

FILED UNDER SEAL PURSUANT TO PROTECTIVE ORDER

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

ACORN SEMI, LLC,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA,
INC., SAMSUNG SEMICONDUCTOR,
INC., and SAMSUNG AUSTIN
SEMICONDUCTOR, LLC,

Defendants.

Civil Action No. 2:19-cv-000347-JRG

JURY TRIAL DEMANDED

FILED UNDER SEAL

PROPOSED JOINT PRE-TRIAL ORDER

The Pre-trial Conference is scheduled for March 11, 2021, pursuant to the Court’s Sixth Amended Docket Control Order (Dkt. No. 155), its February 18, 2021 Notice Resetting Hearing and Rule 16 of the Federal Rules of Civil Procedure. The following parties submit this Joint Pre-trial Order: Plaintiff Acorn Semi, LLC (“Plaintiff” or “Acorn”) and Defendants Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor, LLC (collectively, “Defendants” or “Samsung”).

A. COUNSEL FOR THE PARTIES

1. Plaintiff:

John C. Hueston (CA SBN 164921) (to be admitted *pro hac vice*)
Douglas J. Dixon (CA SBN 275389)
Christina V. Rayburn (CA SBN 255467)
Neil G. Anderson (CA SBN 307668)
Daniel Vinson (CA SBN 308797)
Julia Haines (CA SBN 321607)
Justin J. Sorensen (CA SBN 324817)
Abigail Majane (CA SBN 330347)
HUESTON HENNIGAN LLP
620 Newport Center Dr., Suite 1300
Newport Beach, CA 92660
Telephone: (949) 226-6741
jhueston@hueston.com
ddixon@hueston.com
crayburn@hueston.com
nanderson@hueston.com
dvinson@hueston.com
jhaines@hueston.com
jsorensen@hueston.com
amajane@hueston.com

Robert W. Weber (SBN 21044800)
5505 Plaza Drive
Texarkana, Texas 75503
Telephone: (903) 223-5656
bweber@smithweber.com

2. Defendants:

Melissa R. Smith

State Bar No. 24001351
GILLAM & SMITH, LLP
303 South Washington Avenue
Marshall, Texas 75670
Telephone: (903) 934-8450
Facsimile: (903) 934-9257
Email: melissa@gillamsmithlaw.com

Mark Fowler (pro hac vice)
Alan Limbach (pro hac vice)
Aaron Wainscoat (pro hac vice)
Erik R. Fuehrer (admitted 5/24/12)
Carrie Williamson (pro hac vice)
Asa Wynn Grant (pro hac vice)
DLA PIPER LLP (US)
2000 University Avenue
East Palo Alto, CA 94303-2215
Telephone: (650) 833-2000
Facsimile: (650) 833-2001
mark.fowler@us.dlapiper.com
alan.limbach@us.dlapiper.com
aaron.wainscoat@us.dlapiper.com
erik.fuehrer@us.dlapiper.com
carrie.williamson@us.dlapiper.com
asa.wynn-grant@us.dlapiper.com

Joel Chao-lee Lin (pro hac vice)
DLA Piper LLP (US)
1251 Avenue of the Americas
27th Floor
New York, NY 10020-1104
Telephone: (212) 335-4500
Facsimile: (212) 335-4501

David R. Knudson (pro hac vice)
DLA PIPER LLP (US)
401 B Street
Suite 1700
San Diego, CA 92101-4297
Telephone: (619) 699-2700
Facsimile: (619) 699-2701
david.knudson@us.dlapiper.com

John M. Guaragna Texas Bar No. 24043308
DLA PIPER LLP (US)
401 Congress Avenue, Suite 2500

Austin, TX 78701-3799
Telephone: (512) 457-7125
Facsimile: (512) 457-7001
john.guaragna@us.dlapiper.com

Jackob Ben-Ezra
DLA PIPER LLP (US)
1000 Louisiana Street
Suite 2800
Houston, TX 77002-5005
Telephone: (713) 425-8400
Facsimile: (713) 425-8401
jackob.ben-ezra@us.dlapiper.com

Robert Groselak (pro hac vice)
DLA Piper LLP (US)
444 West Lake Street, Suite 900
Chicago, IL 60606-0089
Telephone: (312) 368-4000
Facsimile: (312) 236-7516

Ruffin B. Cordell TX Bar No. 04820550
Michael J. McKeon DC Bar No. 459780
Lauren A. Degnan DC Bar No. 452421
Daniel A. Tishman DC Bar No. 1013923
FISH & RICHARDSON P.C.
1000 Maine Ave SW
Suite 1000
Washington, DC 20024
Phone: (202) 783-5070
Fax: (202) 783-2331
cordell@fr.com
mckeon@fr.com
LAD@fr.com
tishman@fr.com

Francis J. Albert (pro hac vice)
FISH & RICHARDSON P.C.
12860 El Camino Real, Suite 400
San Diego, CA 92130
Tel: 858-678-5070
Fax: 858-678-5099
albert@fr.com

B. STATEMENT OF JURISDICTION

This is a civil action arising under the Patent Laws of the United States, 35 U.S.C. § 101, *et seq.* The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338(a). For the purposes of this action, the parties do not contest that this Court has personal jurisdiction over all parties. Likewise, the parties do not contest that venue is proper in the United States District Court for the Eastern District of Texas, Marshall Division.

C. NATURE OF THE ACTION

Acorn’s Statement

Acorn owns several patents that claim a critical innovation in the semiconductor industry related to reducing resistance in a transistor, and thereby increasing the performance of modern electrical devices. Four of those patents are asserted in this lawsuit: U.S. Patent No. 8,766,336 (the “’336 Patent”); U.S. Patent No. 9,461,167 (the “’167 Patent”); U.S. Patent No. 9,905,691 (the “’691 Patent”); and U.S. Patent No. 10,090,395 (the “’395 Patent”) (together, the Asserted Patents).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. In this matter, Acorn asserts that Samsung infringes Claims 13, 77, and 80 of the ’336 Patent, Claims 1, 6, and 16 of the ’167 Patent, Claims 6, 8, 10, 12, and 19 of the ’691 Patent, and Claims 17, 20, 23, 25, and 26 of the ’395 Patent (together, the “Asserted Claims”). Samsung’s infringement of the Asserted Claims has been and continues to be willful. Acorn is entitled to injunctive relief, including a permanent injunction against

Samsung's infringing activities, and money damages in the amount of a reasonable royalty. Because of Samsung's willful infringement and egregious misconduct (including throughout this litigation), Acorn is also entitled to enhanced damages and attorneys' fees and costs under 35 U.S.C. § 284 and 285.

