

**** NOT FOR PRINTED PUBLICATION****

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
BEAUMONT DIVISION

MARK A. BARRY, M.D.,

Plaintiff,

v.

MEDTRONIC, INC.,

Defendant.

Civil Action No. 1:14-cv-104

JUDGE RON CLARK

PRD

ORDER REGARDING PLAINTIFF MARK A. BARRY, M.D.'S MOTIONS IN LIMINE

Before the court are Plaintiff Mark A. Barry's Motions in Limine. [Dkt. ## 341, 342]. Defendant Medtronic, Inc. responded. [Dkt. # 348]. The court's rulings are set out in the attached chart. As always in this court, the grant of a motion in limine is reciprocal. If one side cannot introduce some piece of evidence without approaching the bench, neither can the other side. The court does not invite a re-hash of every ruling, but if counsel believes in good faith that evidence becomes relevant, say for impeachment, or an opponent "opens the door," that issue should be brought to the court's attention outside the presence of the jury.

Rulings on Plaintiff Dr. Barry's Motions in Limine

MIL #	Plaintiff's MIL	Defendant's Response	Ruling
1.	Medtronic's Admission That it was Aware of the Patents-in-Suit in 2013.	The facts giving rise to the alleged admission demonstrate that this motion should be denied. Further, Medtronic is permitted to contradict this testimony. <i>See Lindquist v. City of Pasadena, Tex.</i> , 656 F. Supp. 2d 662, 698 (S.D. Tex. 2009).	Denied. Dr. Barry may use deposition as permitted by Rules & Medtronic may attempt to explain or contradict. Court may instruct jury on purpose & effect of 30(b)(6) deposition.
2.	Evidence Referring to the "SmartLink" Product Should Be Precluded.	Medtronic states that this order should apply equally to both parties.	Agreed by parties.
3.	Documents Not Timely Disclosed by Medtronic With Its First Amended Patent Invalidity Contentions.	This motion is overbroad and seeks to exclude all evidence with production numbers above the listed range, for all purposes. Yet Barry has used them and included them on his exhibit list. Both parties should be permitted to use all admitted exhibits for any permissible purpose.	Denied as stated in MIL. This matter has been subject of prior rulings, and Medtronic's invalidity contention presentation has been limited. But all the exhibits that were broadly "identified" in Dr. Barry's MIL have not yet been offered by Medtronic for other purposes and the court is not going to rule on that type of offer before it is made and a proper objection is made at trial.
4.	Testimony Regarding "Experimental" Surgeries or Instruments is Inadmissible.	This motion misconstrues the Court's prior order. Barry seeks relief beyond what the Court has previously ordered.	Granted as to testimony regarding Dr. Barry's surgeries being "experimental" in the context of medical ethics. As previously ordered (Dkt. # 292), there is no fact issue that Dr. Barry's surgeries were <i>not</i> experimental. But denied as to testimony regarding whether Dr. Barry's surgeries were experimental, i.e. non-public, for the purposes of rebutting prior use/prior invention. Evidence as to whether Dr. Barry's surgeries were kept confidential, i.e. whether they were non-public, or not is probative as to invalidity.

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5.	Opinions Not Disclosed in Medtronic's Rule 26 Reports Should be Excluded; Opinions That are Estopped Under 35 U.S.C. § 315 Should Also be Excluded.	This is essentially a <i>Daubert</i> motion filed under the guise of a motion <i>in limine</i> , and it has already been denied.	Barry moves to exclude several specific opinions that Medtronic's experts have set out in various documents. The Court grants and denies as follows. (a) Denied as to Dr. O'Brien's opinion that the '121 Patent is "not entitled to a December 30, 2004 effective filing date." (item (i) at MIL, p. 4). Dr. O'Brien wrote that the '121 patent is entitled to a priority date no earlier than December 30, 2004 (O'Brien Rpt. at ¶ 46), not that the priority date is December 30, 2004. (b) Denied as moot as to Dr. O'Brien's opinion that Dr. Lenke "reduced to practice" on any date prior to February 9, 2006 (item (ii) at MIL, p. 4). The court has already ordered that Dr. O'Brien's testimony is limited to this date (Dkt. # 307, at 1, 7–8). (c) Granted. Medtronic is limited to the defenses set forth in the parties' joint pre-trial order, which does not plead indefiniteness, enablement, or lack of written description (item (iii) at MIL, p. 4). None of these theories were preserved in joint pre-trial order. (d) Granted in part as to invalidity opinions based on patents or printed publications, although documentary evidence may evidence use or prior use or prior invention (item (iv) at MIL, p. 5). Invalidity arguments based on patents or printed publications were not preserved in the joint pre-trial order. (e) Denied as to Dr. O'Brien's "percipient witness" testimony as to prior invention surgeries (MIL, p. 5).

