

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF FLORIDA**

Case No. 1:16-cv-21761-KMM

PRISUA ENGINEERING CORP.,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC.,  
SAMSUNG ELECTRONICS LATINOAMERICA  
MIAMI, INC.,

Defendants.

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**OMNIBUS ORDER**

This cause came before the Court upon various motions filed by Plaintiff Prisia Engineering Corp. (“Prisia”) and Defendants Samsung Electronics America, Inc., Samsung Electronics Co., Ltd., and Samsung Electronics Latinoamerica Miami, Inc.’s (collectively, “Samsung”).

**I. BACKGROUND**

Prisia alleges that Samsung has infringed upon U.S. Patent No. 8,650,591 (“the ’591 Patent”)—a patent indisputably owned by Prisia. The ’591 Patent, entitled “Video Enabled Digital Devices for Embedding User Data in Interactive Applications” generally relates to a method for generating an edited video data stream from an original video stream wherein generation of said edited video stream comprises a step of: substituting at least one object in a plurality of objects in said original video stream by at least a different object. In sum, Samsung argues that it did not infringe upon the ’591 Patent and, in the alternative, that the ’591 Patent is invalid. The Parties have litigated the matters of infringement and invalidity extensively.

## II. THE PARTIES' MOTIONS IN LIMINE

### A. Applicable Law

A motion in limine is “any motion, whether made before or during trial, to exclude anticipated prejudicial evidence before the evidence is actually offered.” *Luce v. United States*, 469 U.S. 38, 40 n. 2 (1984). Motions in limine are generally disfavored. *See United States v. Amor*, No. 14-20750-CR-Lenard/Goodman, 2015 WL 6438479, at \*1 (S.D. Fla. Oct. 23, 2015). Evidence is excluded upon a motion in limine “only if the evidence is clearly inadmissible for any purpose.” *Stewart v. Hooters of Am., Inc.*, No. 8:04-cv-40-T-17-MAP, 2007 WL 1752873, at \*1 (M.D. Fla. June 18, 2007).

Under Rule 401, “evidence is relevant if (a) it has any tendency to make a fact more or less probable than it would be with the evidence; and (b) the fact is of consequence in determining the action. Fed. R. Evid. 401. Under Rule 402, irrelevant evidence is not admissible. Fed. R. Evid. 402. And Rule 403 requires the Court to “balance[e] the probative value of and the need for the evidence against the harm likely to result from its admission.” Fed. R. Evid. 403, advisory committee note.

Generally, evidentiary rulings do not raise issues that are unique to patent law. *Honeywell Int’l Inc. v. Universal Avionics Systems Corp.*, 488 F.3d 982, 994 (Fed. Cir. 2007). The Court applies the law of the Court of Appeals for the Eleventh Circuit in making these procedural rulings. *Rhodia Chimie v. PPG Indus. Inc.*, 402 F.3d 1371, 1376–77 (Fed. Cir. 2005) (internal citation omitted).

B. **Prisua's Motion in Limine**<sup>1</sup>

Prisua moves to exclude evidence and argument relating to the *inter partes* review conducted by the Patent Trial and Appeal Board (“PTAB”) on the basis that such evidence is irrelevant and any probative value is outweighed by the risk of prejudice, confusion, and delay. In response, Samsung argues that the record in the *inter partes* review proceedings is highly relevant and that Prisua will not be unduly prejudiced.

On March 29, 2017, Samsung filed a petition with the PTAB seeking *inter partes* review of claims 1, 3–4, 8 (collectively, the “Asserted Claims”), and 11 of the ’591 Patent. On October 11, 2017, the PTAB declined to institute *inter partes* review of the Asserted Claims but did institute review of non-asserted claim 11. PTAB Decision (ECF No. 132-1). The PTAB stated that it “cannot conclude that [Samsung] has established a reasonable likelihood of prevailing in showing Claims 1, 3–4 and 8 are unpatentable under any of the asserted grounds.” *Id.* at 153.

Prisua seeks to exclude the PTAB’s Decision under Rules 401 and 402 of the Federal Rules of Evidence as irrelevant. An *inter partes* review proceeding conducted by a PTAB “is not an examination by a patent examiner in which a decision is made about the scope and validity of a patent. It is an adjudicative proceeding during which . . . three administrative law judges[ ] determine whether the challenger has shown ‘a reasonable likelihood’ that it will prevail on its challenges.” *Wisconsin Alumni Research Found. v. Apple, Inc.*, 135 F. Supp. 3d 865, 873 (W.D. Wisc. 2015) (citing *Abbott Labs v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013)). In *inter partes* proceedings, invalidity must be proved by a preponderance of the evidence as opposed to the clear and convincing standard of proof that applies in district court.

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<sup>1</sup> Prisua filed its Motion in Limine to Exclude Evidence and Argument Regarding *Inter Partes* Review (ECF No. 150). Samsung responded in opposition (ECF No. 177) and Prisua replied (ECF No. 200).

*Novartis AG v. Noven Pharms. Inc.*, 853 F.3d 1289, 1294 (Fed. Cir. 2017) (stating that even where the evidence before the PTAB and district court is the same, the PTAB may properly reach a different conclusion).

Here, Samsung sought review of the ‘951 Patent based on three prior art references. PTAB Decision (ECF No. 132-1) at 8. In denying institution on claims 1–4 and 8, the PTAB stated it could not determine the scope of claim 1 and therefore could not “determine whether the prior art teaches claim 1 and the claims that depend therefrom”—claims 2–4 and 8. *Id.* at 11. In essence, Samsung argues that the PTAB’s analysis of unasserted claim 11 is relevant because the limitations in claim 11 and claim 1 are virtually identical and therefore the PTAB’s rejection of certain of Prisua’s arguments is informative in this matter. However, the PTAB identified Claims 1 and 11 as independent claims and indeed treated them differently by declining to pursue *inter partes* review of claim 1 but doing so for claim 11. Because “[t]he IPR proceeding is subject to different standards, purposes and outcomes than both the original prosecution and this court proceeding,” and given that the PTAB’s findings of patentability pertain to unasserted claim 11, the relevance of the interlocutory PTAB Decision is minimal but the risk of prejudice and confusion high. *Wisconsin Alumni Research Found v. Apple, Inc.*, 135 F. Supp. 3d at 875.

