

1 UNITED STATES DISTRICT COURT  
2 FOR THE EASTERN DISTRICT OF CALIFORNIA  
3

4 DUHN OIL TOOL, INC.,

5 Plaintiff/Counterclaim-  
6 Defendant,

7 vs.

8 CAMERON INTERNATIONAL CORPORATION,

9 Defendant/Counterclaim-  
10 Plaintiff.

1:05-cv-01411 OWW GSA

ORDER RE PLAINTIFF DUHN OIL  
TOOL'S MOTIONS IN LIMINE  
(DOCKET NOS. 518-525, 546-  
547).

11 Pending before this Court are Plaintiff/Counterclaim  
12 Defendant Duhn Oil Tool, Inc.'s ("Duhn") Motions in Limine Nos. 1  
13 through 10 (Docs. 518-525, 546-547). The Court has considered all  
14 the parties' respective moving and opposition papers and related  
15 documents and oral arguments, and finds as follows:  
16

- 17 1. Duhn's Motion in Limine No. 1, Preclude Cameron from  
18 Offering Evidence, Argument or Instructions Regarding a  
19 Purported Non-Infringement Opinion (Doc. 518).  
20

21 Duhn's Motion in Limine No. 1 is DENIED without prejudice.

- 22 2. Duhn's Motion in Limine No. 2, Preclude Cameron from  
23 Offering Evidence, Argument or Instructions Regarding its  
24 Allegation that John A. Rogers is a Co-Inventor of Patent  
25 No. 6,920,925 (Doc. 519).  
26

27 Duhn's Motion in Limine No. 2 is DENIED without prejudice.  
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1           3. Duhn's Motion in Limine No. 3, Preclude Cameron's Expert  
2           Alan Ratliff from Offering the Royalty Rate Opinion Set  
3           Forth in his Report (Doc. 547-Filed Under Seal)

4           Duhn seeks to exclude opinions offered by Defendant Cameron  
5           International Corp.'s ("Cameron") damages expert, Mr. Alan  
6           Ratliff. The Court ordered that Duhn may take another deposition  
7           of Mr. Ratliff regarding his opinion regarding adjustment of the  
8           royalty rate of 1%. That deposition has been concluded. The Court  
9           has reserved ruling on this motion. Mr. Ratliff may testify to  
10          disclosed opinions.  
11

12          4. Duhn's Motion in Limine No. 4, Preclude Cameron from  
13          Offering Evidence or Argument Regarding Inequitable Conduct  
14          based on Duhn's Alleged Failure to Apprise the Patent Office  
15          of the Instant Action During Prosecution of the '407 Patent  
16          (Doc. 520)

17          Duhn seeks to preclude reference to any alleged failure to  
18          apprise the Patent Office of the instant action during  
19          prosecution of the '407 Patent. The Court has previously ruled on  
20          and rejected Cameron's "reverse infectious estoppel" inequitable  
21          conduct argument. Cameron now seeks to introduce evidence  
22          regarding the prosecution of the '407 Patent as subsequent  
23          conduct relevant under Fed. R. Evid. 404(b).  
24

25          Duhn's Motion in Limine No. 4 is DENIED, on the condition  
26          that the foundation must be laid for the evidence. Cameron must  
27

1 show that: disclosure of the instant litigation was deferred or  
2 withheld from the Patent Office at all relevant times; the  
3 information regarding the instant litigation was material at all  
4 relevant times; the information would have made a difference to  
5 the prosecution of the application that matured into the '407  
6 Patent; and that the '407 Patent is a continuation of the '925  
7 Patent. These showings must be made before the opening statement  
8 or evidence entered regarding this effect of the prosecution of  
9 the '407 Patent.  
10

11 5. Duhn's Motion in Limine No. 5, Preclude Cameron from  
12 Offering Evidence or Argument Regarding Duhn's Corporate  
13 Identification Disclosure Statement (Doc. 521)  
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15 Duhn seeks to preclude Cameron from offering evidence or  
16 argument regarding Plaintiff's Supplemental Corporate  
17 Identification Disclosure Statement ("Corporate Disclosure  
18 Statement") (Doc. 251). Cameron contends that the Corporate  
19 Disclosure Statement provides evidence of knowledge of entities  
20 related to Duhn. The Court rules that the Corporate Disclosure  
21 Statement may only be admissible to establish a disputed fact if  
22 there is a dispute regarding corporate knowledge of the entities  
23 or their affiliation or if it bears on payment of the small  
24 entity fees.  
25

26 Duhn's Motion in Limine No. 5 is DENIED. However, the  
27 Corporate Disclosure Statement will not be automatically allowed  
28

1 into evidence; the offering party must provide a further showing  
2 of relevance because the Corporate Disclosure Statement does not,  
3 per se, establish what it is offered to prove.