Relating to validity, Samsung is limited in this matter to challenging only the validity of *some* of the claims of the Asserted Patents, and only those under an enablement argument pursuant to 35 U.S.C. § 112. Samsung's enablement argument is without merit.¹

Samsung's Statement

Acorn's claims are without merit. In its Complaint against Defendants, Acorn alleged infringement of U.S. Patent Nos. 7,084,423, 8,766,366, 9,209,261, 9,461,167, 9,905,691 and 10,090,395. The '423 patent is no longer at issue in the case because the Court found the sole asserted independent claim, claim 62, indefinite, also eliminating asserted claims 63, 64, and 66 via dependency. Dkt. Nos. 85, 133. Acorn's experts did not offer any infringement or damages opinions as to the '261 patent. The remaining asserted patents therefore are the '366, '167, '691, and '395 patents (the "Patents-in-Suit"). Samsung does not infringe any asserted claim of the Patents-in-Suit, either literally or under the doctrine of equivalents.² Moreover, Samsung's alleged infringement of the Patents-in-Suit has not been, and is not, willful. Further, the

¹ In a footnote to Samsung's Statement, and elsewhere throughout this document, Samsung purports to reserve its right to raise additional invalidity defenses, depending on whether the Court allows Acorn to formally serve two supplemental reports of its infringement expert, Dr. Edwin Piner. Acorn objects to that reservation of rights. Nothing in either of Dr. Piner's supplemental expert reports warrants Samsung raising new invalidity defenses at this late date.

² Acorn does not assert infringement under the doctrine of equivalents for any asserted patent.

following claims of the asserted patents are invalid for failure to comply with the requirements of 35 U.S.C. § 112: all asserted claims of the '336 and '167 patents.^{3 4}

Acorn is not entitled to any relief, including injunctive relief or monetary damages.

Acorn is not entitled to enhanced damages, nor is this an exceptional case entitling Acorn to its attorneys' fees and costs. Samsung, however, is entitled to recovery of its attorneys' fees under 35 U.S.C. § 285, as well as its costs, and any other relief the Court deems appropriate.

D. CONTENTIONS OF THE PARTIES

The parties set forth below a summary of their contentions for trial. The parties do not necessarily agree with each other's summaries and contentions and reserve all objections.

Acorn's Statement of its Contentions

Acorn provides the following statement of contentions without waiver of any affirmative claim pled, any response given during discovery, or any opinion expressed by Acorn's experts. By providing these contentions, Acorn does not waive any of its motions *in limine*, motions for summary judgment, *Daubert* motions, or motions to strike.

1. Acorn contends that Samsung literally and directly infringes, under 35 U.S.C. § 271(a), each of the Asserted Claims by manufacturing, selling, offering to sell, and/or importing into the U.S.: wafers and processors having transistors manufactured according to Samsung's 14 nm FinFET process technology, as well as any products that incorporate such processors ("Accused Products").

³ Per the Notices Regarding Samsung *Inter Partes* Review Institution and Prior Art Stipulations (Dkt. Nos. 177 and 237), because the PTAB instituted Samsung IPR petitions against every Patent-in-Suit, Samsung has withdrawn in this district court action all invalidity grounds under sections 102 and 103 on the basis of prior art patents or printed publications.

⁴ Subject to the Court's ruling on Acorn's motions for leave to file supplemental expert reports of its technical expert, Dr. Piner, Samsung reserves the right to raise additional defenses.

2. Acorn contends that Samsung's infringement of the Asserted Claims has been and continues to be willful.

3. Acorn contends that it has been damaged by Samsung's infringement of the Asserted Claims and is entitled to a reasonable royalty under 35 U.S.C. § 284.

4. Acorn contends that it is entitled to enhanced damages and reasonable costs.

5. Acorn contends that this is an exceptional case entitling it to attorneys' fees under 35 U.S.C. § 285.

6. Acorn contends that it is the valid, presumptive assignee of the patents containing the Asserted Claims and all rights thereto, including the right to claim damages for past infringement.

7. Acorn contends that the invention date of each of the Asserted Claims is at least June 28, 2001.

8. Acorn contends that each of the Asserted Claims is not invalid for any reason, including under 35 U.S.C. § 112.

9. Acorn contends that each of the Asserted Claims is not unenforceable for any reason, including any legal or equitable theory asserted by Samsung.

10. Acorn contends that its damages for Samsung's past infringement of the Asserted Claims are not barred or limited by 35 U.S.C. §§ 286 or 287.

11. Acorn contends that Samsung is not entitled to any finding in their favor that this case is exceptional, or to any damages, attorneys' fees, or costs.

12. Acorn contends that it is entitled to supplemental damages for the period between the jury verdict and the entry of final judgment, as well as pre-judgment and post-judgment interest.

13. Acorn seeks all equitable relief from the Court that is just and proper, including but not limited to injunctive relief under 35 U.S.C. § 283.

Samsung's Statement of its Contentions

Samsung provides the following statement of contentions without waiver of any affirmative defense pled, any response given during discovery, or any opinion expressed by Samsung's experts. By providing these contentions, Samsung does not waive any of its motions *in limine*, motions for summary judgment, *Daubert* motions, or motions to strike.

1. Samsung contends that it has not infringed any asserted claim of the Patents-in-Suit.

2. Samsung contends that the following claims of the Patents-in-Suit are invalid based on lack of enablement under 35 U.S.C. § 112: all asserted claims of the '336 and '167 patents.

