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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

Nikola Corporation, a Delaware
corporation,

Plaintiff,

vs.

Tesla, Inc., a Delaware corporation,

Defendant.

Case No.: 3:18-CV-07460-JD

**JOINT CASE MANAGEMENT
STATEMENT**

Date: April 11, 2019
Time: 10:00 a.m.
Courtroom: 11, 19th Floor
Judge: Honorable James Donato

1 Pursuant to the Order Setting Rule 16 Case Management Conference (Dkt. 80), the
2 Standing Order for All Judges of the Northern District of California, dated January 17, 2017,
3 Local Patent Rule 2-1, and Civil Local Rule 16-9, the parties submit the following Joint Case
4 Management Statement.

5 **1. Jurisdiction and Service.**

6 This case arises under the Patent Act of the United States of America, 35 U.S.C. § 1 *et*
7 *seq.* and the Lanham Act, 15 U.S.C. § 1051 *et seq.* This Court has jurisdiction over the
8 Complaint pursuant to 28 U.S.C. §§ 1331 and 1338.

9 All parties have been served, and neither party is contesting personal jurisdiction or
10 venue.

11 **2. Facts.**

12 **Chronology:** This case involves allegations of design patent, utility patent, and trade
13 dress infringement. Nikola alleges that it designed an alternative fuel semi-truck and filed six
14 design patent applications on 30 December 2015. Nikola alleges that on 1 December 2016, it
15 unveiled its prototype in Salt Lake City to a crowd of 600 journalists. On 30 December 2016,
16 Nikola submitted a utility patent application.

17 On 28 April 2017, Tesla released a teaser photo of its semi-truck design. On 7
18 November 2017, Nikola sent a letter to Tesla concerning Tesla's semi truck and what Nikola
19 claimed to be potential intellectual property infringement. On 16 November 2017, Tesla
20 unveiled its semi-truck in Hawthorne, California.

21 Between February and April 2018, the United States Patent and Trademark Office
22 ("PTO") issued six design patents to Nikola. On 1 May 2018, Nikola filed suit against Tesla
23 for patent infringement of three design patents (U.S. Patent No. D811,944; U.S. Patent No.
24 D811,968; and U.S. Patent No. D816,004, collectively "design patents-in-suit"). On 18
25 September 2018, the PTO issued Nikola a utility patent (U.S. Patent No. 10,077,084, "'084
26 patent"). On 18 October 2018, Nikola filed its Third Amended Complaint alleging that Tesla
27 infringed the design patents-in-suit, the '084 patent, and Nikola's alleged trade dress.
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1 **Factual Issues in Dispute:** At this stage, the parties believe that the principal factual
2 issues in dispute include: one or more facts related to whether Tesla infringes any of Nikola's
3 asserted patents; one or more facts related to whether such patents are valid and enforceable;
4 one or more facts related to whether Nikola has protectable and enforceable trade dress rights
5 and, if so, whether Tesla infringes the alleged trade dress; and one or more facts related to
6 whether Nikola is entitled to damages or any other relief for any alleged infringement by Tesla
7 and, if so, the amount of any such damages.
8

9 This description should not be construed as an admission or adoption by any part of any
10 factual contention alleged by the other party. The parties reserve the right to revise or include
11 any other appropriate issues as they develop or become known to the parties through the course
12 of discovery and investigation.

13 **3. Legal Issues.**

14 Nikola asserts that Tesla infringes the design patents-in-suit, the '084 patent, and certain
15 alleged trade dress in Nikola's Nikola One truck. At this stage, the parties believe that the
16 principal legal issues in dispute include: the proper construction of the asserted claims of the
17 design patents-in-suit and the '084 patent; whether Tesla infringes any of the asserted claims
18 of the design patents-in-suit or the '084 patent; whether any of the asserted claims of the design
19 patents-in-suit or the '084 patent are invalid or unenforceable; whether Nikola's alleged trade
20 dress satisfies the legal requirements for protectable trade dress and, if so, whether Tesla
21 infringes the alleged trade dress; if Tesla is found liable for infringement of any valid and
22 enforceable claim of the design patents-in-suit, the '084 patent, or trade dress, the amount of
23 damages, if any, to which Nikola is entitled from Tesla; and whether either Nikola or Tesla is
24 entitled to attorneys' fees and costs, including pursuant to 35 U.S.C. § 285.

