

**IN THE UNITED STATES DISTRICT COURT  
FOR THE MIDDLE DISTRICT OF FLORIDA  
ORLANDO DIVISION**

<b>NXP B.V.,</b>	:	
<b>Plaintiff</b>	:	<b>No. 6:12-cv-00498-YK</b>
	:	
<b>v.</b>	:	<b>(Judge Kane)</b>
	:	
<b>BLACKBERRY, LTD., et al.,</b>	:	
<b>Defendants</b>	:	

**MEMORANDUM**

Before the Court is Plaintiff NXP B.V.’s omnibus motion in limine, seeking a pretrial order precluding Defendants BlackBerry Limited and BlackBerry Corporation, including its counsel and witnesses, from presenting certain categories of evidence or argument at trial. (Doc. No. S-171.) Defendants have filed a reply brief, and the matter is now ripe for disposition. (Doc. No. S-241.) For the reasons that follow, the Court will deny and grant Plaintiff’s motion in part.

**I. STANDARD OF REVIEW**

A motion in limine addresses the admissibility of evidence prior to trial, and as such, the order, like any other interlocutory order, remains subject to reconsideration by the Court throughout trial. Amegy Bank Nat. Ass’n v. DB Private Wealth Mortg., Ltd., No. 12-243, 2014 WL 791505, at \*1 (M.D. Fl. Feb. 24, 2014). The Court may only exclude evidence in limine when it is clearly inadmissible on all grounds; the preferred practice is to defer evidentiary rulings until trial to allow questions of foundation, relevancy, and prejudice to be resolved in context. Mee Indus. v. Dow Chem. Co., 05-1520, 2008 WL 874836, at \*1 (M.D. Fl. Mar. 27, 2008) (citation omitted). Accordingly, denying a party’s motion in limine does not necessarily mean the evidence will be admitted at trial; rather, it means the Court cannot determine whether

the evidence in question should be excluded outside the trial context. Id. (citing Luce v. United States, 469 U.S. 38, 41 (1984)).

## **II. DISCUSSION**

### **A. Application of infringement analysis to Defendants' accused products**

Plaintiff moves the Court to preclude Defendants from presenting argument or introducing evidence that suggests Plaintiff's expert witness Dr. Alpert's infringement analysis is not applicable to each and every of Defendants' accused products.<sup>1</sup> (Doc. No. S-171 at 4.) Plaintiff asserts that Defendants refused to provide information about its source code in a timely fashion, and therefore Defendants should be precluded from arguing that Plaintiff's expert analysis is incomplete as to certain accused products. Plaintiff asserts that Defendants engaged in the following obfuscatory tactics that merit excluding any argument that their expert witness analysis is incomplete: (1) Defendants delayed making the source code available, and added a final drive of source code (Volume 4) seven days before expert reports were due, (2) Defendants did not produce its code as kept in the ordinary course of business, and (3) Defendants refused to answer an interrogatory regarding the difference in functionality or operation of the source code between accused products. (Doc. No. S-171 at 3-10.) Defendants argue that Plaintiff's request is improper inasmuch as it asks the Court to extend Plaintiff's expert's opinions to products he did not analyze in his report, and that it provided Plaintiff's source code in the exact manner to which Plaintiff agreed. (Doc. No. S-241 at 2-7.)

Federal Rule of Civil Procedure 37(c)(1) provides that if a party fails to provide

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<sup>1</sup> Plaintiff accuses the BlackBerry Pearl, Curve, Bold, Storm, Tour, Torch, Playbook, Q10, and Z10 families of products of infringement. (Doc. No. S-171 at 2.)

information as required by Federal Rules 26(a) or (e), the party is precluded from using that information at trial unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c)(1). Whether to exclude evidence not produced in compliance with a proper discovery request is within the district court's discretion. Woods v. DeAngelo Marine Exhaust, Inc., 692 F.3d 1272, 1279 (Fed. Cir. 2012). When exercising its discretion to determine whether non-disclosure of evidence is substantially justified or harmless for purposes of Rule 37(c)(1) exclusion analysis, a district court should be guided by the following factors: (1) the surprise of the party against whom the evidence would be offered, (2) the ability of that party to cure the surprise, (3) the extent to which allowing the evidence would disrupt the trial, (4) the importance of the evidence, and (5) the non-disclosing party's explanation for its failure to disclose the evidence. Two Men and a Truck Int'l, Inc. v. Residential & Comm. Transp. Co., LLC, No. 08-067, 2008 WL 5235115, at \*2 (N.D. Fl. 2008).