One compounding factor requires attention: the PTAB declined to institute *inter partes* review of claims 1, 3–4, and 8 based on indefiniteness under 35 U.S.C. § 112. This, Prisua argues, was beyond the scope of the PTAB’s authority which is limited by 35 U.S.C. § 102, regarding anticipation, and 35 U.S.C. § 103, regarding obviousness. The Court need not review the PTAB’s scope of authority. The PTAB’s conclusions regarding indefiniteness must be excluded for the same reasons set forth above regarding the claim 11 analysis—the PTAB employs a different standard of review and considers different evidence.

In sum, the PTAB's findings with respect to claim 11 are not relevant to the issues before this Court regarding claim 1. Further, the risk of prejudice and confusion to the jury outweighs any purported benefit—the PTAB employed a different standard of review, considered different evidence, and made conclusions regarding an unasserted claim. *See Personalized User Model, L.L.P. v. Google Inc.*, No. 09-525-LPS, 2014 WL 807736, \*3 (D. Del. Feb. 27, 2014) (granting motion to exclude evidence of reexamination proceedings). Accordingly, Prisua's motion to exclude evidence of the PTAB's interlocutory decision is granted.

**C. Samsung's Omnibus Motion in Limine<sup>2</sup>**

Samsung moves to preclude Prisua from offering evidence or argument regarding: (1) Samsung's alleged discovery deficiencies; (2) Prisua's proposed licensing fee offered during its licensing negotiation with Samsung; (3) Samsung's or its affiliates' total net worth, total revenues and total profits; (4) infringement under the doctrine of equivalents; (5) references to other litigation involving Samsung or its affiliates, employees or officers; and (6) that Samsung Electronics Co. Ltd.'s headquarters is outside of the United States.

**1. Evidence of Samsung's Alleged Discovery Deficiencies**

Samsung moves to exclude any mention of alleged discovery deficiencies by Samsung. Samsung anticipates that Prisua will argue to the jury that Samsung's document production or other discovery responses were incomplete or insufficient based upon a statement contained in Prisua's damages expert's report. In response, Prisua clarified that there is no alleged discovery dispute regarding Mr. Leathers's receipt of certain documents because Mr. Leathers clarified the issue in a supplemental report. It is unclear what other issues Samsung anticipates with respect to arguments regarding alleged discovery deficiencies.

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<sup>2</sup> Samsung filed an Omnibus Motion in Limine (ECF No. 156). Prisua responded in opposition (ECF No. 179) and Samsung replied (ECF No. 206).

Accordingly, Samsung's broad request is denied without prejudice. The Court will address related issues, if any, as they arise during the course of trial.

2. Evidence of Prisua's Proposed Licensing Fee

On July 29, 2015, Prisua attempted to negotiate a licensing agreement with Samsung in connection with the '591 Patent. Samsung moves to exclude evidence that Prisua plans to introduce regarding the royalty rate of \$0.09 that Prisua proposed during its pre-litigation licensing negotiation with Samsung. Samsung argues that this proposed licensing fee evidence violates Rule 408 of the Federal Rules of Evidence.

Rule 408 provides that "conduct or statements made in compromise negotiations about the claim" are "not admissible—on behalf of any party—either to prove or disprove the validity or amount of a disputed claim." Fed. R. Evid. 408(a)(2). The purpose of excluding such evidence is to encourage settlement.

In response, Prisua argues that it is not attempting to prove or disprove the validity or amount of damages of any disputed claim but instead seeks to admit the \$0.09 rate because it is one of several considerations supporting Mr. Leathers's reasonable royalty calculation. Samsung clarified that it is not moving to exclude Mr. Leathers's use of the rate from the licensing agreement but instead moves to preclude Prisua from relying on the licensing negotiations conducted by the Parties. Prisua contends that license agreements are admissible in patent infringement cases when the expert has relied on them in calculating a reasonable royalty rate and cites several cases in support thereof. *See* Prisua's Response (ECF No. 179) at 8. But here there was no licensing agreement—Prisua merely proposed a licensing fee agreement which Samsung declined. Accordingly, the cases cited by Prisua do not support finding such evidence admissible.

To the extent Mr. Leathers supports the \$0.09 licensing fee by relying on licensing negotiations, Mr. Leathers may not do so. Mr. Leathers may rely on a \$0.09 licensing fee calculation if derived from sources other than Prisua's pre-litigation offer.

3. Evidence of Samsung's Net Worth

Samsung moves to exclude any evidence or argument relating to the total net worth, total revenues, and total profits of Samsung or its affiliates. Samsung argues that this evidence is irrelevant, highly prejudicial, and likely to mislead the jury. In response, Prisua argues that Samsung's request is overly broad and lacks specificity. Indeed, Prisua intends to introduce at trial "considerable evidence and argument relating to Samsung's financial information, all of which is highly relevant and admissible to prove its damages." Prisua's Response (ECF No. 179) at 10.

The Supreme Court has stated that "the presentation of evidence of a defendant's net worth creates the potential that juries will use their verdicts to express biases against big businesses." *State Farm Mut. Auto. Ins. Co. v. Campbell*, 538 U.S. 408, 417 (2003) (quoting *Honda Motor Co. v. Oberg*, 512 U.S. 415, 432 (1994)). Here, Samsung's request is clear, contrary to Prisua's assertion. The Court finds that evidence of Samsung's or its affiliates' net worth, total revenues, and total profits is irrelevant and likely to mislead the jury. Prisua has failed to articulate how Samsung's net worth is relevant to damages calculations for the alleged infringement. Accordingly, Samsung's motion is granted in this respect.

4. Evidence Regarding the Doctrine of Equivalents

Samsung moves to exclude evidence or argument that Samsung infringes the Asserted Claims under the doctrine of equivalents.

“The doctrine of equivalents is an alternative avenue for a patentee to prove infringement of its patented product.” *UCB v. Teva Pharmaceuticals USA, Inc.*, No. 1:12-CV-4420-CAP, 2015 WL 11199058, \*14 (N.D. Ga. Mar.18, 2015). This doctrine permits “the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 733 (2002). It is the patentee’s burden of proving infringement by equivalents and the patentee “must provide this evidence to the finder of fact at trial.” *Eli Lilly & Co. v. Teva Parenteral Meds., Inc.*, No. 1:10-cv-01376-TWP-DKL, 2015 WL 735724, at \*2 (S.D. Ind. Feb. 20, 2015). The Court of Appeals for the Federal Circuit has held that

A patentee must . . . 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). Exclusion of evidence regarding the doctrine of equivalents is appropriate when an expert fails to include the evidence in his or her report. *Honeywell Int’l Inc. v. Universal Avionics Sys. Corp.*, 488 F.3d at 994 (Fed. Cir. 2007) (affirming district court’s preclusion of plaintiff’s reliance upon the doctrine of equivalents where the only testimony on the matter was defective because it was not contained in expert’s report).

