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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA**

ECOSERVICES, LLC,)	CV 16-01824-RSWL-SP
)	
Plaintiff,)	
)	ORDER re: Plaintiff's
v.)	Motions in Limine Nos.
)	1-2 [178]; Defendant's
)	Motions in Limine Nos.
)	1-3 [181-183]
CERTIFIED AVIATION)	
SERVICES, LLC,)	
)	
Defendant.)	
)	
)	

Plaintiff EcoServices, LLC ("Plaintiff") brings this Action against Defendant Certified Aviation Services, LLC ("Defendant") for infringement of patents related to Plaintiff's EcoPower Engine Wash System, U.S. Patent Nos. 5,868,860 (the "'860 Patent") and 9,162,262 (the "'262 Patent"). Currently before the Court are the parties' Motions in Limine ("MIL") for the forthcoming trial on June 26, 2018. Plaintiff has filed an Omnibus MIL, which includes two MIL seeking

1 the Court to:

2 MIL #1) Exclude testimony of undisclosed
3 conversations between Defendant's expert
4 and representatives of Defendant; and

5 MIL #2) Exclude testimony from Defendant's expert
6 contradicting the Court's Claim
7 Construction Order.

8 Defendant filed three MIL seeking the Court to:

9 MIL #1) Preclude evidence regarding injunctive
10 relief;

11 MIL #2) Exclude inventor testimony related to old
12 prototypes; and

13 MIL #3) Preclude evidence of lost sales and
14 reduced prices.

15 For the reasons set forth below, the Court **GRANTS**
16 **in part** and **DENIES in part** Plaintiff's MIL #1, **DENIES**
17 Plaintiff's MIL #2, **DENIES** Defendant's MIL #1, **GRANTS**
18 Defendant's MIL #2, and **DENIES** Defendant's MIL #3.

19 **I. DISCUSSION**

20 **A. Plaintiff's MIL #1 Is GRANTED in Part and DENIED in**
21 **Part**

22 In its **MIL #1**, Plaintiff seeks to preclude
23 Defendant from offering evidence or testimony related
24 to Defendant's expert Gerald Micklow, Ph.D's alleged
25 conversations with Cycleclean operators during the on-site
26 inspection of the Cycleclean system. Plaintiff's MIL #1
27 also seeks to preclude any testimony relating to
28 opinions based on these alleged conversations. As part

1 of the on-site inspection, the parties agreed that
2 "[t]he inspection attendees will not be permitted to
3 communicate in any way with any individuals present in
4 or around the inspection site and engine wash,
5 including any representatives of the airline customer."¹
6 Decl. of Stephen K. Shahida in Supp. of Pl.'s Omnibus
7 MIL ("Shahida Decl."), Ex. B, ECF No. 178-1. Dr.
8 Micklow admits that he had conversations with the
9 Cycleclean operators during the on-site inspection. While
10 Defendant argues that Plaintiff's counsel was present
11 during Dr. Micklow's conversation, Dr. Micklow's
12 deposition testimony clarifies that everyone in
13 attendance of the on-site inspection was in the "same
14 immediate vicinity." Id., Ex. C at 13:9-10. This does
15 not show that Plaintiff's counsel was an actual party
16 to the conversation. Because Dr. Micklow violated the
17 inspection protocols by initiating conversations with
18 the Cycleclean employees, the Court **GRANTS in part**
19 Plaintiff's MIL #1 and excludes any testimony regarding
20 these conversations.²

21

22 ¹ Defendant contends that the agreement was that all
23 attendees could only ask questions through Defendant's counsel.
24 However, even if this was the parties' understanding, which
25 directly contradicts the specific terms of the agreement,
26 Defendant admitted that Dr. Micklow did not ask questions of the
27 Cycleclean employees through Defendant's counsel. Therefore, the
28 conversations were still in violation of the inspection
29 protocols.

27 ² Defendant argues that Plaintiff has failed to establish
28 how it would be prejudiced by allowing testimony regarding Dr.
29 Micklow's conversations with the Cycleclean employees. However,
30 Plaintiff is not required to articulate how it would be

1 However, Plaintiff's MIL #1 essentially seeks to
2 exclude all testimony from Dr. Micklow related to [REDACTED]
3 [REDACTED],³ including any calculations performed based on
4 Dr. Micklow's understanding of the [REDACTED].

