

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION**

OMEGA PATENTS, LLC,

Plaintiff,

v.

Case No: 6:13-cv-1950-Orl-40DAB

CALAMP CORP.,

Defendant.

ORDER

This cause comes before the Court on the following:

1. Plaintiff Omega Patents, LLC's Motion *In Limine* (Doc. 94), filed September 29, 2015; and
2. Defendant CalAmp Corp.'s Response in Opposition (Doc. 101), filed October 16, 2015.

Upon consideration, the motion is granted in part and denied in part for the reasons set forth below.

I. BACKGROUND

Omega Patents, LLC ("Omega") contends that CalAmp Corp. ("CalAmp") infringes upon the claims of U.S. Patent No. 6,346,876 ("the '876 Patent"), U.S. Patent No. 6,737,989 ("the '989 Patent"), U.S. Patent No. 6,756,885 ("the '885 Patent"), U.S. Patent No. 7,671,727 ("the '727 Patent"), and U.S. Patent No. 8,032,278 ("the '278 Patent") (collectively, the "patents-in-suit"). (Doc. 1). The patents-in-suit relate to control systems for vehicles with a "data communications bus." (Doc. 54, pp. 1–2). Omega asserts that CalAmp's devices are used to monitor particular vehicle characteristics and conditions

and report vehicle information to an end user, thus infringing on the patents-in-suit. (*Id.* at p. 2).

CalAmp advertises for sale the LMU-3000, LMU-3030, and LMU-3050 (the “Accused Devices”) which are described as full-featured tracking systems which “access vehicle diagnostic interface data, track vehicle speed and location, plus detect hard braking, cornering, or acceleration.” (Doc. 114-1, p. 2; 114-2, p. 2). CalAmp denies that the Accused Devices infringe upon any claim of the patents-in-suit and further asserts a number of defenses. (Doc. 10).

II. Omega’s Motions *In Limine*: Theories Not Disclosed in Discovery

A. Unfair Competition Liability and Damages

Omega seeks exclusion of evidence of liability and damages for alleged unfair competition, arguing that CalAmp dropped the unfair competition claim in its amended counterclaim and failed to specify a theory of damages in its Rule 26 disclosures. (Doc. 94, p. 2). The Court previously denied Omega’s motion for summary judgment on CalAmp’s unfair competition claim as moot because CalAmp failed to alleged unfair competition in its amended counterclaim. (Doc. 118, p. 3). Therefore, Omega’s motion *in limine* on this issue is denied as moot.

B. Undisclosed Invalidity Theories

Omega moves the Court to exclude testimony and documentary evidence offered by CalAmp on undisclosed 35 U.S.C. § 112 invalidity theories. (Doc. 94, p. 4). Omega contends that CalAmp’s generic statement that the patents-in-suit are invalid “based on written description, enablement and indefiniteness under § 112” is insufficient to preserve these defenses. (*Id.*). In its initial invalidity contentions, CalAmp identifies the claims of

each patent-in-suit it believes to be invalid. (Doc. 94-3). Thereafter, CalAmp provides a series of charts identifying prior art references to support its contentions of anticipation and/or obviousness and invalidity. (*Id.* at pp. 9–13). CalAmp provides the following generic observation:

CalAmp contends that various asserted claims of the patents-in-suit are also invalid based upon lack of written description, lack of enablement, and indefiniteness under 35 U.S.C. § 112. However, as discussed above, the asserted claims of the patents-in-suit have not yet been construed by the Court. As such, CalAmp reserves the right to present its § 112 contentions after the Court's construction of the asserted claims.

(*Id.* at p. 13)

The Court entered the order on claim construction on February 20, 2015. (Doc. 50). CalAmp filed its Supplemental Invalidity Contentions on March 24, 2015. (Doc. 94-4). After identifying prior art references supporting its contentions of anticipation and/or obviousness and invalidity, CalAmp provides verbatim the same general assertion that the claims are invalid based on the lack of written description, lack of enablement, and indefiniteness, including the observation that CalAmp reserves the right to present its § 112 contentions after the Court's construction of the asserted claims—which order had issued one month earlier. (*Id.* at p. 14).

