositions were not unlimited. Plaintiff provides no support for its alternative request for unlimited 30(b)(6) depositions.

(a) [**Defendant's proposal:** The parties may take up to 14 hours of deposition testimony of any named inventor, and those hours may be taken on separate, non-contiguous days]⁴;

(b) Depositions of experts shall be limited to one day of seven (7) hours, unless the parties agree to additional time or the expert has provided more than one expert report, in which case the expert may be deposed for an additional consecutive day of seven (7) hours for a total of up to fourteen (14) hours.

Any party may later move to modify these limitations for good cause, and the party's ability to do so shall not be prejudiced in any way by this paragraph.

⁴ **Plaintiff's position:** Plaintiffs oppose Defendant's attempt to have two bites at the inventor apple. Like the deposition of any fact witness, the depositions of the inventors should be limited to a single day of no more than seven hours. Defendant's only justification for the second day is to be able to depose the inventors before and after claim construction, presumably to use inventor testimony as part of its claim construction argument. This is not a viable reason. As the Federal Circuit has warned, "This Court has often repeated that inventor testimony is of little probative value for purposes of claim construction." *E-Pass Tech., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1370 n.5 (Fed. Cir. 2003) (emphasis added); *see also Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1346 (Fed. Cir. 2008) ("The testimony of an inventor cannot be relied on to change the meaning of the claims. In particular, we have explained that the subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of the claim.") (emphasis added). Because whatever the inventors say has little bearing on claim construction, Defendant will not be prejudiced by taking inventor depositions after the deadline for substantially complete document production (or whenever it wishes). This subsection (a) should be struck.

Defendant's position: Defendant proposes that the limit on the number of hours per deposition be expanded such that the parties may take up to 14 hours of deposition testimony of any named inventor, and that those hours may be taken on separate, non-contiguous days. This is not an attempt by Defendant to have two bites at the apple with the inventors, as Plaintiff argues. Rather, it is a necessary result of the case schedule. Defendant's proposal will allow the parties to depose the named inventors prior to claim construction briefing, which will occur in September 2014. An inventor is "a competent witness to explain the invention and what was intended to be conveyed by the specification and covered by the claims." *Voice Tech. Group, Inc. v. VMC Sys., Inc.*, 164 F.3d 605, 615 (Fed. Cir. 1999). Plaintiff's document production, however, may not be complete by that time. The proposed Docket Control Order does not require the parties' document productions to be "substantially complete" until September 16, 2014. Thus, it is possible that Plaintiff will produce documents relevant to the inventors' depositions after claim construction and then Defendant would not have the opportunity to depose them on those documents. The inventors are likely to be the centerpiece of Plaintiff's case, they are consultants for Plaintiff, and there is no prejudice to Plaintiff in allowing the parties to depose them twice. Defendant's proposal addresses this concern. Plaintiff's refusal to agree to this provision presents Defendant with a Hobson's choice.

The parties recognize that this proceeding is still in a preliminary stage and that discovery has not yet commenced. The limitations contained in this order may be modified by agreement of the parties subject to approval of the court or by motion to the court with the burden on the party seeking modification. Accordingly, the parties agree to meet and confer in good faith about reasonable adjustments to any of the preceding limits as discovery progresses. Furthermore, to the extent the parties are unable to reach agreement, any party may later move to modify these limitations for good cause.

- 6. Privileged Information.** There is no duty to disclose privileged documents or information. However, the parties are directed to meet and confer concerning privileged documents or information after the Status Conference. By the deadline set in the Docket Control Order, the parties shall exchange privilege logs identifying the documents or information and the basis for any disputed claim of privilege in a manner that, without revealing information itself privileged or protected, will enable the other parties to assess the applicability of the privilege or protection. Any party may move the Court for an order compelling the production of any documents or information identified on any other party's privilege log. If such a motion is made, the party asserting privilege shall respond to the motion within the time period provided by Local Rule CV-7. The party asserting privilege shall then file with the Court within 30 days of the filing of the motion to compel any proof in the form of declarations or affidavits to support their assertions of privilege, along with the documents over which privilege is asserted for *in camera* inspection.

