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**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

<p>PRESIDIO COMPONENTS, INC., Plaintiff, vs. AMERICAN TECHNICAL CERAMICS CORP., Defendant.</p>	<p>CASE NO. 14-CV-2061-H (BGS) ORDER: (1) GRANTING IN PART AND DENYING IN PART PLAINTIFF’S MOTIONS IN LIMINE; AND [Doc. No. 242.] (2) GRANTING IN PART AND DENYING IN PART DEFENDANT’S MOTIONS IN LIMINE [Doc. No. 246.]</p>
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On February 26, 2016, the parties each filed five motions in limine to exclude certain evidence. (Doc. Nos. 242, 246.) On March 11, 2016, the parties filed their oppositions. (Doc. Nos. 272, 273.) On March 18, 2016, the parties filed their replies. (Doc. Nos. 266, 267.) The Court held a hearing on the matter on March 25, 2016. Brett A. Schatz and Gregory F. Ahrens appeared for Presidio. Ronald E. Cahill, Peter F. Snell, and Heather Repicky appeared for ATC. For the reasons below, the Court grants in part and denies in part Presidio’s motions in limine, and the Court grants in part and denies in part ATC’s motions in limine.

1 **Background**

2 On September 2, 2014, Plaintiff Presidio Components, Inc. filed a complaint for
3 patent infringement against Defendant American Technical Ceramics Corp., alleging
4 infringement of U.S. Patent No. 6,816,356 (“the ’356 patent”). (Doc. No. 1, Compl.)
5 On December 8, 2015, the United States Patent and Trademark Office issued a
6 reexamination certificate for the ’356 patent, amending certain claims of the patent.¹
7 (Doc. No. 170-2, FAC Ex. 2.) Amended claim 1 of the ’356 patent, the only
8 independent claim asserted by Presidio in this action, is as follows:

9 1. A capacitor comprising:

10 a substantially monolithic dielectric body;

11 a conductive first plate disposed within the dielectric body;

12 a conductive second plate disposed within the dielectric body and forming
13 a capacitor with the first plate;

14 a conductive first contact disposed externally on the dielectric body and
15 electrically connected to the first plate; and

16 a conductive second contact disposed externally on the dielectric body and
17 electrically connected to the second plate, and the second contact being
18 located sufficiently close to the first contact in an edge to edge relationship
19 in such proximity as to form a first fringe-effect capacitance with the first
20 contact that is capable of being determined by measurement in terms of a
21 standard unit.

22 U.S. Patent No. 6,816,356 C2, at 1:23-36 (Reexamination Certificate filed Dec. 8, 2015)
23 (emphasis removed from original).

24 On December 22, 2015, Presidio filed a first amended complaint, alleging
25 infringement of the ’356 patent as amended by the reexamination certificate. (Doc. No.
26 170, FAC.) Specifically, Presidio alleges that ATC’s 550 line of capacitors infringes
27 claims 1, 3, 5, 16, 18, and 19 of the ’356 patent. (Id. ¶ 26.) On December 22, 2015,
28 ATC filed a second amended answer and counterclaims to the first amended complaint.
(Doc. No. 171.) On February 10, 2016, the Court granted ATC’s motion for summary

¹ The PTO previously issued a reexamination certificate for the ’356 patent on
September 13, 2011. (Doc. No. 170-1, FAC Ex. 1.) This reexamination certificate did not
alter any of the claims at issue in the present action. (Id.)

1 judgment of its affirmative defense of absolute intervening rights and held that Presidio
2 is entitled to infringement damages only for the time period following the issuance of
3 the reexamination certificate on December 8, 2015. (Doc. No. 234.)