On March 21, 2014, CalAmp responded to Omega's Interrogatories, including interrogatory number 6, which asks CalAmp to "[s]tate with specificity in a claim chart the basis for CalAmp's allegations the Patents-in-Suit are invalid, including a limitation-by-limitation comparison of each claim with any prior art references that you intend to use to support your claims of invalidity of the Patents-in-Suit." (Doc. 94-2, pp. 10–11). After asserting various objections, CalAmp replies, "Once Omega identifies which claims it is

asserting, CalAmp will provide its invalidity contentions showing which claims it contends are invalid, and which prior art references it intends to rely on, at the time designated by the Court.” (*Id.* at p. 10). The Court is not aware of any supplemental response to this interrogatory having been provided by CalAmp. Moreover, the Court has reviewed CalAmp’s Initial Disclosure, pursuant to Rule 26(a)(1) of the Federal Rules of Civil Procedure, and the disclosure does not provide any information or insight as to how claims of the various patents-in-suit are invalid based on lack of written description, lack of enablement, and indefiniteness. (Doc. 94-1). The Court is also unaware of a supplemental Rule 26 disclosure by CalAmp.

Omega seeks the exclusion of § 112 contentions not disclosed or articulated during discovery, observing that CalAmp’s expert did not testify about these § 112 invalidity theories or address them in his expert report (Doc. 94, p. 4, n.3). Prior to considering CalAmp’s response, it is worth addressing the concepts of enablement, lack of written description, and indefiniteness. The enablement requirement is set forth in 35 U.S.C. § 112 (2006):

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same

To comply with the enablement requirement, the specification must teach those skilled in the art how to make and use the full scope of the claimed invention without “undue experimentation.” *MagSil Corp. v. Hitachi Global Storage Techs., Inc.*, 687 F.3d 1377, 1380 (Fed. Cir. 2012) (internal quotation marks omitted). Therefore, the scope of the claims must be less than or equal to the scope of the enablement provided by the specification. *Id.* at 1381. “The specification must contain sufficient disclosure to enable

an ordinarily skilled artisan to make and use the entire scope of the claimed invention at the time of filing.” *Id.*

The Court in *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1342 (Fed. Cir. 2010), addressed whether 35 U.S.C. § 112 contains a written description requirement separate from an enablement requirement. The Court concluded that the first paragraph of § 112 contains two distinct description requirements consisting of “a ‘written description’ [i] of the invention, *and* [ii] of the manner and process of making and using [the invention].” *Id.* at 1344. The written description requirement is separate from the enablement requirement and must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” *Id.* at 1351 (internal quotation marks omitted).

Moreover, as noted by the United States Supreme Court, § 112 entails a “delicate balance” between the “modicum of uncertainty” that is the “price of ensuring the appropriate incentives for innovation” and the precision needed to afford clear notice of what is claimed. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2128–29 (2014) (internal quotation marks omitted). Accordingly, a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and considering the prosecution history, fail to inform, with reasonable certainty, those skilled in the art of the scope of the invention. *Id.*

CalAmp asserts that it has identified prior art references predating the filing date of the patents, thereby shifting the burden to Omega to prove entitlement to an earlier priority date. (Doc. 101, pp. 2–3). The Court does not comprehend how the timely disclosure of prior art references, as set forth in CalAmp’s initial and supplemental

invalidity contentions, relates to the defense of lack of written description, lack of enablement, and indefiniteness which are asserted after the charts identifying prior art references. Omega is not contesting the fact that it has the burden of establishing entitlement to a priority date earlier than the filing date of the patents-in-suit when, and if, CalAmp proves that such prior art invalidates one or more of the patents-in-suit.