3. Samsung denies that Acorn has been damaged by Samsung's alleged infringement, and contends Acorn is not entitled to any monetary damages under any theory, including a reasonable royalty theory, nor is Acorn entitled to pre- and/or post-judgment interest.

4. Samsung contends that its alleged infringement of the Patents-in-Suit has not been, and is not, willful.

5. Samsung contends Acorn is not entitled to enhanced damages under 35 U.S.C. § 284.

6. Samsung contends Acorn is not entitled to any attorneys' fees or costs under 35 U.S.C. § 285.

7. Samsung contends Acorn is not entitled to injunctive relief, or any relief whatsoever.

8. Samsung is entitled to its costs, expenses, and attorneys' fees under 35 U.S.C. § 285, and any other relief the Court deems appropriate.⁵

E. STIPULATIONS AND UNCONTESTED FACTS

Stipulations

1. The parties will continue to meet and confer to attempt to resolve their objections to deposition designations and exhibits, and to identify additional potential stipulations, including stipulations related to the admissibility of exhibits, and will supplement these stipulations to the extent that additional stipulations are agreed by the parties.

2. The parties agree that any date listed on the exhibit list is not evidence of nor an admission of the date of the document, and that failing to list a date is neither evidence of nor an admission of whether the document is dated. The parties agree that any description of a document on an exhibit list is provided for convenience only and shall not be used as an admission or otherwise as evidence regarding that document.

3. Legible photocopies of the Patents-in-Suit and their USPTO file history may be offered as evidence in lieu of certified copies thereof.

4. Legible photocopies of documents may be offered and received in evidence in lieu of originals thereof, subject to all foundational requirements and other objections that might be made to the admissibility of originals.

5. The parties agree that the demonstrative exhibits the parties intend to use at trial do not need to be included on their respective lists of trial exhibits attached as Exhibits F and G to this Order. The parties otherwise reserve all rights to object to any demonstrative exhibits.

⁵ Subject to the Court's ruling on Acorn's motions for leave to file supplemental expert reports of its technical expert, Dr. Piner, Samsung reserves the right to raise additional defenses.

6. For purposes of Federal Rule of Evidence 901, the parties agree that all documents produced by Acorn and appearing on their face to have originated from, or have been kept in the ordinary course of business by Acorn, are authentic. The parties otherwise reserve all rights with respect to the admissibility of any such documents.

7. For purposes of Federal Rule of Evidence 901, the parties agree that all documents produced by Samsung and appearing on their face to have originated from, or have been kept in the ordinary course of business by Samsung, are authentic. The parties otherwise reserve all rights with respect to the admissibility of any such documents.

8. The parties agree that written answers to interrogatories and requests for admission or stipulations agreed to in this case shall be treated by the opposing party as having been given under oath, whether or not the answers were signed or verified by the party making them.

Uncontested Facts

1. Acorn filed its Complaint in this action on October 23, 2019.

2. Acorn is a limited liability company organized and existing under the laws of the State of Delaware, with a registered place of business at 445 Cambridge Avenue, Suite A, Palo Alto, CA 94306.

3. Acorn is a wholly-owned subsidiary of Acorn Technologies, Inc.

4. Samsung Electronics Co., Ltd. is a Korean company that manufactures consumer electronics, and manufactures semiconductor wafers having transistors made in accordance with Samsung's 14nm FinFET process technology.

5. Samsung Electronics America, Inc. is a New York corporation that maintains places of business within Texas and sells consumer electronics products that include processors having

transistors made in accordance with Samsung's 14nm FinFET process technology.

6. Samsung Semiconductor, Inc. is a California corporation that does business in Texas and sells products that include processors having transistors made in accordance with Samsung's 14nm FinFET process technology.

7. Samsung Austin Semiconductor, LLC is a Delaware company with its principal place of business in Texas and manufactures and sells semiconductor wafers having transistors made in accordance with Samsung's 14nm FinFET process technology.

8. Samsung Austin Semiconductor, LLC is a wholly owned subsidiary of Samsung Semiconductor, Inc.

9. Samsung Semiconductor, Inc. is a wholly owned subsidiary of Samsung Electronics America, Inc.

F. CONTESTED ISSUES OF FACT AND LAW

The parties identify the following issues of fact and law that remain to be litigated. The parties reserve the right to identify additional factual or legal issues that may arise, including issues raised in any motions *in limine*.⁶

Acorn's Statement of Contested Issues of Fact and Law

1. Whether Samsung has infringed claims 13, 77, and 80 of the '336 Patent.
2. Whether Samsung has infringed claims 1, 6, and 16 of the '167 Patent.
3. Whether Samsung has infringed claims 6, 8, 10, 12, and 19 of the '691 Patent.
4. Whether Samsung infringed claims 17, 20, 23, 25, and 26 of the '395 Patent.

⁶ Subject to the Court's ruling on Acorn's motions for leave to file supplemental expert reports of its technical expert, Dr. Piner, Samsung reserves the right to raise additional defenses. Acorn objects to this purported reservation of rights.

5. Whether Samsung has willfully infringed any of the Asserted Claims.
6. Whether Claims 1, 6, 16 of the '167 Patent, or Claims 13, 77, and 80 of the '336 Patent are invalid for lack of enablement.
7. Whether Acorn is entitled to the damages it seeks, including for past infringement, prejudgment interest, and costs.
8. Whether Acorn is entitled to enhanced damages under 35 U.S.C. § 284 and, if so, the amount of enhancement.
9. Whether this case is exceptional under 35 U.S.C. § 285 and, if so, whether Acorn or Samsung is entitled to attorneys' fees or costs.
10. Whether Acorn is entitled to a permanent injunction in the event that Samsung is found to infringe any of the Patents-in-Suit.
11. Whether the terms in the asserted patents should be construed (and/or held not indefinite) as Acorn argued in this case, including in Dkt. 58, Dkt. 62, Dkt. 65, Dkt. 71, Dkt. 75, Dkt. 93, and Dkt. 101.