4 6. Duhn's Motion in Limine No. 6, Preclude Cameron from  
5 Presenting Argument or Evidence Alleging that Prior to April  
6 2009 Cameron's Frac Mandrel had a Substantial Non-Infringing  
7 Use (Doc. 522)

8 The Court has found that there is a disputed question of  
9 fact as to whether Cameron's frac mandrel had a substantial non-  
10 infringing use prior to April 2009, or any other specific date.  
11 Duhn's Motion in Limine No. 6 is DENIED.  
12

13 7. Duhn's Motion in Limine No. 7, Preclude Cameron from  
14 Offering Evidence or Argument Regarding the Second Opinion  
15 of James E. Bradley (Doc. 523)

16 Duhn moved to preclude Cameron's expert James E. Bradley  
17 from testifying regarding a number of subjects contained in the  
18 Second Opinion of James E. Bradley. Duhn's Motion in Limine No. 7  
19 is GRANTED in part and DENIED in part.  
20

21 Duhn's request to preclude Mr. Bradley from offering an  
22 opinion that paying large entity maintenance fees to the Patent  
23 Office does not provide sufficient notice of change of small  
24 entity status and that a separate notice is required, is GRANTED.  
25 Mr. Bradley shall not testify that a separate notice of change of  
26 small entity status is necessary.  
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1           The Court also GRANTS Duhn's request to preclude Mr. Bradley  
2 from offering an opinion that prior art is material and not  
3 cumulative, if covered by another defense patent expert.

4           Cameron's expert may express opinions regarding standards  
5 disclosed in his report or at his deposition, except where he has  
6 not cited any supporting case, rule, regulation, custom, practice  
7 or other identified authority stating the rule or establishing  
8 the standard. Second, the expert may give an analytical  
9 conclusion based upon a permissible disclosed standard.

10  
11           8. Duhn's Motion in Limine No. 8, Preclude Cameron from  
12           Offering Evidence or Argument Regarding Previously Asserted  
13           Patent Claims (Doc. 524)

14           Duhn's Motion in Limine No. 8 is GRANTED. No party shall  
15 offer evidence or argument regarding previously asserted patent  
16 claims except as pertaining to the invalidity defense, the '925  
17 Patent prosecution history, or the existence of a "substantial  
18 noninfringing use." In addition, the parties shall not offer  
19 evidence or argument regarding any claims or defenses that have  
20 been superseded in the Final Pretrial Order.

21  
22           9. Duhn's Motion in Limine No. 9, Preclude Cameron from  
23           Offering Evidence or Argument Regarding any Arguments made  
24           by Duhn re the Scope of the Claims of the '925 Patent Prior  
25           to the Court's Order re Claim Construction (Doc. 525)

26           Duhn moves the Court to preclude Cameron from offering  
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1 evidence or argument regarding any arguments made by Duhn  
2 regarding the scope of the claims of the '925 Patent prior to the  
3 Court's entry of its Order re Claim Construction. To the extent  
4 that the motion encompasses the prosecution history of the '925  
5 Patent, the motion is DENIED. The prosecution history of the '925  
6 Patent and arguments to the Patent Office are not excluded.  
7

8 Otherwise, the motion is GRANTED. Attorney representations  
9 in pleadings in this litigation are excluded until Cameron  
10 identifies specific courtroom conduct that Cameron contends is  
11 admissible. The Court will rule upon each identified statement or  
12 representation to determine if it is admissible.  
13

14 10. Duhn's Motion in Limine No. 10, Preclude Cameron from  
15 Introducing, Publishing or Otherwise Disclosing the Stock  
16 Purchase Agreement between Seaboard International and Duhn  
17 (Doc. 540)

18 Duhn moves the Court to prohibit publishing or otherwise  
19 disclosing the contents of the Stock Purchase and Contribution  
20 Agreement between Seaboard International and Duhn ("SPCA"). Duhn  
21 contends that the SPCA contains highly confidential business  
22 information and that disclosure would substantially harm Seaboard  
23 and Cameron. The Court conducted an *in camera* review of the Stock  
24 Purchase Agreement and its exhibits with counsel for Duhn on  
25 January 5, 2011.  
26

27 Cameron contends that the SPCA is relevant to multiple  
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1 issues. First, Cameron contends that the SPCA had bearing on the  
2 affiliate status of other entities related to Duhn, its parent  
3 Seaboard and the holding company, IGP. The issue has been  
4 resolved by the Court's ruling on lost profits in this case.  
5 Therefore, the SPCA is not relevant on that ground.  
6

7 Second, Cameron asserts that the SPCA goes to the issue of  
8 bias. The Court is confident that there is nothing in the SPCA  
9 that will add to or subtract from the quantum of interest that  
10 any witness has in this litigation. This is not a ground for  
11 allowing disclosure of the document.

12 Third, on the issue of calculation of a reasonable royalty,  
13 the Court has determined that there is no information in the SPCA  
14 breaking down the value of the patent or revenues generated by  
15 the '925 Patent. Nothing in the SPCA would assist in determining  
16 damages in this case.  
17

18 In addition, Duhn has explained that in 2007, Cameron was a  
19 bidder for Duhn. The parties to the SPCA believe that it contains  
20 confidential and trade secret information that, if disclosed,  
21 could result in competitive harm or economic adversity.  
22

23 For the foregoing reasons, the Court believes that the SPCA  
24 will not help to prove or disprove any issue in the case. The  
25 Court finds that any probative value is outweighed by the  
26 prejudice that disclosure would cause under Fed. R. Evid. 403. The  
27 motion is GRANTED.  
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Damages Issue

Upon argument by Cameron, the Court has modified its ruling to permit Cameron to take the deposition of Mr. Rex Duhn, before the start of the trial, for the sole purpose of asking questions regarding his valuations of the '925 Patent.

IT IS SO ORDERED.

Dated: January 18, 2011

                  /s/ Oliver W. Wanger  
Oliver W. Wanger  
United States District Judge