CalAmp next argues that it raised the lack of written description to support priority in a separate motion, citing Defendant's motion (Doc. 95) that the patents-in-suit are not entitled to an earlier priority date (*Id.* at p. 3). CalAmp's motion on the issue of entitlement to a priority date was filed on September 29, 2015. (*Id.*). To the contrary, in its motion to determine priority date, CalAmp focuses upon the written description found in the '551 Patent and whether the description is sufficient to enable Omega to use the filing date of the '551 Patent as the priority date for the continuations-in-part (the "CIPs"):

Omega must now produce evidence that the patents are entitled to an earlier filing date to be entitled to anything earlier than the actual CIP filing date in its claims of priority. . . For example, in support of the priority claim for the '876 patent, Omega has not identified anything in the '551 patent that discloses 'at least one set of command signals comprising at least one working command signal and at least one non-working command signal for a given vehicle to thereby provide command compatibility with a plurality of different vehicles,' which is required in all asserted claims of the '876 patent . . . The same is true with the '885 patent

(Doc. 95, pp. 5–6)

The defense of lack of written description focuses upon whether the written description of the patent-in-suit "clearly allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed." *Ariad Pharm.*, 598 F.3d at 1351. Therefore, the argument presented by CalAmp in its motion to preclude entitlement to an

earlier priority date for the patents-in-suit does not raise the lack of written description defense.¹

CalAmp further contends that it has “previously raised that Omega failed to address the alleged ‘control function’ performed by the accused devices, and instead has simply ignored this requirement by giving it no meaning.” (Doc. 101, p. 3). The Court first observes that the defense of lack of written description does not concern whether Omega has addressed the manner in which the Accused Devices function. Rather, as discussed above, the defense of lack of written description concerns whether the patents-in-suit provide adequate notice that the inventor invented what is claimed. Therefore, it is irrelevant that Omega may or may not have addressed the control function performed by the Accused Devices, at least in the context of this defense.

CalAmp next asserts that it previously noted that “the written description of the patents-in-suit does not support Omega’s position that any function is a ‘control function,’ and during discovery, at least Andrews, Chen and Hergesheimer provided testimony regarding the meaning of ‘control function.’” (Doc. 101, p. 3). Because CalAmp does not support this assertion with citations to deposition testimony, the Court is unable to ascertain the context of the testimony regarding the adequacy of the written description of the patents-in-suit relative to the term “control function.” Finally, CalAmp only responds to Omega’s contention that CalAmp failed to properly disclose the basis of its lack of written description defense; therefore, CalAmp concedes that it has not presented

¹ Additionally, CalAmp’s motion to preclude entitlement to an earlier priority date was filed after the close of discovery. (Doc. 29).

evidence of the lack of enablement or indefiniteness defenses which are distinct from the lack of written description defense.²

For the foregoing reasons, the Court grants Omega's motion *in limine* to preclude the presentation of evidence by CalAmp on the invalidity defenses of lack of enablement and indefiniteness. The Court will defer ruling on the defense of lack of written description pending trial; however, CalAmp may not address the lack of written description defense in opening statement or present evidence on this issue until the Court has had an opportunity to discuss with counsel the context of the deposition testimony on the issue of "control function" to determine whether Omega was provided timely and adequate notice of this defense.³

C. Undisclosed Anticipation Theories

Omega next moves to exclude CalAmp's invalidity theory under 35 U.S.C. § 102 for the '989 Patent. (Doc. 94, p. 5). Omega notes that CalAmp contends that the Trimble CrossCheck "'anticipates' the claims of the '989 patent." (*Id.*). Omega asserts that, in fact, CalAmp relies upon multiple documents to support its anticipation defense as to the '989 Patent. (*Id.*). Omega correctly reminds the Court that anticipation requires disclosure of the identical invention in a single reference and may not draw upon multiple references, as one may to allege obviousness. *King Pharm., Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274 (Fed. Cir. 2010). CalAmp incorrectly argues that anticipation may be shown by citing

² CalAmp's response is titled "Lack of Adequate Written Description" and does not address enablement or indefiniteness. (See Doc. 101, p. 2).

