

**PRIORITY SEND**

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

CIVIL MINUTES -- GENERAL

Case No. EDCV 05-426-VAP(MRWx)

Date: March 6, 2015

Title: G. DAVID JANG, M.D. -v- BOSTON SCIENTIFIC CORPORATION, etc,  
et al.

=====

PRESENT: HONORABLE VIRGINIA A. PHILLIPS, U.S. DISTRICT JUDGE

Marva Dillard  
Courtroom Deputy

None Present  
Court Reporter

ATTORNEYS PRESENT FOR  
PLAINTIFFS:

ATTORNEYS PRESENT FOR  
DEFENDANTS:

None

None

PROCEEDINGS: MINUTE ORDER RE: MOTIONS IN LIMINE (DOC. NOS.  
498-99, 501-503) (IN CHAMBERS)

On March 24, 2014, Plaintiff G. David Jang, M.D. ("Dr. Jang") and Defendant Boston Scientific Corporation ("BSC") filed their motions in limine in anticipation of trial.<sup>1</sup> (See Doc. Nos. 498-99, 501-03.) The parties filed Oppositions to the motions on March 31, 2014. (See Doc. Nos. 506-10, 512.)

---

<sup>1</sup> Although the motions were filed in 2014, the Court granted BSC's motion for interlocutory review of the order denying its motion for summary judgment (Doc. No. 537), thus staying all proceedings and delaying the hearing of the motions until February 2015.

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

Replies were filed by Dr. Jang on April 7, 2014 (Doc. Nos. 518-520) and BSC on February 3, 2015 (Doc. Nos. 549-550).<sup>2</sup> The matter came before the Court for a hearing on February 9, 2015. The Court rules on those motions in limine as follows.

**A. Dr. Jang's Motion in Limine #1 ("PMIL #1") (Doc. No. 502) to Bar Parol Evidence**

Dr. Jang's first motion in limine seeks to preclude BSC from introducing parol evidence related to the Assignment Agreement at the center of this litigation. As explained in the Court's previous ruling denying BSC's motion for summary judgment, on June 3, 2002, Dr. Jang and BSC executed an Assignment Agreement, whereby Dr. Jang conveyed his right to all of his previous inventions, patents, and patent applications relating to coronary stents.<sup>3</sup> The patents at issue in this case were included in that portfolio of patents. The Assignment Agreement contains a governing law provision that states the agreement shall be interpreted in accordance with Massachusetts state law. (Order Denying Summary Judgment ("MSJ Order") (Doc. No. 504) at 5.) The Court has previously found that the Assignment Agreement is unambiguous. (Order Denying BSC's Motion to Amend its Answer (Doc. No. 455) at 8.)

Before the Assignment Agreement was executed, there were two precursor agreements: a "Term Sheet," executed on March 14, 2001, which provided for Dr. Jang to be paid one million dollars immediately,<sup>4</sup> and an "Option Agreement,"

---

<sup>2</sup> The Court gave BSC leave to file its Replies late after a dispute arose concerning the propriety of filing Replies to motions in limine. (See Doc. Nos. 527, 536, 548.)

<sup>3</sup> This included U.S. Patent Nos. 5,922,021 ("the '021 patent") and 5,954,743 ("the '743 patent"), both named "Intravascular Stent," which were issued to Dr. Jang in 1999 (collectively the "Jang Patents").

<sup>4</sup> The one million dollar payment due to Dr. Jang immediately in the Term Sheet is characterized as "earnest money" owed to him while the parties "[made] reasonable efforts to complete an execute a definitive agreement," and that if no

(continued...)

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

executed on May 4, 2001, which paid Dr. Jang \$10 million. (MSJ Order at 5.) Under the Term Sheet, an additional \$10 million would be owed to Dr. Jang in the event that "no 'PSJ' stent system has received a CE mark as of July 31, 2004 (the 'noncommercialization fee')." (Term Sheet at 1.)

PMIL #1 argues that definitional terms included in the Term Sheet, specifically, the characterization of a \$10 million payment owed to Dr. Jang as a "noncommercialization fee" in the event that no stent system incorporating his designs received a CE Mark,<sup>5</sup> should be excluded. (PMIL #1 at 3-4.) According to Dr. Jang, by the time the Assignment Agreement was executed, the terms for the \$10 million payment "had been materially modified such that the payment was no longer contingent on commercialization of products related to Dr. Jang's patents." (Id. at 2.) The Assignment Agreement states that "[BSC] shall pay to Jang as additional consideration for the purchase of the Assets, an additional purchase price amount equal to \$10,000,000 if [BSC] has not received a CE mark for any Contingent Payment Product by 11:59 PM Boston time on July 31, 2004." (PMIL #1 Ex. B ("Assignment Agreement") (Doc. No. 502-4) § 3.1(e).)