Plaintiff's motion does not specify which accused products that Dr. Alpert analyzed nor does it list the accused products which he did not analyze but to which Plaintiff argues his infringement analysis should nevertheless apply. Neither does Plaintiff directly tie Defendants' alleged obfuscatory tactics to Dr. Alpert's inability to analyze accused products beyond those he analyzed in his report. (Doc. No. S-171 at 10.) The Court acknowledges that Defendants' production of source code has proved a point of contention in this case. (See, e.g., Doc. No. 385.) The Court cannot find, however, that Plaintiff's motion concretely links Defendants' alleged failure to provide information to Plaintiff as required by Rule 26(a) to Dr. Alpert's failure

to analyze accused products beyond those referenced in his report.<sup>2</sup> Moreover, inasmuch as Plaintiff wishes to rely on a representative approach for Dr. Alpert's infringement analysis at trial, the Court finds that Plaintiff appears to have proposed and then abandoned this plan during discovery as of May 2013. (Doc. No. S-256 at 2, Doc. No. S-257.) Accordingly, the Court will deny Plaintiff's motion in limine seeking to preclude Defendants from arguing that Plaintiff's expert analysis of Defendants' source code is not applicable to each and every of Defendants' accused products.

**B. Conversations with employees not disclosed in Rule 26 disclosures**

Plaintiff moves the Court to prevent Defendants from presenting any argument or evidence stemming from conversations with individuals that Defendants disclosed in Dr. Michalson's rebuttal expert report. (Doc. No. S-171 at 11-13.) These individuals include: Jonathan Ball, Rob Watt, Jay Glanville, Erin Rahnenfuehrer, Sean Hungerford, TeleCommunications Systems, Xtreme Labs, and Bitheads. (Id. at 11.) Plaintiff argues that these individuals possess discoverable information about the Facebook and Maps applications. (Id.) Defendants assert that they offered Plaintiff the opportunity to depose the "undisclosed" individuals following their disclosure in Dr. Michalson's rebuttal report, and Plaintiff never responded. (Doc. No. S-241 at 8 n.43.)

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<sup>2</sup> Although Plaintiff argues in its motion that it propounded an interrogatory to Defendants during the course of discovery that requested identification of the differences in source code from one accused product to another, which Defendants refused to answer on the grounds that the burden on Plaintiff to ascertain the answer would be substantially the same as that on Defendants, the Court finds that Plaintiff should have filed a motion to compel discovery on that topic, rather than move to preclude Defendants from arguing that Plaintiff's expert analysis does not extend equally to all accused products. (Doc. No. S-168.) Furthermore, the Court cannot discern from Plaintiff's motion why Dr. Alpert was able to analyze certain accused products in his expert report, yet he was not able to analyze the other accused products.

