

1                                    IN THE UNITED STATES DISTRICT COURT  
2                                    FOR THE NORTHERN DISTRICT OF CALIFORNIA

3  
4 GUIDETECH, INC.,

No. C 09-5517 CW

5                                    Plaintiff,

ORDER ON MOTIONS  
IN LIMINE AND  
TRIAL BRIEFS

6                                    v.

7 BRILLIANT INSTRUMENTS, INC.

(Re: Docket Nos.  
251, 260, 261,  
262, 267)

8                                    Defendant.

9  
10 AND ALL RELATED COUNTERCLAIMS

11  
12                                    On March 19, 2014, the Court held a pretrial conference and  
13 heard arguments regarding the parties' motions in limine and other  
14 pretrial motions. The Court issues the following rulings:

15 I.    Motions in Limine

16        a.    Brilliant's Motions

17                                    No. 1 - Motion to exclude Dr. West's testimony that "a  
18 processor circuit configured to receive said time signals . . . to  
19 determine a time interval," or its equivalent: DENIED. Any  
20 inconsistencies in Dr. West's testimony go to its weight, not to  
21 its relevance and reliability and may be explored by Brilliant  
22 through cross-examination.

23                                    No. 2 - Motion to exclude reasonable royalty theory: GRANTED.  
24 At the hearing, GuideTech represented that it would not be  
25 pursuing a reasonable royalty theory of damages.

26                                    Nos. 3, 4, 5, 6, 7 - Motion to exclude lost profits theory:  
27 DENIED. Because GuideTech produced some evidence of its lost  
28

1 profits theory during discovery, it would be inappropriate to  
2 exclude all evidence supporting this theory. GuideTech may only  
3 present evidence it has disclosed to Brilliant and must cite  
4 before trial where such evidence was disclosed.

5 No. 8 - Motion to exclude testimony that the relevant market  
6 is a two-supplier market: DENIED. GuideTech's witnesses,  
7 including Ronen Sigura, may offer their percipient knowledge of  
8 the relevant market. Brilliant can impeach Sigura with his  
9 somewhat inconsistent statement that GuideTech investigated  
10 whether a third company was a competitor in the relevant market.

11 No. 9 - Motion to exclude Tabatabaei as an expert witness:  
12 GRANTED. Tabatabaei served an expert report only on the validity  
13 of the '231, '671, and '649 patents, but not one concerning  
14 infringement; Tabatabaei may not testify as an expert on  
15 infringement. However, he may testify about facts of which he has  
16 personal knowledge based on his employment with GuideTech during  
17 the time Brilliant was allegedly infringing.

18 No. 10 - Motion to exclude evidence supporting permanent  
19 injunction: DENIED. GuideTech may present any evidence that it  
20 has disclosed to Brilliant that supports its request for a  
21 permanent injunction. If the evidence is also relevant to jury  
22 issues it may be presented to the jury; if relevant only to the  
23 injunction request it may be presented to the Court alone. The  
24 request for an injunction will not be alluded to before the jury.

25 No. 11 - Motion to exclude evidence of pending or prior legal  
26 proceedings: GRANTED. Proceedings in the state court action  
27 involving the same parties are not relevant to the patent  
28 infringement issues in this case. See Fed. R. Evid. 401, 403.

1           No. 12 - Motion to exclude documents produced after February  
2 19, 2014: DENIED. GuideTech produced these documents in a timely  
3 fashion and any disorganization was substantially harmless.  
4 GuideTech also may use Dr. West's demonstratives at trial, so long  
5 as they are disclosed before trial and are within the scope of Dr.  
6 West's expert report, as GuideTech represents.

7           b. GuideTech's Motions

8           No. 1 - Motion to exclude reference to Court's claim  
9 construction and summary judgment order: GRANTED IN PART. The  
10 Court's claim constructions will of course be available for  
11 purposes of instructing the jury.

12           However, the Court's summary judgment order on infringement  
13 may not be shared with the jury because any probative value is  
14 outweighed by the prejudicial effect and danger of confusing the  
15 issues. Fed. R. Evid. 403. Brilliant argues the summary judgment  
16 order is relevant for determining willfulness, i.e., whether "the  
17 infringer acted despite an objectively high likelihood that its  
18 actions constituted infringement of a valid patent." In re  
19 Seagate Technology, LLC, 497 F.3d 1360, 1371 (Fed. Cir. 2007) (en  
20 banc). Indeed, the Court's summary judgment order finding no  
21 disputed issue regarding literal infringement of the '671 and '649  
22 patents, which was affirmed by the Federal Circuit, might be  
23 probative of whether Brilliant acted willfully. But, while the  
24 jury may decide factual questions underlying the willfulness  
25 inquiry, the objective aspects of willfulness, which is where the  
26 Court's summary judgment order is relevant, is a question that  
27 must be decided by the Court. Bard Peripheral Vascular, Inc. v.  
28 W.L. Gore & Associates, Inc., 682 F.3d 1003, 1007 (Fed. Cir.