³ The ruling on Omega's motion to exclude undisclosed invalidity theories is not intended to address whether properly identified prior art references may be cited to support invalidity, anticipation and/or obviousness.

to multiple documents, and cites several cases which it contends support this premise. (Doc. 101, pp. 3–4)

The jurisprudence from the Federal Circuit clearly establishes that “anticipation requires all elements of a claim to be disclosed within a single reference.” *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1364 (Fed. Cir. 2008). Additionally, the prior art reference “must also disclose those elements arranged as in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (internal quotation marks omitted). While CalAmp cites *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1327 (Fed. Cir. 2001) to distinguish this proposition, *Telemac* holds that “[a] prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently, to anticipate.” Moreover, *Unitherm Food Systems, Inc. v. Swift-Eckrich, Inc.*, 375 F.3d 1341, 1352–54 (Fed. Cir. 2004), cited by CalAmp, addresses the defense of public use and public sale, as opposed to anticipation, and *Netscape Communications Corp. v. Konrad*, 295 F.3d 1315, 1320 (Fed. Cir. 2002), also pertains to the defense of public use. The other cases cited by CalAmp either support Omega’s position or are inapposite to the defense of anticipation.

To the extent CalAmp intends to use more than a single prior art reference to support its defense of anticipation as to the ‘989 Patent, or any other patent-in-suit, CalAmp is prohibited from so doing. Accordingly, Omega’s motion in limine will be granted.

Omega next asserts that CalAmp disclosed for the first time after the close of discovery, in opposition to Omega’s motion for summary judgment, that it was relying upon the features of the Trimble CrossCheck device to establish anticipation. (Doc. 94,

p. 5). CalAmp responds that the invalidity contentions identify the Trimble CrossCheck manuals, and Mr. Andrew's expert report identifies the CrossCheck AMPS Mobile Unit as including all aspects of the asserted claims of the '989 Patent. (Doc. 101, p. 4). It appears from the briefing that the actual Trimble CrossCheck device will be used by CalAmp to support its anticipation defense relative to the '989 Patent. It further appears that the physical device was not disclosed to Omega in discovery (Doc. 94, p. 5), a fact not contested by CalAmp.

Based upon the record as it stands, the Court is unable to determine whether the untimely disclosure of the Trimble CrossCheck device prejudices Omega, since various documents relating to the device were disclosed in a timely manner. Clearly, the failure to disclose an exhibit relied upon by one's expert in the formulation of opinions is quite serious, as is precluding opposing counsel from having the opportunity to inspect and test the device. The Court will defer ruling on the admissibility of the Trimble CrossCheck device pending discussion with counsel regarding any prejudice or surprise, or lack thereof, sustained by Omega due to the untimely disclosure of the device.

D. Undisclosed Improper Inventor Theory

Omega avers that during the preparation of the Joint Final Pretrial Statement CalAmp raised for the first time the defense that one or more of the patents-in-suit are invalid because they fail to satisfy the requirement that the actual inventor be named. (Doc. 94, pp. 5–6). Omega notes that this theory of invalidity was not identified in response to Interrogatory Number 6 or in CalAmp's invalidity contentions.⁴ CalAmp's

⁴ The Court has reviewed the interrogatory answers and the initial and supplemental invalidity contentions prepared by CalAmp, and there is no reference to invalidity due to improper inventor.

counterclaim for declaratory judgment of invalidity of the patents-in-suit alleges that the “Patents-in-Suit, and each claim thereof, are invalid, for failure to comply with one or more of the provisions of 35 U.S.C. §§ 101, *et seq.*, including without limitation 35 U.S.C. §§ 101, 102, 103, and 112.” (Doc. 20, ¶ 83). While Count II of the counterclaim incorporates by reference paragraphs 1 through 74, none of these paragraphs allege that the patents-in-suit are invalid due to the failure to disclose the proper inventor.⁵