25 These legal issues are not intended to be final or exhaustive, and the parties reserve the
26 right to revise or include any other appropriate issues as they develop or become known to the
27 parties through the course of discovery and investigation.
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1 **4. Motions**

2 Nikola filed its original Complaint in the District of Arizona on May 1, 2018 (Dkt. 1).
3 A first Amended Complaint was filed June 20, 2018 (Dkt. 18). In response, Tesla filed a
4 motion to dismiss Nikola’s design patent claims on 9 July 2018 (Dkt. 26). That motion is fully
5 briefed. (*See* Dkts. 26, 30, 35, 60.) Tesla also filed an Answer (Dkt. 27) to the First Amended
6 Complaint concurrently with its motion to dismiss as required by the District of Arizona’s
7 Mandatory Initial Discovery Pilot program in effect at that time. (*See* Dkt. 8 at ¶ A.5.) After
8 the motion was fully briefed and informing the Court during the Initial Case Management
9 Conference held on August 24, 2018 of a forthcoming utility patent, Nikola filed a Second
10 Amended Complaint on September 26, 2018 (Dkt. 48) to add a utility patent infringement
11 claim and a trade dress claim. Thereafter, Nikola filed a Third Amended Complaint on October
12 18, 2018 (Dkt. 57) with Tesla’s permission. The Third Amended Complaint asserts the same
13 claims as the Second Amended Complaint. Before this case was transferred to this Court, the
14 United States District Court for the District of Arizona ordered the parties to “inform the Court
15 whether the pending Motion to Dismiss (Doc. 26) is moot in light of the pending third amended
16 complaint.” (Dkt. 55.) The parties informed the Court that the Third Amended Complaint left
17 the design patent claims largely unchanged and that the motion to dismiss should be considered
18 against the design patent claims of the Third Amended Complaint. (Dkt. 60.) The parties
19 provided an additional paragraph of argument to address one allegation that Nikola contended
20 affected the motion to dismiss. (*Id.*) In transferring this case from the District of Arizona, the
21 court ordered that “the motion to dismiss shall remain pending upon the transfer of venue.”
22 (Dkt. 69.) The parties agree that the Third Amended Complaint is the operative complaint
23 before this Court, and that Tesla’s motion to dismiss is ripe for decision. The parties also agree
24 that Tesla will answer the Third Amended Complaint after the Court rules on its motion to
25 dismiss. The parties request oral argument on Tesla’s motion to dismiss.
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1 On 27 March 2019, this Court administratively terminated the motion to dismiss in light
2 of Nikola's amendments of the complaint. (Dkt. 84.) The parties understand that the Court
3 will discuss this order at the CMC.

4 *Plaintiff Nikola Corp.:*

5 Nikola anticipates filing the following motions:

- 6 • Motion for Summary Judgment: The motion will address Tesla's affirmative
7 defenses; and
- 8 • Motions to Strike Experts: The motion will address any and all shortcomings in
9 any expert used or report submitted by Tesla.

10 *Defendant Tesla, Inc.:*

11 Tesla may file one or more of the following motions:

- 12 • Motions for Summary Judgment: The motion(s) will address one or more of
13 Tesla's defenses to the patent and trade dress infringement claims, and any other
14 defenses properly considered on summary judgment; and
- 15 • Motions to Strike or Otherwise Disqualify Experts: The motion(s) will address
16 any and all shortcomings in any expert used or report submitted by Nikola.

17 **5. Amendment of Pleadings**

18 *Plaintiff Nikola Corp.:*

19 Nikola may seek leave of Court to amend the pleadings to add additional claims against
20 Tesla based on pending patent applications. Nikola does not expect to add additional parties
21 to the case.

22 *Defendant Tesla, Inc.:*

23 As noted above, Tesla has not yet answered the Third Amended Complaint, which the
24 parties understand to be the operative complaint. Tesla filed an Answer (Dkt. 27) to the First
25 Amended Complaint concurrently with its motion to dismiss as required by the District of
26 Arizona's Mandatory Initial Discovery Pilot program in effect at that time. (See Dkt. 8 at ¶
27 A.5.) On November 1, 2018, the District of Arizona changed its rules, no longer requiring an
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1 Answer to be filed concurrently with a motion to dismiss like Tesla's. In light of the rule
2 change, the parties agreed Tesla did not need to file an Answer to the Third Amended
3 Complaint until its motion to dismiss was ruled on. (Dkt. 63.)

