

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

TQ DELTA LLC,	:	
	:	
Plaintiff,	:	
	:	
v.	:	Civil Action No. 14-954-RGA
	:	Consolidated
ADTRAN, INC.,	:	
	:	
Defendant.	:	

ORDER ON MOTIONS IN LIMINE RE: FAMILY 4 PATENTS

PMIL #1 (D.I. 1047-12). Plaintiff makes five arguments in three pages. The motion should be denied for that reason alone. The arguments are generally that Defendant's expert will testify contrarily to the requirements of various construed or plain meaning claim limitations. The arguments relate to: (1) the "phase characteristic" is output from a constellation encoder; (2) "computing a phase shift" requires a mathematical operation resulting in a number or a "two-bit value"; (3) "combining" requires a mathematical operation; (4) an "input" has to come from an external source; and (5) infringement of claim 14 of the '041 patent depends on configuration by customers. On constellation encoder, Plaintiff also argues that the expert's opinions are not disclosed, but Defendant cites to the expert's report as disclosure, and Plaintiff did not respond in its reply papers other than in a footnote. Thus, I consider the opinions are disclosed. Defendant otherwise responds to Plaintiff's arguments: (1) the output from a constellation encoder "flows from the plain and ordinary meaning of phase characteristic;" (2) the expert is not going to say that a mathematical equation is required; (3) the expert is not going to say that "combining" requires mathematical operations on complex numbers; (4) the expert is not going to construe

“input bit stream,” although he will say it is not met based on “the relevant facts;” and (5) the expert is going to testify as to “the state of certain elements, not capabilities.” Plaintiff’s reply interprets Defendant’s responses to more or less resolve the second and third disputes. As to the first, Defendant’s expert is not allowed to offer claim construction of “phase characteristic,” but he can testify as a fact (if it is a fact) that one can only get a phase characteristic from a constellation encoder output. As to the fourth, Defendant’s expert cannot construe “input” but can say (if it is a fact) that whatever Plaintiff is pointing to as an input is not an input because it does not come from an external source. As to the fifth, there seems to be a claim construction dispute. The parties present nothing in the motion in limine that would allow me to resolve that dispute. Thus, while noting Defendant’s representations in regard to items two and three, all requests are DISMISSED without prejudice to Plaintiff making appropriate objections at trial if Defendant’s expert engages in claim construction during his testimony.

PMIL #2 (D.I. 1047-13). Plaintiff makes three arguments in three pages. The arguments are or relate to: (1) the source code does not store or operate on two-bit pairs; (2) bit scramblers; and (3) particular lines of source code. In response, Defendant says: (1) both sides’ experts agree the source code stores and operates on two-bit values; (2) the source code operates by scrambling bits, not phase characteristics, and Defendant’s expert offered an opinion in his expert report (D.I. 969 at 527 of 843, ¶ 97) that supports the scrambling bits opinion; and (3) the expert cited the particular lines of source code at issue by citing the portion of Plaintiff’s expert’s report that cited the source code. In reply, Plaintiff says: (1) both sides’ experts agree that the source code does not store or operate on two-bit pairs; (2) Defendant’s expert did not offer bit scrambling opinions in his expert report; and (3) Defendant’s expert did not respond to a particular phrase in Plaintiff’s argument. The first argument contains opposing assertions about what the experts will

say. I cannot resolve that on a motion in limine; thus, the request is DENIED. In regard to the second argument, Defendant's expert's opinions appear to be disclosed in his report. If Defendant's attorneys are arguing that he says something that he doesn't say, Plaintiff can bring that out through cross-examination. Right now, I can't tell. In regard to the third argument, Plaintiff does not argue with the general point Defendant makes. Thus, Plaintiff's second and third requests are DENIED.

PMIL #3 (D.I. 1047-14). Plaintiff seeks to prevent six different invalidity arguments by Defendant's expert, based on the assertion that he has not disclosed the opinions. Plaintiff seeks to prohibit Defendant's expert from testifying that prior art "necessarily" reduces PAR. From what I can tell by Defendant's response, it concedes that its expert has not offered that opinion, but disputes that such an opinion is required. Thus, without resolving the legal question here, Plaintiff's motion is granted on this particular argument. The second issue is moot, as Defendant agrees that it will not argue Stopler or Hayashino combined with the knowledge of a POSITA. On the third issue, while the brevity of the parties' arguments makes it difficult to understand them, it does appear to me, contrary to Plaintiff's argument, that Defendant's expert explicitly combines Hayashino and Shively. (*E.g.*, D.I. 969 at 147-49 of 843, ¶¶ 344-46). On the fourth issue, the parties agree that Jones does not "inherently" disclose a pseudorandom number generator. (D.I. 1047-14 at 5, 10, 12). Thus, that request will be dismissed as moot. On the fifth issue, Defendant's expert has sections in his invalidity report that are captioned "obviousness over Jones" (D.I. 969 at 280 & 399 of 843; *see, e.g., id.* at 291 of 843, ¶ 824), which seem to disclose a combination of Jones and the knowledge of a POSITA. On the sixth issue, Defendant cites a portion of its expert's reply report (D.I. 969 at 766-67 of 843, ¶ 448) that seems to have all the concepts Plaintiff says are missing. Plaintiff in its reply does not retreat from its position,