Samsung's Statement of Contested Issues of Fact and Law

1. Whether Acorn has proven by a preponderance of the evidence that Samsung has directly and literally infringed the asserted claims of the '336 patent.
2. Whether Acorn has proven by a preponderance of the evidence that any infringement by Samsung of the '336 patent was willful.
3. Whether Acorn has proven by a preponderance of the evidence that Samsung has directly and literally infringed the asserted claims of the '167 patent.
4. Whether Acorn has proven by a preponderance of the evidence that any infringement by Samsung of the '167 patent was willful.
5. Whether Acorn has proven by a preponderance of the evidence that Samsung has

directly and literally infringed the asserted claims of the '691 patent.

6. Whether Acorn has proven by a preponderance of the evidence that any infringement by Samsung of the '691 patent was willful.

7. Whether Acorn has proven by a preponderance of the evidence that Samsung has directly and literally infringed the asserted claims of the '395 patent.

8. Whether Acorn has proven by a preponderance of the evidence that any infringement by Samsung of the '395 patent was willful.

9. Whether Samsung has proven by clear and convincing evidence that the asserted claims of the '336 patent are invalid based on lack of enablement under 35 U.S.C. § 112.

10. Whether Samsung has proven by clear and convincing evidence that the asserted claims of the '167 patent are invalid based on lack of enablement under 35 U.S.C. § 112.

11. Whether Acorn is entitled to a reasonable royalty under 35 U.S.C. § 284 for Samsung's alleged infringement of the asserted claims of the '336 patent, and if proven, the total amount of such royalty.

12. Whether Acorn is entitled to a reasonable royalty under 35 U.S.C. § 284 for Samsung's alleged infringement of the asserted claims of the '167 patent, and if proven, the total amount of such royalty.

13. Whether Acorn is entitled to a reasonable royalty under 35 U.S.C. § 284 for Samsung's alleged infringement of the asserted claims of the '691 patent, and if proven, the total amount of such royalty

14. Whether Acorn is entitled to a reasonable royalty under 35 U.S.C. § 284 for Samsung's alleged infringement of the asserted claims of the '395 patent, and if proven, the total amount of such royalty.

15. Whether Acorn has proven that it is entitled to enhanced damages under 35 U.S.C. § 284 in the event that Samsung is found to have willfully infringed the asserted claims of the '336 patent, and, if so, in what amount.

16. Whether Acorn has proven that it is entitled to enhanced damages under 35 U.S.C. § 284 in the event that Samsung is found to have willfully infringed the asserted claims of the '167 patent, and, if so, in what amount.

17. Whether Acorn has proven that it is entitled to enhanced damages under 35 U.S.C. § 284 in the event that Samsung is found to have willfully infringed the asserted claims of the '691 patent, and, if so, in what amount.

18. Whether Acorn has proven that it is entitled to enhanced damages under 35 U.S.C. § 284 in the event that Samsung is found to have willfully infringed the asserted claims of the '395 patent, and, if so, in what amount.

19. If infringement of any of the Patents-in-Suit is found, whether Acorn is entitled to pre- or post-judgment interest, and if so, the total amount of such interest.

20. Whether Acorn is entitled to its costs, expenses and attorneys' fees pursuant to 35 U.S.C. § 285.

21. Whether Samsung is entitled to its costs, expenses and attorneys' fees pursuant to 35 U.S.C. § 285.

22. Whether Acorn is entitled to a permanent injunction in the event that Samsung is found to infringe any of the Patents-in-Suit.

23. Whether the terms in the asserted patents should be construed as Samsung offered in this case, including in Dkt. 58, Dkt. 62, Dkt. 69, Dkt. 75, Dkt. 92, and Dkt. 99.

G. LIST OF WITNESSES

1. Acorn's witness list is attached as Exhibit A. Samsung's objections to Acorn's

witness list are included in Exhibit B.

2. Samsung's witness list is attached hereto as Exhibit C. Acorn's objections to Samsung's witness list is attached as Exhibit D.

3. Acorn's list of deposition designations and Samsung's counter-designations are appended hereto as Exhibit E.

4. Samsung's list of deposition designations and Acorn's counter-designations are appended hereto as Exhibit F.

H. LIST OF EXHIBITS

1. Acorn's exhibit list is appended hereto as Exhibit G.

2. Samsung's exhibit list is appended hereto as Exhibit H.

I. LIST OF ANY PENDING MOTIONS

Acorn's Pending Motions

Dkt. No.	Date	Title
147	December 28, 2020	Acorn's Motion to Strike and Exclude Portions of Rebuttal Expert Report of Dr. Jeffrey Bokor
148	December 28, 2020	Acorn's Motion to Strike and Exclude Portions of Opening Expert Report of Dr. Jeffrey Bokor
149	December 28, 2020	Acorn's Motion for Partial Summary Judgment re Patent Validity
152	December 28, 2020	Acorn's Motion to Strike and Exclude Portions of the Expert Report of Paul Meyer
206	January 21, 2021	Acorn's Motion for Leave to Supplement the Expert Report of Dr. Edwin Piner
234	February 8, 2021	Acorn's Opposed Motions <i>in Limine</i>
243	February 11, 2021	Acorn's Motion for Leave to Supplement the Expert Report of Dr. Edwin Piner to Address Late-Produced Documents and Related Testimony
259	February 19, 2021	Acorn's Motion for Leave to File Notice of Supplemental Facts in Support of Plaintiff's Motion to Strike and Exclude Portions of the Expert Report of Paul Meyer
261	February 19, 2021	Acorn's Motion for Leave to File Notice of Supplemental Facts in Support of Plaintiff's Opposition to Defendants' Motion to Exclude Mr. Dell's Opinions and Testimony

Samsung's Pending Motions

Dkt. No.	Date	Title
145	December 28, 2020	Defendants' Motion to Exclude Expert Testimony of Dr. Edwin Piner
146	December 28, 2020	Defendants' Motion for Partial Summary Judgment of No Willful Infringement
153	December 28, 2020	Defendants' Motion to Exclude Mr. Dell's Opinions and Testimony Under Fed. R. Evid. 702 and <i>Daubert</i>
156	December 28, 2020	Defendants' Motion to Exclude Expert Testimony of Dr. Kelin Kuhn and Strike Portions of Dr. Kuhn's Expert Report
232	February 8, 2021	Defendants' Opposed Motions <i>In Limine</i>
238	February 10, 2021	Defendants' Renewed Motion to Stay Pending Determination of <i>Inter Partes</i> Review of the Patents-in-Suit

J. PROBABLE LENGTH OF TRIAL

The probable length of trial is 5 days. The parties request 14 hours per side for direct, cross, and rebuttal examination. The parties further request 30 minutes per side for *voir dire*. Acom requests 45 minutes per side for opening statements and 60 minutes per side for closing arguments. Samsung requests 30 minutes per side for opening statements and 45 minutes per side for closing arguments.