As stated above, Federal Rule of Civil Procedure 37(c)(1) requires that if a party fails to identify witnesses or information as required by Rule 26(a) or (e), the party is precluded from relying on such evidence at trial, unless the failure was substantially justified or harmless. There does not appear to be any dispute that Defendants first disclosed the existence of these individuals in Dr. Michalson's rebuttal expert report, dated August 23, 2013.<sup>3</sup> (Doc. No. S-171 at 13, Doc. No. S-241 at 9, Doc. No. S-258.) The Court agrees with Plaintiff that Defendants' disclosure of these previously undisclosed witnesses on August 23, 2013, would have made it difficult to depose them before the close of fact discovery on August 30, 2013. However, as Defendants point out, they offered Plaintiff's counsel the opportunity to depose these individuals as of September 13, 2013. (See Doc. No. S-260 at 4.) Although Plaintiff tangentially refers to this offer in its motion, it nevertheless asserts that Defendants' disclosure of these individuals in Dr. Michalson's rebuttal expert report on August 23, 2013 would have made it impossible to depose these individuals in time to comply with the October 28, 2013 deadline for dispositive motions. (Doc. No. S-171 at 13-14 n.64.) The Court finds that it would have been difficult, but not impossible, to conduct depositions in that two-month interval, and Plaintiff cannot now claim prejudice. The Court will therefore deny Plaintiff's motion in limine with respect to evidence or argument relating to these individuals.

### **C. Distribution of Fischer, Choi, and Cole references**

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<sup>3</sup> Plaintiff argues that although it successfully proposed to the Court that it could amend its infringement theories and claims by means of disclosure in expert report without amending its answers to interrogatories (Doc. No. 157 at 18:5-15), its position is not equally applicable to the disclosure of fact witnesses in expert reports. (Doc. No. S-171 at 13 n.61.) Defendants take issue with this distinction, arguing that Plaintiff must be held to its earlier arguments that disclosures in expert reports are timely supplements. (Doc. No. S-241 at 8.)

Plaintiff asks the Court to limit Defendants' expert witness Dr. Chris Heegard to the information he relied on in his expert report regarding whether certain prior art references satisfy the "printed publication" requirement. (Doc. No. S-171 at 14.) Plaintiff claims that Dr. Heegard solely relied on the fact that the Fischer, Cole, and Choi references were available on the IEEE website in his expert report, and therefore Dr. Heegard cannot now testify that the Fischer, Choi, and Cole references were distributed at the 802.11 committee meetings, as he did at his October 16, 2013 deposition. (Doc. No. S-171 at 14 (citing Doc. No. S-197 at 115:8-20, 118:6-120:2, 112:9-124:5, 176:5-177:3, 190:18-193:18).) Defendants argue that Dr. Heegard timely detailed his personal knowledge of the 802.11 committee meetings at which prior art references were distributed in his expert report, and Dr. Heegard did not provide any "new" information at his deposition. (Doc. No. S-241 at 11 n.55 (citing Doc. No. S-197 at 115:8-20, 118:6-120:2, 122:9-124:5, 176:5-177:3, 190:18-193:18).)

The Court has reviewed the portions of Dr. Heegard's expert report cited by Defendants, and finds that although Dr. Heegard made clear in his expert report that the references in question could have been downloaded from the IEEE website,<sup>4</sup> he does not state that the Fischer, Choi, and Cole references were also distributed at the IEEE meetings, which is what he testified in his deposition. (See, e.g., Doc. No. S-197 at 193:13-25.) Accordingly, the Court will grant Plaintiff's motion in limine to the extent that Defendants may not rely on Dr. Heegard's testimony relating to the distribution of the Fischer, Choi, and Cole references at IEEE meetings. Given that this testimony bears on validity of the '455 patent, the Court cannot find that

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<sup>4</sup> See Doc. No. S-187 ¶ 197 ("Just as I explained with Fischer and Cole above, the Choi reference could have been downloaded from the IEEE website at least during the time period before the '455 patent's priority date.")

Defendants' disclosure was justified or harmless. Because Dr. Heegard did not disclose this information in his expert report, Defendants may not rely on it at trial. See Fed. R. Civ. P. 37(c)(1).