Samsung seeks to exclude testimony and evidence on the doctrine of equivalents arguing that Prisua has failed to meet the requirement for asserting infringement under the doctrine and because it is not probative, likely to confuse the jury, unfairly prejudicial, and a waste of trial



time. Samsung also notes that Prisua did not advance a theory of infringement under the doctrine of equivalents in its infringement contentions.

Prisua argues that its experts testified that the Accused Devices infringe literally or by equivalents and that it should be permitted to elicit further expert testimony on the subject of equivalents at trial, noting that it only recently received Samsung's non-infringement report—long after Prisua's experts served their infringement report. First, Prisua's Joint Expert Report only cursorily addresses the doctrine of equivalents. Joint Expert Report of Dr. Yolanda Prieto and Walter Overby (ECF No. 179, Ex. 3) at ¶¶ 2, 42, 113, 137.<sup>3</sup> Prisua's rationale for the lack of evidence on the subject is unavailing—Prisua did not proffer the theory in its own infringement contentions. Indeed, Prisua argues that it should be permitted to “elicit further expert testimony on the subject of equivalents at trial.” Prisua's Response (ECF No. 179) at 11. Given that Prisua has not offered any particularized expert testimony on the subject of equivalents, this would fit the definition of trial by ambush.

Samsung's motion is granted. Prisua may not introduce evidence or testimony on the doctrine of equivalents.

##### 5. References to Other Litigation Involving Samsung

Samsung moves to preclude Prisua from admitting evidence referencing other litigation involving Samsung or its affiliates, employees, or officers, as inadmissible hearsay under Rule 801 of the Federal Rules of evidence. Samsung also argues that not only is such evidence hearsay but it has no probative value, is highly prejudicial, and is also likely to mislead the jury.

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<sup>3</sup> Prisua cites to each of these paragraphs in support of its contention that Samsung was on notice of Prisua's intent to proffer evidence on equivalents. Prisua's Response (ECF No. 179) at 11. However, each reference to equivalents in the Joint Report of Dr. Prieto and Mr. Overby (ECF No. 179, Ex. 3) is no more than a conclusory statement or definition of equivalents. Not a shred of testimony or evidence is provided to explain how Samsung allegedly infringes by equivalents.

Prisua's damages expert, Mr. Leathers, references Samsung's prior litigation as one of several considerations supporting his reasonable royalty calculation. In response to the motion, Prisua argues that evidence referencing other litigation is not hearsay because it is not an out of court statement being offered to prove the truth of the matter asserted.

An out-of-court statement offered into evidence to prove the truth of the matter asserted is inadmissible. Fed. R. Evid. 901(c)(1)–(2). However, an expert is permitted “to base his opinion on facts or data which would otherwise be inadmissible, such as hearsay, if other ‘experts in the particular field would reasonably rely on those kinds of facts or data in forming an opinion.’” *Broussard v. Maples*, 535 F. App'x 825, 828 (11th Cir. 2013) (quoting Fed. R. Evid. 703). In patent infringement cases, courts have permitted experts conducting reasonable royalty calculations to analyze prior litigation resulting in settlement and license agreements under certain limited circumstances. See *LaserDynamics, Inc. v. Quanta Computer Inc.*, 694 F.3d 51, 77 (Fed. Cir. 2012); *ResQNet.com, Inc. v. Lansa, Inc.*, 594 F.3d 860, 872–73 (Fed. Cir. 2010) (an expert may rely on related licenses in calculating the reasonable royalty rate).

The two prior litigations involving Samsung upon which Mr. Leathers relies are *Apple v. Samsung* and *Summit 6 LLC v. Samsung Electronics Co.* Leathers Report (ECF No. 156, Ex. 1) ¶¶ 27–28, 101. In the *Apple* case, Samsung's expert opined on the reasonable royalty rate for patents for smartphone cameras, as well as a patent “covering a method for bookmarking a user's location in a photo gallery of a smartphone.” *Id.*, ¶ 101. In the *Summit 6 LLC* case, at issue was a patent allegedly covering software that automatically processes digital photos prior to their transmission over a network by a mobile device. *Id.* ¶ 28.

In light of the applicable case law and upon consideration of the proffered testimony, the Court agrees with Prisua that this information is admissible. Accordingly, Samsung's motion to exclude references to other litigation involving Samsung is denied.

6. Samsung's Headquarters

Defendant Samsung Electronics Co., Ltd. ("SEC") moves to exclude Prisua from presenting evidence or argument regarding SEC's headquarters being located outside of the United States. SEC argues that this evidence is irrelevant, prejudicial, and likely to mislead the jury.

In response, Prisua argues that evidence that SEC is headquartered in South Korea is highly relevant and critical to establishing Prisua's claims. Specifically, Prisua delivered its initial written notice of infringement to SEC at its headquarters and this, Prisua argues, is critical in establishing willfulness. Prisua also delivered its written offer to license the '591 Patent to SEC's headquarters.

Samsung's motion to exclude evidence or argument regarding SEC's headquarters is granted in part. To the extent relevant admissible evidence noting the location of SEC's headquarters' address—such as the written notice of infringement—is introduced, the Court shall admit that evidence if the only basis for exclusion is SEC's foreign address. *See Personalized User Model, L.L.P. v. Google Inc.*, 2014 WL 807736, \*4 (granting motion to exclude references to company as a foreign company but stating that "if relevant admissible evidence happens to contain a foreign address, that evidence will not be excluded solely based on the foreign address.")

### III. THE PARTIES' *DAUBERT* MOTIONS

#### A. Applicable Law

Rule 26(a)(2)(B) of the Federal Rules of Civil Procedure provides that expert disclosures be accompanied by a written report, signed by the witness, containing a complete statement of all opinions the witness will express and the bases for those opinions. Fed. R. Civ. P. 26(a)(2)(A), (B). Rule 702 of the Federal Rules of Evidence provides that expert testimony is admissible if

scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.