5 Defendant argues that Dr. Micklow's opinion regarding
6 [REDACTED] is based on Dr. Micklow's personal
7 observations of the [REDACTED] as well as his review of
8 photographs and video of the [REDACTED]. In regard to [REDACTED]
9 [REDACTED], Dr. Micklow's report specifically states that

10 [REDACTED]
11 [REDACTED].” *Id.*, Ex. D ¶ 62.

12 Plaintiff has not provided any evidence to suggest that
13 Dr. Micklow's opinions regarding [REDACTED] were based
14 on the conversations Dr. Micklow had with the Cyclean
15 employees. Therefore, while the Court **GRANTS in part**
16 Plaintiff's MIL #1 and excludes any testimony regarding
17 the conversations Dr. Micklow had with the Cyclean
18 employees at the on-site inspection, the Court **DENIES**
19 **in part** Plaintiff's MIL #1 to the extent it seeks to
20 exclude Dr. Micklow's testimony related to [REDACTED]

21 _____
22 prejudiced by Defendant's failure to disclose these
23 conversations. *See Torres v. City of L.A.*, 548 F.3d 1197, 1213
24 (9th Cir. 2008). Instead, the burden is on Defendant to
25 establish that the failure to disclose was harmless or
substantially justified. *Id.* Other than conclusory statements
that the failure to disclose was harmless, Defendant does not
make any argument sufficient to meet this burden.

26 ³ In accordance with the Court's Orders regarding the
27 parties' requests to seal certain confidential information, the
28 Court has redacted all references to such sealed information in
this Order. However, the Court's grant of the applications to
seal is only relevant for pre-trial motions.

1 [REDACTED]
2 [REDACTED].
3 **B. Plaintiff's MIL #2 Is DENIED**

4 Plaintiff's **MIL #2** seeks to preclude Dr. Micklow
5 from arguing that the Cyclean system does not have an
6 "information detector" because the basis for his
7 opinion contradicts the Court's Claim Construction
8 Order.⁴ More specifically, Plaintiff argues that Dr.
9 Micklow's opinion regarding the claimed "information
10 detector" seeks to limit the information detector to
11 require radio-frequency identification ("RFID") or bar
12 code reader technology, an argument the Court
13 previously rejected.

14 An expert may not offer an opinion that contradicts
15 the court's claim construction of a term. See Exergen
16 Corp. v. Wal-Mart Stores, Inc., 575 F.3d 1312, 1321
17 (Fed. Cir. 2009) ("Once a district court has construed
18 the relevant claim terms, and unless altered by the
19 district court, then that legal determination governs
20 for purposes of trial."); Dynetix Design Sols., Inc. v.
21 Synopsys, Inc., No. C 11-5973 PSG, 2013 U.S. Dist.
22 LEXIS 120404, at *13 (N.D. Cal. Aug. 22, 2013) ("Any
23 expert testimony must adhere to the court's claim
24 constructions and must not apply alternative claim

25 _____
26 ⁴ Plaintiff's MIL #2 also originally sought to exclude Dr.
27 Micklow's opinion regarding the term "small quantities" being
28 indefinite. However, Defendant noted that it no longer intends
to present this issue to the jury. Def.'s Opp'n to Pl.'s Omnibus
MIL 6 n.3. Therefore, the Court **DENIES as MOOT** this portion of
Plaintiff's MIL #2.

1 constructions.”). Dr. Micklow testified at deposition
2 that he concluded in his report that the information
3 detector corresponds to technologies involved in RFID
4 and bar codes. Shahida Decl., Ex. C at 136:13-17. He
5 was asked whether that was the construction he applied
6 to the information detector limitation, and he stated,
7 “That is part of it, yes, but I was thinking about
8 okay, how are they going to do this, radio frequency
9 detector, bar code detectors, et cetera, other sensors
10 possibly.” Id. at 136:22-25. This testimony does not
11 show Dr. Micklow limiting the information detector to
12 only include RFID or bar code technology. Rather, he
13 relies on dictionary definitions and his own experience
14 to explain the plain and ordinary meaning of
15 “information detector,” the construction this Court
16 adopted in its Claim Construction Order. He then
17 relies on this plain and ordinary meaning in offering
18 “an opinion on how a court’s claim construction should
19 be applied to the facts of a case.” In re Maxim
20 Integrated Prod., Inc., No. 12-244, 2015 WL 5311264, at
21 *4 (W.D. Pa. Sept. 11, 2015). Because Dr. Micklow’s
22 opinion does not limit the information detector to only
23 include RFID or bar code technology, his opinion does
24 not contradict the Court’s Claim Construction Order.
25 The Court therefore **DENIES** Plaintiff’s MIL #2. If Dr.
26 Micklow does attempt to rely on the specification of
27 the ‘262 Patent to limit the claimed “information
28 detector” to RFID or bar code technology, Plaintiff can

1 object to such at trial.