4 Tesla may present additional defenses and/or counterclaims when it answers the Third
5 Amended Complaint. Tesla does not expect to add additional parties to the case.

6 **6. Evidence Preservation.**

7 The parties certify that they have reviewed the Guidelines Relating to the Discovery of
8 Electronically Stored Information ("ESI Guidelines"). The parties have met and conferred
9 regarding evidence preservation, and reasonable and proportionate steps taken to preserve
10 evidence.

11 **7. Disclosures.**

12 The parties served their initial disclosures on August 8, 2018 and produced documents
13 with their initial disclosures pursuant to the District of Arizona's Mandatory Initial Discovery
14 Pilot program.

15 **8. Discovery.**

16 The parties have produced some documents to each other in response to Mandatory
17 Initial Discovery Program in the District of Arizona, but anticipate additional documents being
18 produced. No other discovery has been taken. The parties ask the Court to adopt the discovery
19 limitations that were imposed by the Court in the District of Arizona (Dkt. 39), namely: 25
20 interrogatories, including subparts, 25 requests for production, including subparts, and 25
21 requests for admission, including subparts.

22 The parties agree that each side be allowed 10 depositions, with no deposition lasting
23 more than 7 hours. The parties further acknowledge that the Court allows one deposition
24 pursuant to Federal Rule of Civil Procedure 30(b)(6) with no more than 10 topics proposed for
25 the deposition.

26 The court in the District of Arizona entered a largely stipulated Protective Order (Dkt.
27 41), which includes provisions regarding assertions of privilege or work-product. The parties
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1 ask that discovery materials in the case continue to be governed by that already-entered
2 Protective Order (Dkt. 41). With respect to paragraph 13 of the Protective Order (“Filing
3 Protected Material”), the parties understand that this Court’s local rules and this Court’s
4 Standing Order for Civil Cases before Judge James Donato govern the requirements for filing
5 any documents under seal.

6 **E-Discovery Order:** The parties will jointly submit any proposed modifications to the
7 Court’s Standing Order for E-Discovery and Email Discovery in Patent Cases within 30 days
8 after the initial Case Management Conference.

9 **Discovery Plan:** The parties served their initial disclosures on August 8, 2018.

10 *Plaintiff Nikola Corp.:* Nikola will seek discovery from Tesla in the nature of e-mails,
11 business records, marketing plans, design drawings, development documents of the Tesla
12 Semi, technical documents, sales and accounting records, financial projections and other
13 financial documents, either stored electronically or in paper form. Nikola anticipates deposing
14 relevant witnesses from Tesla, Inc. This discovery goes to the central issues of the case,
15 Tesla’s infringement of Nikola’s patents and trade dress, and damages associated with such
16 infringement. As alleged in the complaint, Nikola is seeking its lost profits and disgorgement
17 of Tesla’s profits. As such, the amount in controversy is quite large, estimated to be over \$2
18 billion. Tesla has greater access to this information than Nikola. In sum, the discovery sought
19 by Nikola is proportional to the needs of the case.

20 *Defendant Tesla, Inc.:* Tesla will seek discovery from Nikola in the nature of e-mails,
21 business records, marketing plans and market statements, licensing documents and plans, the
22 conception and reduction to practice of the claimed designs and inventions, the prosecution of
23 the patents-in-suit, design drawings, development documents of the claimed designs, the
24 Nikola One, and other Nikola products, technical documents, sales and accounting records,
25 financial projections and other financial documents, documents that otherwise substantiate
26 Nikola’s damages claims, either stored electronically or in paper form. Tesla anticipates
27 deposing relevant witnesses from Nikola Corporation, including the inventors of the patents-
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1 in-suit. Tesla will also seek discovery from third parties regarding prior art to the design
2 patents-in-suit and the '084 patent, which will include documents and potential testimony.
3 This discovery is relevant and proportional to Nikola's infringement and damages claims, as
4 well as Tesla's defenses, including invalidity. Tesla will also seek additional discovery in
5 connection with any counterclaims it brings.

6 Discovery should be completed by April 10, 2020. The parties do not believe discovery
7 should be in phases or limited to particular issues.