In response, CalAmp contends that “this information is closely related to CalAmp’s inequitable conduct claim.” (Doc. 101, p. 4). CalAmp argues that it became clear during the deposition of the inventor, Mr. Flick, that he lacked sufficient understanding of the language in his own patents or what they covered so as to raise an issue of whether Mr. Flick “improperly signed the oaths and declarations as required by the USPTO.” (*Id.* at p. 5). CalAmp does not contest Omega’s argument that CalAmp raised the defense of improper inventorship for the first time well after the close of discovery. Rather, CalAmp suggests that evidence of Mr. Flick’s alleged lack of familiarity with the invention is relevant to—and inextricably intertwined with—the inequitable conduct defense.⁶ However, the Court granted Omega’s summary judgment motion as to CalAmp’s counterclaim for inequitable conduct, which in fairness to CalAmp had not occurred at the time CalAmp briefed its response to the motion *in limine*.

⁵ The introductory paragraphs of the counterclaim fail to identify 35 U.S.C. §§ 111 and 115 which pertain to the written application and inventor’s oath.

⁶ While Mr. Flick may have lacked some familiarity with the details of the drawings and language employed in the prosecution of the patent application, it is clear that “conception is the touchstone of inventorship, the completion of the mental part of invention.” *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1227–28 (Fed. Cir. 1994).

Since there is no dispute that CalAmp failed to place Omega on notice that it intended to assert the defense of improper inventorship until the defense was asserted in CalAmp's statement of the case in the Joint Final Pretrial Statement, the Court finds the defense may not now be asserted. The failure of CalAmp to disclose this defense in response to Omega's interrogatories, in CalAmp's initial and supplemental invalidity contentions, and in the report of its expert results in prejudice to Omega who may have, if placed on notice, elected to retain an expert on this potentially dispositive issue. Thus, Omega's motion *in limine* will be granted.

E. Testimony Outside the Scope of Expert Report

1. Unfair Competition Damages

Omega seeks to exclude testimony from CalAmp's experts on the issue of damages allegedly sustained by CalAmp due to Omega's alleged unfair competition. (Doc. 94, p. 7). This motion is rendered moot by the Court's Order on Omega's motion for summary judgment. Moreover, CalAmp failed to articulate in its Rule 26(a)(1) disclosure the damages allegedly sustained as a result of unfair competition, and CalAmp affirmatively stated that "[a]t this time, CalAmp has not asserted claims for damages in this action outside of an award of fees and costs, but reserves the right to claim damages if such claims arise from conducting discovery in this matter." (Doc. 94-1, p. 3). CalAmp never supplemented the Rule 26(a)(1) disclosure, and neither expert retained by CalAmp addressed this issue. Omega's motion *in limine* will be denied as moot.

2. Undisclosed Evidence of Use of the Accused Devices

Omega submits that CalAmp disclosed for the first time on September 8, 2015 (after the close of discovery) that it possessed data related to the use of the Accused

Devices by end users which may demonstrate that only a subset of end users implement the Accused Devices in a manner that requires multi-vehicle operation. (Doc. 94, p. 8). Omega contends that neither of CalAmp's retained experts have offered opinions on this issue and that no lay witness with knowledge of this fact was identified in CalAmp's Rule 26(a)(1) disclosure. (*Id.*).

CalAmp opposes the relief sought by Omega, accurately observing that Omega has the burden of showing that the Accused Devices infringe. (Doc. 101, p. 7). CalAmp argues that Omega failed to ask Mr. Andrews, CalAmp's expert, or any of CalAmp's lay witnesses whether the Accused Devices send only a single message. (*Id.*). This is important because CalAmp contends that the Accused Devices do not infringe if they send only a single message. (*Id.*). CalAmp concludes that to the extent CalAmp witnesses have information they could testify to regarding the operation of the Accused Devices, including which vehicles utilize which bus type, it should not be precluded from offering the testimony "simply because Omega did not inquire into these areas." (*Id.* at pp. 7–8). Finally, CalAmp submits that it had no duty to inquire of its own witnesses into these areas. (*Id.* at p. 8).