2 **C. Defendant's MIL #1 Is DENIED**

3 Defendant's **MIL #1** seeks to exclude any evidence
4 related to Plaintiff's claim for injunctive relief. In
5 its Opposition, Plaintiff noted that if it presents
6 evidence related "to the issue of injunctive relief, it
7 is being offered for some other reason." Pl.'s Opp'n
8 to Def.'s MIL #1 4:11-12, ECF No. 199. Therefore,
9 Plaintiff does not intend to introduce to the jury
10 evidence to support a claim of injunctive relief.⁵
11 Accordingly, the Court **DENIES** Defendant's MIL #1.

12 Further, while Plaintiff may not have been specific
13 in the Proposed Final Pretrial Conference Order
14 regarding the evidence it intended to offer in support
15 of its injunctive relief claim, the Court cannot order
16 a blanket exclusion of all evidence that may be
17 relevant to injunctive relief, especially when the
18 Court does not know what that evidence is.

19 **D. Defendant's MIL #2 Is GRANTED**

20 Defendant's **MIL #2** seeks to exclude testimony of
21 the inventors of the '262 Patent regarding the [REDACTED]
22 [REDACTED] prototype. Defendant argues
23 that the prototype is not relevant to the infringement
24

25
26 ⁵ Defendant notes this, but argues that because Plaintiff
27 failed to provide any discovery on its injunctive relief claim,
28 Plaintiff should be barred from pursuing the claim altogether.
However, that is not the purpose of a MIL. MIL deal with the
presentation of evidence at trial, not the merits of a
plaintiff's claims.

1 analysis because the jury must compare the Cyclean
2 system to the claims of the '262 Patent, not a
3 prototype or product the inventors made. Plaintiff
4 argues that the [REDACTED] prototype is relevant to the
5 conception date of the invention and thus relevant to
6 Defendant's prior art defense. However, Defendant has
7 made clear that it does not intend to introduce the
8 prior art to which the conception date of the invention
9 would be relevant. Def.'s Reply in Supp. of MIL #2
10 2:3-7, ECF No. 219. Thus, this argument is irrelevant.

11 Plaintiff also argues that the [REDACTED] prototype is
12 relevant to Defendant's written description defense.
13 Under this defense, the written description must
14 adequately describe the claims to show to a person of
15 skill in the art that "the patentee invented what is
16 claimed." LizardTech, Inc. v. Earth Res. Mapping,
17 Inc., 424 F.3d 1336, 1345 (Fed. Cir. 2005). The [REDACTED]
18 prototype is not disclosed in the specification;
19 therefore, it is not relevant to whether the
20 specification adequately describes the claims.

21 Ultimately, because the role of the jury is to
22 determine infringement based on a comparison of the
23 claims of the '262 Patent and the Cyclean system, see
24 Zenith Labs, Inc. v. Bristol-Myers Squibb Co., 19 F.3d
25 1418, 1423 (Fed. Cir. 1994) ("As we have repeatedly
26 said, it is error for a court to compare in its
27 infringement analysis the accused product or process
28 with the patentee's commercial embodiment or other

1 version of the product or process; the only proper
2 comparison is with the claims of the patent.”),
3 testimony regarding an [REDACTED] prototype, which may or may
4 not practice the claims of the '262 Patent, would
5 confuse and mislead the jury, especially if the jury is
6 led to believe the [REDACTED] prototype and the Cyclean keypad
7 are similar. While the [REDACTED] prototype may be part of
8 the invention story, it is just one small part of that
9 story. The inventors are still free to tell the rest
10 of their story. Accordingly, the risk of undue
11 prejudice to Defendant outweighs any minor probative
12 value testimony related to the [REDACTED] prototype may have.
13 See Allergan Sales, LLC v. UCB, Inc., No.
14 2:15-CV-01001-JRG-RSP, 2016 U.S. Dist. LEXIS 191852, at
15 *3 (E.D. Tex. Nov. 6, 2016) (excluding testimony
16 regarding prototypes due to the risk of confusing the
17 jury). The Court **GRANTS** Defendant's MIL #2.