**D. Conversations with Michael Fischer and Matthew Shoemake**

Plaintiff also moves the Court to preclude Defendants from relying on conversations that Dr. Heegard had with Michael Fischer and Matthew Shoemake. (Doc. No. S-171 at 15.) Plaintiff argues that Defendants only disclosed these witnesses in its supplemental Rule 26(a)(1) disclosures five days before submitting Dr. Heegard's expert report, and thus Defendants should not be allowed to rely on this "ambush tactic." (Doc. No. S-171 at 16.) In response, Defendants submit that Dr. Heegard's expert report identified his conversations with Michael Fischer and Matthew Shoemake, submitted six weeks before the close of fact discovery, and Defendants also listed them in their supplemental Rule 26(a)(1) disclosures, submitted on July 12, 2013. (Doc. No. S-241 at 2 n.60-61, Doc. No. S-264.) The Court finds that Dr. Heegard timely disclosed his conversations with Matthew Shoemake (Doc. No. S-187 ¶ 155 n.80, n.82) and Michael Fischer (Doc. No. S-187 ¶ 160 n.85-87, n.88), and Defendants identified Shoemake and Fischer in their supplemental expert disclosures, served on July 12, 2013. (Doc. No. S-264 at 14.) Accordingly, the Court will deny Plaintiff's motion in limine.

**E. Defense based on RAND/FRAND obligations**

Plaintiff submits that Defendants should be precluded from offering any affirmative defense based on claims that Plaintiff failed to license the patents-in-suit under reasonable and non-discriminatory (RAND) or fair, reasonable, and non-discriminatory (FRAND) terms, because Defendants never asserted such defenses in its answer or expert reports. Plaintiff

therefore argues that Defendants should be limited to the defenses they have disclosed. (Doc. No. S-171 at 16.) Defendants argue that it timely pleaded and disclosed this theory in discovery, claiming that it pled implied license and equitable estoppel defenses in accord with RAND caselaw in its answer, as well as in its response to Plaintiff's third set of interrogatories. (Doc. No. S-240 at 12-13 n.66.) The Court assumes this dispute relates to Mr. Weinstein's alternative royalty rate opinion on the '654 patent, which the Court excluded as insufficient under Daubert and Federal Rule of Evidence 702, and therefore Plaintiff's motion may be moot. To the extent that it is not moot, the Court finds that Defendants may assert defenses based on RAND/FRAND obligations for the reasons that follow, and will deny Plaintiff's motion in limine on this point.

An affirmative defense is one that admits to the complaint, but avoids liability, wholly or partly, by new allegations of excuse, justification, or other negating matters. Adams v. Jumpstart Wireless Corp., 294 F.R.D. 668, 671 (S.D. Fl. 2013) (citation omitted). Affirmative defenses are subject to the general pleading requirements of Federal Rule of Civil Procedure 8(b)(1)(A), which requires that a party "state in short and plain terms its defenses to each claim asserted against it." Although Rule 8 does not obligate a defendant to set forth detailed factual allegations, a defendant must give the plaintiff "fair notice" of the nature of the defense and the grounds upon which it rests. Bell Atl. Corp. v. Twombly, 500 U.S. 544, 555 (2007).

Although it is true that Defendants did not specifically plead they planned to argue that remedies in this matter should be limited based on Plaintiff's failure to license its patents under RAND/FRAND terms, Defendants assert in their answer submitted that Plaintiff's complaint is "barred or otherwise limited by the doctrines of license, exhaustion, and/or implied license," (Doc. No. 98 ¶ 62) and that Plaintiff's infringement claims were unenforceable against Defendant

under the doctrine of estoppel (Doc. No. 98 ¶ 56). As Defendants rightly point out, other courts have found that although asserting a party is bound by its RAND obligations is not a “complete defense” to an infringement lawsuit, it may provide defenses based on “implied license, patent misuse, or equitable estoppel.” See In re Innovatio IP Ventures, LLC Patent Litig., 921 F. Supp. 2d 903, 915-916 (N.D. Ill. 2013); see also Wi-Lan, Inc. v. HTC Corp., Pretrial Order 11-cv-00068, Docket No. 608 (E.D. Tx. Oct. 11, 2013) at 8 (“[T]he issue of FRAND is an affirmative defense”).