4 **Discussion**

5 **I. Presidio's Motion in Limine No. 1**

6 In its first motion in limine, Presidio moves to exclude all testimony, evidence,
7 and argument related to any contention by ATC that the '356 patent is invalid, including
8 all testimony, evidence, and argument related to ATC's affirmative defense that the
9 '356 patent is invalid due to indefiniteness. (Doc. No. 242-1 at 4-8.) Presidio argues
10 that invalidity due to lack of patentable subject matter under 35 U.S.C. § 101, lack of
11 novelty under 35 U.S.C. § 102, or obviousness under 35 U.S.C. § 103 is not at issue in
12 the present case. (Id. at 4.) Presidio further argues that although invalidity due to
13 indefiniteness is at issue in this case, indefiniteness is a question of law for the Court
14 to decide, and, therefore is not relevant to the factual issues to be decided by the jury.
15 (Id. at 4-5.) In response, ATC argues that Presidio's motion should be denied because
16 it is common for courts to permit the jury to hear evidence on issues to be decided by
17 the court in order to have a unified trial. (Doc. No. 273 at 2, 6.) ATC further argues
18 that there should be a unified trial on the issues of indefiniteness and infringement
19 because its indefiniteness defense is inextricably intertwined with its non-infringement
20 defense. (Id. at 4-6.)

21 The Court agrees that indefiniteness is a question of law involving underlying
22 factual determination to be decided by the Court. See Teva Pharm. USA, Inc. v.
23 Sandoz, Inc., 789 F.3d 1335, 1341 (Fed. Cir. 2015). But, Presidio's motion is premised
24 on the notion that the Court will hold a bifurcated trial where there will be a jury trial
25 on the issue of infringement and other questions of fact and then a separate bench trial
26 on the issue of indefiniteness. Exercising its sound discretion and for the reasons
27 discussed at the hearing, the Court declines to bifurcate the trial on the issue of
28 indefiniteness. The Court agrees with ATC that much of its indefiniteness defense is

1 inextricably intertwined with its non-infringement defense, and, therefore, in the interest
2 of judicial economy, the Court will hold one trial on the issues of both infringement and
3 invalidity.² See Hangarter v. Provident Life & Acc. Ins. Co., 373 F.3d 998, 1021 (9th
4 Cir. 2004) (affirming district court’s refusal to bifurcate trial where there was a
5 substantial overlap in evidence between the claims at issue); see also Zivkovic v. S.
6 California Edison Co., 302 F.3d 1080, 1088 (9th Cir. 2002) (“Rule 42(b) of the Federal
7 Rules of Civil Procedure confers broad discretion upon the district court to bifurcate a
8 trial.”). Accordingly, the Court denies Presidio’s first motion in limine without
9 prejudice to any contemporaneous objections at trial made outside the presence of the
10 jury.

11 **II. Presidio’s Motion in Limine No. 2**

12 In its second motion in limine, Presidio moves to exclude all testimony, evidence
13 and argument related to ATC’s affirmative defense of intervening rights. (Doc. No.
14 242-1 at 8-12.) Presidio argues that ATC’s affirmative defense of absolute intervening
15 rights has already been ruled on by the Court, and ATC’s defense of equitable
16 intervening rights is an equitable issue to be decided by the Court. (Id. at 8-9) Presidio
17 argues, therefore, that ATC’s intervening rights affirmative defense is not relevant to
18 any of the factual issues to be decided by the jury. (Id.) In response, ATC argues that
19 Presidio’s motion should be denied because evidence related to its defense of equitable
20 intervening rights is also relevant to the jury issues of damages and willfulness. (Doc.
21 No. 273 at 7-10.) ATC further argues that in light of this overlap of evidence, the issue
22 of equitable intervening rights should be presented in a single trial along with the
23 factual issues to be decided by the jury. (Id.)

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25 ² In addition, exercising its discretion, the Court concludes that it is appropriate in this
26 case to present the issue of invalidity due to indefiniteness to an advisory jury. See Fed. R.
27 Civ. P. 39(c) (“In an action not triable of right by a jury, the court, on motion or on its own:
28 (1) may try any issue with an advisory jury”); DePuy Spine, Inc. v. Medtronic Sofamor
Danek, Inc., 567 F.3d 1314, 1324 (Fed. Cir. 2009) (“If a district court believes that an
advisory verdict would be helpful, . . . then one may be obtained under Federal Rule of Civil
Procedure 39(c).”).

