

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

IMAGE PROCESSING TECHNOLOGIES,
LLC,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,
and SAMSUNG ELECTRONICS
AMERICA, INC.,

Defendants.

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Case No. 2:20-CV-00050-JRG-RSP

ORDER ON MOTIONS *IN LIMINE*

The Court held a Pretrial Conference in the above-captioned case on June 1, 2020 and June 4, 2020, regarding motions *in limine* filed by Plaintiff Image Processing Technologies, LLC (“IPT”) (**Dkt. No. 78**) and Defendants Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, “Samsung”) (**Dkt. No. 76.**). This Order summarizes and memorializes the Court’s rulings and reasons, including additional instructions given to the parties. While this Order memorializes such rulings, it in no way limits or constrains the Court’s rulings as announced into the record from the bench. Further, a party must approach the bench before introducing evidence or argument about the subject matter of a motion *in limine* that has been granted. Accordingly, it is hereby **ORDERED** as follows:

A. IPT's Motions *in Limine* (Dkt No. 78)

1. IPT's MIL No. 1: Preclude Samsung From Mentioning (1) Dismissed Or Non-Asserted Claims or Patents, and (2) Claims or Patents Pending in the Other Case.

This motion *in limine* is **GRANTED** to the extent that neither side is permitted to make any mention of the fact that other claims or patents were asserted previously and have been withdrawn or dropped before the jury. The effect of granting this is that Counsel needs to seek leave from the Court before deviating from this in the presence of the jury, but not that there can be no reference to any other patent or claim.

2. IPT's MIL No. 2: Preclude Samsung from Mentioning any PTO Proceedings Relating to the Patents or Claims Now or Previously Pending in Either Case.

This motion *in limine* is **GRANTED** with the understanding that there should be no reference to the Patent Trial Appeal Board or Patent and Trademark Office post-grant proceedings before the jury.

3. IPT's MIL No. 3: Preclude Samsung From Presenting Arguments That Do Not Conform To The Court's Claim Construction Order, Or That Reference Positions Taken During Claim Construction Or The Court's Statements In The Order.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party will present arguments that do not conform to the Court's claim construction order, or that reference positions taken during claim construction or the Court's statements in the Order." Dkt. No. 152 at 1.

4. IPT's MIL No. 4: Preclude Samsung And Its Witnesses From Disparaging Image Processing's And GPC's Structure, Business Model, And Patent Enforcement Practices.

This motion *in limine* is **GRANTED** as reflected in the Proposed Joint Pretrial Order

(Dkt. No. 77) in §(V)(C)(11). This language states: “Preclude Samsung and its witnesses from referring to Image Processing or its managing member General Patent Corporation (GPC) as “Trolls” or similar pejorative terms. This category does not preclude Samsung from offering argument, testimony or evidence of a factual nature concerning Image Processing’s business model” Dkt. No. 77 at 10.

5. IPT’s MIL No. 5: Preclude Samsung From Mentioning The Possibility Of Injunctive Relief Or The Actual or Potential Impact Of A Verdict On Samsung Or The Market.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: “Neither party will mention the possibility of injunctive relief or the actual or potential impact of a verdict on Samsung or the market.” Dkt. No. 152 at 1.

6. IPT’s MIL No. 6: Preclude Samsung From Mentioning Unconsummated Licenses To The Asserted Patents And Any Related Negotiations.

This motion *in limine* is **GRANTED**.

7. IPT’s MIL No. 7: Preclude Samsung From Mentioning Sales Or Efforts to Sell The Asserted Patent, And Any Related Negotiations.

This motion *in limine* is **GRANTED IN PART** as to the unconsummated sale through Ocean Tomo. This motion *in limine* is **DENIED IN PART** as to how the patent was acquired.

8. IPT’s MIL No. 8: Preclude Samsung From Discussing Non-Infringing Alternatives Not Disclosed During Fact Discovery.

This motion *in limine* is **DEFERRED** until the orders resolving IPT’s Daubert Motion to Exclude the Testimony of Michael E. Tate (Dkt. No. 14) and IPT’s Motion to Strike Portions of Expert Reports and Preclude Certain Testimony of Dr. Robert L. Stevenson (Dkt. No. 15).

9. IPT's MIL No. 9: Exclude Any Evidence Or Argument Comparing The Preferred Embodiments Or Any Commercial Embodiment Of The Asserted Patents To The Accused Instrumentalities.

This motion *in limine* is **GRANTED**.

10. IPT's MIL No. 10: Preclude Samsung From Presenting A “Practicing Prior Art” Defense, Or Comparing Prior Art To Image Processing’s Infringement Theories.

This motion *in limine* is **GRANTED**. Whatever probative value there may be in the cross-examination of Dr. Bovik on his approach to invalidity, it here is outweighed by the prejudicial effects, confusion to the jury, and unnecessary consumption of time, in view of the dropping of the challenge to validity.

11. IPT's MIL No. 11: Preclude Testimony Beyond or Contradicting Samsung’s Rule 30(b)(6) Testimony, Or Not Provided During Fact Discovery.