8 The parties do not have any issues about disclosures, discovery, or preservation of
9 electronically stored information.

10 The parties believe that an order under Federal Rule of Evidence 502(d) is warranted
11 in this case, and included it as a term in the Protective Order entered by the District of Arizona
12 (Dkt. 41).

13 The parties do not have any discovery disputes at this time.

14 **9. Class Actions.**

15 This is not a class action case.

16 **10. Related Cases.**

17 There are no related cases pending before other courts or other judges of this Court, or
18 before another court or administrative body.

19 **11. Relief.**

20 *Nikola's Position:* Nikola is seeking damages from Tesla, at a minimum, as a
21 reasonably royalty as determined by applicable law. Alternatively, Nikola may seek its lost
22 profits as calculated under applicable law. Nikola is also seeking disgorgement of Tesla's
23 profits under 35 U.S.C. § 289 or 15 U.S.C. § 1117, as determined by applicable law.
24 Specifically, Nikola will base its damages on the revenue or profit that Tesla has gained or
25 Nikola has lost because of Tesla's infringement of Nikola's design and utility patents and trade
26 dress, minus any costs as allowed under applicable law. Lastly, Nikola will seek its attorney's
27 fees and costs under applicable statutes, and other relief the Court deems appropriate
28

1 *Tesla's Position:* Tesla denies that Nikola is entitled to any of its requested relief. Tesla
2 asserts that Nikola's claims constitute an exceptional case under both 35 U.S.C. § 285 and 15
3 U.S.C. § 1117(a) and, accordingly, requests the Court award Tesla costs and reasonable
4 attorneys' fees incurred in connection with this action under this and any other applicable
5 statutes, and such other relief as the Court deems just and proper.

6 **12. Settlement and ADR.**

7 The parties have complied with ADR Local Rule 3-5 and elected for a private
8 mediation. The parties believe that discovery necessary to position the parties to negotiate a
9 resolution may include discovery related to the development and design of the parties' vehicles
10 and intellectual property, relevant prior art to the design patents-in-suit and the '084 patent,
11 Nikola's infringement contentions, Tesla's invalidity contentions, and certain limited,
12 relevant, financial information of the parties. The parties also believe that resolution of Tesla's
13 motion to dismiss the design patents-in-suit and any claim construction order may help
14 position the parties to negotiate a resolution. The parties are negotiating the mediation process,
15 including the mediator and the timing of the mediation.

16 **13. Consent to Magistrate Judge For All Purposes.**

17 The parties do not consent to have a magistrate judge conduct all further proceedings
18 including trial and entry of judgment.

19 **14. Other References.**

20 This case is not suitable for reference to binding arbitration, a special master, or the
21 Judicial Panel on Multidistrict Litigation.

22 **15. Narrowing of Issues.**

23 The parties believe that issues for trial may be narrowed through motions for summary
24 judgment. The parties do not request bifurcation of any issues, claims, or defenses.

25 **16. Expedited Trial Procedure.**

26 The parties agree that this case is not suitable to be handled under the Expedited Trial
27 Procedure of General Order No. 64.
28

1 DATED: April 4, 2019

By /s/ Amit Makker
Amit Makker

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21 Attorneys for Defendant Tesla, Incorporated

ATTESTATION

I, Amit Makker, am the ECF user whose user *ID* and password authorized the filing of this Document. Under Civil L.R. 5-1(i)(3), I attest that all signatories to this document have concurred in this filing.