1 The Court has already ruled on ATC’s affirmative defense of absolute
2 intervening rights, and, therefore, that issue has been resolved. (See Doc. No. 234.)
3 ATC’s affirmative defense of equitable intervening rights remains, but it is an equitable
4 issue to be decided by the Court. See 35 U.S.C. § 252; Revolution Eyewear, Inc. v.
5 Aspex Eyewear, Inc., 563 F.3d 1358, 1373 (Fed. Cir. 2009). Further, exercising its
6 sound discretion, the Court concludes that it is appropriate under the present
7 circumstances, to bifurcate the trial with respect to the issue of equitable intervening
8 rights, and have that issue decided by the Court, if necessary, after the jury trial on the
9 other issues in this case has been completed. See Fed. R. Civ. P. 42(b); Zivkovic, 302
10 F.3d at 1088 (“Rule 42(b) of the Federal Rules of Civil Procedure confers broad
11 discretion upon the district court to bifurcate a trial.”).

12 In light of the Court’s decision to bifurcate the trial as to the issue of equitable
13 intervening rights, the Court grants Presidio’s second motion in limine. See Fed. R.
14 Evid. 402, 403. The Court excludes all testimony, evidence and argument related to
15 ATC’s affirmative defense of absolute and equitable intervening rights, absent a further
16 showing from ATC as to relevance.

17 **III. Presidio’s Motion in Limine No. 3**

18 In its third motion in limine, Presidio moves to exclude all testimony, evidence
19 and argument related to ATC’s affirmative defenses of laches, equitable estoppel, and
20 waiver. (Doc. No. 242-1 at 12-15.) Presidio argues that these equitable affirmative
21 defenses are to be decided by the Court, and, therefore, are not relevant to any of the
22 factual issues to be decided by the jury. (Id.) In response, ATC argues that Presidio’s
23 motion should be denied because the evidence underlying these affirmative defenses
24 is also relevant to issues to be decided by the jury. (Doc. No. 273 at 10-12.) ATC
25 further argues that theses affirmative defenses should be presented in a single trial along
26 with the issues of fact to be decided by the jury. (Id.)

27 ATC’s affirmative defenses of laches, equitable estoppel, and waiver are all
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1 equitable issues to be decided by the Court. See A.C. Aukerman Co. v. R.L. Chaides
2 Const. Co., 960 F.2d 1020, 1028 (Fed. Cir. 1992) (en banc); Qualcomm Inc. v.
3 Broadcom Corp., 548 F.3d 1004, 1019 (Fed. Cir. 2008). Further, exercising its sound
4 discretion, the Court concludes that it is appropriate under the present circumstances,
5 to bifurcate the trial with respect to these equitable issues, and have these equitable
6 issues decided by the Court, if necessary, after the jury trial on the other issues in this
7 case has been completed. See Fed. R. Civ. P. 42(b); Zivkovic, 302 F.3d at 1088 (“Rule
8 42(b) of the Federal Rules of Civil Procedure confers broad discretion upon the district
9 court to bifurcate a trial.”).

10 In light of the Court’s decision to bifurcate the trial as to the issue of laches,
11 equitable estoppel, and waiver, the Court grants Presidio’s second motion in limine.
12 See Fed. R. Evid. 402, 403. The Court excludes all testimony, evidence and argument
13 related to ATC’s affirmative defenses of laches, equitable estoppel, and waiver, absent
14 a further showing from ATC as to relevance.

15 **IV. Presidio’s Motion in Limine No. 4**

16 In its fourth motion in limine, Presidio moves to exclude all testimony, evidence,
17 and argument related to prior settlement negotiations between the parties. (Doc. No.
18 242-1 at 15-19.) Presidio argues that evidence of conduct or statements made in
19 settlement negotiations is inadmissible under Federal Rule of Evidence 408. (Id. at 16.)
20 Presidio further argues that even if such evidence is admissible it should be excluded
21 under Federal Rule of Evidence 403 because such evidence is prejudicial to Presidio
22 and would confuse or mislead the jury. (Id. at 18.) In response, ATC argues that the
23 evidence related to the parties’ prior settlement negotiations is admissible and relevant
24 to the issues of willfulness, induced infringement, and damages. (Doc. No. 273 at 13-
25 15.)

