

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

SILICON GRAPHICS, INC.,

Plaintiff,

v.

ATI TECHNOLOGIES, INC.,
ATI TECHNOLOGIES ULC and
ADVANCED MICRO DEVICES, INC.

Defendants.

ORDER

3:06-cv-00611-bbc

A final pretrial conference was held in this case on January 31 and February 1, 2008, before United States District Judge Barbara B. Crabb. Plaintiff appeared by James M. Bollinger, Philip L. Hirschhorn, David W. Marston and Edward Pardon. Defendants appeared by William H. Manning, Jake S. Zimmerman, Aaron R. Fahrenkrog, Cole M. Fauver, Diane L. Simenson and Amy E. Slusser. Also present was Kent J. Cooper, Director of Patents and Licensing for defendant Advanced Micro Devices, Inc.

The first matter taken up was plaintiff's decision to concede its infringement case, withdraw its remaining claims and allow dismissal of all of the claims with prejudice. Defendants were caught off guard by plaintiff's decision but maintained that a trial was still

necessary because they had asserted a counterclaim for invalidity. After reviewing the case law over night, I determined that trial should go forward on the invalidity issues, as well as defendants' claim of inequitable conduct and their motion for sanctions.

To give counsel more time to prepare for the invalidity trial, the jury will be selected on Monday, given introductory instructions and shown the FJC video on the patent process before they are sent home for the rest of the day. The actual invalidity trial will begin on Tuesday and should be concluded by Wednesday. Inequitable conduct and sanctions will be argued on Thursday. Trial days will begin at 9:00 and will run until 5:30, with at least an hour for lunch, a short break in the morning and another in the afternoon.

Counsel agreed that with the exception of experts, all witnesses would be sequestered. Counsel are either familiar with the court's visual presentation system or will make arrangements with the clerk for some instruction on the system.

No later than noon on Monday, February 4, defendants' counsel will advise plaintiff's counsel of the witnesses defendants will be calling on Tuesday and the order in which they will be called. Plaintiff's counsel shall have the same responsibility in advance of its case. Also, no later than 4:30 pm on Monday, February 4, counsel shall meet to agree on any exhibits that either side wishes to use in opening statements. Any disputes over the use of exhibits are to be raised with the court before the start of opening statements.

Counsel should use the microphones at all times and address the bench with all

objections. If counsel need to consult with one another, they should ask for permission to do so. Only the lawyer questioning a particular witness may raise objections to questions put to the witness by the opposing party and argue the objection at any bench conference.

Counsel are to provide the court with copies of documentary evidence before the start of the first day of trial.

Counsel agreed to the voir dire questions in the form distributed to them at the conference. The jury will consist of eight jurors to be selected from a qualified panel of fourteen. Each side will exercise three peremptory challenges.

Counsel discussed the form of the verdict and the instructions on liability. Final decisions on the instructions and form of verdict will be made at the instruction conference at the close of the liability phase of trial.

The following rulings were made on the parties' motions in limine.

Plaintiff's motions

1. Amend any judgment that is entered to allow plaintiff to obtain up-to-date sales information from defendants. DENIED as moot with the dismissal of the infringement claims.
2. Bifurcate the trial of inequitable conduct. The motion is GRANTED. The issue will be tried by the court after completion of the invalidity trial.
3. Preclude testimony of Harry Manbeck. GRANTED insofar as testimony relates to general

information regarding patents and the process in the PTO for issuing patents. Ruling reserved on testimony relating to the prosecution history of the '327 patent and plaintiff's alleged failure to provide prior art to the PTO.

4. Strike James Bollinger and Philip Hirschhorn from witness list. GRANTED.
5. Preclude defendants from offering a new theory of inequitable conduct. GRANTED.
6. Preclude evidence relating to bankruptcy proceeding. GRANTED.
7. Bifurcate trial of judicial estoppel defense. DENIED as unnecessary.
8. Strike ex parte testing and factual testimony of Dr. Wolfe. DENIED as moot.
9. Clarify "scan conversion." DENIED as unnecessary.

Defendants' motions

1. Limit testimony of plaintiff's experts, Stevenson and Gleicher. DENIED. Decisions will be made on objections to specific testimony, subject to certain rules. Any evidence not included in plaintiff's responses to interrogatories is barred *unless* it was provided to defendants in some other form. Testimony by the experts that is contrary to claim construction will not be allowed but they may testify about how the claims operate generally. The experts may not testify about anything that was not included at all in the expert reports but they may testify about matters that were included but with which defendants disagree.
2. Exclude plaintiff's expert testimony regarding claim construction as it relates to order in

which steps and functions recited in claims 17 and 22 occur. DENIED.

3. Exclude cumulative expert testimony. GRANTED to extent that plaintiff's experts' testimony overlaps.

4. Exclude evidence relating to claim 7 of '327 patent. GRANTED.

5. Exclude email referring to plaintiff's suit against defendants. GRANTED.

6. Exclude arguments that defendants stole invention. GRANTED.

7. Preclude plaintiff from presenting language in body of '327 patent and underlying application as evidence of disclosure of prior art references to the PTO. DENIED as unnecessary.

8. Preclude evidence regarding U.S. Patent Application No. 9/614,363, a continuation from the '327 patent. DENIED as it relates to inequitable conduct; GRANTED as it relates to obviousness.

9. Circumscribe the time in which plaintiff may seek damages. DENIED as moot. 10. Exclude evidence of willfulness during liability phase of trial. DENIED as moot.

11. Exclude testimony of Terry Musika. DENIED as moot.

12. Strike Musika's supplemental expert report. DENIED as moot..

Entered this 1st day of February 2008.

BY THE COURT:
/s/
BARBARA B. CRABB
District Judge