but neither does it offer any explanation why the expert report is insufficient. Thus, Plaintiff's first request is GRANTED, the second is DISMISSED as moot, the third is DENIED, the fourth is DISMISSED as moot, the fifth is DENIED, and the sixth is DENIED.

DMIL #1 (D.I. 1047-17). Defendant's motion states that Plaintiff is going to make two contradictory arguments for infringement. Defendant states the jury will be confused, and the standards-based argument should be excluded. If in fact Plaintiff intends to offer contradictory arguments, which Plaintiff denies, that can only benefit Defendant, who can use effective cross-examination to its benefit. I also note that a standards-based argument is more likely to be understood by the jury than a source-code based argument. Thus, the standards-based argument has probative value that is not substantially outweighed by the risk of confusion. Defendant's motion is DENIED.

DMIL #2 (D.I. 1047-18). Defendant's motion mostly concerns claim construction. The claim construction arguments concern: (1) "amongst the carriers;" and (2) "substantially scramble." Defendant throws in an argument about Dr. Madisetti offering a new opinion on a limitation that Hayashino does not disclose. Plaintiff states that while its expert uses the phrase "amongst the carriers," the expert is doing so not to add a limitation but to explain why PAR is not reduced. As far as I can see, Plaintiff is right on this one, and thus Defendant's request on it is DENIED. On the second claim construction argument, Plaintiff responds that none of its expert's opinions are contrary to the claim construction for "substantially scrambles." Defendant's reply paints the issue as one of consistency, that is, whether Plaintiff is arguing capability on infringement but saying that showing capability in the prior art is not enough on invalidity. I do not think that is what Plaintiff is doing, but, if I am wrong, Plaintiff is on notice that if I have to declare a mistrial, it will have to pay for the cost of this trial before I hold a

retrial. Defendant's motion on the second point is DENIED. On the third point, Plaintiff states generally that anything said in a deposition becomes a disclosed opinion. I disagree with that general proposition. Here, Plaintiff's expert offered an opinion about Hayashino for no apparent reason. There is argument that there may be other opinions where Dr. Madisetti is responding to deposition testimony of Defendant's expert or elaborating on something in his report. Those are different cases. But absent proper supplementation of Dr. Madisetti's reports, the particular opinion about Hayashino is excluded. Defendant's motion on the third point is, to that extent, GRANTED.

DMIL #3 (D.I. 1047-19). This is Defendant's grab-bag motion. It for the most part concerns issues that have arisen in prior related trials. To the extent I can, I expect to make roughly the same rulings as I have made in the two prior related trials. Thus, I do not want anyone introducing anything about discovery issues without my express permission; there should be no discussion about any interactions between Plaintiff and Defendant on the subject of licensing (i.e., no discussion of "why [Plaintiff] approached Adtran in the first place"); there should be no discussion about whether the patents-in-suit or other patents have been licensed by anyone. I am going to allow the inventor to testify about the significance of his inventions and the problems he was facing and trying to solve. Other than these general guidelines, parties must object to specific questions that seek irrelevant – or barely relevant but very prejudicial – testimony. Somewhat out of the mainstream of the issues Defendant raises, Defendant also seeks to preclude Plaintiff's expert – Dr. Madisetti – from discussing "the functionality and design of prior art bit scramblers." Plaintiff says it is offering the opinions for only one point, which is to respond to Defendant's expert's opinions about bit scramblers. Plaintiff seems to concede the discussion of prior art bit scramblers is offered, not in relation to invalidity, but in relation to

literal infringement. I gather that Plaintiff's rather convoluted argument is that bit scramblers were known at the relevant time, they were different than Defendant's product, so Defendant's product must not be a bit scrambler. (*See id.* at 9). I am having a hard time understanding the logic of Plaintiff's position. Generally-speaking, infringement is determined by comparing the accused product to the relevant claim. The prior art is irrelevant. But I think the better course is to reserve this issue for trial. The parties should bring this issue up when there is some context for understanding it. I decline to decide it now.

IT IS SO ORDERED this 17th day of August 2020.

/s/ Richard G. Andrews
United States District Judge