26 The evidence of the parties’ prior settlement negotiation primarily relates to
27 ATC’s equitable defenses which will be tried to the Court, if necessary, in a separate
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1 trial. Moreover, to the extent any of the parties' prior settlement negotiations are
2 relevant to any of the issues to be tried before the jury, the Court concludes that the
3 probative value of such evidence is substantially outweighed by the danger of unfair
4 prejudice to Presidio and the risk of confusing or misleading the jury. Accordingly, the
5 Court grants Presidio's fourth motion in limine. See Fed. R. Evid. 403, 408. The Court
6 excludes all testimony and evidence related to prior settlement negotiations between the
7 parties, absent a further showing from ATC.

8 **V. Presidio's Motion in Limine No. 5**

9 In its fifth motion in limine, Presidio moves to exclude all testimony, evidence,
10 and argument by ATC that U.S. Patent No. 8,446,705 ("the '705 patent") covers the
11 accused products and provides a defense to infringement or liability. (Doc. No. 242-1
12 at 19-21.) Presidio argues that whether ATC owns a patent that allegedly covers the
13 accused products is not relevant to any of the issues in the case, for example whether
14 the accused products infringe the '356 patent. (Id.) ATC argues that it is entitled to
15 refer to the '705 patent to rebut the opinions of Presidio's infringement expert, who
16 extensively cites to and relies on the '705 patent in his expert report. (Doc. No. 273 at
17 17-22.) In its reply, Presidio clarifies that it is not moving to exclude any reference to
18 the '705 patent by ATC. (Doc. No. 266 at 9-10.) Rather, it is only moving to exclude
19 evidence that the '705 patent covers the accused products as a defense to Presidio's
20 claims of infringement. (Id.)

21 The Court agrees with ATC that Presidio opened the door for reference to and
22 analysis of the '705 patent by having its infringement expert rely on that patent as part
23 of his infringement analysis. Therefore, ATC may reference and introduce evidence
24 related to the '705 patent at trial. Further, to the extent that Presidio contends that
25 ATC's rebuttal analysis of the '705 patent might go too far, the Court concludes that
26 this issue would more appropriately be addressed through a contemporaneous objection
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1 at trial.³ Accordingly, the Court denies Presidio's fifth motion in limine without
2 prejudice to any contemporaneous objections at trial made outside the presence of the
3 jury.

4 **VI. ATC's Motion in Limine No. 1**

5 In its first motion in limine, ATC moves to exclude portions of Dr. Huebner's
6 supplemental expert report and the opinions contained therein. (Doc. No. 251 at 1-5.)
7 Specifically, ATC argues that Dr. Huebner's supplemental expert report contains
8 material that is beyond the scope of what was permitted under the Court's Amended
9 Scheduling Order. (Id.) In response, Presidio argues that the content of Dr. Huebner's
10 supplemental expert report was in compliance with the Court's Amended Scheduling
11 Order. (Doc. No. 272 at 1-6.)

12 The Court agrees with Presidio that Dr. Huebner's supplemental expert report
13 complied with the Court's Amended Scheduling Order. Further, even assuming some
14 of the opinions contained in the supplemental expert report were technically outside the
15 scope of the Amended Scheduling Order, ATC suffered no prejudice from such
16 opinions. ATC was permitted to serve its own supplemental rebuttal expert report and
17 to depose Dr. Huebner regarding his supplemental expert report. (Doc. No. 207 at 3.)
18 Accordingly, the Court declines to exclude the opinions contained in Dr. Huebner's
19 supplemental expert report.

20 ATC also argues that the Court should exclude Dr. Huebner's opinions regarding
21 his simulation testing of the accused products. (Doc. No. 251 at 3-4.) ATC argues that
22 Dr. Hueber's simulation testing is now irrelevant in light of the Court's holding that a
23 fringe-effect capacitance that is merely derivable or calculatable by using theoretical
24 calculations or simulations is outside the scope of the amended claims. (Id. at 4 (citing
25 Doc. No. 234 at 20).) In response, Presidio argues that Dr. Huebner's simulation testing

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27 ³ In addition, the Court notes that in order to help remedy this issue, Presidio can also
28 submit a proposed jury instruction on the relevant law.