Reviewing other answers asserting the opposing party’s RAND obligation as an affirmative defense, it would appear that the better practice is to assert the RAND obligation in conjunction with pleading license, exhaustion, or implied license.<sup>5</sup> However, because the consensus appears to be that asserting a party’s RAND obligation may provide a defense based on implied license, patent misuse, or equitable estoppel, see In re Innovatio IP Ventures, LLC Patent Litig., 921 F. Supp. 2d at 915-916, the Court finds that Defendants may raise Plaintiff’s RAND obligation at trial as an affirmative defense. Moreover, Defendants disclosed during discovery on June 24, 2013 that it planned to assert that “Plaintiff had an affirmative obligation to offer RAND or (FRAND) terms based on Plaintiff’s contentions that one or more of its patents

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<sup>5</sup> Compare Zenith Elec. LLC v. Craig Elec., Inc., 13-cv-80567, Doc. No. 47 at 12 (S.D. Fl. Nov. 22, 2013) (“Twelfth Affirmative Defense . . . On information and belief, Plaintiffs’ claims for recovery are barred, in whole or in part, by the doctrine of express license and/or implied license for reasons including, without limitation, that Plaintiffs are barred from asserting claims of infringement of one or more of the Asserted Patents against ViewSonic under the MPEG LA ATSC Patent Portfolio License and the MPEG LA Agreement Among Licensors”); In the Matter of Certain Wireless Communications Equipment and Articles Therein, Inv. No. 337-TA-866, Response of Ericsson Inc. and Telefonaktiebolaget LM Ericsson to the Complaint of Samsung Electronics Co., Ltd. & Samsung Telecomm. Am., LLC under Section 337 of the Tariff Act of 1930, as amended, and Notice of Investigation at 68 (Mar. 8, 2013) (“Ninth Affirmative Defense – Breach of FRAND obligation (breach of contract, estoppel, patent misuse, unclean hands”).

are essential to the practice of any particular standard.” (Doc. No. S-267 at 11-12, Objections and Response to Interrogatory No. 10.) Accordingly, the Court concludes that Defendants sufficiently disclosed that it planned to assert Plaintiff’s RAND obligation. See, e.g., Bioval Corp. Intern. v. Andrex Pharm., Inc., No. 98-7096, 2000 WL 35729723, at \*1 (S.D. Fl. Jan. 10, 2000) (denying motion in limine on Defendants’ Section 112 affirmative defense because Defendant pled generally that Plaintiffs’ patent did not comply with Title 35, and evidence to support their Section 112 defense came from Plaintiff’s witnesses and the issue of wording had been the subject of litigation for some time). Accordingly, the Court will deny Plaintiff’s motion in limine on Defendants’ assertion of Plaintiff’s alleged RAND obligation.

**F. Testimony outside the scope of Rule 30(b)(6) depositions**

Plaintiff moves the Court to limit Defendants to offering testimony and opinions that are consistent with the scope of information on which its Rule 30(b)(6) corporate designees were prepared to testify, arguing that Defendants failed to properly prepare its designees. Specifically, Plaintiff argues that Defendants’ Rule 30(b)(6) designees George Drozdyuk and Mahesh Narayanan’s testimony were unprepared to testify as to the following: (1) Defendants’ implementation of GPS functionality and power-related features, (2) whether the GPS chips included in the accused products transitioned between power states, (3) whether Defendants’ software caused a change between the power modes documented by chip manufacturers, (4) issues relating to the power state of GPS components when a representative phone is booted up, and (5) the operation of BlackBerry Maps and Facebook features identified in Plaintiff’s infringement contentions. (Doc. No. S-171 at 18-20.) Plaintiff also argues that Defendants’ designee Mr. Michael Montemurro was unprepared to testify on the technical subject matter of

the '455 patent, including whether the accused products comply with 802.11 standards. (Doc. No. S-171 at 21.) Defendants argue that Plaintiff's motion should be denied because: (1) it is vague and overbroad, (2) it is unfounded as the witnesses were not designated to testify on the topics as to which Plaintiff complains, and (3) Plaintiff did not seek to depose additional witnesses to correct these alleged deficiencies. (Doc. No. S-241 at 14.)