The issue is not quite this straight-forward. CalAmp asserts in Count I of its counterclaim the following important allegations:

78. Counterclaimant CalAmp is not infringing, and has not infringed, contributed to the infringement of, or induced the infringement of any valid and enforceable claim of any of the Patents-in-Suit, either literally or under the doctrine of equivalents.

(Doc. 20, ¶ 78)

CalAmp asserted the counterclaim that the Accused Devices do not infringe the patents-in-suit and was obligated to identify individuals likely to have discoverable

information pursuant to Federal Rule of Civil Procedure 26(a)(1). CalAmp identified Gallin Chen, Senior Director of Business Development for CalAmp, and Steve Hall, Director of Systems Engineering and Technology at CalAmp, as individuals likely to have information that CalAmp may use to support its counterclaims and/or defenses. (Doc. 94-1, p. 2). Both of these witnesses were identified by CalAmp as having knowledge of the operation of the LMU-3000. (*Id.*). To the extent these two witnesses may testify about how the LMU-3000 operates, they have been properly disclosed. CalAmp did not disclose any other witnesses as having relevant knowledge, and the time for so doing has passed. The extent to which these two gentlemen are competent as lay witnesses to explain the operation of the Accused Devices will be addressed at trial, if necessary, outside the presence of the jury.

Mr. Andrews is a retained expert, and he is required to submit a detailed report, pursuant to Rule 26(a)(2)(B)(i–vi), including “a complete statement of all opinions the witness will express and the basis and reasons for them.” Fed. R. Civ. P. 26(a)(2)(B)(i). While CalAmp has no duty to inquire of its own expert witness during the deposition, CalAmp does have an affirmative duty, via its expert, to disclose with specificity the opinions to be offered by the expert to place Omega on notice of the areas requiring investigation. To the extent Mr. Andrews now seeks to render opinions not previously disclosed in his written expert report, he is precluded from so doing. See Fed. R. Civ. P. 37(c)(1).

It is unclear from CalAmp’s response whether it intends to offer testimony from lay or expert witnesses about the statistical subset of vehicles whose end users utilize the Accused Devices in a manner constituting infringement of the patents-in-suit. Clearly, the

admissibility of expert testimony is linked directly to the expert's report, and the admissibility of lay witness testimony will depend on whether the witness was identified in the Rule 26(a)(1) disclosure and competency of the lay witness.⁷

Accordingly, the Court will grant Omega's motion *in limine* as follows: no expert may testify to matters not properly addressed in the expert's Rule 26 report, and no lay witness may testify on the issue of whether the Accused Devices send only a single message or on the subset of end users operating the Accused Devices in a manner constituting infringement of the patents-in-suit without first alerting the Court.

F. Precluding CalAmp from Calling Omega's Invalidity Expert

Omega also seeks to preclude CalAmp from calling Plaintiff's expert, Mr. McAlexander, as an expert witness in CalAmp's case-in-chief to testify regarding unfair competition. (Doc. 94, p. 8). Since CalAmp failed to allege unfair competition in its amended counterclaim, this motion will be denied as moot.

CalAmp suggests that it may call Mr. McAlexander not only to testify about unfair competition but to address whether some or all of the patents-in-suit are entitled to priority predating the prior art references offered by CalAmp to demonstrate invalidity. (Doc. 101, p. 9). In the event CalAmp presents evidence that some or all of the patents-in-suit are invalid due to prior art references, the burden of persuasion shifts back to Omega to establish that the patents-in-suit are entitled to an earlier priority date. CalAmp contends that Mr. McAlexander provided testimony in prior litigation in which he allegedly asserted that certain claims within certain patents-in-suit were not disclosed in the '551 Patent.

⁷ The Court disagrees with Omega's contention that only an expert should be permitted to testify on these matters. (Doc. 94, p. 8).