K. MANAGEMENT CONFERENCE LIMITATIONS

None.

L. TRIAL MANAGEMENT PROCEDURES STIPULATIONS

1. With respect to opening statements, by no later than 12:00 p.m. Central Time on the calendar day before the opening statements, the parties shall exchange by email (a) lists of any non-pre-admitted exhibits for which there are pending objections remaining, and (b) electronic copies of any demonstrative exhibits that they intend to use in their respective opening statements. By no later than 3:00 p.m. Central Time that same day, the receiving party shall notify the other party of any objections to the exhibits and demonstrative

exhibits. By no later than 5:00 p.m. Central Time that same day, the parties shall meet and confer to resolve any objections. Any transcripts of testimony (excluding testimony given during this trial) must have been previously designated by the parties and cleared of outstanding objections before being shown to the jury during opening or on direct examination. A party may not show deposition testimony of their own employees or witnesses during opening statements.

2. If a party no longer expects to call a witness identified on the “will call” list, or if a party expects to call live a witness on the “may call” witness list, that party shall provide the other side notice of the change as soon as possible, but in no event shall notice of the change be provided less than 2 calendar days before the witness may be called.

3. A party shall identify the witnesses it intends to call to testify, whether it intends to do so in person or by deposition, and the order in which they are to be called, by 6:30 p.m. Central Time two calendar days before they are to be called (*e.g.*, witnesses for Monday morning will be disclosed on Saturday evening), except for Acorn's rebuttal witnesses, whom Acorn will identify one calendar day before they are to be called.

4. A party shall provide demonstrative exhibits to be used in connection with direct examination by 6:30 p.m. Central Time the calendar day before their intended use (*e.g.*, exhibits for Monday morning will be disclosed on Sunday evening). Any objections will be provided no later than 8:30 p.m. Central Time that same day, and the parties shall promptly meet and confer by 9:00 p.m. Central Time on any such objections. If parties cannot resolve objections, they will submit the issue to the Court by 10:00 pm that same day, with responsive submissions to the Court by 7:00 am the following day. The opening and responsive submissions to the Court shall be limited to one page (double spaced) per disputed demonstrative exhibit.

5. A party shall identify trial exhibits to be used in connection with direct examination

by noon Central Time the calendar day before their intended use (*e.g.*, exhibits for Monday morning will be disclosed at noon on Sunday). Any objections will be provided no later than 6:30 p.m. Central Time that same day, and the parties shall promptly meet and confer by 9:00 p.m. Central Time on any such objections. If parties cannot resolve objections, the objecting party will submit the issue to the Court by 10:00 pm that same day, with responsive submissions to the Court by 7:00 am the following day. The parties shall each be limited to one page (double spaced) per disputed trial exhibit.

6. The parties' exhibit lists include exhibits that may not necessarily be introduced into evidence. Each party reserves the right to add additional exhibits to its exhibit list, for good cause shown, by agreement of the parties, or as ordered by the Court. A party's failure to introduce any exhibit appearing on its list shall not be commented on during trial.

7. Subject to other provisions of this Order, no party may offer as evidence an exhibit not present on its exhibit list absent court order or agreement of the parties, except for purposes of impeachment or rehabilitation, if otherwise competent for such purposes.

8. If a party provides a binder of exhibits to a witness prior to examination, the party will provide one copy to the other party.

9. The party seeking to use a demonstrative exhibit shall provide a color (if the original exhibit is in color) representation of the demonstrative in PDF format to the other side in accordance with the schedule set forth above. For videos or animations, the party seeking to use the demonstrative exhibit shall provide it to the other side in digital interactive format, including, as applicable, flash format, PPT format, MPG, or other video format. A party's demonstrative will not be used, in whole or in part, by the other party prior to being used by the disclosing party.

10. The parties agree that there is no exchange of demonstratives to be used for cross

or redirect examination of witnesses.

11. With respect to non-documentary demonstratives, such as physical exhibits, that the parties plan to use at trial for use during direct examination—but not for cross-examination:

- a. 6:30 p.m. Central Time two calendar days before anticipated use: Parties shall identify and make available the non-documentary demonstratives/physical exhibits.
- b. 12:00 p.m. Central Time one calendar day before anticipated use: Parties shall exchange objections to non-documentary demonstratives/physical exhibits.
- c. 9:00 p.m. Central Time one calendar day before anticipated use: Parties shall discuss outstanding objections during demonstrative meet and confer.
- d. If parties cannot resolve objections, the objecting party will submit the issue to the Court by 10:00 pm that same day, with responsive submissions to the Court by 7:00 am the following day. The parties shall each be limited to one page (double spaced) per disputed non-documentary demonstrative or live product demonstration.

Non-documentary demonstratives will not be used by the other party prior to being used by the disclosing party.

12. The parties agree that notice of a party's intended use of enlargements of trial exhibits and/or deposition testimony and of ballooning, excerption, highlighting, etc. of such exhibits and/or deposition testimony need not be given (and need not be exchanged as a demonstrative exhibit), as long as the party has identified its intent to use the trial exhibit and/or deposition testimony according to the provisions of this Order, and such ballooning, excerption, highlighting, etc., accurately reflects the content of the exhibit. The parties further agree that the above notice provisions concerning demonstrative exhibits do not apply to demonstrative exhibits created in the courtroom during live testimony or that were previously shown to the jury, or that

are ballooning, excerption, highlighting, etc. of witness testimony, attorney statements, or attorney argument generated during the trial before the jury.