Federal Rule of Civil Procedure 30(b)(6) governs deposition notices directed to organizations. The deposition notice "must describe with reasonable particularity the matters for examination." Fed. R. Civ. P. 30(b)(6). In response, the organization must designate one or more persons to testify on its behalf as to those matters, and, the organization has a "duty to present and prepare a Rule 30(b)(6) designee [] beyond matters personally known to that designee or to matters in which that designee was personally involved." Cont'l Cas. Co. v. First Fin. Employee Leasing, Inc., 716 F. Supp. 2d 1176, 1189 (M.D. Fl. 2010) (citation and quotation marks omitted). Accordingly, a corporate party does not satisfy its obligations under Rule 30(b)(6) by simply "producing a designee and [then] seeing what he has to say or what he can cover." Cont'l Cas., 716 F. Supp. 2d at 1189; see also FTC v. CyberSpy Software, LLC, No. 08-1872, 2009 WL 2386137, at \*1 (M.D. Fl. July 31, 2009). If the designated deponent cannot answer questions regarding the subject matter to which he is designated, then the corporation has failed to comply with its Rule 30(b)(6) obligations and may be subject to sanctions. King v. Pratt & Whitney, a Div. of United Techs. Corp., 161 F.R.D. 475, 476 (S.D. Fl. 1995). Such sanctions may include preventing the organization from introducing evidence on that subject matter unless the evidence was previously unavailable. See Function Media, LLC v. Google, Inc., No. 07-279, 2010 WL 276093, at \*1 (E.D. Tx. Jan. 15, 2010); Super Future Equities, Inc. v. Wells Fargo

Bank Minn., N.A., No. 06-0271, 2007 WL 4410370, at \*8 (N.D. Tx. Dec. 14, 2007). Or, “[p]hrased differently, the lack of knowledge answer is itself an answer which will bind the corporation at trial.” QBE Ins. Corp. v. Jorda Enter., Inc., 277 F.R.D. 676, 690 (S.D. Fl. 2012).

The Court begins with the testimony of Rule 30(b)(6) designee Mahesh Narayanan. (Doc. No. 217-14 at 12, Doc. No. S-165 at 22:2-10.) Plaintiff’s objections appear to relate to Mr. Narayanan’s testimony regarding Topic 9.<sup>6</sup> Having reviewed the context of the excerpts of Mr. Narayanan’s deposition testimony cited by Plaintiff, the Court finds that his testimony complied with Rule 30(b)(6). Although it is true that Mr. Narayanan was not able to testify as to certain Qualcomm components, it appears this is because, as Mr. Narayanan points out, “[t]hat’s a piece of Qualcomm code that I have no control on. It should be a question to Qualcomm.” (Doc. No. S-165 at 239:19-25, 240:1.) And, concerning the question posed by Plaintiff regarding booting the Z10 phone, Mr. Narayanan explained that “[t]he power would be supplied by the modem software. The modem power is determined by Qualcomm modem, so they will determine whether the power state of their software engine would be at.” (Doc. No. S-165 at 242:1-9.) As Defendants explain in their brief, to the extent that Plaintiff sought testimony on Qualcomm chips in BlackBerry phones that include power-saving features, such chips would be controlled by Qualcomm software. (See Doc. No. S-241 at 15; QBE Ins. Corp., 277 F.R.D. at 691 (“The

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<sup>6</sup> Topic 9 related to “The development, testing, operability, and use of power savings features or strategies related to global positioning (GPS) functionality in each Accused Product, including the software (including source code) and hardware related to enabling, establishing, or implementing the power saving features of any component relating to global positioning system (GPS) technology (including, without limitation, activation, powering up, going hot, or similar in response to user input, websites, or applications). (Doc. No. S-170 at 9.) Mr. Narayanan was designated as to Qualcomm-based GPS topics, and Mr. Drozdyuk was designated as to non-Qualcomm based GPS topics. (Doc. No. S-170 at 7.)

mere fact that a designee could not answer every question on a certain topic does not necessarily mean that the corporation failed to comply with its obligation.”.)