1 remains relevant. Presidio argues that although it does not directly prove that the
2 relevant limitation is satisfied by the accused products, Dr. Huebner's simulation testing
3 acts as a building block for his ultimate conclusion that the accused products satisfy the
4 limitations of the asserted claims. (Doc. No. 272 at 6-7.) The Court concludes that
5 ATC's challenges to Dr. Huebner's opinions at issue go to the weight of his testimony,
6 rather than its admissibility. Accordingly, the Court declines to exclude Dr. Huebner's
7 opinions regarding his simulation testing. See Alaska Rent-A-Car, Inc. v. Avis Budget
8 Grp., Inc., 738 F.3d 960, 970 (9th Cir. 2013) (affirming the denial of a motion to
9 exclude where the movant's challenges went to "the weight of the testimony and its
10 credibility, not its admissibility").

11 ATC also argues that Dr. Huebner's opinions regarding his insertion loss testing
12 should be excluded. (Doc. No. 251 at 4-5.) In so doing, ATC essentially raises the
13 same arguments that it previously did in its Daubert motion, which the Court denied.
14 (Doc. No. 209.) The Court again concludes that ATC's challenges to Dr. Huebner's
15 opinions go to the weight of his testimony, rather than its admissibility. Accordingly,
16 the Court declines to exclude Dr. Huebner's opinions related to his insertion loss
17 testing. See Alaska Rent-A-Car, 738 F.3d at 970. In sum, the Court denies ATC's first
18 motion in limine without prejudice to any contemporaneous objections at trial made
19 outside the presence of the jury.

20 **VII. ATC's Motion in Limine No. 2**

21 In its second motion in limine, ATC moves (1) to preclude Presidio's damages
22 expert, Mr. Thomas, from testifying that the 560 capacitor is not an available
23 non-infringing alternative and (2) to exclude his supplemental expert report. (Doc. No.
24 251 at 5-11.) Turning to the first part of ATC's motion, ATC argues that Mr. Thomas
25 should be precluded from opining that the 560 capacitor is not an available
26 non-infringing alternative because his opinion is based on the fact that the 560 capacitor
27 was not widely available during the damages period and was sold to only one customer.

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1 (Id. at 5-6.) ATC argues that Mr. Thomas’s position is legally erroneous. (Id. at 5.)
2 In response, Presidio argues that ATC’s contentions go to weight rather than the
3 admissibility of Mr. Thomas’s opinions. (Doc. No. 272 at 9-11.) The Court agrees with
4 Presidio. See Alaska Rent-A-Car, 738 F.3d at 970 (affirming the denial of a motion to
5 exclude where the movant’s challenges went to “the weight of the testimony and its
6 credibility, not its admissibility”). Further, the opinions from Mr. Thomas at issue are
7 relevant to Presidio’s assertion of lost profit damages, specifically Panduit⁴ factor two:
8 “absence of acceptable noninfringing substitutes.” See Siemens Med. Sols. USA, Inc.
9 v. Saint-Gobain Ceramics & Plastics, Inc., 637 F.3d 1269, 1288 (Fed. Cir. 2011) (“To
10 be ‘available,’ an acceptable noninfringing substitute must have been ‘available or on
11 the market’ at the time of infringement.”). Accordingly, the Court denies ATC’s
12 motion to preclude Mr. Thomas from testifying that the 560 capacitor is not an available
13 non-infringing alternative without prejudice to any contemporaneous objections at trial
14 made outside the presence of the jury.

