

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

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PROCTOR & GAMBLE  
COMPANY,

Plaintiff,

FINAL PRETRIAL  
CONFERENCE ORDER

08-cv-251-bbc

v.

McNEIL-PPC, INC.,

Defendant.

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A final pretrial conference was held in this case on May 21, 2009, before United States District Judge Barbara B. Crabb. Plaintiff appeared by Paul Keller and Dave Bassett. Defendant appeared by Ray Nimrod, David Eiseman, Kristin Graham-Noel, Gregory Bonifield and Chris Mathews.

Counsel predicted that the case would take 4 days to try. If it runs longer, it will be continued the following week. 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 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 the Friday before trial, plaintiff's counsel will advise defendant's counsel of the witnesses plaintiff will be calling on Monday and the order in which they will be called. Counsel should give similar advice at the end of each trial day; defendant's counsel shall have the same responsibility in advance of defendant's case. 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 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 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 against the entire panel. Before counsel give their opening statements, the court will give the jury the introductory instructions on the way in which the trial will proceed and their responsibilities during the trial and show the Federal Judicial Center patent video.

Counsel are to prepare juror notebooks that include a copy of the '240 patent, a

listing of the construed claims, including “low flexural stiffness,” which shall read: “a combination of strip thickness, width and elasticity that allows a strip to conform readily to the surface of the teeth with little pressure” as written on page 46 of the court’s May 12, 2009 order rather than “the quality of the strip of material that allows it to easily conform to the surface of the teeth with little pressure” as written on page 58 of the same order. The notebook should also contain the parties’ agreed upon definition of the person of ordinary skill in the art.

Counsel discussed the form of the verdict and the instructions on liability. Plaintiff’s counsel stated that it would be asserting only claims 1-3 and 14 at trial. No later than noon on Friday, May 28, and preferably earlier, defendant’s counsel are to pare down their prior art designations and give plaintiff’s counsel a final list of prior art references on which they intend to rely at trial. The verdict will be amended at the instruction conference to reflect the relevant prior art references. At the same time, the court will make final decisions on the instructions and form of verdict.

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

Plaintiff’s Motions in Limine

\_\_\_\_\_ 1. Preclude defendant from making any comparison of accused product to commercial embodiment of claimed technology. GRANTED.

2. Preclude defendant from introducing any evidence about the possible issuance of an injunction, award of treble damages and attorney fees. GRANTED.

3. Preclude defendant from introducing evidence of or referring to any evidence of prior art not disclosed to plaintiff. GRANTED as unopposed.

4. Preclude defendant from introducing any evidence about the work load of the PTO or making any effort to disparage the PTO. GRANTED as unopposed.

5. Preclude defendant from introducing any testimony by any witness not properly disclosed. DENIED as overbroad except as to witnesses not properly disclosed under Rule 26.

6. Preclude defendant from introducing any evidence suggesting that patent issued under wrong standard of obviousness. DENIED.

7. Preclude defendant from introducing any evidence regarding plaintiff's duty of candor or any claim of inequitable conduct. GRANTED. However, defendant may argue that certain prior art was not before the examiner at the time he approved plaintiff's application for the '240 patent.

8. Preclude defendant from introducing any testimony by fact witnesses regarding matters of law. DENIED.

9. Preclude defendant from introducing any evidence that the accused product does not infringe because it does not dissolve. DENIED. Defendant is not precluded from saying

that the accused produce dissolves so long as it does not suggest that the dissolving feature makes the product non-infringing.

10. Preclude defendant from introducing any evidence that accused product does not infringe because the “thin” layer does not have structural integrity. GRANTED as unopposed.

11. Preclude defendant from introducing any evidence that the tooth whitening composition layer of accused product is not “physically separate” or “physically separable” from the alleged strip of material. GRANTED under court’s determination during claim construction that tooth whitening composition layer must be separate and distinct from the strip of material but that this does not mean that layers must be separable or capable of being separated from each other.

12. Preclude defendant from introducing any evidence that the accused product does not infringe because the unfinished layer is not sized during manufacturing to cover one or more teeth. GRANTED as unopposed.

13. Preclude defendant from introducing any argument by defendant that the accused product does not infringe because the claims require the peroxide concentration to be measured at some specific time. GRANTED as unopposed.