Dated: April 4, 2019

/s/ Amit Makker

Amit Makker

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EXHIBIT A

MATTER	DEADLINE	PLAINTIFF(S) REQUEST	DEFENDANT(S) REQUEST
Disclosure of Asserted Claims and Infringement Contentions and Document Production Accompanying Disclosure (N.D. Patent L.R. 3-1(a)-(h) to 3-2(a)-(e)).	Scheduling Conference Date plus fourteen (14) days (N.D. Patent L.R. 3-1 and 3-2).		April 26, 2019
Last Day to File Motions to Add Parties and Amend Pleadings	Scheduling Conference Date plus sixty (60) days.		60 days after Tesla's Answer is due
Disclosure of Invalidity Contentions and Production Accompanying Invalidity Contentions (N.D. Patent L.R. 3-3(a)-(d) to 3-4(a)-(b)).	Deadline for Infringement Contentions Disclosure plus forty-five (45) days (adapted from N.D. Patent L.R. 3-3).		June 14, 2019
Exchange of Proposed Terms for Construction (N.D. Patent L.R. 4- 1(a)-(b)).	Deadline for Invalidity Contentions Disclosure plus fourteen (14) days (N.D. Patent L.R. 4-1).		June 28, 2019
Exchange of Preliminary Claim Constructions and Extrinsic Evidence (N.D. Patent L.R. 4- 2(a)-(c)).	Exchange of Proposed Terms for Construction plus twenty-one (21) days (N.D. Patent L.R. 4-2).		July 19, 2019
Damages Contention	50 days after Invalidity Contentions (N.D. Patent L.R. 3-8)		August 16, 2019
Joint Claim Construction and Prehearing Statement (N.D. Patent L.R. 4-3(a)-(e)).	60 days after Invalidity Contentions.		August 23, 2019
Responsive Damages Contention	30 days after Damages Contention (N.D. Patent L.R. 3-9)		September 20, 2019

1	Completion of Claim Construction Discovery (N.D. Patent L.R. 4-4.)	30 days after Joint Claim Construction and Prehearing Statement	September 23, 2019	
2				
3	Opening Claim Construction Briefs	Deadline for filing of Joint Claim Construction and Prehearing Statement plus forty-five (45) days (N.D. Patent L.R. 4-5)	October 7, 2019	
4				
5				
6	Responsive Claim Construction Briefs	Deadline for filing of Opening Claim Construction Briefs plus fourteen (14) days (N.D. Patent L.R. 4-5)	October 21, 2019	
7				
8				
9				
10	Reply Claim Construction Briefs	Deadline for filing of Responsive Claim Construction Briefs plus seven (7) days (N.D. Patent L.R. 4-5)	October 28, 2019	
11				
12				
13	Technology Synopsis	7 days before technology tutorial	October 31, 2019	
14				
15	Technology Tutorial	One to two weeks before claim construction hearing	November 7, 2019	
16				
17	Claim Construction Hearing	As the Court's calendar permits	November 21, 2019	
18				
19	Claim Construction Ruling Date		February 21, 2019	January 10, 2020
20	Production Related to Reliance Upon Advice of Counsel (N.D. Patent L.R. 3-7(a)-(c).)	30 days after service of the Claim Construction Ruling.	March 23, 2019	February 11, 2020
21				
22				
23	Subsequent Case Management Report	Judge Donato's Standing Order for Claim Construction	At the Court's convenience	
24				
25	Fact Discovery Cut-Off		April 10, 2020	March 6, 2020
26	Last Day to Serve Initial Expert Reports (unrelated to claim construction).		May 8, 2020	March 27, 2020
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1	Last Day to Serve Rebuttal Expert Reports (unrelated to claim construction).		June 5, 2020	April 24, 2020
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3				
4	Last Day to Conduct Settlement Proceedings.		August 28, 2020	June 12, 2020
5	Expert Discovery Cut- Off.		September 4, 2020	May 29, 2020
6				
7	Summary Judgment Opening Briefs		September 18, 2020	June 26, 2020
8	Summary Judgment Responsive Briefs		October 16, 2020	July 24, 2020
9				
10	Summary Judgment Reply Briefs		October 30, 2020	August 7, 2020
11	Last Day to File <i>Daubert</i> Motions.		September 18, 2020	July 2, 2020
12				
13	Last Day to Serve Motions in Limine	14 days before pre-trial filings	November 6, 2020	September 3, 2020
14	Last Day to Serve Responses to Motions in Limine	4 days before pre-trial filings	November 20, 2020	September 11, 2020
15				
16	Pre-trial Filings	14 days before final pre- trial conference	November 25, 2020	September 17, 2020
17				
18	Last Day to Meet & Confer regarding Deposition Designations	21 days before the start of trial	December 21, 2020	September 29, 2020
19				
20	Final Pre-Trial Conference (Thursdays at 1:30 p.m.)	19 days before the start of trial	December 10, 2020	October 1, 2020
21				
22	Last Day to File Deposition Designations	5 days before the start of trial	January 6, 2021	October 15, 2020
23				
24	Trial		January 11, 2021	October 20, 2020
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