15 Turning to ATC’s request to strike Mr. Thomas’s supplemental expert report, the
16 Court declines to strike the expert report. Even assuming the supplemental expert
17 report was served in violation of the Court’s scheduling order, ATC was not prejudiced
18 by the supplemental expert report as Presidio allowed ATC to serve its own
19 supplemental rebuttal expert report from its damages expert, Dr. Woods. (Doc. Nos.
20 261-1, 261-1, Exs. A-B.) See Genentech, Inc. v. Insmmed Incorporation, No. C-04-5429
21 CW (EMC), 2006 WL 5267971, at *1 (N.D. Cal. Oct. 11, 2006) (denying motion to
22 strike an expert report and noting that there was no prejudice to the moving party as that
23 party was allowed to serve a rebuttal expert report). Moreover, ATC’s motion to strike
24 is untimely as the supplemental expert report at issue was served on November 6, 2015,
25 (Doc. No. 251-2, Ex. 7), well before the Court’s deadlines for the filing of pre-trial

27 ⁴ Panduit Corp. v. Stahlin Bros. Fibre Works, Inc., 575 F.2d 1152 (6th Cir. 1978).
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1 motions and Daubert motions. (Doc. No. 61 at 11.) Yet, ATC did not move to strike
2 the expert report until it filed the present motion in limine on February 26, 2016.
3 Accordingly, the Court denies ATC’s motion to strike Mr. Thomas’s supplemental
4 expert report.

5 **VIII. ATC’s Motion in Limine No. 3**

6 In its third motion in limine, ATC originally moved to exclude all evidence and
7 argument related to the 08-cv-335 litigation, the reexamination proceedings, and ATC’s
8 corporate parents. (Doc. No. 251 at 11-17.) Presidio opposed the motion. (Doc. No.
9 272 at 14-20.) In its reply, ATC narrowed its third motion in limine, so that ATC is
10 now only moving to preclude references to: “Kyocera, which is a majority owner of
11 ATC’s parent corporation, AVX; and Litigations involving ATC, AVX, or Kyocera that
12 do not involve Presidio.” (Doc. No. 267 at 7.)

13 At the hearing, Presidio clarified that it does not oppose the present motion in
14 limine as narrowed by ATC’s reply brief. Accordingly, the Court grants ATC’s third
15 motion in limine. See Fed. R. Evid. 402, 403. The Court excludes any evidence or
16 argument related to Kyocera or unrelated litigation involving ATC, AVX, or Kyocera
17 that does not involve Presidio, absent a further showing from Presidio as to relevance.

18 **IX. ATC’s Motion in Limine No. 4**

19 In its fourth motion in limine, ATC moves to exclude all evidence and argument
20 related to (1) Presidio’s requests for a permanent injunction, an award of treble
21 damages, and an award of attorneys’ fees, or (2) the “presumption of validity” standard
22 afforded to the ’356 Patent. (Doc. No. 251 at 18-21.) In response, Presidio argues that
23 the first part of this motion in limine is moot because it agrees not to reference its
24 requests for an injunction, treble damages, or attorneys’ fees in front of the jury.⁵ (Doc.
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26 ⁵ Although it agrees not to reference the above matters in front of the jury, Presidio
27 clarifies that it should not be precluded at trial from introducing evidence related to the
28 underlying issues that relate to damages. (Doc. No. 272 at 20.)

1 No. 272 at 20-21.) In its reply, ATC agrees that in light of Presidio's representations,
2 this part of its motion in limine is now moot. (Doc. No. 267 at 8.) Accordingly, the
3 Court denies as moot ATC's motion to exclude all evidence and argument related to
4 Presidio's requests for a permanent injunction, an award of treble damages, and an
5 award of attorneys' fees.

6 As to ATC's request to exclude all evidence and argument related to the
7 presumption of validity, in light of the Court's decision to try the issue of indefiniteness
8 to an advisory jury, Presidio may reference the presumption of validity during the jury
9 trial. Accordingly, the Court denies ATC's motion to exclude all evidence and
10 argument related to the presumption of validity without prejudice to any
11 contemporaneous objections at trial made outside the presence of the jury.

12 **X. ATC's Motion in Limine No. 5**

13 In its fifth motion in limine, ATC moves to exclude all evidence and argument
14 related to any alleged willful infringement by ATC. (Doc. No. 251 at 21-25.) ATC first
15 argues that the Court should exclude all evidence and argument related to any assertion
16 of willful infringement occurring prior to December 8, 2015. (Doc. No. 251 at 21-22.)
17 Presidio argues that because the Court granted its motion for summary judgment of its
18 affirmative defense of absolute intervening rights, ATC cannot be liable for any
19 infringement of the '356 patent prior to December 8, 2015, willful or otherwise.