This motion *in limine* is **DENIED** as unnecessary.

12. IPT's MIL No. 12: Preclude Samsung’s Reliance On Agreements With Its Suppliers.

This motion *in limine* is **DENIED** with the understanding that the corresponding testimony will be consistent with documentation produced during discovery and not any underlying documentation that was not produced.

13. IPT's MIL No. 13: Preclude Both Parties From Referencing Daubert Rulings In Any Cases.

This motion *in limine* is **GRANTED** with the understanding that an expert witness opens the door by claiming they have never had their expert testimony limited. An expert witness here will not open the door by offering evidence of having expert testimony allowed in other courts or mentioning the number of times they have testified.

14. IPT's MIL No. 14: Preclude Samsung From Presenting Non-Comparable Licenses.

This motion *in limine* is **DENIED** with the exception that the dollar amounts from the six licenses Samsung contends are not economically relevant shall be redacted. These licenses are the Dicam, Inc., e.Digital Corporation, Minerva Industries, Inc., Walker Digital, LLC, InMotion Imagery Technologies, LLC, and Alex is the Best, LLC licenses. Dkt. No. 14 at 12.

15. IPT's MIL No. 15: Preclude Samsung From Relying On A Belief Of Noninfringement or Invalidity, Or Any Evidence Not Disclosed in Its Interrogatory Response.

This motion *in limine* is **DENIED**.

16. IPT's MIL No. 16: Preclude Samsung From Referring To Products That Are Not Accused Or Presenting Evidence That Unaccused Products Do Not Infringe.

This motion *in limine* is **GRANTED** with an express carveout that this grant does not cover anything that Samsung is allowed to present as a non-infringing alternative.

17. IPT's MIL No. 17: Preclude Reference To Samsung's Patents Or Patent Applications.

This motion *in limine* is **GRANTED IN PART** to the extent that Samsung is not permitted to use other patents as a defense to infringement in this case, but **DENIED** to the extent that Samsung may make reference to Samsung owning patents and being an innovator.

18. IPT's MIL No. 18: Preclude Reference To The Founding Of Samsung Or Irrelevant Achievements Of Samsung, Including Samsung's Contributions to The Job Market For American Workers.

This motion *in limine* is **GRANTED-IN-PART** and **DENIED-IN-PART**. Samsung may offer factual information to succinctly introduce itself, including its location, the number of employees it has, and what products it makes. Samsung may not introduce evidence of its charitable activities.

19. IPT's MIL No. 19: Preclude Either Party From Referencing Patent Marking.

This motion *in limine* is **GRANTED** based on the understanding that IPT is relying on Notice and not on Marking as the basis for pre-suit damages.

20. IPT's MIL No. 20: Preclude Samsung From Discussing Any Post-Discovery Changes To Its Accused Algorithms Or Use of Non-Accused Algorithms.

This motion *in limine* is **GRANTED** with the understanding that this does not preclude Samsung from discussing updated sales information or Samsung's continued use of these algorithms for the accused products.

21. IPT's MIL No. 21: Preclude Comment On the Absence of Overseas Witnesses.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party shall refer to the attendance or non-attendance of party representatives, decisions to call or not call particular witnesses, decisions to call witnesses live or by deposition or video, or the absence of any witness from trial." Dkt. No. 152 at 1.

22. IPT's MIL No. 22: Preclude Both Parties From Commenting On Expert Reports to the Extent Based on Other Patents or Claims, or on Information Relevant Only to the Previous Hypothetical Damages Negotiation

This motion *in limine* is **DENIED**.

B. Samsung's Motions *in Limine* (Dkt. No. 76)

1. Samsung's MIL No. 1: Expert Reports, Testimony, Or Opinions From Other IPT Litigations.

This motion *in limine* is **GRANTED** with respect to the limitation that IPT's damages expert Paul C. Benoit is precluded from referencing Bradford Kullberg's opinions from IPT's prior litigation against Canon. This ruling does not prohibit arguing for a value multiplier without reference to Kullberg. This motion *in limine* is **DENIED** with respect to Bruce Godfrey's report as disclosed by IPT to Samsung and the Court. The Court finds that Godfrey, as a survey expert, is the type of expert on whose report an economist, like Benoit, reasonably relies, which qualifies the report for the exception envisioned by Rule 703.

2. Samsung's MIL No. 2: Development, Operation or Efforts to Monetize the GVPP.

This motion *in limine* is **DENIED**, with the understanding that IPT will not imply that GVPP practices the '293 patent.

3. Samsung's MIL No. 3: Alleged Reactions To Or Offers For Licenses Never Consummated.

This motion *in limine* is **GRANTED** as to any offers that were not consummated and as to any hearsay statements of third parties.

4. Samsung's MIL No. 4: Third-Party Valuations.

This motion *in limine* is **GRANTED**.

5. Samsung's MIL No. 5: Third Party Reverse Engineering Reports.

This motion *in limine* is **DEFERRED** until the exhibits hearing.

