

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

THIRD WAVE TECHNOLOGIES, INC.,

Plaintiff,

v.

STRATAGENE CORPORATION,

Defendant.

ORDER

04-C-680-C

A final pretrial conference was held in this case on August 11, 2005, before United States District Judge Barbara B. Crabb. Plaintiff Third Wave Technologies, Inc., appeared by Donald Best, Tom Pasternak, Mark Pals and Cindy Ahn. Defendant Stratagene Corporation appeared by James Peterson, Kevin Bell and Mark Labgold.

Counsel approved the proposed voir dire questions in the form distributed to them at the final pretrial conference with one exception. The question involving genetically engineered foods will be removed from the voir dire. Counsel also agreed that the magistrate judge could select the jury and give the jury the introductory instructions and preside over the showing of the Federal Judicial Center video on patent cases.

Counsel were advised that the schedule for the trial would be as follows: Jury selection would take place on Monday before the magistrate judge following the selection of the jury in Henderson v. Belfueil. Trial would actually begin on Tuesday morning, August 23, 2005, at 9:00 a.m. Trial on Tuesday, Wednesday and Thursday would last from 9:00 a.m. to 5:30 p.m., with an hour for lunch. On Friday, August 26, 2005, trial will last from 9:00 a.m. until 2:00 p.m. with no real lunch break, but two shorter breaks during the morning. During the second week, trial in this case would begin at 1:30 p.m. and last until 6:30 p.m. On Tuesday morning, the trial would begin at 8:00 a.m. and last until 1:00 p.m. and the same schedule would be followed for Wednesday, Thursday and Friday if the trial lasts that long.

Trial in this case will be bifurcated. Counsel are not to refer to the matter of damages in the liability phase of trial. The question of wilfulness will be tried during the damages phase of the trial.

Eight jurors will be selected from a qualified panel of fourteen. Each side will exercise three peremptory challenges to the qualified panel.

All witnesses will be sequestered, with the exception of expert witnesses and corporate representatives. Counsel are to confer on the question of allowing Kevin Conroy to remain in the courtroom during the trial when he is going to be testifying as a witness.

No later than Monday, August 22, 2005, plaintiff is to advise defendant of the witnesses it will be calling on Tuesday, August 23, 2005, and of the order that it will be

calling them. Thereafter, at the end of each trial day, the party calling the witnesses the next day will advise the other party of the witnesses it intends to call and the order in which it will be calling them. It is each side's responsibility to ensure that it has a full slate of witnesses ready to testify each day.

Counsel are to provide the court with exhibit lists and copies of documentary exhibits no later than Monday, August 22, 2005.

Counsel are to work together to prepare notebooks for the jurors to use during the trial that will include copies of the patents or portions of them and a list of the words that will be used in the trial and the court's claim constructions.

Counsel have agreed between themselves to divide up their time equally. They will do their own timekeeping.

The parties are still disputing ownership of the patents in issue. They have agreed that the court can resolve the question. Plaintiff will file a brief on the issue no later than Wednesday, August 16, 2005. The response brief is due Wednesday, August 24, 2005, and plaintiff may have until August 29, 2005, in which to file and serve a reply brief.

On the motions in limine, the following rulings were made:

1. Defendant's motion to bar plaintiff from introducing any evidence related to indirect infringement other than the May 20, 2005 stipulation is DENIED.
2. Defendant's motion to hold plaintiff to the claim construction in Third Wave

Technologies, Inc. v. EraGen Biosciences, Inc., is GRANTED.

3. Defendant's motion to limit plaintiff's evidence on direct infringement to the issue of its actual "use" of the claimed methods is DENIED.

4. Defendant's motion to bar plaintiff from submitting any evidence regarding direct infringement not previously disclosed is DENIED as premature. Defendant may raise the issue again if any such evidence is proposed by plaintiff.

5. Defendant's motion to bar the use of statements by its employees related to a discussion about the possible need to obtain a license from plaintiff in order to market *Pfu* FEN-1 is DENIED.

6. Defendant's motion to bar plaintiff from attempting to offer expert testimony not previously disclosed is DENIED as premature. However, the parties are limited to the expert testimony disclosed in expert reports.

7. Defendant's motion to bar plaintiff from arguing infringement under the Doctrine of Equivalents is moot.

8. Defendant's motion to omit the reading of any attorney colloquy in deposition designations is GRANTED. However, counsel may re-raise this subject if he believes any colloquy is necessary to the jury's understanding of the questions and answers given.

9. Defendant's motion to bar all reference to other litigation in which it was a party is GRANTED. That ruling applies to litigation involving plaintiff as well, with the

exception of the EraGen litigation.

10. Defendant's motion to bar plaintiff from asserting that the date of conception was earlier than December 26, 1995, is GRANTED as unopposed.

11. Plaintiff's motion to substantially limit the scope of testimony of defendant's expert, Dr. Joseph Falkinham, is GRANTED with respect to FEN-1 nucleases, DENIED as to his testimony on anticipation, DENIED as to his testimony on Gelfand and Turchi prior art and GRANTED with respect to obviousness, DENIED with respect to failure to comply with 35 U.S.C. § 112 and DENIED with respect to non-enablement.

12. Plaintiff's request to bar defendant from presenting evidence or argument related to three affirmative defenses is DENIED with respect to any exemption under 271(e)(1), but such evidence would come in only in the damages phase of the trial. As to inequitable conduct the motion is GRANTED and as to prosecution history estoppel the motion is DENIED as moot.

13. Plaintiff's motion to preclude defendant from asserting that plaintiff's '717 patent is prior art to the '314 and '543 patents is RESERVED for ruling at a later time.

14. Plaintiff's motion to preclude defendant from entering evidence related to its patents nos. '254, '250, '580 is GRANTED.

15. Plaintiff's motion to bar defendant from introducing evidence comparing its products to plaintiff's products covered by the patents at issue is DENIED.

16. Plaintiff's motion to preclude defendant from presenting evidence at trial regarding its reliance on opinions of counsel for defendant's failure to comply with discovery requests is GRANTED. Defendant may elicit such evidence only if it has been previously disclosed to plaintiff.

17. Plaintiff's motion to preclude defendant from introducing at trial nineteen inadvertently disclosed documents allegedly containing privileged information is GRANTED with respect to the specified pages of Exhibits 962, 966, 994, 1024, 1026 and 1030. It is DENIED with respect to the unspecified pages of these exhibits and with respect to Exhibits 1191, 1221, 1223, 1226, 1227, 1228, 1230 and 1231.

Entered this 12th day of August, 2005.

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