(*Id.*). CalAmp states that it may call Mr. McAlexander as a “percipient” witness regarding this prior testimony. (*Id.*). Since Omega did not raise this issue in its motion *in limine*, the Court need not determine whether Mr. McAlexander may be called by CalAmp to address alleged prior admissions regarding whether some of the patents-in-suit are entitled to a priority date preceding the prior art. To the extent CalAmp seeks to call Mr. McAlexander to discuss his prior testimony, the Court reserves judgment on whether this line of questioning will be permitted.

G. Improper Character Evidence of Ken Flick

During the deposition of Mr. Flick, the inventor of the patents-in-suit, CalAmp posed questions regarding Mr. Flick’s knowledge of the diagrams, claims, and specifications of the various patents-in-suit. (Doc. 94, pp. 9–10). Omega submits that Mr. Flick suffers from dyslexia and contends CalAmp’s questioning of Mr. Flick unfairly highlights his learning disability. (*Id.*).

CalAmp states it was unaware of Mr. Flick’s learning disability, which was not raised by Omega until after the deposition. (Doc. 101, p. 11). Rather than harassing Mr. Flick, CalAmp contends the questioning is intended to “determine his factual knowledge, determine what he actually invented, and determine the basis for his sworn oath.” (*Id.* at p. 12).

The Court has previously ruled that the defense of improper inventorship was not asserted in a timely manner, and the Court granted summary judgment on CalAmp’s counterclaim of inequitable conduct. Accordingly, Omega’s motion *in limine* will be granted. To the extent CalAmp offers an alternative basis for questioning Mr. Flick about his knowledge of the patents-in-suit, CalAmp is directed to so advise opposing counsel

and the Court at which time the Court will entertain CalAmp's proffer of the relevance of this line of questioning. CalAmp may not comment on Mr. Flick's knowledge of the patents-in-suit in opening statement without prior authorization from the Court.

H. Unauthenticated Documents and Physical Devices as Prior Art

Omega argues that CalAmp has identified several documents it contends constitute prior art, including Defendant's Exhibits 12–16, 18–26, 35, and 36, (Doc. 90-2), and submits that these exhibits should be excluded because CalAmp failed to demonstrate during discovery that the documents were sufficiently disseminated and accessible to qualify as prior art under § 102.⁸ (Doc. 94, p. 12). Omega also argues that CalAmp has failed to authenticate the exhibits. (*Id.*). Furthermore, Omega seeks the exclusion of the CrossCheck AMPS device listed as Exhibit 19 on the basis that it was not disclosed by CalAmp during discovery. (*Id.*). Omega avers it has been denied the opportunity to inspect and test the physical device and the opportunity to ascertain whether the device was within the United States prior to the patents-in-suit. (*Id.* at p. 13).

CalAmp proffers that its witnesses are competent to authenticate the documentary exhibits consistent with Federal Rule of Evidence 901. (Doc. 101, p. 12). CalAmp outlines in its reply the manner by which its witnesses will authenticate documents obtained from the Internet. (*Id.*). Issues of authentication, exceptions to the prohibition against hearsay, and the competency of whether lay witnesses lay the requisite foundation for CalAmp's exhibits shall be reserved for trial. Based on the record, the Court is unable to determine

⁸ For documentary evidence to qualify as prior art, the documents must be published prior to the invention. See 35 U.S.C. §102. “[D]issemination and public accessibility are the keys to the legal determination whether a prior art reference was published.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (internal quotation marks omitted).

whether the documentary exhibits identified Omega are admissible. Accordingly, Omega's motion *in limine* will be denied.