Likewise, the Court finds that Mr. Drozdyuk was sufficiently prepared for his deposition. Mr. Drozdyuk was designated as to non-Qualcomm based GPS topics relating to Topic 9. (Doc. No. S-170 at 7.) Although it is true that he was not able to testify as to all of Plaintiff’s counsel’s questions, the Court has reviewed his testimony and found that omissions in Mr. Drozdyuk’s knowledge appear to have resulted from the broad scope of Plaintiff’s questions, rather than Defendants’ failure to adequately prepare him. (See, e.g., Doc. No. S-167 at 42:15-25, 45:1-25.) With respect to the excerpts of Mr. Drozdyuk’s testimony cited by Plaintiff in their brief, the Court finds that neither the timing and history of RIM’s inclusion of GPS functionality on a cellphone was included in the topics for which Mr. Drozdyuk was designated, nor was the importance of battery life to RIM. Plaintiff cannot therefore claim that Mr. Drozdyuk was not sufficiently prepared on the noticed topics. (Doc. No. S-170 at 8-9.)

The Court next examines the testimony of Rule 30(b)(6) deponent Michael Montemurro, who was designated as to Topics 2, 3, 8, 11, 15, 24, 34, and 35. (Doc. No. S-170.) Plaintiff’s complaint appears to relate to Mr. Montemurro’s lack of knowledge concerning the ‘455 patent accused products’ compliance with the 802.11g wireless standard. (Doc. No. S-171 at 20.) The Court finds that Mr. Montemurro was sufficiently prepared, and Plaintiff’s cited excerpts take Mr. Montemurro’s testimony out of context. Although Mr. Montemurro was unable to confirm whether BlackBerry products comply with IEEE 802.11, read in context, Mr. Montemurro also testified that BlackBerry obtained certification from the Wi-Fi alliance for “interoperability,” which means that “BlackBerry devices can communicate with access points that are also Wi-Fi

Alliance certified.” (Doc. No. S-198 at 28:23-35, 29:1-13.) With respect to Plaintiff’s complaint concerning Mr. Montemurro’s inability to testify as to “why” BlackBerry provides Wi-Fi functionality on its handsets, the Court finds that question is outside the scope of the topics on which Mr. Montemurro was designated. That question would appear to fall under Topic 22,<sup>7</sup> on which Defendants designated Kevin Williams and Karl Wiezbicki. (Doc. No. S-170 at 10.)

Plaintiff’s final contention is that Defendants should not be allowed to offer factual testimony concerning non-infringement or non-infringing alternatives that it asserted was privileged during Rule 30(b)(6) depositions. (Doc. No. S-171 at 22.) Although Plaintiff’s motion is vague as to the precise category of evidence that it seeks to exclude, the Court assumes that Plaintiff refers to Topic 15 and Topic 35, which relate to the substance and factual support for Defendants’ denial of Plaintiff’s infringement claims, and, the identity, function, and operation of any products that Defendants contend constitute non-infringing alternatives with respect to each accused product or component. First, as Defendants point out, Plaintiff agreed that “legal topics” would be off the table for all witnesses. (Doc. No. S-276 at 2.) Second, it appears that Defendants did allow its Rule 30(b)(6) deponents to answer questions concerning non-privileged facts that related to non-infringement and non-infringing alternatives. (See, e.g., Doc. No. S-198 at 300:3-24, Doc. No. S-165 at 103:12-25.)

Accordingly, the Court will deny Plaintiff’s motion in limine seeking to exclude any evidence or opinions outside the scope of Defendants’ Rule 30(b)(6) deponents’ testimony.

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<sup>7</sup> Topic 22 related to “[t]he commercial performance of each accused product and the reasons RIM developed each product, the perceived advantages or benefits of each product, and any evaluations, analysis, or commentary from third parties regarding the success or failure of each product.” (Doc. No. S-170 at 10.)