13. The parties request that during the pendency of the trial, counsel be permitted to move, and the Court admit if appropriate, evidence following use of the evidence, to the extent not admitted at the time of use. To clarify, this provision shall apply only to trial exhibits, properly admissible under the Federal Rules of Evidence, and about which a witness has referenced and specifically provided testimony.

14. Upon the end of all parties' presentation of evidence, the parties will make available to the jury copies of all exhibits in evidence, but not any demonstrative exhibits, unless admitted into evidence.

15. With respect to witnesses who may be called to testify by deposition, the parties have designated specific page and line numbers of deposition testimony that they may read or play back during the respective parties' case-in-chief. New materials may not be added without good cause or the other party's agreement. All irrelevant and redundant material such as objections and colloquy between counsel will be eliminated when the deposition is read or viewed at trial to the extent feasible.

16. Any deposition testimony may be used at trial for the purpose of impeachment, regardless of whether a party identified that testimony on its list of deposition designations, if the testimony is otherwise admissible for such purpose.

17. In order to reduce the number of duplicative exhibits, where a deposition excerpt refers to a document by exhibit number and that identical document was also marked as a different exhibit number, a party may substitute one exhibit for another.

18. With respect to a witness being offered by deposition:

- a. 6:30 p.m. Central Time two calendar days before the deposition testimony is expected to be read or played in Court: Calling party shall provide a list of final deposition designations (from the previously designated testimony) it intends to introduce. The calling party shall identify the specific pages and lines of transcript from the witness's deposition that it proposes to read or play during trial.
- b. 6:30 p.m. Central Time one calendar day before the deposition testimony is expected to be read or played in Court: Receiving party shall identify for each such witness its objections to the identified testimony and counter-designations as set forth in this Pre-Trial Order and any objections to the identified trial exhibits.
- c. 8:30 p.m. Central Time one calendar day before the deposition testimony is expected to be read or played in Court: Calling party identifies objections to counter-designations. Parties promptly meet and confer.
- d. 10:30 p.m. one calendar day before the deposition testimony is expected to be read or played in Court: If parties cannot resolve objections, they will submit jointly the issue to Court, including highlighted copies of the disputed materials and an itemized list of the remaining objections along with a brief indication (*i.e.*, no more than one sentence per objection) of the basis for the objection and the offering party's response to it. (The objecting party will provide the initial draft of the joint submission at 9:30 pm and the opposing party will respond with any edits by 10:00 pm, at which point the parties will promptly meet and confer to finalize the joint submission.)
- e. The party that seeks to play the deposition testimony must also provide the opposing party, by 6:30 p.m. CT the day before the deposition testimony is to be

played, a workable copy of the actual recording to be played, including all designations and counter-designations and a timed report of the deposition designations.

19. If a party designates deposition testimony, and the other party counter-designates, then the designations and counter-designations will be read or played together in chronological order. Regardless of whether deposition testimony is read or played by video, the time available for each party's trial presentation shall be reduced by the length of its designations and counter-designations.

20. The parties agree to exchange lists of "Admitted Exhibits" by 10:00 p.m. the night before the lists are to be submitted to the Court. The parties shall exchange the list of exhibit numbers to be read into the record by 6:30 p.m. CT the day the exhibits are used at trial. The parties shall exchange objections to the list of exhibit numbers to be read into the record by 8:30 p.m. CT that night, and the parties will meet and confer to resolve objections by 9:00 p.m. CT.

21. Any documents, deposition transcripts, or portions thereof, or other items, not specifically identified herein or offered into evidence, may still be used at trial for purposes of cross-examination, impeachment, or rehabilitation, if otherwise competent for such purposes, and may be admitted into evidence consistent with the requirements of the Federal Rules of Evidence.

22. Samsung expects that one or more witnesses will testify live in a language other than English. The parties will continue to discuss who the trial interpreter will be and will discuss sharing the costs of interpreter services.

23. By 9:00 p.m. Central Time two calendar days before it intends to rest its case in chief, the resting party shall give the other party notice of its intention to rest so that the parties have an opportunity to comply with the other provisions of this order.

24. The parties understand that the Court prefers to present a tutorial video from the Federal Judicial Center regarding the U.S. Patent Office to the members of the jury as part of its preliminary instructions to the jury.

25. The jurors shall be permitted to take handwritten notes during the presentations of the parties.

26. Fact witnesses will be sequestered so that they cannot hear other witnesses' testimony, pursuant to Federal Rule of Evidence 615.

M. AGREED MOTIONS IN LIMINE (Proposed)

Acorn and Samsung jointly request the Court order the following agreed motions *in limine*:

1. References to any pretrial rulings (or lack of ruling) by the Court on *Daubert* or summary judgment motions.

The parties will not present any evidence, testimony or argument regarding any pretrial ruling (or lack of ruling) from the Court on the parties' *Daubert* or summary judgment motions in this case.

2. References to the geographic origin of counsel, the size of the parties' law firms, or the number of attorneys representing the parties.

The parties will not refer to the other party's counsel's geographic origin or make disparaging statements about the number of attorneys representing the other party or the size of any firm representing the parties. This includes phrases like "army of lawyers," "giant global law firm," "California lawyers," "Los Angeles lawyers," "San Francisco lawyers," "Silicon Valley lawyers," and similar terms to describe the geographic origin or size of counsel.

3. References, evidence, testimony (including expert testimony), arguments, or inquiries attempting to elicit testimony, regarding whether any testimony or opinions of either party's experts have been excluded or found unreliable in this lawsuit.

The parties will not make any references, introduce any evidence, testimony (including expert testimony) or arguments, or make inquiries attempting to elicit testimony, regarding whether any testimony or opinions of either of the party's experts have been excluded or found unreliable in this lawsuit.