*STMicroelectronics, Inc. v. SanDisk Corp.*, No. 4:05cv45, 2007 WL 4386234 (E.D. Tex. Mar. 15, 2007) (quoting Fed. R. Evid. 702). “Rule 702 compels the district courts to perform the critical ‘gatekeeping’ function concerning the admissibility of expert *scientific* evidence.” *U.S. v. Frazier*, 387 F.3d 1244, 1260 (11th Cir. 2004) (emphasis in original) (citing *Daubert v. Merrill Dow Pharmaceuticals, Inc.*, 509 U.S. 579, 589, n.7, 597 (2006)). The court must also act as gatekeeper with respect to the admissibility of technical expert evidence. *Kumho Tire Co. v. Carmichael*, 526 U.S. 137, 147 (1999).

In determining the admissibility of expert testimony under Rule 702, the Court considers whether:

(1) The expert is qualified to testify competently regarding the matters he intends to address; (2) the methodology by which the expert reaches his conclusions is sufficiently reliable as determined by the sort of inquiry mandated in *Daubert*; and (3) the testimony assists the trier of fact, through the application of scientific, technical, or specialized expertise, to understand the evidence or to determine a fact in issue.

*Finestone v. Florida Power & Light Co.*, No. 03-14040-CIV, 2006 WL 267330, \*8 (S.D. Fla. Jan. 6, 2006) (internal citations omitted).

**B. Prisua's Daubert Motion<sup>4</sup>**

Prisua moves to exclude the expert opinions of Dr. Delp, who offered rebuttal testimony on infringement, and Mr. Lettiere, who opined on a reasonable royalty calculation.

**1. Dr. Delp's Testimony**

Dr. Delp's rebuttal testimony relates to whether Samsung's Accused Devices, which incorporate the "Best Face" software application supplied by ArcSoft, Inc. ("ArcSoft") infringe on the '591 Patent. Prisua moves to exclude the expert opinion testimony of Dr. Delp arguing that: (1) Dr. Delp's rebuttal testimony regarding whether the Accused Devices utilize software that infringes upon the '591 Patent is based upon testimony Dr. Delp obtained from a previously undisclosed individual; (2) Dr. Delp's testimony conflicts with the Court's claim constructions or advances new constructions of previously unconstructed terms; and (3) Dr. Delp's opinions on infringement and invalidity rest on differing claim constructions.

*a. Dr. Delp's Reliance on Undisclosed Expert*

Prisua argues that Dr. Delp improperly relied upon communications with another individual, Mr. Goodin, in forming his opinion regarding ArcSoft's Source Code production and Best Face operations. *See* Rebuttal Expert Report of Edward J. Delp, Ph.D, Regarding Non-Infringement of the Asserted Patent ("Delp Rebuttal Report") (ECF No. 157, Ex. 3). Prisua argues that it has not had an opportunity to determine the reliability of Mr. Goodin's analysis and

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<sup>4</sup> Prisua filed its *Daubert* Motion to Exclude ("Prisua's *Daubert* Motion") (ECF No. 168) expert opinion testimony of Samsung's experts Edward J. Delp ("Dr. Delp") and Richard Lettiere ("Mr. Lettiere"). Samsung responded in opposition (ECF No. 208) and Prisua replied ((ECF No. 210).

that Mr. Goodin does not qualify as a Person of Ordinary Skill in the Art (“POSITA”) as defined by Dr. Delp, thus calling into question the reliability of Dr. Delp’s opinions.

In response, Samsung states that Dr. Delp did previously disclose the conversation with consultant Mr. Goodin, as well as Mr. Goodin’s qualifications as an expert. Samsung also states that Prisua had the opportunity—and did—inquire about Dr. Delp’s conversation with Mr. Goodin during Dr. Delp’s deposition. Additionally, Samsung emphasizes Mr. Goodin’s limited involvement in reviewing the ArcSoft code—Mr. Goodin reviewed the ArcSoft source code that Prisua’s expert Mr. Overby reviewed for the purpose of ensuring that Dr. Delp did not need to review additional ArcSoft source code in order to conduct analysis and form expert opinions regarding infringement.

“Where a testifying expert has expertise in the field covered by a consulting expert and independently verifies the latter’s conclusions, there is no danger that the former is acting as a mere ‘mouthpiece or conduit’ of the latter.” *Medism Ltd. v. BestMed LLC*, 861 F. Supp. 2d 158, 169 (S.D.N.Y. 2012) (internal quotation omitted). Because of the limited nature of Mr. Goodin’s review and Dr. Delp’s independent basis for reaching his conclusions, Prisua’s argument that Dr. Delp’s testimony should be excluded on this basis is unavailing.

*b. Claim Construction Conflicts with the Court’s Markman Order*

“Claim construction is not for an expert to determine; it is a matter of law for the Court to decide.” *523 IP LLC v. CureMD.Com*, 48 F. Supp. 3d 600, 648 (S.D.N.Y. 2014) (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391 (1996)). Expert testimony that conflicts with a court’s claim construction should be excluded under *Daubert* as unreliable and unhelpful to the finder of fact. *EMC Corp. v. Pure Storage, Inc.*, 154 F. Supp. 3d 81, 109 (D. Del. 2016).

Prisua argues that Dr. Delp's testimony should be excluded to the extent it conflicts with the Court's claim constructions or advances new constructions of previously unconstrued terms. Prisua identifies several terms used by Dr. Delp as troublesome, arguing that Samsung improperly expands upon the Court's claim construction. Samsung asserts that Dr. Delp's definitions are consistent with the Court's *Markman* Order.

The Court included the phrase "image frames" in its definition of "user input video data stream" and "original video data stream." *Markman* Order (ECF No. 103) at 8. Dr. Delp opined that "the term 'image frame' in the context of the Court's claim construction order signifies that this sequence of image frames is not any set of images but is a sequence of image *frames* that form a video. Distinct photographs (no matter how they are spaced visually or in the time domain) are not 'image frames' and, for this reason, Dr. Prieto's vague analysis of a user input video data stream is wrong." Delp Rebuttal Report, ¶ 71. Samsung argues that this is consistent with the *Markman* Order and that it was necessary to include this opinion because Dr. Prieto omitted the word "frame" from her opening report. Samsung's Response (ECF No. 208) at 4. The Court fails to see how Dr. Prieto's omission of the word "frame" necessitates Dr. Delp's construction of the phrase "image frame." Indeed, the Court agrees with Prisua that this is an improper attempt to construe a term that does not need construction.

Relatedly, on the subject of the "illusion of movement," Dr. Delp opined that

the Best Face display does not display motion which I understand to be a requirement of "sequence of image *frames*." This is consistent with Prisua's statements regarding its claim construction. I have reviewed the transcript from the claim construction hearing and confirmed that Prisua's counsel stated: "When you play a sequence of images, it's in our construction, *you get the illusion of motion*."

