

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

CARDWARE INC.,

Plaintiff

v.

SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendants.

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Civil Action No. 2:22-cv-00141-JRG-RSP

JURY TRIAL DEMANDED

**JOINT MOTION FOR ENTRY OF ORDER FOCUSING CLAIMS AND PRIOR ART TO
REDUCE COSTS**

Plaintiff CardWare Inc. (“CardWare”) and Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) have conferred regarding a proposed Order Focusing Claims and Prior Art to Reduce Costs and hereby submit such a proposed Order, attached hereto. The attached proposed Order raises one dispute between the parties in Paragraph 3, regarding the number of days between the Final Election of Asserted Claims and the service of opening expert reports.

CardWare’s Position

This is a 5-patent case, currently involving more than 100 asserted claims and approximately the same number of prior art references. Accordingly, the parties have agreed to narrow the scope of the case as it approaches trial. To this end, the parties have agreed to most of the Court’s Model Order Focusing Patent Claims and Prior Art to Reduce Costs, including the two-stage approach to narrowing the number of asserted claims and prior art references. The only dispute is the date by which the parties are to complete that process.

Paragraph 3 of the Model Order provides that “No later than 28 days before the service of expert reports by the party with the burden of proof on an issue, the patent claimant shall serve a Final Election of Asserted Claims, which shall identify no more than five asserted claims per patent from among the ten previously identified claims and no more than a total of 16 claims.” CardWare has no issue with the limit on number of claims in this paragraph, but seeks to modify the “28 day” window to “14 days” in view of the overall schedule in the case. Specifically, the close of expert discovery in this case is set for September 14, 2023 while the close of fact discovery is September 11, 2023. If the Paragraph 3 window is 28 days, then CardWare would have to pick its final election of 16 claims by August 17, 2023, which is 25 days before the close of fact discovery and just 9 days after the Markman hearing. Given that many of Samsung’s technical witnesses are in Korea and the fact that CardWare may need to take technical discovery after the Markman hearing, CardWare is concerned about its ability to pick its final 16 claims by an August 17 deadline. Accordingly, CardWare seeks an extra two weeks before picking its final 16 claims (until Aug. 31, 2023), which is still two weeks before the due date for opening expert reports. Of course, CardWare has no problem giving Samsung an extra 14 days to narrow its list of asserted prior art references.

Samsung’s Position

Samsung proposes adopting the 28 day provision of Paragraph 3 of the Model Order without modification. CardWare’s proposed modification to Paragraph 3 of the Model Order unfairly shortens the time for Samsung to focus its expert reports on the 16 claims that will actually go to trial out of the 32 claims CardWare will elect in the first round of narrowing. CardWare proposes leaving Samsung just 14 days after receiving that Final Election of Claims to prepare invalidity expert reports, which would increase costs and burden to Samsung and its

experts because preparation of those reports would necessarily need to start earlier than 14 days before they are due, and as such that work would have to address all 32 claims. CardWare's proposal to give Samsung an extra 14 days to elect its prior art is a hollow offer, because Samsung's invalidity expert reports are due 14 days before CardWare's proposed extended deadline. Given that CardWare currently knows it wishes to take depositions of technical witnesses, including witnesses in Korea, and fact discovery has been open for several months, its delay in prosecuting its case cannot be an excuse to prejudice Samsung. Further, CardWare's justification that it "may need to take technical discovery after the Markman hearing" is undercut by the fact that after CardWare's first reduction of claims on June 2, 2023, only a single disputed claim construction remains (all other issues for *Markman* concern indefiniteness). CardWare can readily ask any technical witnesses about the competing constructions for a single claim term before the *Markman* hearing.

DATED: June 6, 2023

Respectfully submitted,

By: /s/ Allan M. Soobert

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CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that on counsel for Defendants complied with the meet and confer requirement in Local Rule CV-7(i). This motion is unopposed.

/s/ Allan M. Soobert

Allan M. Soobert

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was filed electronically in compliance with Local Rule CV-5 on June 6, 2023. As of this date, all counsel of record had consented to electronic service and are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5(a)(3)(A).

/s/ Allan M. Soobert

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