Dr. Jang contends that the language of the Assignment Agreement controls because it contains a merger clause. Specifically, the Assignment Agreement states "the terms and provisions contained in this agreement . . . constitute the

---

<sup>4</sup>(...continued)

such agreement was signed, Dr. Jang was obligated to return \$750,000 of that sum and retain the balance "in consideration of the exclusive duration period," for the parties to negotiate a definitive agreement. (PMIL #1 Ex. C ("Term Sheet") (Doc. No. 502-5) at 3.)

<sup>5</sup> A "CE mark" is "the European regulatory approval that is required for commercial sales in Europe." See AGA Med. Corp. v. W.L. Gore & Associates, Inc., 2011 WL 11023511, at \*5 (D. Minn. Oct. 19, 2011).

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

entire understanding of the parties . . . and supersede all previous communications, representations, agreements and understandings relating to the subject matter hereof." (Assignment Agreement § 9.10.)

BSC states that it intends to rely on the Term Sheet because it is consistent with its interpretation of the Assignment Agreement and that such extrinsic evidence is permissible even where the contract is not ambiguous. (PMIL #1 Opp'n (Doc. No. 507) at 1-2.) Specifically, BSC intends to use the Term Sheet to confirm the meaning of § 3.1(e) of the Assignment Agreement as a noncommercialization payment, which provided that BSC would pay \$10 million if BSC had not received a CE mark for any Contingent Payment Product by July 21, 2004. (Id. at 2.)

Under Massachusetts law, "[a] fully integrated agreement is a statement which the parties have adopted as a complete and exclusive expression of their agreement." Chambers v. Gold Medal Bakery, Inc., 83 Mass. App. Ct. 234, 242 (2013) (citation omitted). "Such an agreement discharges prior agreements to the extent that they are within its scope; evidence of those prior agreements thus is not admissible to vary or to broaden the written terms of the fully integrated agreement." Id. (citations omitted). Where an agreement is integrated and unequivocal, "admission of evidence of any antecedent agreement varying or contradicting those terms violate[s] the parol evidence rule." Commerce Bank & Trust Co. v. Hayeck, 46 Mass. App. Ct. 687, 691 (1999). The parol evidence rule, in turn, "does not permit the admission of any extrinsic evidence to vary the terms of an unambiguous contract." Siebe, Inc. v. Louis M. Gerson Co., 74 Mass. App. Ct. 544, 550 n.11 (2009) (citing Robert Indus., Inc. v. Spence, 362 Mass. 751, 754, 291 N.E.2d 407 (1973); Ward v. Grant, 9 Mass. App. Ct. 364, 368, 401 N.E.2d 160 (1980)). Under this general rule of parol evidence, extrinsic evidence is excluded in these circumstances because the intent of the parties may be inferred from the terms of the contract. Id.

To support its argument that parol evidence, i.e., the Term Sheet, may be admissible to confirm the parties' intent despite the fact that the Court has held that the contract is not ambiguous, BSC cites two Massachusetts cases, McDonald's Corp. v. Rappaport, 532 F. Supp. 2d 264, 269 (D. Mass. 2008) and Keating v. Stadium Mgmt. Corp., 508 N.E.2d 122, 123 (Mass. App. Ct. 1987). (PMIL #1 Opp'n

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

at 4.) As Dr. Jang points out, however, those cases found ambiguities in the contract, and needed to use extrinsic evidence to resolve those ambiguities. (PMIL #1 Reply at 5.)

The Court GRANTS PMIL #1. The Court finds that the Assignment Agreement's merger clause precludes the introduction of extrinsic evidence to vary or explain its terms. BSC may not use the Term Sheet to explain the terms of the Assignment Agreement.