Delp Rebuttal Report (ECF No. 157, Ex. 3), ¶ 81 (emphasis in original). In the *Markman* Order, the Court adopted Prisua's definition of "video" as "a series of images in succession that creates

the illusion of movement,” and noted the addition of the term “frames” to qualify “images.” *Markman* Order (ECF No. 103) at 8. The Court is persuaded that Dr. Delp’s opinion as to the “illusion of movement” is consistent with the Court’s claim construction.

Prisua moves to exclude Dr. Delp’s opinions on the claim term “spatially matching.” The Court considered the Parties’ proposed definitions for “spatially matching” and adopted Prisua’s construction of the term as “aligning a set of pixels in the spatial domain.” *Markman* Order (ECF No. 103) at 10. In his Rebuttal Report, Dr. Delp states “it is my understanding that at least mapping, stretching, rotating, scaling, zooming, curling, shearing, distorting, and morphing are not spatially matching according to Prisua. With that understanding in mind, it is my opinion that the Best Face application does not spatially match an area of the first image with an area of the second image resulting in the equal spatial lengths and widths between said two spatially matched areas.” Delp Rebuttal Report (ECF No. 157, Ex. 3), ¶ 160. The Court agrees with Prisua that this an improper expansion of the definition set forth by the Court.<sup>5</sup>

Prisua also argues that Dr. Delp’s construction of the preamble of the Asserted Claims is waived as it was not made during claim construction. *See* Delp Rebuttal Report ¶¶ 66, 156). Samsung argues that it was appropriate for Delp to opine on the limitations of the preamble in order to point out Prisua’s failure to address those limitations. Samsung had the opportunity to brief the issue of the preamble as limiting prior to the *Markman* Hearing and also could have raised it before the Court at the hearing. It did not do so. And now, months after the Court’s

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<sup>5</sup> Samsung argues that Dr. Delp does apply the Court’s construction and notes that Prisua’s experts have represented that “spatially matching” does not include scaling or resizing. Samsung’s Response (ECF No. 208) at 6. Prisua instead takes aim at the inclusion of “a slew of new limitations” but did not explicitly address which limitations are troublesome. Upon a review of the record and briefing on this issue, it appears that the Parties agree that scaling or resizing is not a part of “spatially matching” but this does not fully resolve this particular dispute.



*Markman* Order issued, Samsung merely argues that the parties were in agreement that the preamble is limiting. The Court has already denied Samsung's motion to amend its invalidity contentions and consistent with that ruling, Dr. Delp shall not be permitted to opine on the preamble as limiting.

Additionally, Prisua argues that Dr. Delp improperly provides new definitions for terms not construed by the Court. Prisua's Motion (ECF No. 168) at 7. These terms include: "image display device," "data entry device," digital processing unit," and "at least one pixel." *Id.* Prisua argues that these newly proposed claim construction arguments are waived because they were not raised during the Court's claim construction. The Court finds that Dr. Delp's definitions for these terms are inappropriate and shall be excluded.

The portions of Dr. Delp's Rebuttal Report identified above which improperly expand upon claims already addressed in the Court's *Markman* Order are hereby stricken as conclusory, irrelevant, and unreliable. *See 523 IP LLC v. CureMD.Com*, 48 F. Supp. 3d at 650 (striking experts' conclusions that are "simply implicit arguments about what claim construction should be, and are therefore irrelevant advocacy rather than helpful expert testimony.") Terms newly defined by Dr. Delp that were not raised during claim construction are similarly excluded. To the extent not addressed herein, remaining arguments regarding Dr. Delp's construction of particular terms are denied without prejudice.

c. *Inconsistent Claim Constructions in Dr. Delp's Reports*

Distinct from the argument regarding conflicts with the Court's *Markman* Order, Prisua also asserts that Dr. Delp's separate opinions on validity and infringement are inconsistent with one another and that Dr. Delp's opinions must therefore be deemed unreliable.

Of course it cannot be that a party may use different claim constructions for purposes of infringement and validity analyses. *See Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001) (“Because the claims of a patent measure the invention at issue, the claims must be interpreted and given the same meaning for purposes of both validity and infringement analyses.”) (internal citation and quotation omitted). But “nothing precludes [an accused infringer] from arguing for a narrower application of the limitation on the infringement context, while also arguing, in the alternative that—if the district court were to disagree—the patent claim would be so broad as to be invalid.” *Stryker Corp. v. Zimmer, Inc.*, 782 F.3d 649, 658 n.4 (Fed. Cir. 2014), vacated in part on other grounds, *Halo Elecs. Inc. v. Pulse Elecs., Inc.*, 136 S.Ct. 1923 (2016).

Prisua rattles off a list of paragraphs in Dr. Delp’s Opening Report on Invalidity (ECF No. 157, Ex. 4) and Dr. Delp’s Rebuttal Report regarding Non-Infringement of the Asserted Patent (ECF No. 157, Ex. 3) that allegedly reflect inconsistent claim constructions. However, Prisua does not address Samsung’s argument that they are not inconsistent but rather narrow applications of the same claim constructions.

Accordingly, Prisua’s motion to exclude Dr. Delp’s testimony on this basis is denied without prejudice. However, the Court notes that Dr. Delp’s testimony is limited in accordance with the ruling on the issue of claim construction conflicts with the Court’s *Markman* Order. *See supra*.

## 2. Mr. Lettiere’s Expert Testimony

Prisua also seeks to exclude the testimony of Mr. Lettiere, Samsung’s damages expert. Prisua argues that: (1) Mr. Lettiere’s analysis is improperly predicated on information unknown at the time of the hypothetical negotiation; (2) Mr. Lettiere improperly relies on unrelated

litigation settlements; (3) Mr Lettiere unduly relies on the ArcSoft Licensing Agreements; and (4) Mr. Lettiere improperly relies on the market approach in calculating damages.

*a. Information Unknown at the Time of Hypothetical Negotiation*

Once infringement has been found by the trier of fact, a patentee is entitled to “damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer.” 35 U.S.C. § 284. A reasonable royalty calculation depends on the particular facts of each case and where there is a lack of “evidence of royalties in the marketplace, this court accepts evidence about hypothetical results of hypothetical negotiations between the patentee and the infringer (both hypothetically willing) at the time the infringement began.” *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1579 (Fed. Cir. 1996). Thus, the determination of a reasonable royalty is based upon what the parties to the negotiation would have considered at the time of the negotiations. *Hanson v. Alpine Valley Ski Area, Inc.*, 718 F.2d 1075, 1081 (Fed. Cir. 1983).