Regarding the physical device—the Trimble CrossCheck Device—CalAmp concedes that the device was acquired after the close of discovery, preventing the expert witnesses retained by Omega and CalAmp from inspecting the device. (*Id.* at p. 14). CalAmp suggests that any prejudice associated with the untimely acquisition of this device is cured by the prior production of “information . . . relating to the Trimble CrossCheck device.” (*Id.*). Since CalAmp failed to submit for the Court's review the information previously provided to Omega, the Court cannot ascertain whether the acquisition of the physical device after the close of discovery prejudices Omega. The Court is not comforted by CalAmp's observation that one of its witnesses “will testify as to the details of the acquisition of the device, and the jury can decide how much weight to give to his testimony.” (*Id.*). The Court is charged with ensuring the parties are not prejudiced by the untimely production of trial exhibits and is responsible for determining whether evidentiary foundations have been met. It is no small matter that Omega has been denied the opportunity to inspect the physical device to independently determine whether a challenge to its admissibility should be raised.

The Court will defer ruling on the admissibility of the exhibits, including the physical device, pending trial. However, CalAmp is instructed not to present the Trimble CrossCheck device to the jury in opening statement and is prohibited from discussing the physical device with witnesses for either party until the Court has ruled on the admissibility of the device.

I. Oral Testimony Regarding State of the Art

Omega objects to CalAmp's witnesses presenting generic, uncorroborated oral testimony of prior inventorship (Doc. 94, pp. 13–14). *Tex. Dig. Sys. v. Telegenix, Inc.*, 308 F.3d 1193, 1218 (Fed. Cir. 2002) (upholding district court's refusal to admit uncorroborated oral testimony of prior inventorship). Omega offers by way of illustration deposition testimony of Mr. Chen, a CalAmp representative, who is credited with testifying that “there was significant prior art on the so-called GPS patents . . . so we felt that the patents[-in-suit] should be invalid.” (Doc. 94, p. 13). CalAmp distinguishes the facts of the jurisprudence cited by Omega and argues that “[t]o the extent that Omega is referring to oral testimony regarding any of the devices described in various documents, then such testimony is not oral testimony alone, but is corroborated by the documentation.” (Doc. 101, p. 15). CalAmp suggests that Mr. Chen is “entitled to explain the search and review process he went through, and what he relied on, and the jury can evaluate such testimony.” (*Id.*).

Both parties are correct in their respective positions. Omega is correct that a witness, whether an expert or a lay witness, may not offer uncorroborated oral testimony on the issue of prior inventorship or invalidity. CalAmp is correct that a witness—if the proper predicate is laid—may testify about documents reviewed which support his or her testimony regarding prior inventorship. The facts offered by both parties are inadequate to support a ruling *in limine* on this point. However, the Court reminds the parties that the first consideration is whether the document identified by the witness has been disclosed in discovery, via invalidity contentions, expert report(s), or responses to discovery requests. No witness may predicate his or her testimony upon documents that have not

been disclosed to opposing counsel. Whether Mr. Chen is competent as a lay witness to authenticate documents, which are by definition hearsay, and whether he is competent to offer lay testimony, properly limited in scope and consistent with Federal Rule of Evidence 701, remains to be determined.⁹ Based upon the current record, and with the guidance provided herein, Omega's motion *in limine* will be denied.

J. Reference to Omega as a "Patent Troll"

Omega requests a ruling prohibiting CalAmp from referring to it as a "patent troll" or a "patent pirate," (Doc. 94, p. 14), and CalAmp agrees with this request (Doc. 101, p. 16). As a result, Omega's motion *in limine* will be granted.

III. CONCLUSION

Accordingly, it is **ORDERED AND ADJUDGED** that Plaintiff Omega Patents, LLC's Motion *In Limine* (Doc. 94) is **GRANTED IN PART** and **DENIED IN PART** as stated herein.

DONE AND ORDERED in Orlando, Florida on January 19, 2016.


PAUL G. BYRON
UNITED STATES DISTRICT JUDGE

Copies furnished to:
Counsel of Record

⁹ Federal Rule of Evidence 701 permits lay witnesses to testify in the form of an opinion, if the opinion is "(a) rationally based on the witness's perceptions; (b) helpful to clearly understanding the witness's testimony or to determining a fact in issue; and (c) not based on scientific, technical, or other specialized knowledge within the scope of Rule 702."