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			(f) Granted as to invalidity evidence that was raised or could have reasonably been raised during IPR (MIL, pp. 5–6). Medtronic is limited to the prior art set forth in the parties' joint pre-trial order.
6.	Expert Opinion by Fact Witness Dr. Lenke Should be Excluded.	Medtronic will not present expert testimony from fact witnesses. However, Lenke's testimony will necessarily be of a scientific or technical nature when he describes his work, his concept, and his use of that concept, and by all accounts he is a leading expert in the field. Dr. Lenke should be permitted to testify as to factual matters within his personal knowledge and based on his own experiences and perceptions.	Granted in part, denied in part. The court will not permit expert testimony from fact witnesses. Dr. Lenke is not allowed to opine, or to answer hypotheticals, as to whether his surgical methods or devices meet one or more limitations of either patent in suit. He is not permitted to testify as to the ultimate issues of invalidity, meeting claim limitations, "having all the elements" of a claim, etc. Those are not "lay opinions" allowed from a fact witness. He is allowed to testify to his personal knowledge about what was actually done and used in surgeries in which he participated, but not to compare it to any patent claim or claim element or step.
7.	Evidence and Arguments Contradicting the Court's Constructions Including the Term, "Mechanically Linked."	Barry makes an argument that the Court has previously rejected. Additionally, according to the Court's order, this motion is premature.	Denied. To be clear, the court is not holding that Medtronic's witnesses or counsel may contradict or question the claim construction in the presence of the jury as might be inferred from this denial as applied only to the artfully worded title of MIL 7. Dr. Barry's MIL 7 actually pertains to Dr. Marco's testimony and the court set out the limits to that testimony in Dkt. # 301.
8.	Dr. Barry's Interpretation of the Claims of the Asserted Patents.	Barry is the alleged inventor, and while case law prohibits him from giving self-serving testimony regarding claim construction, there is no support for the argument that he cannot be asked questions that are contrary to his	Denied. However, though Dr. Barry was not designated as an "expert," if Medtronic starts asking for opinions, it will have opened the door and it may be hard for Medtronic to complain about the answer Medtronic receives to its questions.

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		interests and that are highly relevant to infringement.	
9.	Invalidity Under 35 U.S.C. § 102(b) Based on “Disclosure” to Third Parties.	Barry is attempting to win summary judgment on Medtronic’s invalidity defense under 35 U.S.C. § 102(b), but that has already been denied. Evidence of the disclosure is highly relevant to Medtronic’s defenses, which are still at issue.	Denied.
10.	Cross-examination based on Robert Pfefferkorn declarations.	This was a material change to the facts that was hidden from the Court. This is relevant to Barry’s duty of candor, as well as the credibility of these witnesses.	Denied in part, granted in part. Denied as to cross-examination concerning his changes in testimony about the date and whether his testimony was sworn or not. But Granted as to questions phrased in terms of “failure to disclose to the court” or “hiding from the court” or “breach of duty to the court” and the like.
11.	Biomet and Dr. Barry’s alleged need to “renegotiate” the Biomet license agreement.	This is relevant to damages, as Barry’s damages expert relies on the Biomet license to inform her damages model. If the exclusivity provisions for which Biomet paid a premium are removed, the price Biomet paid for the license would be inflated, as would any damages model based on this agreement.	Denied.
12.	Documents Relating to Damages and Testimony Regarding Tracking of VCM usage.	These documents were produced pursuant to Court order because Barry obtained an order compelling their production. He has had them in his possession for nearly a year. Rule 37(c) is not applicable here.	Denied.
13.	Dr. Barry’s Agreements with Law Firms.	Agreed.	Agreed by parties.

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14.	Suggestion that Prices of Medical Products Will Increase Based on Litigation or that Availability of Medical Products Will Decrease.	Agreed.	Agreed by parties.
15.	Evidence and Argument Regarding "Laches, Waiver and/or Estoppel" Should be Excluded.	Medtronic only intends to present evidence of laches. This is because of Barry's destruction of documents. Medtronic should not be precluded from doing so simply because it cannot identify the documents it never saw but that Barry confirmed had been destroyed.	Granted in part, as to evidence and argument regarding waiver and estoppel. As Medtronic represented at the Oct. 27, 2016 Final Pre-trial Conference, it does not intend to advance its defenses of waiver and estoppel. Any evidence related solely to either one or both of those two issues is excluded. Denied in part, as to laches. Though laches is an equitable defense, <i>see, e.g., A.C. Aukerman Co. v. R.L. Chaides Constr. Co.</i>, 960 F.2d 1020, 1028 (Fed. Cir. 1992) (en banc), <i>overruled on other grounds by SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC</i>, 807 F.3d 1311, 1332 (Fed. Cir. 2015), the court will allow evidence related to laches to be presented to the jury, insofar as, per representations by Medtronic counsel, this evidence relates to Medtronic's other defenses.