IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

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

JOHN MEZZALINGUA ASSOCIATES, INC.,
d/b/a/ PPC,

FINAL PRETRIAL
CONFERENCE ORDER

Plaintiff,

03-C-353-C

v.

ARRIS INTERNATIONAL, INC.,

Defendant.

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

A final pretrial conference was held in this case on November 25, 2003, before United States District Judge Barbara B. Crabb. David Harth, Sarah Reindl and Gabrielle Bina appeared for plaintiff. Lindley Brenza, Kaspar Stoffelmayr and Gregory Everts appeared for defendant.

We began by discussing the proposed voir dire questions. Plaintiff had several changes to suggest that were incorporated into the proposed voir dire questions. Counsel disagreed about the expected length of trial. For the purposes of jury selection, I will tell the panel that the case may last as long as seven days, although counsel agree that it will

probably be shorter than that. Counsel are aware that the trial will run from 9:00 a.m. to 5:30 p.m. each day with an hour for lunch. There will be eight jurors selected from a qualified panel of fourteen, with each side exercising three peremptory challenges. Counsel are aware that they will need to have enough witnesses on hand to fill the entire day and that they need to advise their opponent of the witnesses they expect to call the next day. A sequestration order will be in effect.

Counsel advised the court that they are preparing notebooks for the jury that will include a copy of the patent and other materials that will help the jurors follow the evidence and the arguments in the case.

Just before the final pretrial conference, defendant filed a memo to limit pre-suit damages. Plaintiff has no objection to the motion.

Turning to the motions in limine, I GRANTED plaintiff's motion to exclude references to unrelated litigation. Defendant had no objection to the motion. I GRANTED defendant's motion to exclude references to the Florida litigation on the ground that such references would have no relevance during the liability phase of trial. If plaintiff believes the Florida litigation is relevant at the damages phase, plaintiff can renew its request to have the evidence admitted at that time. I made the same ruling with respect to defendant's motion to exclude any references to the preliminary injunction proceeding.

I DENIED plaintiff's motion to exclude the testimony of Mr. McGlynn, ruling that

he has sufficient skill in the art to testify as to what an ordinary person would have known at the relevant time and also that he can testify about the file history of the '194 patent. I reserved a ruling about whether he could testify about the practices within the patent office. Having had the opportunity to review the case law, I will GRANT plaintiff's motion to exclude any testimony about the workings of the patent office and specifically, whether a patent examiner would necessarily have read every listed piece of prior art. McGlynn's testimony seems to be directed to suggesting that the parent examiner for the '194 patent was too busy and too pressed for time to "conduct [her] analysis according to the governing regulations." Id. Such testimony would conflict with the presumption that government officials are presumed to have '"properly discharged their official duties.'" In re Portola Packaging, Inc., 110 F. 3d 786, 790 (Fed. Cir. 1997) (quoting U.S. v. Chemical Foundation, Inc., 272 U.S. 1, 15 (1926)).

I DENIED defendant's motion to exclude certain testimony of Professor Eldering and ruled that he was qualified to testify as an expert. (Of course, it is ultimately up to the jury to decide whether to accept Mr. McGlynn or Professor Eldering as experts.)

Defendant advised the court that it did not intend to move for the admission of the declarations of Yao, Huang and Wang.

I GRANTED plaintiff's motion to exclude some of documents attached to these declarations, namely, the drawings of the connector and the injection molds as hearsay

evidence that cannot come in under the business records exception. However, I ruled that the purchase orders can be admitted under the business records exception to the hearsay rule.

Defendant's motion to exclude the oral statements of the patent examiner is GRANTED and its motion to exclude the testimony of Patrick Henry is DENIED.

Defendant moved to exclude any evidence of supplemental testimony by Dr. Osswald and to bar the admission of Osswald's new photographs. The motion was GRANTED. The new testing was done too late to be admissible.

Defendant moved also to exclude Professor Eldering from testifying about samples of several "T" connectors manufactured by defendant that plaintiff says were received only recently. There is a dispute about when plaintiff received the new samples. Until that dispute is resolved, I will reserve a ruling on the motion to exclude the testimony.

The parties discussed the proposed form of the verdict. Plaintiff pointed out that the verdict form should not include Question 9 about the intentional withholding of material prior art from the patent examiner because it is up to the court to decide questions relating to inequitable conduct. That question will be omitted from the verdict form. Also omitted from the verdict form will be Questions 5 and 6 which relate to anticipation. Defendant has advised the court that it will not be arguing anticipation. Finally, defendant advised the court that it has several grounds for asserting the obviousness of claims 1 and 2 of the '194

patent and not just the combination of the Holliday '220 patent and the Saba '043 patent. Therefore, present Questions 7 and 8 (to be renumbered to 5 and 6) will be changed to read "Is claim 1 [or 2] of the '194 patent obvious?"

The question of wilfulness will be tried during the damages portion of the trial. The issue of inequitable conduct will be tried to the court while the jury is deliberating after the liability phase.

Plaintiff has opposed the jury instruction proposed by defendant that would direct the jury to consider only the shape of the compression ring in its "first pre-installed position over the outer sleeve." I agreed with plaintiff that such a jury instruction would be incorrect in view of the rulings made on claim construction.

Entered this 26th day of November, 2003.

BY THE COURT:

BARBARA B. CRABB
District Judge