14. Preclude defendant from creating its own definitions and tests for “flexural stiffness.” GRANTED.

15. Preclude defendant from introducing any arguments by defendant that the “Handle-O-Meter” is the only appropriate test or a required test to determine the low flexural stiffness of a product that allegedly infringes. DENIED, without prejudice.

16. Preclude defendant from suggesting or arguing that flexural stiffness is a property of the material used to make the strip of material, rather than a property of the strip of material itself. DENIED.

17. Preclude defendant from introducing any evidence that the claimed strip of material must be solid. DENIED, without prejudice.

18. Preclude defendant from introducing any evidence that the claimed strip of material is a delivery system. DENIED.

19. Preclude defendant from introducing any evidence that the claimed “tooth whitening system” must be gel. DENIED as moot.

20. Preclude defendant from introducing any evidence about Johnson & Johnson’s acquisition of the Rembrandt product from plaintiff. DENIED.

21. Preclude defendant from introducing any evidence regarding the parties’ revenues, profits or wealth. GRANTED, as to liability phase of trial.

22. Preclude defendant from introducing any evidence regarding any other litigation involving plaintiff or defendant. GRANTED.

23. Preclude defendant from introducing any evidence concerning court’s denial of

any dispositive motion. GRANTED.

24. Preclude defendant from introducing any evidence concerning any motion in limine brought by any party. GRANTED.

25. Preclude defendant from introducing any evidence during liability phase of trial to plaintiff's response to entrance of other competitors' products into the oral care commercial market. GRANTED.

26. Preclude defendant from introducing any evidence during liability phase of trial concerning amount of damages that plaintiff is seeking from defendant. GRANTED, as unopposed.

27. Preclude Dr. Anthony Brennan from testifying that he is skilled in the art of tooth whitening products. DENIED.

28. Preclude defendant from introducing any evidence relating to '579 patent. DENIED, subject to reconsideration if plaintiff can show that its expert Smith can separate the damages attributable to the '240 patent from those attributable to the '579 patent.

29. Preclude defendant from introducing any testimony from its experts, Dr. Freeman and Dr. Brennan. Dkt. #380. GRANTED with respect to any testimony from these experts that "separate" means "separable." DENIED as to whether the "thin layer" has low flexural stiffness in isolation and therefore in final product and if these experts offer evidence of microscopic images.

30. Designate a limited amount of prior art to assert at trial. Dkt. #381.  
GRANTED.

31. Grant leave to file motion in limine to preclude defendant from offering the testimony of its expert, James Sheridan. Leave to file is GRANTED; motion is DENIED without prejudice.

#### Defendant's Motions in Limine

\_\_\_\_\_ 1. Preclude plaintiff from seeking pre-suit damages by offering evidence relating to information subject to Dec. 6, 2007 confidentiality agreement. Dkt. #384. GRANTED.

2. Preclude plaintiff from introducing expert testimony on the 2002 Gerlach-Sagel article, dkt. #389. GRANTED, as unopposed.

3. Preclude plaintiff from introducing the testimony of Daniel Smith on commercial success or other secondary indicia of non-obviousness. Dkt. #385. DENIED without prejudice, subject to plaintiff's showing that Smith has information relating solely to the '240 patent.

4. Preclude plaintiff from introducing any evidence about damages and willfulness during liability phase of trial, dkt. #386. GRANTED. Willfulness is no longer part of case.

5. Preclude plaintiff from introducing any evidence asserting that plaintiff told the PTO that the Crest Whitestrips Original or Professional Products were prior art. Dkt. #387.



DENIED.

6. Preclude plaintiff from introducing any evidence relating to the activities or financial results of Pfizer or Johnson & Johnson, dkt. #388. GRANTED.

7. Preclude plaintiff from offering opinions, argument or or evidence based on its untimely supplemental expert opinions, dkt. #390, is GRANTED.

8. Preclude plaintiff from offering opinions, argument or evidence on the doctrine of equivalents, dkt. #396. GRANTED. Plaintiff has not disclosed any such opinions.

Entered this 27th day of May, 2009.

BY THE COURT:

/s/

BARBARA B. CRABB

District Judge