**B. Dr. Jang's Motion in Limine #2 ("PMIL #2") (Doc. No. 501) to Exclude Evidence of the USPTO's Findings of Invalidity and BSC's Motion in Limine #2 ("DMIL #2") (Doc. No. 499) to Exclude Evidence that the Jang Patents were Novel**

Dr. Jang's second motion in limine seeks to exclude any evidence that elements of the patents assigned by Dr. Jang to BSC were recently declared invalid by the United States Patent and Trademark Office ("USPTO"). (PMIL #2 at 2.) As the Court explained in the MSJ Order, on October 8, 2013, BSC filed an application with the USPTO for ex parte reexamination of the Jang Patents.<sup>6</sup> (See Doc. Nos. 387-1 (ex parte reexamination request); 428-1 (USPTO's Order granting ex parte reexamination and finding that the request had "established a substantial new question of patentability" for the challenged claims in the Jang Patents).)

At the time BSC filed the notice of this application with the Court, BSC maintained that "under the constructions asserted by Dr. Jang -- the claims would cover the prior art and thus would be invalid." (Doc. No. 387 at 2.) BSC informed Dr. Jang that, despite its right to do so as the owner of the challenged patents, it would not contest the USPTO's rejection of those claims; in response, Dr. Jang brought an ex parte application for a temporary restraining order seeking to compel

---

<sup>6</sup> The ex parte reexamination procedure allows any party to file a request for reexamination of any previously issued patent to correct examiner errors, for example, patents that have been "defectively examined and therefore erroneously granted." See Patlex Corp. v. Mossinghoff, 758 F.2d 594, 604 on reh'g, 771 F.2d 480 (Fed. Cir. 1985).

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

BSC to relinquish power of attorney over the Jang Patents and allow Dr. Jang to defend them in the reexamination proceedings, but the Court denied that request.<sup>7</sup> (See Dr. Jang's Ex Parte Application for TRO (Doc. No. 456); Order Denying Ex Parte Application (Doc. No. 460).) On February 10 and 11, 2014, the USPTO issued reexamination certificates canceling the challenged claims in the '021 patent and '743 patent respectively and declaring those claims invalid. (See Doc. Nos. 477, 484.) The USPTO's decision invalidated claims 1, 6, 7, 8, and 17 of the '021 patent and claims 1, 10, 11, 13, and 16-20 of the '743 patent, because, as the patent owner, BSC did not contest the USPTO's rejection of those claims.

In its motion for summary judgment, the Court summarized BSC's argument why it did not owe Dr. Jang anything under the Assignment Agreement as follows: "as the USPTO has conclusively determined claims in the Jang Patents to be invalid, BSC argues that, to the extent Dr. Jang contends that the Express Stents are a 'Contingent Payment Product,' he cannot collect anything else under the Assignment Agreement because those products are predicated on the existence of a 'Valid Claim,' which in turn requires that the patent claims are valid." (MSJ Order at 15.) The Court rejected that argument, stating that "where at least a substantial total of the royalties would have been due sometime in 2007, the assignor cannot avoid payment of those royalties with a finding of invalidity seven years later in 2014." (*Id.* at 17.)

BSC argues that allowing Dr. Jang's experts to argue during trial that his stent designs were novel, while not acknowledging that those designs have been invalidated, would be "a travesty." (PMIL #2 Opp'n (Doc. No. 509) at 2.) Moreover,

---

<sup>7</sup> Though the Court found that Dr. Jang's ex parte application for a TRO was untimely, the Court also stated that it lacked the authority to compel BSC to relinquish its control of the ex parte reexamination process. (See Order Denying Ex Parte Application (Doc. No. 460) at 5 (citing Emerson Elec. Co. v. Davoil, Inc., 88 F.3d 1051, 1054 (Fed. Cir. 1996)).)

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

BSC's second motion in limine similarly argues that Dr. Jang should be precluded from introducing evidence that the design of the Jang Patents were novel. (DMIL #2 at 2.)

The Court agrees with Dr. Jang. The Court previously has found that the USPTO's previous findings of invalidity several years after the payments under the Assignment Agreement were due are of no moment in this litigation. BSC entered into the Assignment Agreement because it ascribed some value to the Jang Patents as a novel and innovative design with the potential for commercialization and profitability. Dr. Jang's potential earnings under that agreement would have been due years before the patents were invalidated at BSC's request. Both Dr. Jang and BSC ascribed some degree of innovation to the Jang Patents at the time the Assignment Agreement was executed; a later finding of the USPTO does not affect that.

Second, the USPTO's finding of invalidity is not binding on this Court. Belkin Int'l, Inc. v. Kappos, 696 F.3d 1379, 1385 (Fed. Cir. 2012) ("Suffice it to say here that the courts have the final say on unpatentability of claims, not the PTO."). Allowing this evidence would needlessly confuse the jury; this Court's previous claim constructions are law of the case, and will guide the jury in their determination of whether the Express Stents infringe on the Jang Patents. Evidence that those claims were declared invalid would be a needless distraction.