18 **E. Defendant's MIL #3 Is DENIED**

19 Defendant's MIL #3 seeks to exclude specific
20 evidence related to Plaintiff's lost sales and reduced
21 prices due to Defendant's competition in the market.
22 Defendant makes clear that it "does not dispute that
23 generalized testimony concerning the introduction of a
24 new competitor via a patent license can be relevant to
25 a reasonable royalty calculation." Def.'s MIL #3 3:3-
26 5, ECF No 183. Rather, Defendant argues that evidence
27 regarding contracts with specific airlines and dollar
28 values Plaintiff believes it lost because of Defendant

1 is not relevant to a reasonable royalty, the damages
2 theory on which Plaintiff relies.

3 Throughout its Opposition, Plaintiff argues that
4 testimony regarding lost sales or reduced prices is
5 pertinent to Plaintiff's damages expert Richard
6 Lettiere's reasonable royalty analysis. The losses
7 Plaintiff may have suffered are relevant to the
8 hypothetical negotiation between the parties to
9 determine a reasonable royalty. Power Integrations,
10 Inc. v. Fairchild Semiconductor Int'l, Inc., No. C
11 09-5235 MMC, 2014 U.S. Dist. LEXIS 126294, at *17 (N.D.
12 Cal. Sep. 9, 2014) (noting that "losses the parties
13 reasonably would have anticipated in light of
14 information available to them at the time of the
15 negotiation" were relevant to an expert's reasonable
16 royalty analysis).

17 Further, unlike in the cases Defendant cites in MIL
18 #3, Plaintiff is not seeking to obtain damages above
19 the reasonable royalty Mr. Lettiere calculated. In
20 Rodime PLC v. Seagate Technology Inc., 174 F.3d 1294,
21 1308 (Fed. Cir. 1999), the Court noted that "[t]he
22 condition of [the p]laintiff's business at the time of
23 [] a hypothetical negotiation" may be factored into the
24 reasonable royalty analysis. The court took issue with
25 the fact that the plaintiff's expert tried to admit
26 evidence regarding consequential business damages that
27 were "over and above the royalty revenues." Id.
28 Therefore, the court only excluded expert testimony

1 regarding these consequential business damages. Id.
2 Here, Mr. Lettiere offers an opinion regarding a per-
3 wash royalty. While Mr. Lettiere references
4 Plaintiff's lost sales and reduced prices, Mr. Lettiere
5 is only using this data to inform his reasonable
6 royalty opinion; Mr. Lettiere does not offer an opinion
7 regarding damages over and above the reasonable
8 royalty.

9 Finally, Defendant points to specific portions of
10 the depositions of two of Plaintiff's employees, which
11 discuss contracts and sales Plaintiff believes it lost
12 to Defendant. See Def.'s MIL #3 4:18-7:2. While
13 Defendant attacks the foundation of this testimony,
14 such attacks are better served on cross-examination.
15 See Daubert v. Merrell Dow Pharm., Inc., 509 U.S. 579,
16 596 (1993) ("Vigorous cross-examination, presentation
17 of contrary evidence, and careful instruction on the
18 burden of proof are the traditional and appropriate
19 means of attacking shaky but admissible evidence.").
20 Accordingly, Mr. Lettiere's opinions, which may be
21 based on or reference this testimony, should not be
22 excluded on a MIL. The jury should be able to hear
23 this evidence and decide what weight to give such
24 evidence. Therefore, the Court **DENIES** Defendant's MIL
25 #3.

26 II. CONCLUSION

27 Based on the foregoing, the Court **GRANTS in part**
28 and **DENIES in part** Plaintiff's MIL #1, **DENIES**

1 Plaintiff's MIL #2, **DENIES** Defendant's MIL #1, **GRANTS**
2 Defendant's MIL #2, and **DENIES** Defendant's MIL #3.

3 **IT IS SO ORDERED.**

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5 DATED: June 19, 2018

s/ RONALD S.W. LEW
HONORABLE RONALD S.W. LEW
Senior U.S. District Judge

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