6. Samsung's MIL No. 6: Pre-Suit Settlement And NDA Discussions.

This motion *in limine* is **GRANTED IN PART** and **DENIED IN PART**. This motion *in limine* is **GRANTED IN PART** as to some communications during the effective period of the standstill agreement and effective period of the NDA. The Court finds these periods to be October 3, 2013 through July 1, 2015, and March 2, 2016 through May 13, 2016 (the filing date of the

Underlying Suit). This motion *in limine* is **DENIED** as to any other period. Which communications outside the effective period of the standstill agreement and effective period of the NDA will be admitted will be addressed at the exhibit hearing.

7. Samsung's MIL No. 7: Opinions Of Counsel.

This motion *in limine* is **GRANTED**. IPT is allowed an opportunity to file notice of additional cases within one week of the pretrial conference.

8. Samsung's MIL No. 8: Testimony Concerning Infringement Or Non-Infringement By Non-Accused Products And Features.

This motion *in limine* is **MOOTED** by IPT's agreement not to assert that FotoNation infringes or that Canon's products do not infringe.

9. Samsung's MIL No. 9: FotoNation Being "Dropped" From Any Samsung Product.

This motion *in limine* is **GRANTED** to the extent that IPT's expert will not be permitted to testify about the alleged press release from FotoNation about the Samsung products.

10. Samsung's MIL No. 10: Other Samsung Litigations.

This motion *in limine* is **GRANTED**. The FotoNation case has been addressed separately at Dkt. No. 169.

11. Samsung's MIL No. 11: Defendants' Irrelevant And Prejudicial Financial Information.

This motion *in limine* is **DENIED**. If Samsung formally withdraws its expert's references to this information, it may reurge this motion after proper meeting and conferring, as appropriate.

12. Samsung's MIL No. 12: Negative Unrelated News.

This motion *in limine* is **GRANTED**.

13. Samsung's MIL No. 13: Taking Jobs From American Workers.

This motion *in limine* is **GRANTED**.

14. Samsung's MIL No. 14: Document Retention Practices Or Discovery Disputes.

This motion *in limine* is **GRANTED**.

15. Samsung's MIL No. 15: Patent Marking by IPT Or Its Licensees.

This motion *in limine* is **GRANTED** based on the understanding that IPT is relying on Notice and not on Marking.

16. Samsung's MIL No. 16: Money Allegedly Spent On R&D for the Inventions.

This motion *in limine* is **DENIED**.

17. Samsung's MIL No. 17: Irrelevant Details Regarding The Greslin Litigation.

This motion *in limine* is **DENIED** on the broad general grounds. The Court will take up the details at the exhibit hearing.

18. Samsung's MIL No. 18: Allegations Of Criminal Activity By Non-Witnesses.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party shall refer to any allegations of criminal activity by any party, witness or non-witness, including any convictions, contempt citations or related orders, arrests, arrest orders, or the like." Dkt. No. 152 at 2.

19. Samsung's MIL No. 19: Allegations That Samsung Does Not Respect Intellectual Property.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party shall introduce evidence or argument that either party in general respects or does not respect intellectual property rights. This agreement does not preclude either party from introducing evidence or argument that Samsung has or has not respected Plaintiff's rights in the Asserted Patent, subject to the other party's specific objections." Dkt. No. 152 at 2.

20. Samsung's MIL No. 20: Reference To Attendance Or Non-Attendance Of Representatives.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party shall refer to the attendance or non-attendance of party representatives, decisions to call or not call particular witnesses, decisions to call witnesses live or by deposition or video, or the absence of any witness from trial." Dkt. No. 152 at 1.

21. Samsung's MIL No. 21: References to COVID-19 or Disparagement Based on Nationality.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party shall refer to COVID-19 in connection with a party or its witnesses (including a decision to call or not call, or as a reason excusing attendance at trial), or shall refer to a witness's nationality, citizenship or place of residence in a disparaging manner." Dkt. No. 152 at 2.

22. Samsung's MIL No. 22: Non-Asserted Patents.

This motion *in limine* is **GRANTED**.

23. Samsung's MIL No. 23: Prior or Pending Motions.

This motion *in limine* is **GRANTED**.

24. Samsung's MIL No. 24: IPR and Ex Parte Reexamination Proceedings.

This motion *in limine* is **GRANTED**.

25. Samsung's MIL No. 25: Privilege Claims.

This motion *in limine* is **AGREED AS MUTUAL**. This agreement states: "Neither party will refer to a claim of privilege made by that party or the other party. This order in limine does not preclude either party from commenting on Samsung's failure to obtain an opinion of counsel, subject to other objections or MILs on this subject, or preclude a party from introducing evidence

of investigation or lack of investigation regarding the Asserted Patent, subject to other objections or MILs on this subject.” Dkt. No. 152 at 2.

26. Samsung’s MIL No. 26: Attorneys and Law Firms.

This motion *in limine* is **GRANTED**.

SIGNED this 8th day of June, 2020.


ROY S. PAYNE
UNITED STATES MAGISTRATE JUDGE