27. Preclude any comment, argument, testimony, or evidence stating, suggesting, or implying that the conduct of the other party is responsible or the cause for (1) the timing of the trial as it relates to the specific date of the trial, (2) jurors having to come to the courthouse and/or serve on the jury during the pandemic, (3) any risk to health or safety of the jurors, their families, members of the community, or anyone else, or (4) any burden or inconvenience to the jurors as it relates to the pandemic or the specific date of the trial.

The parties will not make any comment, argument, testimony, or evidence stating, suggesting, or implying that the conduct of the other party is responsible for or the cause of (1) the timing of the trial as it relates to the specific date of the trial, (2) jurors having to come to the courthouse or serve on the jury during the pandemic, (3) any risk to health or safety of the jurors, their families, members of the community, or anyone else, or (4) any burden or inconvenience to the jurors as it relates to the pandemic or the specific date of the trial.

4. Preclude evidence or argument regarding choice to testify in native language.

The parties will not make any references or introduce any evidence, testimony (including expert testimony), arguments, or inquiries attempting to elicit testimony regarding any witness's choice to testify in his or her native language, unless the witness elects to testify at trial in a language different from that which the witness elected in a past deposition in this case.

5. That Defendants cannot infringe simply because they have their own patents or because the accused products practice other patents.

The parties will not make any comment, argument, testimony, or evidence stating, suggesting, or implying that Defendants cannot infringe simply because they have their own patents or because the accused products practice other patents.

6. Advice of counsel defense.

The parties will not make any comment, argument, testimony, or evidence stating, suggesting, or implying that Samsung obtained or did not obtain an opinion of counsel.

7. Fee arrangements with counsel or with litigation funding entities.

The parties will not make any comment, argument, testimony, or evidence stating, suggesting, or implying that either party has entered into any fee arrangements with counsel or with any litigation funding entities.

8. Any attempt to disparage the USPTO.

The parties will not make any comment, argument, testimony, or evidence disparaging the United States Patent and Trademark Office.

9. Reference to Acorn Semi, LLC or Acorn Technologies, Inc. as a “patent troll,” “troll,” “NPE” or “non-practicing entity” or similarly disparaging labels or characterizations.

The parties will not make any reference to Acorn Semi, LLC or Acorn Technologies, Inc. as a “patent troll,” “troll,” “NPE” or “non-practicing entity” or make use of any similarly disparaging labels or characterizations. The parties may reference or introduce testimony that Acorn does not make/sell products that practice the patents or otherwise make/sell any products.

10. Testimony from Sungsam Lee or Bo Yun Tu.

The parties will not present any testimony from Sungsam Lee or Bo Yun Tu.

11. Derogatory, pejorative or prejudicial statements about (a) Samsung being a foreign or Korean company; (b) any suggestion that COVID originated from an Asian country; or (c) any suggestion that Samsung sets transfer pricing to defraud any tax authority.

The parties will not make any pejorative references or pejorative statements about Samsung being a foreign or Korean company. The parties further will not make any suggestion that COVID originated from an Asian country. The parties nevertheless can factually describe Samsung as a foreign company or a Korean company. The parties will not make any argument or suggestion that Samsung sets transfer pricing to defraud any tax authority.

N. ADDITIONAL MATTERS

Acorn's Position

1. On February 11, 2021, Samsung for the first time asked Acorn to narrow its asserted claims in this matter, and asked that Acorn do so by March 5, 2021. Consistent with the DCO, *see* Dkt. 155 at 4, Acorn has done so herein. Consistent with this District's Model Order Focusing Patent Claims and Prior Art to Reduce Costs, Acorn has narrowed its claims to no more than 16 asserted claims, comprising no more than 5 from each Asserted Patent. Acorn does not believe Acorn should be required to identify fewer claims than set forth by the Model Order.

2. Acorn does not believe that a trial continuance is warranted or necessary at this time. Nor does Acorn believe that it is appropriate for Samsung to shield its witnesses from trial and the jury for COVID-related reasons.

3. Acorn believes that, given the Stipulation that Samsung entered into with the PTAB, *see* Dkt. 177-1, Samsung should not be allowed to pursue in this case an identical enablement argument regarding the "low contact resistance" claims to the one it has already raised—and is pursuing—before the PTAB. Samsung stipulated not to pursue in this case "any invalidity ground . . . that was raised or that could have been reasonably raised in an IPR." *Id.* Acorn's position is that the enablement challenge is more appropriate in this case, but believes that, given its Stipulation, Samsung should be forced to make an election.

4. Plaintiff's technical expert, Dr. Kelin Kuhn, [REDACTED]

[REDACTED], Acorn requests the Court's leave to allow Ms. Kuhn to testify by videotaped trial deposition. Acorn and Ms. Kuhn will make a final decision on this matter no later than three weeks before jury selection (March 15, 2021), and will present Ms. Kuhn for her trial deposition more than one week before jury selection.

Samsung's Position

1. Certain of the parties' witnesses may not be able to attend trial in person in April as a result of being in COVID-19 high-risk categories for severe illness or residing with someone who is in a high-risk category. To allow each side to fully and fairly present their case, Samsung respectfully requests that the Court either (1) continue the trial to a date when it is safe for all witnesses to travel and testify live in person, or (2) allow the parties to present at trial testimony by any such witnesses via trial deposition taken in advance of trial. As this situation is rapidly evolving, Samsung will continue to discuss with Acorn how both parties should handle requests for trial depositions.

2. Acorn's characterization that the PTAB is pursuing an "identical" enablement argument is incorrect. The PTAB is analyzing whether the claims are valid under Section 102 and 103, not under Section 112. Samsung's lack of enablement defense challenges Acorn's claims under Section 112, and Samsung's stipulation did not address Section 112 defenses.

3. Samsung requested that Acorn reduce their asserted claims from 73 to 10 claims by March 5, 2021. On February 17, Acorn reduced its asserted claims to 16 claims and has indicated it will not provide any further reduction. To the extent Acorn later drops claims,

Samsung reserves the right to seek relief from the court.

