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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

OJMAR US, LLC,
Plaintiff,
v.
SECURITY PEOPLE, INC., et al.,
Defendants.

Case No. [16-cv-04948-HSG](#)

**ORDER GRANTING DEFENDANTS'
MOTION IN LIMINE NO. 1 RE:
EXCLUSION OF THE TESTIMONY OF
ROBERT TAYLOR**

Re: Dkt. No. 214

On May 22, 2018, Security People, Inc. (“Digilock”) and Asil Gokcebay (collectively, “Defendants”) and Ojmar U.S., LLC (“Ojmar” or “Plaintiff”) each filed five motions in limine. See Dkt. Nos. 214-223. Defendants’ first motion in limine seeks to exclude the testimony of attorney Robert Taylor under Federal Rule of Evidence (“Rule”) 702. Dkt. No. 214 (“Defs. MIL 1”) at 2; see *Daubert v. Merrell Dow Pharm., Inc.*, 509 U.S. 579, 597 (1993). On May 29, 2018, Plaintiff filed an opposition to the motion. Dkt. No. 234 (“Pl. MIL Opp. 1”). On June 12, 2018, the Court heard argument on the motions. After considering the parties’ arguments, the Court **GRANTS** Defendants’ first motion in limine.¹

I. LEGAL STANDARD

Federal Rule of Evidence (“Rule”) 702 allows a qualified expert to testify “in the form of an opinion or otherwise” where:

- (a) the expert’s scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;
- (b) the testimony is based on sufficient facts or data;
- (c) the testimony is the product of reliable principles and methods;
- and (d) the expert has reliably applied the principles and methods to the facts of the case.

¹ The Court will issue a further written order resolving the other pending motions in limine.

1 Expert testimony is admissible under Rule 702 if it is both relevant and reliable. See *Daubert*, 509
2 U.S. at 589. “[R]elevance means that the evidence will assist the trier of fact to understand or
3 determine a fact in issue.” *Cooper v. Brown*, 510 F.3d 870, 942 (9th Cir. 2007); see also *Primiano*
4 *v. Cook*, 598 F.3d 558, 564 (9th Cir. 2010) (“The requirement that the opinion testimony assist the
5 trier of fact goes primarily to relevance.”) (quotation omitted). Under the reliability requirement,
6 the expert testimony must “ha[ve] a reliable basis in the knowledge and experience of the relevant
7 discipline.” *Primiano*, 598 F.3d at 565. To ensure reliability, the Court “assess[es] the [expert’s]
8 reasoning or methodology, using as appropriate such criteria as testability, publication in peer
9 reviewed literature, and general acceptance.” *Id.* at 564.

10 **II. DISCUSSION**

11 Ojmar seeks to elicit Taylor’s testimony on “[r]easonable practice by patent litigation
12 attorneys when investigating filing, and pursuing patent lawsuits; reasonable practice by patent
13 attorneys providing legal opinions regarding patent issues; [and the] objective baselessness of
14 Defendants’ four patent lawsuits against Ojmar.” Dkt. No. 249-1, Ex. A (“Pl. Witness List”) at 2.
15 According to Ojmar, Taylor is well-qualified to explain “what happened factually in Digilock’s
16 four lawsuits against Ojmar and in the USPTO [U.S. Patent and Trademark Office], and whether
17 behavior engaged in by Defendants and their lawyers is compliant with the practices and customs
18 of other similarly situated within the same community.” Pl. MIL. Opp. 1 at 1–2; see also Dkt. No.
19 214-2 (“Taylor Report”) at 2–4 (outlining the nature and scope of Taylor’s assignment and
20 summarizing his conclusions). Taylor’s qualifications include his experience as a patent attorney
21 and PTO examiner; he also has a degree in electrical engineering. Pl. MIL Opp. 1 at 1.

22 Defendants set forth two primary reasons why Taylor’s testimony is inadmissible. First,
23 Defendants argue that Taylor cannot properly opine on the “objective baselessness” of
24 Defendants’ underlying patent lawsuits or the materiality of certain prior art because he is not a
25 technical expert or a person of ordinary skill in the art of locks. See *Defs. MIL* 1 at 1–2. Second,
26 Defendants contend that Taylor’s opinions on “reasonable” patent attorney practices would require
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1 him to draw improper legal conclusions, including for instance, as to whether Defendants violated
2 “any rules of procedure (e.g. Rule 56 or Rule 11) . . . with respect to the underlying patent
3 prosecution and litigation. . . .” See *id.*

