IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

- - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - -

ULTRATEC, INC. and
CAPTEL, INC.,

Plaintiffs,

v.

SORENSON COMMUNICATIONS,
INC. and CAPTIONCALL, LLC,

Defendants.

FINAL PRETRIAL CONFERENCE ORDER

13-cv-346-bbc

- - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - - -

A final pretrial conference was held in this case on October 2, 2014, before United States District Judge Barbara B. Crabb. Plaintiffs appeared by Kristin Graham Noel, Anthony Tomaselli, Josephine Benkers, Martha Jane Snyder, Stephen J. Garner and Matt Duchemin. Defendants appeared by Bryant Boren, Samara Kline, Jonathan Rubenstein, Brian Oaks and Allen Arntsen.

Counsel understand that they have no more than 9 days in which to try this case and have proffered an agreement on proposed time limits and procedures for efficient trial presentation. Each side will have 22 hours in which to present its case. Trial days will begin

at 8:30 amand will run until 5:00 pm, with at least an hour for lunch, a short break in the morning and another in the afternoon.

Counsel agreed to the voir dire questions in the form distributed to them at the conference, with one change. The opening sentence will now read: "This is a civil patent lawsuit involving eight United States patents that relate to telecommunications and voice-to-text transcription."

The jury will consist of ten jurors to be selected from a qualified panel of sixteen. Each side will exercise three peremptory challenges against the panel. Before counsel give their opening statements, the court will give the jury introductory instructions on the way in which the trial will proceed and their responsibilities as jurors. In addition, the court will play the patent video produced by the Federal Judicial Center.

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 instruction on the system.

No later than noon on Friday, October 10, plaintiffs' counsel is to advise defendants' counsel of the witnesses plaintiffs will be calling on Tuesday and the order in which they will be called. Counsel have agreed to give similar advice to the opposing party at the end of each trial day. Also, no later than noon on the Friday before trial, 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 keep in mind that opening statements are just that. Arguments are to be reserved for the end of the trial.

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.

If counsel call the opposing party's witnesses as adverse witnesses, counsel for the opposing party may choose whether (1) to ask only clarifying questions of the witness and call the witness in its own case; or (2) do all its questioning during its opponent's case, in which instance the party calling the witness will have an opportunity to respond with questioning. If counsel choose the first option, they are free to call the witness during their case. Counsel have the same two options as to any adverse witness; they are not bound by their decision on questioning any previous witness. This rule of allowing full questioning of any witness during the other side's case will not apply to questioning of witnesses about validity during the infringement portion of the trial.

Counsel are to provide copies of documentary evidence to the court before the start of the first day of trial. They should prepare jury notebooks for the jury, with a copy of each of the patents in issue and a picture of each witness. After I read the introductory

instructions to the jurors, I will give each of them a copy to add to their notebooks.

Counsel know that matters that have been kept under seal during the pendency of this case, including exhibits, will be disclosed to the public to the extent they are the subject of testimony. The only exception to this is that the parties may maintain the secrecy of their licensing fees and terms. The jury will see all of the exhibits that are received in evidence but the exhibits themselves will not be part of this court's record; counsel are responsible for their own exhibits.

Counsel discussed the form of the verdict and the instructions. I will not instruct the jury in the introductory instructions that "selling" includes licensing or offering to license, but will consider doing so in the post-trial liability instructions. I will, however, explain the burdens of proof in the introductory instructions. Final decisions on the instructions and form of verdict, including whether to ask separate questions on direct infringement and infringement under the doctrine of equivalents, will be made at the post trial instruction conference at the end of the liability phase of trial. I agreed to the parties' proposal to delete the last paragraph of the instruction on method claims, as no longer needed, and to add to the next to last paragraph of the same instruction, the words "defendants actually performed" before the word "each" in the first line of the paragraph. I am deleting the words "is actually performed" after "method" in the same line.

No later than noon on Saturday, October 4, 2014, plaintiffs are to expand on their

motion in support of partial reconsideration relating to secondary considerations on nonobviousness, identifying the specific claims that they believe need construction, setting out their supporting arguments and explaining what they mean by *nearly* simultaneous and how a jury would be expected to understand this term. Defendants may have until 5:00 pm on Monday, October 6, 2014, in which to respond.

In other matters, plaintiffs asked to be able to rely on summary judgment evidence in proving up their equitable defenses. I will reserve a ruling on that request.

Plaintiffs said that they will not proceed on claims 1-6 of the '835 patent and claim 10 of the '578 patent on the condition that defendants will drop their invalidity challenges to these claims. Defendants are to respond to plaintiffs on this point no later than 5:00 pm on Monday, October 6. Plaintiffs intend to put in evidence of direct infringement of the remaining claims of the '835 patent (claims 7 and 8) and claim 2 of the '740 patent.

Also, no later than 5:00 pm on October 6, defendants are to notify plaintiffs of any claims on which they do not intend to proceed.

Plaintiffs asked for a curative instruction in connection with Gregg Vanderheiden's testimony, a copy of which has been sent to them. The parties may have until 5:00 pm on October 6 to respond. In the draft, I said that defendants could introduce Dr. Vanderheiden's testimony and the email he sent to the FCC as evidence of defendants' state of mind. Plaintiffs have questioned whether this evidence is relevant to state of ming

because defendants have not suggested that they were aware of the email. At trial, defendants must provide such evidence if they intend to rely on the email.

Plaintiffs asked that in connection with proving the infringement of dependent claim 6 of the '482 patent, they be allowed to tell the jury that the court has found that independent claim 1 of the '482 patent to be infringed. The parties may raise this again for reconsideration, but at this point, I am not persuaded that it is necessary to give this information to the jury. The question for the jury's consideration is whether the disputed elements of claim 6 have been infringed, not whether any other claims have been infringed.

I understand that the parties have no disputes about what qualifies as prior art, although it remains an open question whether Ryan anticipates. No later than 5:00 pm on Monday, October 6, defendants are to submit their arguments on the continuing existence of a dispute over Ryan's enablement. Plaintiffs may have until 5:00 pm on Tuesday, October 7, to respond.

Defendants have noticed Nicholas Seay as a witness; plaintiffs contend that he has no relevant information, which seems likely. Defendants are to advise plaintiffs no later than 5:00 pm on Wednesday, October 8, whether they intend to call Seay.

Also, no later than 5:00 pm on Wednesday, October 8, the parties are to exchange their final deposition designations.

It is not necessary for the parties to provide exhibit binders to opposing counsel in

advance of examination of any witness.

The parties agree that the '314 patent claims priority to the '482 patent.

I will reserve a ruling on apportionment of damages (whether it is necessary and, if so, how it is to be done) until the damages phase of the trial.

Finally, I note that the court denied plaintiffs' motion in limine no. 16, dkt. #464, to preclude evidence related to the pending inter partes proceeding on the ground of mootness after dismissing plaintiffs' claims of induced infringement. Plaintiffs have pointed out that their motion also refers to invalidity and willfulness, which are still at issue. I will reconsider plaintiffs' motion and issue a separate order on the remaining issues.

Entered this 3d day of October, 2014.

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