Here, it is not disputed that the date of the hypothetical negotiation is February 2014—when the ’591 Patent issued and Best Face was a standard application pre-loaded on all Samsung mobile devices. Mr. Lettiere, however, considered evidence about the alleged use of Best Face that occurred after February 2014. Samsung argues that this was properly considered under the “Book of Wisdom” doctrine. In *Sinclair Ref. Co. v. Jenkins Petrol. Process Co.*, the Supreme Court stated

[T]he absence of market value does not mean that the offender shall go quit of liability altogether. The law will make the best appraisal that it can, summoning to its service whatever aids it can command . . . At times the only evidence available may be that supplied by testimony of experts as to the state of the art, the character of the improvement, and the probable increase of efficiency or saving of expense . . . This will generally be the case if the trial follows quickly after the issue of the patent. But a different situation is presented if years have

gone by before the evidence is offered. Experience is then available to correct uncertain prophecy. Here is a book of wisdom that courts may not neglect. We find no rule of law that sets a clasp upon its pages, and forbids us to look within.

289 U.S. 689, 697–98 (1933). Indeed, post-hypothetical evidence may be helpful to the jury in assessing the reasonableness of a royalty. *Lucent Techs., Inc., v. Gateway, Inc.*, 580 F.3d 1301, 1333 (Fed. Cir. 2009).

Prisua’s issue with Mr. Lettiere’s post-hypothetical reliance is that it is not substantiated by anything but a brief telephone call between Mr. Lettiere and Samsung’s marketing director and thus the testimony and proffered opinion is unreliable. Samsung contends that this goes to the weight, not admissibility, of Mr. Lettiere’s opinions.

Upon a review of Mr. Lettiere’s report and the materials Mr. Lettiere considered in developing his opinions regarding consumer demand for Best Face, the Court agrees with Samsung that Mr. Lettiere’s testimony is admissible and it is for the jury to decide how much weight to bestow upon that testimony.

*b. Unrelated Litigation Settlements*

Mr. Lettiere considered the structure and value of prior settlement agreements reached by Samsung to settle patent litigation disputes with Walker Digital, LLC (“*Walker-Digital*”) and InMotion Imagery Technologies (“*InMotion*”). Lettiere Report (ECF No. 155, Ex. 4) at 34–35. Prisua argues that Mr. Lettiere’s opinion testimony relying on these litigation settlement agreements should be excluded because the agreements have little relevance and involve patents that have no relation to the ’591 Patent.

Prisua cites *Cornell University v. Hewlett-Packard Co.*, No. 01-CV-1974, 2008 WL 11274580 (N.D.N.Y. May 8, 2008), in support of excluding Mr. Lettiere’s testimony on the basis of relevance. There, the court noted that “[t]he avoidance of the risk and expense of litigation

will always be a potential motive for a settlement” and “that a license negotiated under threat of litigation ‘cannot be taken as a standard to measure the value of the improvements patented, in determining the damages sustained by the owners of the patent in other cases of infringement.’” *Cornell University*, 2008 WL 11274580, \*2 (quoting *Rude v. Westcott*, 130 U.S. 152, 164 (1888)). The court excluded the amounts of negotiation offers in Cornell’s negotiations, as well as the amount of license fees. *Id.*, \*3.

Here, Prisua argues that there is an even stronger basis to exclude the negotiated settlements than there was in *Cornell University*—this is so because the *Walker Digital* and *InMotion* settlements were entered into following the initiation of litigation, more than a mere threat of suit. In response, Samsung argues that Mr. Lettiere’s consideration of the *Walker-Digital* and *InMotion* litigation settlements is appropriate because they are utilized as “reasonable checks” as to the structure and amount of a reasonable royalty for the ’591 Patent and because the patents in those prior cases are technically similar.

At this juncture, the Court denies without prejudice Prisua’s motion to exclude evidence considered by Mr. Lettiere pertaining to prior settlement agreements reached by Samsung.

c. *Reliance Upon the ArcSoft Licensing Agreements*

Prisua next contends that Mr. Lettiere’s reliance upon a series of licensing agreements between Samsung and ArcSoft memorializing Samsung’s acquisition of software used to implement Best Face (the “ArcSoft Agreements”) is improper to consider in calculating a reasonable royalty rate. This is so, Prisua argues, because the ArcSoft Agreements involve lump-sum licenses, which Prisua is not seeking, and because Mr. Lettiere fails to explain how he reached his ultimate conclusion. In response, Samsung argues that the ArcSoft licensing agreement is highly relevant and helpful in that these agreements provide considerable insight

into a royalty in this matter because they directly pertain to the Best Face application. Placing this request in context, Prisua asserts that a royalty rate is appropriate while Samsung suggests that damages, if any are awarded, should be based upon a lump sum payment.

Prisua's primary argument is that the ArcSoft Licensing Agreements are not relevant because there is no Prisua licensing agreement related to the '591 Patent. But this is an insufficient basis for exclusion. Prisua's argument that "Lettiere relies too heavily on the ArcSoft Agreements" speaks to the weight of the testimony, not the admissibility.

Regarding the lump-sum form of the ArcSoft Agreements, Prisua argues that it has never sought payment in the form of a lump sum and thus the differing analysis of a royalty rate comparison warrants excluding Mr. Lettiere's testimony on this basis. This is a self-serving argument and Prisua fails to articulate a sound basis for exclusion of this testimony.

The Court is persuaded that the ArcSoft Licensing Agreements—which directly relate to the allegedly infringing technology—are relevant and the probative value of Mr. Lettiere's related testimony outweighs the risk of prejudice.

d. *Reliance Upon the Market Approach*

Prisua also moves for the exclusion of Mr. Lettiere's conclusion because it relies on the market approach and fails to properly consider certain factors. The framework for analyzing such hypothetical negotiations consists of fifteen factors, known as the "*Georgia-Pacific* factors." *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1325 (S.D.N.Y. 1970)). Specifically, Prisua asserts that Mr. Lettiere exclusively relied on the first two *Georgia-Pacific* factors to form his opinion. Regarding Mr. Lettiere's analysis under the market approach, Prisua argues that he improperly cites and relies upon a secondary source pertaining to

trademark infringement damages instead of reasonable royalties in a patent infringement suit. Samsung contends that Mr. Lettiere's analysis of the market approach is permissible.