4 The Court agrees with Defendants. In *Sundance, Inc. v. Demonte Fabricating Ltd.*, the
5 Federal Circuit held that the district court erred in permitting an attorney-expert to testify
6 regarding obviousness or any of the underlying “technical questions, such as the nature of the
7 claimed invention, the scope and content of prior art, the differences between the claimed
8 invention and the prior art, or the motivation of one of ordinary skill in the art to combine these
9 references to achieve the claimed invention.” See 550 F.3d 1356, 1364–65 (Fed. Cir. 2009). In
10 reaching that holding, the *Sundance* court reasoned that “[a]llowing a patent law expert without
11 any technical expertise to testify on the issues of infringement and validity amounts to nothing
12 more than advocacy from the witness stand.” See *id.* That reasoning applies here with equal
13 force: it is undisputed that Taylor lacks technical expertise and skill in the relevant art. See Defs.
14 MIL 1 at 2–3; Pl. MIL Opp. 1 at 4–5. Allowing Taylor to testify that Defendants’ underlying
15 patent infringement lawsuits were “objectively baseless” would necessarily require him to opine
16 on those issues deemed impermissible in *Sundance*: invalidity, infringement, and technical
17 considerations pertaining to the scope and content of prior art. See *Prof'l Real Estate Inv'rs, Inc.*
18 *v. Columbia Pictures Indus., Inc.* (“PRE Investors”), 508 U.S. 49, 60–61 (1993) (explaining that
19 “objective baselessness” requires a showing that “no reasonable litigant could realistically expect
20 success on the merits” of the underlying action); *Nobelpharma AB v. Implant Innovations, Inc.*,
21 141 F.3d 1059, 1072 (Fed. Cir. 1998) (“[U]nder PRE, a sham suit must be both subjectively
22 brought in bad faith and based on a theory of either infringement or validity that is objectively
23 baseless.”) (emphasis added).

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26 Eliciting Taylor’s testimony on materiality and cumulateness would likewise entail an
27 opinion beyond the scope of his expertise. Though the Court will decide the ultimate issue of
28 inequitable conduct, the underlying “but-for materiality” inquiry requires an examination of the

1 withheld prior art references. See *Regeneron Pharm., Inc. v. Merus N.V.*, 864 F.3d 1343, 1351
2 (Fed. Cir. 2017) (“As with an invalidity analysis, the first step in determining but-for materiality
3 of a reference is determining the scope of the claims at issue. . . Next, based on the broadest
4 reasonable construction, the court must determine whether a reasonable patent examiner would
5 have allowed the claims had she known of the Withheld References.”) (emphasis added). So too
6 with Plaintiff’s “Walker Process” claim, which will be submitted to the jury (unless Plaintiff fails
7 to meet its burden in its case-in-chief). See *Nobelpharma AB*, 141 F.3d at 1071 (“[A] finding
8 of Walker Process fraud may not be based upon an equitable balancing of lesser degrees of
9 materiality and intent. Rather, it must be based on independent and clear evidence of deceptive
10 intent together with a clear showing of reliance, i.e., that the patent would not have issued but for
11 the misrepresentation or omission.”); *Dippin’ Dots, Inc. v. Mosey*, 476 F.3d 1337, 1346–48 (Fed.
12 Cir. 2007) (holding that a Walker Process claimant must meet “higher threshold showings of both
13 materiality and intent than are required to show inequitable conduct.”). At bottom, Defendants’
14 alleged misrepresentation or omission must “be of a fact material to patentability,” and Taylor is
15 not qualified to opine on that topic. *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1365 (Fed.
16 Cir. 1998).

17 In similar circumstances, other courts in this district have excluded the testimony of patent
18 attorney-experts. For instance, in *Applied Materials, Inc. v. Advanced Semiconductor Materials*
19 *Am., Inc.*, the court held that the proffered expert, “a former supervising patent examiner and
20 former member of the Patent Office Board of Patent Appeals and Interferences,” could not testify
21 “as to what the prior art teaches,” “the ‘materiality’ of prior art,” or what “the [PTO] examiner
22 would have done if [the expert] had been the examiner, or if the examiner had different
23 information.” 1995 WL 261407, at *2 (N.D. Cal. Apr. 25, 1995). In doing so, the court noted that
24 the defendant’s expert was not a technical expert, and lacked skill in the pertinent art. See *id.* at
25 *2–3. The court found that testimony as to what the examiner “would have done” under different
26 circumstances was “irrelevant speculation” that would impermissibly “advise [the] jury as to
27 applicable principles of law.” See *id.* at *3; accord *Icon-IP Pty Ltd. v. Specialized Bicycle*
28 *Components, Inc.*, 87 F. Supp. 3d 928, 947 (N.D. Cal. 2015) (prohibiting the defendant’s expert,

1 who had spent over thirty-four years working at the PTO, from speculating “about what the PTO
2 would have done had specific prior art references been brought to the examiner’s attention”).

3 Ojmar argues that other courts have allowed attorney-experts to opine as to materiality.
4 But the cases on which Ojmar relies are not binding, and virtually all are from outside of this
5 circuit.² To the extent that Ojmar suggests that *Aevoe Corp. v. AE Tech Co.* stands for the
6 proposition that an attorney-witness can opine on materiality issues underlying an obviousness
7 determination, the Court disagrees with that reading of the case. See 2014 WL 4182343, at *3 (D.
8 Nev. Aug. 20, 2014) (deferring ruling pending “any specific objections if and when Defendants
9 attempt to elicit testimony from [expert] at trial that is beyond the scope of his expertise”). And
10 even if *Aevoe* had so held, this Court would respectfully disagree with that conclusion based on
11 the authorities discussed above. The only case from this district that Ojmar cites, *Therasense, Inc.*
12 *v. Becton, Dickinson & Co.*, 2008 WL 2037732, at *3–4 (N.D. Cal. May 12, 2008), aligns with the
13 Court’s conclusion. In *Therasense*, the court allowed an attorney without skill in the art to opine
14 in the limited circumstance where the alleged falsity “turn[ed] on a single sentence and two
15 interpretations of it.” 2008 WL 2037732 at *3–4. The court explained:

16 Some issues of materiality may be so independent of scientific
17 complexity that even patent lawyers can understand them. If, for
18 example, an inventor swears in a later application that a given
19 formula was always true, he would normally be obligated to reveal
20 that he had sworn in an earlier separate application that the same
21 formula was never true. When the contradiction is manifest,
22 scientists are not needed to explain it. On the other hand, if
23 scientists are needed to explain or set up the contradiction, then
24 mere lawyers should refrain from purporting to explain the science
25 part.

22 Id. at *3.

23 Here, however, Plaintiff has failed to clarify how Taylor can testify on materiality and
24 cumulateness without delving into prior art issues and the technical aspects of locks and locking

26 ² For example, *Se-Kure Controls, Inc. v. Vanguard Prod. Grp., Inc.* predates *Sundance* and applied
27 Seventh Circuit rather than Federal Circuit law on this question. See 2008 WL 169054, at *3 (N.D.
28 Ill. Jan. 17, 2008); see also *Nobelpharma AB*, 141 F.3d at 1069 (“[W]hether conduct in procuring
or enforcing a patent is sufficient to strip a patentee of its immunity from the antitrust laws is to be
decided as a question of Federal Circuit law. This conclusion applies equally to all antitrust
claims premised on the bringing of a patent infringement suit.”).

1 mechanisms. Compare Taylor Report at ¶ 47 (“While I do not intend to offer an opinion as to
2 whether the failure to tell the USPTO about the ‘043 patent was intentional, in my view, the
3 teaching of that reference makes it highly likely that the Examiner would not have issued Claim 4
4 if Mr. Gokcebay or his lawyers had provided it to her.”). The issues here are what the patent
5 examiner would have found if she had Defendants’ prior patent before her, and why she would
6 have made that finding. But Taylor lacks the required technical skill in the art to offer an opinion
7 on those questions, so his proffered testimony does not satisfy the requirements of Rule 702.

8 To the extent that Plaintiff appears to argue that Taylor can simply observe that
9 Defendants’ patent issued, and was later held invalid based on obviousness, then conclude from
10 those facts without any technical analysis that an undisclosed prior art reference was material, that
11 position is inconsistent with Federal Circuit precedent. See *C.R. Bard, Inc.*, 157 F.3d at 1365
12 (observing that “[t]here is no presumption that information not filed by an applicant was material
13 simply because patentability ensued”). This same reasoning underpinned the Court’s denial of
14 Plaintiff’s motion for partial summary judgment on the issue of but-for materiality and
15 cumulateness. See Dkt. No. 192 at 12 (“In sum, the PTAB’s decision does not, on its own,
16 satisfy the ‘but-for’ materiality standard underlying Ojmar’s inequitable conduct claim. Ojmar
17 must therefore prove at trial that the ’043 Patent was ‘but-for material’ and ‘not cumulative of
18 prior art that the PTO considered during prosecution’ of the ’180 Patent.”).


19 Similarly, Taylor’s testimony as to “reasonable practice” by patent attorneys would not
20 help the jury to assess a fact in issue: instead, it would require him to give impermissible legal
21 opinions. See *Argus Chem. Corp. v. Fibre Glass-Evercoat Co.*, 759 F.2d 10, 13 (Fed. Cir. 1985)
22 (“The question of the appropriate standard for determining inequitable conduct in procuring a
23 patent is one of law. Thus, the testimony of an attorney on the practice which some attorneys
24 followed is irrelevant.”); *Alfred E. Mann Found. for Sci. Research v. Cochlear Corp.*, No. CV 07-
25 8108 FMO (SHX), 2014 WL 12586105, at *10 (C.D. Cal. Jan. 3, 2014) (precluding a patent
26 attorney from opining on “matters requiring technical expertise,” “the issue of inequitable conduct,
27 including any opinions as to breach of the duty of disclosure, intent to deceive, or materiality,” and
28 “what practices [were] followed in the prosecution of” the underlying patents). Though Taylor

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could theoretically opine on PTO policy and procedure, Plaintiff does not seek to present testimony on that issue. See, e.g., Sundance, 550 F.3d at 1361 n.2 & n.5 (allowing the defendant’s patent attorney-expert “testify as to patent office procedure generally”) (citing Bausch & Lomb, Inc. v. Alcon Laboratories, Inc., 79 F.Supp.2d 252, 254–55 (W.D.N.Y. 2000)). Thus, the Court concludes that Taylor’s testimony does not satisfy Rule 702, and **GRANTS** Defendants’ first motion in limine. Taylor’s proffered testimony is excluded in its entirety.

IT IS SO ORDERED.

Dated: 6/15/2018


HAYWOOD S. GILLIAM, JR.
United States District Judge