4. Samsung's position is that to each party may use an exhibit that is listed on the other party's exhibit list, to the same effect as though it were listed on its own exhibit list, subject to evidentiary objections. Any exhibit, once admitted, may be used equally by each party. The listing of an exhibit by a party on its exhibit list does not waive any evidentiary or other objections to that exhibit should the opposing party attempt to offer it into evidence. Acorn refuses to agree.

O. CERTIFICATIONS

The undersigned counsel for each of the parties in this action does hereby certify and acknowledge the following:

- a. Full and complete disclosure has been made in accordance with the Federal Rules of Civil Procedure, the Local Rules, and the Court's orders;
- b. Discovery limitations set forth in the Federal Rules of Civil Procedure, the Local Rules, and the Court's orders have been complied with;
- c. Each exhibit in the List of Exhibits herein:
 - i. is in existence;
 - ii. is numbered; and
 - iii. has been disclosed and shown to opposing counsel.

Approved as to form and substance:

Attorneys for Plaintiff(s): /s/ Christina V. Rayburn

Attorneys for Defendant(s): /s/ Carrie Williamson

This Joint Pre-Trial Order is hereby approved this ____ day of _____, 2021.

RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE

Dated: February 19, 2021

/s/ Carrie Williamson
Melissa R. Smith
State Bar No. 24001351
GILLAM & SMITH, LLP
303 South Washington Avenue
Marshall, Texas 75670
Telephone: (903) 934-8450
Facsimile: (903) 934-9257
Email: melissa@gillamsmithlaw.com

Mark Fowler (pro hac vice)
Alan Limbach (pro hac vice)
Aaron Wainscoat (pro hac vice)
Erik R. Fuehrer (admitted 5/24/12)
Carrie Williamson (pro hac vice)
Asa Wynn Grant (pro hac vice)
DLA PIPER LLP (US)
2000 University Avenue
East Palo Alto, CA 94303-2215
Telephone: (650) 833-2000
Facsimile: (650) 833-2001
mark.fowler@us.dlapiper.com
alan.limbach@us.dlapiper.com
aaron.wainscoat@us.dlapiper.com
erik.fuehrer@us.dlapiper.com
carrie.williamson@us.dlapiper.com
asa.wynn-grant@us.dlapiper.com

Joel Chao-lee Lin (pro hac vice)
DLA Piper LLP (US)
1251 Avenue of the Americas
27th Floor
New York, NY 10020-1104
Telephone: (212) 335-4500
Facsimile: (212) 335-4501

David R. Knudson (pro hac vice)
DLA PIPER LLP (US)
401 B Street
Suite 1700
San Diego, CA 92101-4297
Telephone: (619) 699-2700
Facsimile: (619) 699-2701
david.knudson@us.dlapiper.com

John M. Guaragna Texas Bar No. 24043308
DLA PIPER LLP (US)
401 Congress Avenue, Suite 2500
Austin, TX 78701-3799
Telephone: (512) 457-7125
Facsimile: (512) 457-7001
john.guaragna@us.dlapiper.com

Jackob Ben-Ezra
DLA PIPER LLP (US)
1000 Louisiana Street
Suite 2800
Houston, TX 77002-5005
Telephone: (713) 425-8400
Facsimile: (713) 425-8401
jackob.ben-ezra@us.dlapiper.com

Robert Groselak (pro hac vice)
DLA Piper LLP (US)
444 West Lake Street, Suite 900
Chicago, IL 60606-0089
Telephone: (312) 368-4000
Facsimile: (312) 236-7516

Ruffin B. Cordell TX Bar No. 04820550
Michael J. McKeon DC Bar No. 459780
Lauren A. Degnan DC Bar No. 452421
Daniel A. Tishman DC Bar No. 1013923

FISH & RICHARDSON P.C.
1000 Maine Ave SW
Suite 1000
Washington, DC 20024
Phone: (202) 783-5070
Fax: (202) 783-2331
cordell@fr.com
mckeon@fr.com
LAD@fr.com
tishman@fr.com

Francis J. Albert (pro hac vice)
FISH & RICHARDSON P.C.
12860 El Camino Real, Suite 400
San Diego, CA 92130
Tel: 858-678-5070
Fax: 858-678-5099
albert@fr.com

*ATTORNEYS FOR DEFENDANTS
SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA,
INC., SAMSUNG SEMICONDUCTOR,
INC. and SAMSUNG AUSTIN
SEMICONDUCTOR, LLC.*

/s/ Christina V. Rayburn

John C. Hueston (CA SBN 164921) (to be
admitted *pro hac vice*)

Douglas J. Dixon (CA SBN 275389)

Christina V. Rayburn (CA SBN 255467)

HUESTON HENNIGAN LLP

620 Newport Center Dr., Suite 1300

Newport Beach, CA 92660

Telephone: (949) 226-6741

jhueston@hueston.com

ddixon@hueston.com

crayburn@hueston.com

Robert W. Weber (SBN 21044800)

SMITH WEBER LLP

5505 Plaza Drive

Texarkana, Texas 75503

Telephone: (903) 223-5656

bweber@smithweber.com

Attorneys for Plaintiff Acorn Semi, LLC

CERTIFICATE OF SERVICE

The undersigned certifies the foregoing document and attachments were filed electronically in compliance with Local Rule CV-5(a). Defendants' counsel of record were served with a true and correct copy of the foregoing document by electronic mail on February 19, 2021.

/s/ Christina V. Rayburn _____
Christina V. Rayburn

CERTIFICATE OF AUTHORIZATION TO FILE UNDER SEAL

I hereby certify that the foregoing document is authorized to be filed under seal pursuant to the Protective Order entered in this matter.

/s/ Christina V. Rayburn _____
Christina V. Rayburn

Exhibit A

Redacted in its Entirety

Exhibit B

Redacted in its Entirety

Exhibit C

Redacted in its Entirety

Exhibit D

Redacted in its Entirety

Exhibit E

Redacted in its Entirety

Exhibit F

Redacted in its Entirety

Exhibit G

Redacted in its Entirety

Exhibit H

Redacted in its Entirety