Accordingly, the Court GRANTS PMIL #2 and DENIES DMIL #2. The Court precludes BSC from submitting any evidence concerning the 2014 USPTO reevaluation of the Jang Patents or its subsequent finding of invalidity.

**C. Dr. Jang's Motion in Limine #3 ("PMIL #3") (Doc. No. 503) to Exclude Testimony of BSC's Expert, Dr. James E. Moore, Ph. D.**

Dr. Jang's third motion in limine seeks to prevent BSC from introducing evidence that is contrary to the Court's previous Claim Construction Order (Doc. No. 423). The Court previously rejected BSC's argument that certain design elements of the stents described in the Jang Patents -- specifically, the connecting strut columns and the expansion columns -- must have distinct functions. (MSJ Order at 13-14.) Dr. Jang contends that BSC will argue the accused product, BSC's

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

Express Stent, does not infringe the Jang Patents because the elements that Dr. Jang asserts are infringing perform distinct functions. (PMIL #3 at 1.)

BSC asserts that it will not make any argument that is contrary to the Court's Claim Construction Order. (PMIL #3 Opp'n (Doc. No. 510) at 2.) BSC takes issue, however, with another aspect of PMIL #3: Dr. Jang's request to exclude BSC's expert, Dr. James E. Moore, Jr. Ph.D., from testifying about infringement. (Id. at 3.) The Court previously excluded certain elements of Dr. Moore's testimony because they relied in part on materials that were not disclosed timely to Dr. Jang or his experts during discovery. (See Order Granting Plaintiff's Motion to Exclude Expert Testimony (Doc. No. 505) at 8.) Dr. Jang now contends that, even though some elements of Dr. Moore's testimony were excluded, the entirety of his testimony should be excluded because his opinion relied on the faulty premise that the connecting strut columns and the expansion columns were required to have distinct functions. (PMIL #3 at 10-13.)

The Court DENIES PMIL #3. To the extent Dr. Moore has not relied upon evidence that the Court previously excluded, but instead has relied upon "the stents themselves, photos of the stents in the crimped and expanded states, marketing materials" and the like (PMIL #3 Opp'n at 7), he may do so at trial.<sup>8</sup>

---

<sup>8</sup> BSC also contends that by filing this motion in limine, Dr. Jang has run afoul of the Court's prior orders in multiple respects. First, it argues that Dr. Jang's previous motion requesting certain portions of Dr. Moore's testimony be excluded should count against the Court's limit of three motions in limine. (PMIL Opp'n at 4-5.) Though Dr. Jang previously characterized this request as an in limine request in the docket entry for that motion (see Doc. Nos. 461-62), it was filed contemporaneously with his opposition to BSC's motion for summary judgment, as the motion to exclude dealt directly with evidence at issue in the summary judgment motion. (See MSJ Order at 4 n.2.) It should not and does not count against each party's three motion in limine limit. Second, BSC contends that PMIL #2 inappropriately attempts to address multiple items of evidence, in contravention of the Court's scheduling order. (PMIL #3 Opp'n at 4.) The Court finds that this motion (continued...)



EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

**D. BSC's Motion in Limine #1 ("DMIL #1") (Doc. No. 498)**

BSC's first motion in limine seeks to prevent Dr. Jang from pursuing his theory of infringement under the doctrine of equivalents theory for two reasons: (1) because he failed to disclose that he was relying on the doctrine of equivalents in his written discovery responses and (2) because his experts did not state their expert opinion on equivalence sufficiently. (DMIL #1 at 2-7.) The Court takes each argument in turn.

Infringement may be pursued under a theory of literal infringement<sup>9</sup> or under the doctrine of equivalents. "Under the doctrine of the equivalents, 'a product or process that does not literally infringe . . . the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention.'" Duramed Pharm., Inc. v. Paddock Labs., Inc., 644 F.3d 1376, 1380 (Fed. Cir. 2011) (quoting Warner-Jenkins on Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21 (1997)).

