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6 UNITED STATES DISTRICT COURT
7 SOUTHERN DISTRICT OF CALIFORNIA
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9 THERMOLIFE INTERNATIONAL,
10 LLC,

Plaintiff,

11 v.

12 MYOGENIX CORP.; GNC
13 CORPORATION; GENERAL
14 NUTRITION CENTERS, INC.; and
15 GENERAL NUTRITION
16 CORPORATION,

Defendants.

Case No.: 13cv651 JLS (MDD)
(LEAD CASE)

**ORDER (1) GRANTING IN PART
AND DENYING IN PART
PLAINTIFFS' MOTION IN LIMINE
AND (2) DENYING DEFENDANTS'
MOTION IN LIMINE / DAUBERT
MOTION**

(ECF Nos. 209 & 210)

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18 Presently before the Court are Plaintiffs the Board of Trustees of the Leland Stanford
19 Junior University and ThermoLife International, LLC's Motion In Limine to Exclude
20 Certain Prior Art-Related Evidence (Plaintiffs' Motion), (ECF No. 209), as well as
21 Defendants' Opposition to, (ECF No. 219), and Plaintiffs' Reply in Support of, (ECF No.
22 222), Plaintiffs' Motion. Also before the Court are Defendants' Motion In Limine /
23 Daubert Motion to Exclude Plaintiffs' Expert From Offering Testimony Regarding
24 Secondary Considerations of Non-Obviousness (Defendants' Motion), (ECF No. 210), as
25 well as Plaintiffs' Opposition to, (ECF No. 218), and Defendants' Reply in Support of,
26 (ECF No. 221), Defendants' Motion. The Court held a hearing on these Motions on July
27 21, 2016. As explained below, the Court **GRANTS IN PART AND DENIES IN PART**
28 Plaintiffs' Motion and **DENIES** Defendants' Motion.

1 **PLAINTIFFS’ MOTION**

2 The Plaintiffs ask the Court to preclude Defendants from introducing various prior
3 art references and combinations thereof at trial. This District’s Local Rules require
4 invalidity contentions to include “an explanation of why the prior art renders the asserted
5 claim obvious,” Patent L.R. 3.3(b), which prevents unfair surprise at trial and allows
6 patentees time to analyze the prior art as it pertains to particular claims and terms.
7 Similarly, expert reports must disclose the substance of an expert’s testimony for direct
8 examination and the bases for those opinions. See *Jenkins v. Bartlett*, 487 F.3d 482, 487
9 (7th Cir. 2007) (“The purpose of the report is to ‘set forth the substance of the direct
10 examination.’ . . . A party is barred from using at trial evidence that it failed to disclose
11 ‘without substantial justification’ as required by Rule 26(a), unless that failure was
12 harmless.”); Fed. R. Civ. P. 26(a)(2)(B)(i) (expert reports must contain “a complete
13 statement of all opinions the witness will express and the basis and reasons for them.”).

14 The Court **GRANTS IN PART AND DENIES IN PART** Plaintiffs’ Motion and
15 **ORDERS** as follows:

16 1. References Allowed if Disclosed as to Claim Element: Where prior art was
17 disclosed with respect to a particular claim element, whether in the Defendants’ Amended
18 Invalidity Contentions, expert report, rebuttal expert report, or expert deposition,
19 Defendants are not precluded from relying on that reference as invalidating art with respect
20 to that claim or claim element. However, Plaintiffs may renew their objections at trial and
21 explain why, despite the disclosure of the reference in one of these mediums, they would
22 be prejudiced and could not cure the prejudice through cross examination. To the extent
23 that this ruling is more liberal than the Court’s conclusion on summary judgment (with
24 respect to the combination of Levere and Mugge as to claim 10 of the ’459 Patent), the
25 difference is attributable to the static evidentiary record on summary judgment, whereas
26 here Plaintiffs will have the opportunity to explore testimony on cross examination. That
27 is not to say that particularized disclosure was not required, however.

1 2. References Precluded if Not Disclosed as to Claim Element: Where prior art
2 was not disclosed with respect to a particular claim or claim element in Defendants'
3 Amended Invalidity Contentions, expert report, rebuttal expert report, or expert deposition,
4 Defendants are precluded from relying on that reference as invalidating art for that claim
5 element.