- 7. Signature.** The disclosures required by this Order shall be made in writing and signed by the party or counsel and shall constitute a certification that, to the best of the signer's knowledge, information and belief, such disclosure is complete and correct as of the time it is made. If feasible, counsel shall meet to exchange disclosures required by this Order; otherwise, such disclosures shall be served as provided by Federal Rule of Civil Procedure 5. The parties shall promptly file a notice with the Court that the disclosures required under this Order have taken place.
- 8. Duty to Supplement.** After disclosure is made pursuant to this Order, each party is under a duty to supplement or correct its disclosures **immediately** if the party obtains information on the basis of which it knows that the information disclosed was either incomplete or incorrect when made, or is no longer complete or true.
- 9. Discovery Disputes.**

 - (a) Except in cases involving claims of privilege, any party entitled to receive disclosures ("Requesting Party") may, after the deadline for making disclosures, serve upon a party required to make disclosures ("Responding Party") a written statement, in letter form or otherwise, of any reason why the Requesting Party believes that the Responding Party's disclosures are insufficient. The written statement shall list, by category, the items the Requesting Party contends should be produced. The parties shall promptly meet and confer. If the parties are unable to resolve their dispute, then the Responding Party shall, within 14 days after service of the written statement upon it, serve upon the Requesting Party a written statement, in

letter form or otherwise, which identifies (1) the requested items that will be disclosed, if any, and (2) the reasons why any requested items will not be disclosed. The Requesting Party may thereafter file a motion to compel.

(b) In addition to the requirements of Local Rule CV-7(h) and (i), an opposed discovery-related motion must include a certification that an **in-person** conference involving lead and local counsel for all parties to the discovery dispute was held.

(c) Counsel are directed to contact the chambers of the undersigned for any “hot-line” disputes before contacting the Discovery Hotline provided by Local Rule CV-26(e). If the undersigned is not available, the parties shall proceed in accordance with Local Rule CV-26(e).

10. No Excuses. A party is not excused from the requirements of this Discovery Order because it has not fully completed its investigation of the case, or because it challenges the sufficiency of another party’s disclosures, or because another party has not made its disclosures. Absent court order to the contrary, a party is not excused from disclosure because there are pending motions to dismiss, to remand or to change venue.

11. Filings. Only upon request from chambers shall counsel submit to the court courtesy copies of any filings.

13. Proposed Stipulations by the Parties Regarding Discovery.

(a) Production Of Materials Obtained Via Third-Party Subpoena. A party who serves a subpoena in this matter on a third party shall provide a copy to the other party. Subject to the provisions in the parties’ Agreement Regarding

the Format of Document Production, a party who receives documents from a third party pursuant to a subpoena will reproduce those documents to the other party as soon as practicable and at most, no later than three (3) business days after receiving the documents. Where reproduction of documents within three (3) business days is not possible, the party who received the documents will provide prompt notice to the other party and will work in good faith to resolve the issue on a case-by-case basis.

- (b) Post-Complaint Privileged Documents. No party shall be required to identify on their respective privilege log any document or communication dated on or after the filing of the lawsuit, which absent this provision, the party would have been obligated to so identify on said privilege log. The parties shall exchange their respective privilege document logs at a time to be agreed upon by the parties following the production of documents.
- (c) Limitations on Expert Discovery. Testifying experts shall not be subject to discovery of any draft of their reports in this case and such draft reports, notes, outlines, or any other writings leading up to an issued report(s) in this litigation are exempt from discovery. In addition, all communications between counsel for a party and that party's testifying expert, and all materials generated by a testifying expert with respect to that person's work, are exempt from discovery unless they relate to the expert's compensation or identify facts, data or assumptions relied upon by the expert in forming any opinions in this litigation and such information is not already disclosed in the expert's report.