"One way of proving infringement under the doctrine of equivalents is to show, for each claim limitation, that the accused product performs substantially the same function in substantially the same way with substantially the same result as each claim limitation of the patented product. Brilliant Instruments, Inc. v. GuideTech, LLC, 707 F.3d 1342, 1347 (Fed. Cir. 2013) (internal quotation marks and citations omitted). Alternatively, a party show infringement under the "insubstantial differences test," which states that an element is equivalent if the difference between the element and the claimed limitation is insubstantial. Schoell v. Regal Marine Indus., Inc., 247 F.3d 1202, 1210 (Fed. Cir. 2001); Warner-Jenkinson Co., Inc. v.

---

<sup>8</sup>(...continued)

in limine, while addressing multiple pieces of evidence, only concerns one type of evidence: types that would contradict the Court's Claim Construction Order and its findings in the MSJ Order.

<sup>9</sup> Under the literal infringement theory, "every limitation set forth in a claim must be found in an accused product, exactly." Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed. Cir. 1995).

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

Hilton Davis Chem. Co., 520 U.S. 17, 39-40 (1997).

### 1. Dr. Jang's Written Discovery

BSC first contends that Dr. Jang's written discovery did not disclose timely his reliance on the doctrine of equivalents. (DMIL #1 at 2-3.) BSC admits, however, that Dr. Jang asserted this theory in April 2006, when, in response to its first set of special interrogatories, Dr. Jang stated certain claims in the Jang Patents were "present literally or under the doctrine of equivalents in Defendants' Express family of stents . . . ." (Id. at 1 (citing Plaintiff's Memorandum of Contentions of Fact and Law at 22).) According to BSC, this was insufficient because Dr. Jang "never stated how any specific element of the claims is supposedly met by Express under the doctrine of equivalents." (Id.) BSC cites Teashot LLC v. Green Mountain Coffee Roasters, Inc., 2014 WL 485876, at \*6 (D. Colo. Feb. 6, 2014) for the proposition that a party's failure to disclose timely an equivalency theory constitutes waiver. (Id. at 2.) The Teashot court did not hold that disclosure of an equivalence theory is required in the complaint or that any particular timing is required; rather, it found that exclusion was proper sanction for failure to disclose it under Federal Rule of Civil Procedure 37(c)(1) when disclosure was required under the local rules. Teashot, 2014 WL 485876 at \*6-\*8. Here, however, it is uncontested that BSC was aware that Dr. Jang might use this infringement theory before the parties filed their claim construction briefs.

BSC further contends that, to the extent Dr. Jang mentioned this theory in 2006, the disclosure was "boilerplate," entitled to little weight. (DMIL #1 at 3 (quoting Dynetix Design Solutions, Inc. v. Synopsys, Inc., 2013 WL 4537838, \*1 (N.D. Cal. August 22, 2013)).) Dr. Jang's disclosure from 2006 is not the type of boilerplate disclosure at issue in Dynetix. There is no indication that Dr. Jang's infringement contentions "consistently provide[d] a boilerplate preamble that '[the accused product] practices this element literally or equivalently' before going on to explain a single way in which [the accused product] infringes." Dynetix, 2013 WL 4537838, at \*1.

### 2. Sufficiency of Expert Testimony

BSC next argues that, even assuming Dr. Jang disclosed his theory of infringement under the doctrine of equivalents timely, his experts have not provided

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

sufficient detail in their expert reports to support such a theory. (DMIL #1 at 4.)

Dr. Jang's theory of infringement is that the "macro element" and the "micro element" of BSC's Express Stents literally infringe on the "expansion column" and "connecting strut column" elements of the Jang Patents. (DMIL #1 Opp'n (Doc. No. 506) at 2.) Dr. Jang maintains that the doctrine of equivalents is only relevant to the connecting strut column claim because "BSC admits that all but one claim is found in the Express stents, and only sets forth a limited challenge to the 'connecting' column limitations. . . . to the extent BSC has disclosed any remaining basis to contend the 'connecting' limitation is not found in the accused stents . . . Dr. Jang contends the connecting column limitation is satisfied through equivalence," and that the reports tendered by his experts, Michael Lee and Dr. Nicholas A.F. Chronos, M.D., are more than sufficient to advance an equivalence theory of infringement. (Id. at 3.)

With respect to the amount of proof required to succeed on infringement by way of the doctrine of equivalents, the Federal Circuit has stated

a patentee must still provide particularized testimony and linking argument as to the "insubstantiality of the differences between the claimed invention and the accused device or process, or with respect to the function, way, result test when such evidence is presented to support a finding of infringement under the doctrine of equivalents. Such evidence must be presented on a limitation-by-limitation basis. Generalized testimony as to the overall similarity between the claims and the accused infringer's product or process will not suffice.