20 (Id.; Doc. No. 267 at 8-9 (citing 35 U.S.C. § 252).) In response, Presidio argues that
21 evidence related to willfulness that predates the issuance of the reexamination certificate
22 remains relevant. (Doc. No. 272 at 22-23.) The Court agrees with Presidio. The Court
23 agrees with ATC that in light of the Court's ruling on absolute intervening rights, ATC
24 cannot be liable for any infringement, willful or otherwise, prior to December 8, 2015.
25 See 35 U.S.C. § 252; Marine Polymer Techs., Inc. v. HemCon, Inc., 672 F.3d 1350,
26 1361-62 (Fed. Cir. 2012) (en banc). Nevertheless, evidence of ATC's allegedly willful
27 conduct that occurred prior to December 8, 2015 remains relevant to Presidio's
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1 assertions of willful infringement for the period occurring on or after December 8,
2 2015.⁶

3 ATC also argues that the Court should exclude all evidence and arguments
4 related to Presidio's assertions of willful infringement occurring after December 8, 2015
5 because Presidio failed to seek a preliminary injunction in the present case. (Doc. No.
6 251 at 22-23.) ATC argues that a patentee may not recover enhanced damages for any
7 infringement occurring after a complaint for patent infringement has been filed if the
8 patentee did not seek a preliminary injunction. (*Id.* (citing In re Seagate Tech., LLC,
9 497 F.3d 1360, 1374 (Fed. Cir. 2007)).) But, several district courts have rejected the
10 notion that the Federal Circuit's decision in Seagate created a per se bar to claims for
11 willful infringement based on post-filing conduct where the patentee did not seek a
12 preliminary injunction. *See, e.g., Monolithic Power Sys., Inc. v. Silergy Corp.*, No.
13 14-CV-01745-VC, 2015 WL 3799533, at *2-3 (N.D. Cal. June 18, 2015); DataQuill
14 Ltd. v. High Tech Computer Corp., 887 F. Supp. 2d 999, 1014-17 (S.D. Cal. 2011); Inv.
15 Tech. Group, Inc. v. Liquidnet Holdings, Inc., 759 F. Supp. 2d 387, 412 & n. 174
16 (S.D.N.Y. 2010). The Court agrees with the reasoning and conclusions set forth in
17 those district court decisions.

18 Finally, ATC argues that the Court should exclude all references and evidence
19 related to Presidio's assertions of willful infringement occurring after December 8, 2015
20 because it has presented substantial and reasonable invalidity and non-infringement
21 defenses in this case. (Doc. No. 251 at 24-25.) The Court has already rejected ATC's
22 contention that it is entitled to summary judgment on the issue of willfulness based on
23 its invalidity and non-infringement defenses. (Doc. No. 210 at 19-21.) Accordingly,
24 the Court denies ATC's request to exclude all evidence and argument related to
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26 ⁶ If at trial such evidence becomes cumulative, excessive, time consuming, overly
27 prejudicial, or tangential, the Court reserves the right to limit such evidence upon a
28 contemporaneous objection made during the trial outside the presence of the jury.

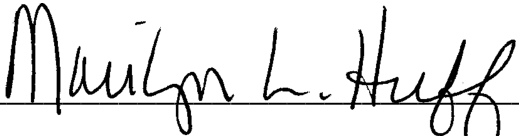
1 Presidio's assertions of willful infringement occurring after December 8, 2015. In sum,
2 the Court denies ATC's fifth motion in limine without prejudice to any
3 contemporaneous objections at trial made outside the presence of the jury.

4 **Conclusion**

5 For the reasons above, the Court grants in part and denies in part Presidio's
6 motions in limine, and the Court grants in part and denies in part ATC's motions in
7 limine.

8 **IT IS SO ORDERED.**

9 DATED: March 25, 2016

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12 MARILYN L. HUFF, District Judge
13 UNITED STATES DISTRICT COURT
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