6 3. Defendants' Expert is Precluded from Testifying About Motivations to
7 Combine References That Were Not Disclosed or Supported by Disclosures in His Expert
8 Report, Rebuttal Expert Report, or Deposition.¹ Plaintiffs devote much of their briefing to
9 arguing Defendants' expert, Dr. Volek, should not be allowed to testify to reasons a person
10 of ordinary skill in the art would be motivated to combine prior art references where those
11 reasons were not provided in his expert report. Although it is unclear whether Defendants
12 actually intend to introduce any such testimony, the Court notes that Defendants' expert
13 may not introduce bases for his opinion and may not testify about reasons or motivations
14 to combine that were not disclosed in his expert report, rebuttal expert report, or deposition.
15 See Jenkins, 487 F.3d at 487; Fed. R. Civ. P. 26(a)(2)(B)(i). By way of example, Dr. Volek
16 is not precluded from testifying that the disclosure in Weider's Arginine & Lysine product
17 would motivate a person of ordinary skill to rely on other teachings—or providing greater
18 detail and elaborating on this disclosed motivation to combine—because this opinion and
19 the basis for it are outlined in his Expert Report. Dr. Volek would be precluded, however,
20 from testifying about some other publication that was not discussed in his report that
21 suggests combining certain prior art references.

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24 ¹ In light of the discussion at the hearing on this motion, the Court clarifies that this Order precludes
25 introduction of individual prior art references as they pertain to particular claims and elements, and does
26 not preclude combinations of art that were not otherwise disclosed. That is, where Defendants have
27 disclosed prior art and explained how it reads on certain claim elements, Plaintiffs are already on notice
28 of how that art might be applied to those elements. The issue likely to arise with respect to previously
undisclosed combinations of art will be the motivation to combine those references. Where Defendants'
expert has not in his expert report, rebuttal expert report, or deposition explained the basis for why a skilled
artisan would combine those references, he may not do so for the first time at trial.

1 **DEFENDANTS’ MOTION**

2 Next, Defendants ask the Court to preclude Plaintiffs’ expert, Dr. Boger, from
3 testifying regarding the secondary considerations of nonobviousness.

4 “[T]he Daubert gatekeeping obligation is less pressing in connection with a bench
5 trial’ where ‘the ‘gatekeeper’ and the trier of fact [are] one and the same.’” *AngioScore,*
6 *Inc. v. TriReme Med., Inc.*, 87 F. Supp. 3d 986, 1016 (N.D. Cal. 2015) (citing various
7 cases). The gatekeeping function must still be performed, however. See *Metavante Corp.*
8 *v. Emigrant Sav. Bank*, 619 F.3d 748, 760 (7th Cir. 2010); see also *Daubert v. Merrell Dow*
9 *Pharm., Inc.*, 509 U.S. 579, 596 (1993) (“Vigorous cross-examination, presentation of
10 contrary evidence, and careful instruction on the burden of proof are the traditional and
11 appropriate means of attacking shaky but admissible evidence.”).

12 Much of Dr. Boger’s testimony with respect to the secondary considerations of
13 nonobviousness would be based on his “knowledge and experience” in the industry, “rather
14 than the methodology or theory behind” his testimony. *United States v. Hankey*, 203 F.3d
15 1160, 1169 (9th Cir. 2000). In such cases, “[t]he Daubert factors (peer review, publication,
16 potential error rate, etc.) simply are not applicable.” *Id.*; see also *See Kumho Tire Co. v.*
17 *Carmichael*, 526 U.S. 137, 150 (1999) (“Engineering testimony rests upon scientific
18 foundations, the reliability of which will be at issue in some cases. . . . In other cases, the
19 relevant reliability concerns may focus upon personal knowledge or experience.”).

20 Although Dr. Boger’s deposition testimony appeared not to be based on particular
21 data or analysis thereof, his opinions are based on his personal experience in the arginine
22 supplementation field and meet the minimum requirements for admissibility. The concerns
23 with the reliability of Dr. Boger’s testimony on this point are more appropriately
24 considered with respect to the weight to which his testimony is entitled. Further, given that
25 this is a bench trial, the danger of prejudice is lessened. If cross examination reveals a
26 complete lack of factual basis for particular aspects of Dr. Boger’s testimony, it may be
27 stricken and disregarded, as opposed to merely given less weight. As a general matter,
28 however, it is not precluded.

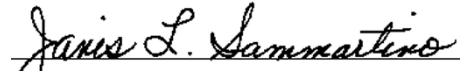
1 Accordingly, Defendants' Motion is **DENIED**.

2 **CONCLUSION**

3 For the foregoing reasons, the Court **GRANTS IN PART AND DENIES IN PART**
4 Plaintiffs' Motion and **DENIES** Defendants' Motion.

5 **IT IS SO ORDERED.**

6 Dated: July 22, 2016

7 
8 Hon. Janis L. Sammartino
9 United States District Judge

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