1 2012). Because the Court will make the ultimate finding on  
2 willfulness, there is no need to present the summary judgment  
3 order to the jury. Additionally, presenting the Court's opinion  
4 of GuideTech's infringement case may confuse the jury.

5 No. 2 - Unopposed motion to exclude reference to the Federal  
6 Circuit opinion: GRANTED. Both parties agree that admitting the  
7 Federal Circuit's opinion would be prejudicial and would confuse  
8 the jury.

9 No. 3 - Motion to exclude mention of non-infringement of the  
10 '959, '767, '382, and '610 patents: GRANTED. Although GuideTech  
11 originally asserted these patents in the present case, at summary  
12 judgment GuideTech chose not to pursue them further. The fact  
13 that GuideTech dropped these patents is not relevant to willful  
14 infringement of the patents remaining in the suit and further  
15 would be confusing and unfairly prejudicial.

16 No. 4 - Motion to exclude any reference to the invalidity of  
17 the '231, '649, and '671 patents: GRANTED. The Court determined  
18 at summary judgment that Brilliant's invalidity case was barred by  
19 assignor estoppel. Brilliant may nevertheless utilize prior art  
20 to defend against GuideTech's doctrine of equivalents case. Tate  
21 Access Floors, Inc. v. Interface Architectural Res., Inc., 279  
22 F.3d 1357, 1367, 1369 (Fed. Cir. 2002).

23 No. 5 - Motion to exclude any mention of previously-excluded  
24 prior art references: DENIED. The Court's previous order striking  
25 Dr. Kaliski's report to the extent that it relied on certain prior  
26 art references for its invalidity opinion expressly stated that  
27 Dr. Kaliski may rely on the references for other purposes. Docket  
28 No. 85 at 4. As discussed previously, Dr. Kaliski may only

1 present opinions that he has properly disclosed in an expert  
2 report.

3 II. Pretrial Motions

4 a. Motion to Realign Parties

5 As the declaratory judgment defendant, GuideTech moves to  
6 realign the parties so that it is the plaintiff and proceeds first  
7 at trial. In the Ninth Circuit, district courts look to the  
8 "primary purpose" of the litigation to determine, in their  
9 discretion, whether to realign the parties in accordance with the  
10 primary dispute in controversy. Plumtree Software, Inc. v.  
11 Datamize, LLC, 2003 WL 25841157, at \*3 (N.D. Cal.) (citing  
12 Prudential Real Estate Affiliates, Inc. v. PPR Realty, Inc., 204  
13 F.3d 867, 873 (9th Cir. 2000)). Because invalidity is no longer  
14 at issue, GuideTech is the sole party bearing the burden of proof  
15 in this case. The motion is GRANTED and the parties are realigned  
16 so that GuideTech is the plaintiff and Brilliant is the defendant.

17 b. Motion to Bifurcate Willfulness from Liability

18 Brilliant moves to bifurcate the issue of willfulness from  
19 the issue of infringement. Fed. R. Civ. P. 42(b). The Court sees  
20 no special risk of prejudice here. Bifurcation would not serve  
21 the interests of judicial economy. The motion is DENIED.

22 c. Motion to Clarify Claim Construction

23 At claim construction, the Court construed "defined within a  
24 signal channel" as "contained within a signal channel." Docket  
25 No. 137 at 8. Neither party challenged the Court's claim  
26 constructions on appeal and the Federal Circuit accepted the  
27 Court's claim constructions in finding a disputed issue of  
28 infringement based on the above-referenced term. Brilliant

1 Instruments, Inc. v. GuideTech, LLC, 707 F.3d 1342, 1345 (Fed.  
2 Cir. 2013). Brilliant now moves to "clarify" that the Court's  
3 claim construction does not include "an embodiment that has a  
4 measurement circuit that is present in more than one channel."  
5 Brilliant contends the Federal Circuit did not consider this  
6 Court's reasoning rejecting GuideTech's proposed construction on  
7 the basis that it "captures an embodiment that has a measurement  
8 circuit that is present in more than one channel, which is not  
9 supported by the claim language, the specification or Figure 1."  
10 Docket No. 137 at 7-8. Contrary to Brilliant's assertion,  
11 however, the Federal Circuit did consider Brilliant's present  
12 argument. See Brilliant Instruments, Inc., 707 F.3d at 1345  
13 ("Brilliant argues that it cannot infringe because the district  
14 court, as a matter of claim construction, rejected GuideTech's  
15 argument that 'defined within' allowed a measurement circuit to be  
16 present in more than one channel."). The Federal Circuit  
17 nevertheless found a disputed issue as to infringement because  
18 GuideTech's evidence showed that, when the accused products  
19 operate in "One-Channel-Two-Edge mode," "the only active signal  
20 path flows from the input to two measurement circuits." Id. The  
21 Court thus declines to adopt Brilliant's proposed change because  
22 it contradicts the Federal Circuit's application of the Court's  
23 claim construction.

24 IT IS SO ORDERED.

25 Dated: 3/25/2014

26   
27 CLAUDIA WILKEN  
28 United States District Judge