Texas Instruments Inc. v. Cypress Semiconductor Corp., 90 F.3d 1558, 1567 (Fed. Cir. 1996). BSC contends that the expert reports provided by Mr. Lee and Dr. Chronos fail to provide a basis for Dr. Jang's equivalence theory as neither provides "the sort of detailed analysis of infringement" required. (DMIL #1 at 4.) According to BSC, Mr. Lee and Dr. Chronos make passing references to equivalence, but neither engages with the theory on a limitation-by-limitation basis. (Id. at 4-5.) As "merely opining that the accused product is 'equivalent'" or incorporating an equivalence argument into a literal infringement argument are insufficient to prevail under the

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

doctrine of equivalents, BSC contends that testimony concerning this theory should be excluded. (Id. at 4 (citing DePuy Spine, Inc. v. Medtronic Sofamor Danel, Inc., 469 F.3d 1005, 1017 (Fed. Cir. 2009); 5 (Lear Siegler, Inc. v. Sealy Mattress Co. of Michigan, Inc., 873 F.2d 1422, 1425 (Fed. Cir. 1989).)

Dr. Jang contends his experts' opinions concerning equivalency are plainly sufficient. Taking issue with BSC's contention that Mr. Lee only discussed literal infringement, and then belatedly attempted to shoe-horn in an equivalency theory, Dr. Jang argues that "[a]n expert is not required to 're-start his testimony at square one when transitioning to a doctrine of equivalents analysis.'" (DMIL #1 Opp'n at 7 (citing Paice LLC v. Toyota Motor Corp., 504 F.3d 1293, 1304 (Fed. Cir. 2007)).) In Paice, the expert in question "drew a line in the sand" and discussed his literal infringement contentions, and then separately discussed his equivalency contentions. 504 F.3d at 1305. The Federal Circuit found that an expert's infringement analysis need not be compartmentalized so that it cannot also be used in to support an equivalency theory; in other words, an answer to a question during testimony concerning literal infringement can be incorporated into a later argument concerning equivalency without needing to ask a separate question. The Federal Circuit thought it prudent "for a witness to incorporate earlier testimony to avoid duplication." Id.

After examining the excerpted sections of Mr. Lee's and Dr. Chronos's reports and their testimony submitted as exhibits to this motion in limine, the Court finds that both Mr. Lee and Dr. Chronos have provided sufficient foundation to support a theory under the doctrine of equivalents. Dr. Chronos's invocation of the theory occurs numerous times in his report. (DMIL Opp'n Ex. 4 at ¶¶ 97, 113, 116, 119, 123, 128.) He notes his conclusion under the literal infringement theory, and then incorporates that analysis into his equivalency theory, a method permissible under Paice. Similarly, Mr. Lee discusses his theory of literal infringement, and then states

EDCV 05-426-VAP(MRWx)  
G. DAVID JANG, M.D. v. BOSTON SCIENTIFIC CORPORATION, etc., et al.  
MINUTE ORDER of March 6, 2015

that some elements of the Express Stent incorporate features that are the "functional equivalent" of the claims in the Jang Patents. (DMIL Opp'n Ex. 3 at ¶¶ 222, 227.) The portion of Mr. Lee's expert report attached to Dr. Jang's Opposition demonstrates that Dr. Jang has satisfied the requirements for presenting this theory to the jury.

As Dr. Jang's disclosures were timely and his expert's opinions were sufficient, the Court DENIES DMIL #1.<sup>10</sup>

For the reasons stated above, the Court:

GRANTS PMIL #1: BSC may not use the Term Sheet to explain the terms of the Assignment Agreement;

GRANTS PMIL #2 and DENIES DMIL #2: BSC is precluded from submitting any evidence concerning the 2014 USPTO reevaluation of the Jang Patents or its subsequent finding of invalidity;

DENIES PMIL #3: Dr. Moore may rely upon "the stents themselves, photos of the stents in the crimped and expanded states, marketing materials" and the like at trial; and

DENIES DMIL #1: Dr. Jang may submit his doctrine of equivalents theory to the jury.

**IT IS SO ORDERED.**

---

<sup>10</sup> As noted above, the Court again rejects BSC's argument that the USPTO's invalidation of certain claims in the Jang Patents affects the admissibility of this evidence. (See DMIL #1 at 7.)