The hypothetical negotiation, also known as the "willing licensor-willing licensee" approach, is a method of ascertaining "the royalty upon which the parties would have agreed had they successfully negotiated an agreement just before infringement began." *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d at 1324 (citing *Georgia-Pacific Corp.*, 318 F. Supp. at 1120).

The Court first turns to Prisua's argument that Mr. Lettiere failed to consider all but the first two *Georgia-Pacific* factors. The first two factors address: (1) "the royalties received by the patentee for the licensing of the patent in suit;" and (2) "the rates paid by the [infringer] for the use of other patents comparable to the patent in suit." *Georgia-Pacific Corp.*, 318 F. Supp. at 1120. In Mr. Lettiere's report (ECF No. 179-2), he not only identifies each of the fifteen *Georgia-Pacific* factors but addresses how each impacted his analysis of the hypothetical negotiation.

The Court next considers Mr. Lettiere's analysis under the market approach and citation to a secondary source. Prisua clarified that its argument takes aim at Mr. Lettiere's sole citation to a secondary source pertaining to the market approach in the context of trademark infringement damages rather than patent infringement damages—Prisua does not argue that the methodology of the market approach is unsound. Prisua's Reply (ECF No. 210) at 8–9. Prisua questioned Mr. Lettiere about his citation to and reliance upon Chapter 18, entitled "A Primer on Trademarks and Trademark Valuation." Mr. Lettiere testified:

Q. But when you are discussing the market approach, it comes from your understanding of the "Economic Damages in Intellectual Property" from Daniel Slottje, correct?

A. No. This -- I mean, market approach comes from my understanding of having used it both in patent litigation and in non-patent litigation -- non-litigation for

intellectual property. So, the market approach is used to value all kinds of intellectual property assets and other assets. And this is just one characterization of the market approach I found in this textbook.

Q. But is it fair to say, though, that you considered Daniel Slottje's "Economic Damages in Intellectual Property" book in rendering your expert opinion?

A. No, I didn't –

Q. I mean, you cite to it?

A. -- I didn't consider his book. I'm just -- once again, this is a description of the market approach contained in his textbook -- or in a chapter of his textbook. So, yes, I believe this is an adequate and fair description of the market approach. I've also used the market approach at least 100 times in my career. So, it's also based on my considerable use of that particular approach. This is just a description, I think is a pretty accurate description of it.

Lettiere Tr. (ECF No. 208, Ex. 3) at 100:22 – 102:1.

Upon consideration of Prisua's argument, Mr. Lettiere's Report, Mr. Lettiere's explanation of his reliance upon this material, and relevant case law, the Court denies Prisua's motion in this respect.

**C. Samsung's Daubert Motion<sup>6</sup>**

In Samsung's *Daubert* Motion, Samsung moves to exclude, in whole or in part, the opinions of Prisua's experts David Leathers, Walter Overby, and Yolanda Prieto.

**1. David Leathers<sup>7</sup>**

Mr. Leathers is Prisua's damages expert. In estimating Prisua's damages, Mr. Leathers proffers two alternative "Reasonable Royalty Damages" computations, as well as two profit and

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<sup>6</sup> Samsung filed a Motion to Exclude Certain Opinions of Plaintiff's Experts ("Samsung's *Daubert* Motion" (ECF No. 155). Prisua responded in opposition (ECF No. 180) and Samsung replied (ECF No. 207).

<sup>7</sup> Prisua and Samsung filed a stipulation (ECF No. 176-1) that obviates portions of Samsung's *Daubert* Motion as it relates to Prisua's expert Mr. Leathers. Accordingly, the Court's analysis of the admissibility of Mr. Leathers's testimony only addresses issues that remain in contention.



value measures in support of his conclusions. Samsung moves to exclude the “Royalty Rate” used by Mr. Leathers arguing that the rate, \$0.09, is based solely upon Prisua’s self-serving estimation of its own value during the course of pre-suit licensing negotiations. In response, Prisua argues that this figure is only based in part upon pre-suit licensing negotiations. Prisua also states that this figure is the exact amount Samsung agreed to pay ArcSoft for licensing of the accused infringing Best Face application.

Samsung’s arguments speak to weight rather than admissibility. Accordingly, Samsung’s motion to exclude Mr. Leathers’ “Royalty Rate” calculation is denied.

## 2. Walter Overby

Samsung moves to exclude the testimony of Mr. Overby on the issue of patent infringement because he does not have at least the qualifications of a person of ordinary skill in the art, or “POSITA.” Mr. Overby’s expert opinion pertains to the software/source code elements of Best Face.

Samsung points to Dr. Prieto’s testimony that a POSITA here “would be knowledgeable in image processing, in image coding and programming and possess some experience in system and hardware applications as applied to image and video applications.” Joint Expert Report, (Ex. 7) ¶ 39. Further, “[t]his level of understanding and implementation capability may be achieved by an engineer with a Bachelor of Science degree and at least three years of imaging and signal processing experience.” *Id.* ¶ 40.

Mr. Overby has a Bachelor of Sciences degree in computer science but no specialized education in image processing. Although Mr. Overby does not have an educational background in image processing, he does have—as Samsung acknowledges—more than the requisite number of years of professional experience in image processing. *See* Samsung’s Reply (ECF No. 207) at

4 (“Indeed, Mr. Overby admitted that he recalls no educational experience on image processing . . . and his professional work in image processing is limited to his four years of work at Group Logic from 1993 until 1997 immediately after he graduated from college.”) Samsung thus concedes that Mr. Overby has more than the requisite number of years of experience in image processing but appears to take issue with the temporal distance from the present matter before the Court and how much of those four years was spent focusing on image processing. The definition of a POSITA in this case does not specify when said image processing experience needed to take place in relation to the present analysis.

Upon a review of Mr. Overby’s curriculum vitae and in light of the testimony regarding a POSITA in this case, the Court finds that Mr. Overby satisfies this definition and his testimony shall not be excluded.

### 3. Doctrine of Equivalents Testimony

Samsung also argues that all of Prisua’s experts should be excluded from offering any evidence or testimony that Samsung infringes the Asserted Claims under the doctrine of equivalents.

As detailed above, Prisua did not refer to the doctrine of equivalents in its invalidity contentions but its expert reports do contain references to the doctrine. *See* Joint Report (ECF No. 155, Ex. 7) ¶¶ 2, 42, 113, 137, 177. However, the references are conclusory in nature and fail to explain how the elements of the Accused Devices and the claimed elements of the patented invention are equivalents. Prisua argues that it should be permitted to elicit further expert testimony on the subject of equivalents at trial because of the timing of the exchange of expert reports. Receipt of Samsung’s non-infringement report has no bearing on the burden of proving infringement by equivalents.