- (d) Electronic Service. The parties agree to serve documents, pleadings, correspondence and other items electronically in lieu of service by U.S. Mail or otherwise, to at least each attorney listed on the docket as attorney of record for the opposing party or to at least the attorneys on an agreed-upon service list. If the document, pleading, correspondence or other item is too large to be served electronically, then a cover letter of other similar notification shall be served electronically and the document, pleading, correspondence or other item shall be served by Federal Express for next day delivery.
- (e) Electronically-Stored Information. Discovery and production of electronically-stored information (ESI), including email and electronic files, shall be governed by the parties' Agreement Regarding the Format of Document Productions.

14. Courtesy Paper Copies.

Papers copies will not be accepted by this Court unless specifically requested.

15. Hearing Notebooks.

Hearing notebooks are no longer required or requested. However, the Court may request hearing notebooks in specific instances.

16. Depositions of Trial Witnesses.

Any party that has made a good faith effort to depose witnesses according to this Order may depose any trial witness not previously deposed in this litigation.⁵

⁵ **Plaintiff's position:** Plaintiffs propose this addition to address the issue of previously undeposed trial witnesses. This provision allows either party to depose a potential trial witness if that party has made reasonable, good faith use of its deposition time during discovery. Even with the increased limits, a witness may go undeposed if, for example, it is unclear whether that witness will appear at trial. If a party proceeds in

17. **Witness Disclosures.**

Any witness (including any fact witness) who intends to offer testimony under Fed. R. Evid. 702, 703, or 705 pursuant to Federal Rule of Civil Procedure 26(a)(2)(B) or (C) and Local Rule CV-26 must submit the required disclosures. A witness that has not submitted the required disclosure may not testify at trial.⁶

IT IS SO ORDERED.

good faith and does not “lay behind the log” regarding depositions, that party may take the deposition of a potential trial witness. Defendant’s claim that this will result in open-ended fact discovery. Not so. This reciprocal provision tries to address the potential for “surprise” witnesses. Moreover, Defendant has given no reason why this provision (or the one below) cannot be in the Discovery Order.

Defendant’s position: Defendant does not agree to Plaintiff’s proposed language. This issue is not covered in the Court’s Model Discovery Order and, thus, since the parties do not agree, this provision has no place in the Discovery Order. Defendant advised Plaintiff that it is willing to discuss this issue further, but is not in a position to agree at this time. Defendant is concerned that this essentially grants the parties open-ended fact discovery. There should not be a blanket order, allowing for depositions on the eve of trial, which is what Plaintiff proposes. Defendant advised Plaintiff that it is willing to address issues regarding trial witnesses not deposed on a case-by-case basis, but does not think it is appropriate to enter into a blanket agreement like that proposed by Plaintiff here.

⁶ **Plaintiff’s position:** Plaintiffs propose to make it explicitly clear that witnesses purporting to offer testimony under FRE 702, 703, or 705 must provide the necessary disclosures or be precluded from testifying regarding same at trial. Plaintiffs do not, as Defendant suggest, seek to deviate from the Federal Rules. Plaintiffs seek to ensure that any witness purporting to provide technical opinions – of which there will undoubtedly be plenty – must provide the report or risk being prevented from offering that testimony at trial.

Defendant’s position: Defendant explained to Plaintiff that the Federal Rules of Evidence and Federal Rules of Civil Procedure govern when opinion testimony is admissible and whether expert reports are required. There is no need for a provision on this issue in the Discovery Order. Indeed, Plaintiff has never explained to Defendant *why* this needs to be included in the Discovery Order. It is not clear if Plaintiff is trying to deviate from the Federal Rules or simply repeat them. In any event, given that this provision is not required to be in the Discovery Order and the parties do not agree, it has no place in the Discovery Order.