Consistent with the Court's ruling *supra*, Samsung's motion to exclude evidence on the doctrine of equivalents is granted.

#### IV. SAMSUNG'S MOTIONS TO STRIKE

##### A. Samsung's Motion to Strike Untimely Declarations<sup>8</sup>

Samsung moves to strike the untimely declarations of Walter Overby, Shariar Nagahdaripour, and Yolanda Prieto, which were filed in support of Prisua's Response to Samsung's Motion for Summary Judgment. Samsung argues that these declarations are additional expert opinions that, due to their filing date, violate the Court's September 26, 2017 Scheduling Order (ECF No. 110) and the Federal Rules of Civil Procedure.

Prisua characterizes these declarations as permissible fact testimony and, in any event, Prisua argues that a motion to strike is an inappropriate mechanism in the context of a declaration submitted in support of summary judgment. *See Polite v. Dougherty Cty. Sch. Sys.*, 314 Fed. App'x 180, 184 n. 7 (11th Cir. 2008) ("[M]otions to strike are only appropriately addressed toward matters contained in the pleadings; here, the affidavit was submitted as part of the motion for summary judgment, which is not a pleading.").

Samsung's arguments in favor of preclusion are unpersuasive. The Court finds that these declarations were properly submitted, relevant, and the risk of prejudice does not outweigh their probative value. The Court denies Samsung's motion to strike the declarations of Mr. Overby, Dr. Prieto, and Dr. Nagaharipour.

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<sup>8</sup> Samsung filed a Motion to Strike the Declarations of Walter Overby, Yolanda Prieto, and Shariar Nagaharipour in Support of Plaintiff's Response to Defendants' Motion for Summary Judgment (ECF No. 189). Prisua responded in opposition (ECF No. 215) and Samsung replied (ECF No. 223).

**B. Samsung's Motion to Strike and Exclude from Trial Plaintiff's Improper Attempt to Substantively Alter Its Expert's Deposition Testimony<sup>9</sup>**

Samsung moves to strike the errata form submitted by Plaintiff's expert Walter Overby, arguing that the errata changes are improper and constitute a new expert opinion in violation of Rules 26 and 30 of the Federal Rules of Civil Procedure. In response, Prisua argues that a motion to strike is an inappropriate vehicle for the relief sought and the errata sheet is proper.

Samsung first argues that Mr. Overby's errata testimony completely changes his opinion as stated in his report and during his deposition. Specifically, Samsung argues that Mr. Overby's errata changes regarding the five burst photos as the "original video data stream" are inconsistent with Prisua's theory of infringement throughout the course of the litigation. Samsung argues that this supplementation is a new theory that is prejudicial, unfair, and in contravention of the Court's Scheduling Order and Federal Rules. Prisua argues that these errata changes do not reflect a new theory. Samsung also argues that Mr. Overby's new opinion, as detailed in the errata, violates the requirements of Rule 26(B)(i) which requires a complete statement of all opinions the witness will express and the basis and reasons for them. Fed. R. Civ. P. 26(B)(i). Further, Samsung states that the new opinion expressed in the errata violates Rule 30(e) of the Federal Rules of Civil Procedure. Rule 30(e) provides that "the deponent must be allowed 30 days after being notified by the officer that the transcript or recording is available in which . . . if there are changes in form or substance, to sign a statement listing the changes and the reasons for making them."

The Court finds no good cause for striking the errata form properly submitted by Mr. Overby. Samsung's motion to strike is accordingly denied.

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<sup>9</sup> Samsung filed a Motion to Strike and Exclude from Trial Plaintiff's Improper Attempt to Substantively Alter its Expert's Deposition Testimony Through an Errata (ECF No. 227). Prisua responded in opposition (ECF No. 242) and Samsung replied (ECF No. 258).

## V. SAMSUNG’S NOTICE OF SUPPLEMENTAL AUTHORITY

Samsung filed a Notice of Supplemental Authority (“Notice”) (ECF No. 234), reiterating legal arguments contained in its prior motions. Plaintiff noted the lack of supplemental authority in its response (ECF No. 236). Samsung replied (ECF No. 254) and argued that the supplemental authority cited is the Court’s own Order on Motion for Leave to Amend Invalidity Contentions (ECF No. 231). Indeed, the purported new authority cited by Samsung is the Court’s own Order.

Pursuant to the Local Rules of this Court, the filing of Samsung’s Notice is impermissible without prior leave of Court. S.D. Fla. L.R. 7.1(c) (providing that beyond an opening brief and a reply brief, a moving party shall file “[n]o further or additional memoranda of law . . . without prior leave of Court.”) “Failure to comply with the requirements of this Local Rule may be cause to grant or deny the motion and impose on counsel an appropriate sanction . . .” *Id.* The Notice was not authorized by the Court

The Court is, unsurprisingly, already familiar with its own Order.<sup>10</sup> What Samsung portrays as “an urgent issue of fundamental fairness” that is allegedly dispositive of several of Samsung’s pending motions, including its motion for summary judgment, is no more than an improper attempt to bolster previously raised arguments and delay adjudication of the issues. *See Tracfone Wireless, Inc. v. Unlimited PCS, Inc.*, No. 12-20013-CIV-Ungaro, 2012 WL 12996615, \*1 (S.D. Fla. Mar. 13, 2012) (striking a notice of supplemental authority that was

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<sup>10</sup> Aside from the procedural impropriety of filing the Notice, the Court questions Samsung’s motives for its filing. It is not unheard of for a party or its counsel to attempt that second bite at the apple. But it is worrisome that counsel would engage in a full round of briefing, wasting not only its own time but its client’s resources, on filing a Notice informing the Court of its own ruling.

filed without prior authorization of the court, constituted re-briefing of arguments already before the Court, and presented no new authority).

The Notice is hereby stricken.

**VI. CONCLUSION**

For the foregoing reasons, the Motions (ECF Nos. 150, 155, 156, 168, 189, and 227) are GRANTED IN PART and DENIED IN PART as set forth *supra*. Samsung's Notice of Supplemental Authority (ECF No. 234) is hereby STRICKEN.

DONE AND ORDERED in Chambers at Miami, Florida, this 13th day of February, 2018.

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K. MICHAEL MOORE  
CHIEF UNITED STATES DISTRICT JUDGE