**G. Inter partes review proceedings**

Plaintiff moves the Court to preclude Defendants from making any reference to the pending inter partes review proceeding on the '420 patent,<sup>8</sup> arguing that reference to incomplete inter partes review is purely speculative and would be highly prejudicial to Plaintiff. (Doc. No. S-171 at 23.) Defendants argue that this evidence is probative of Defendants' defenses, and, any prejudicial effect could be alleviated by jury instructions. (Doc. No. S-241 at 18.) The Court finds that the evidence would be highly prejudicial to Plaintiff and confusing to the jury, and Defendants are thus precluded from offering evidence of the pending inter partes review process. See Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331, 1342 (Fed. Cir. 2009) ("The non-final re-examination determinations were of little relevance to the jury's independent deliberations of the factual issues underlying the question of obviousness. In contrast, the risk of jury confusion if evidence of the non-final PTO proceedings were introduced was high."). Accordingly, the Court will grant Plaintiff's motion in limine on the pending inter partes review proceedings.

**H. Plaintiff's motivations for filing suit**

Plaintiff moves the Court to prevent Defendants from introducing any evidence or testimony relating to Plaintiff's motivations and state of mind for filing suit, arguing that it has no bearing on the lawsuit and offers no probative value on Plaintiff's infringement claims. (Doc. No. S-171 at 24.) Defendants assert that Plaintiff's state of mind is relevant to the extent that it relates to the parties' prior relationship and thus damages, and excluding this evidence would prevent full exploration of the Georgia-Pacific factors at trial. (Doc. No. S-241 at 18.) The

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<sup>8</sup> Plaintiff's motion in limine with respect to the inter partes review proceedings of the '697 patent is now moot, as the parties are working to withdraw the '697 patent from the lawsuit.

Court will reserve ruling on this issue.

**I. Defendants' current financial status**

Plaintiff moves the Court to preclude Defendants from introducing evidence or argument related to its decline in revenue and financial condition in an attempt to gain sympathy from the jury. (Doc. No. S-171 at 24.) Defendants object, arguing that Plaintiff's motion seeks to exclude Defendant from presenting routine general corporate background that is routinely admitted as helpful to the jury's understanding of the case. (Doc. No. S-241 at 19.) Defendants also argue that evidence of Defendants' recent performance may be necessary to explain the absence of certain former employees from the trial. (*Id.*) The Court will reserve ruling on this issue.

**J. References to Plaintiff's status as a non-practicing entity**

Plaintiff seeks to preclude Defendants from characterizing Plaintiff as a non-practicing entity, or referring to its relationship with a licensing agent, arguing that such evidence or argument would offer no probative value, and it would be highly prejudicial to Plaintiff. (Doc. No. S-171 at 25.) Defendants argue that the undisputed fact that Plaintiff does not practice all of its patents is relevant to damages and not prejudicial. (Doc. No. S-241 at 19.) Defendants also object to Plaintiff's request to preclude any references to its licensing agent IPValue, which Dr. Ugone references in its reasonable royalty analysis in his rebuttal damages report. (*Id.* at 20.) The Court finds that non-practicing entity is an accurate and neutral term, and bears on Plaintiff's damages claim. *See DNT, LLC v. Sprint Spectrum, LP*, No. 09-21, 2010 WL 582164, at \*4-5 (E.D. Va. 2010) (granting Plaintiff's motion *in limine* as to "patent troll," and denying Plaintiff's motion *in limine* to use "non-practicing entity"). Moreover, Plaintiff's relationship with IPValue is relevant to Dr. Ugone's rebuttal expert report on damages. Accordingly, the Court will deny

Plaintiff's motion in limine, subject to Plaintiff's right to renew its motion were Defendants to utilize disparaging terms regarding Plaintiff's status as a non-practicing entity.

### **III. CONCLUSION**

The Court will deny in part and grant in part Plaintiff's omnibus motion in limine. An order consistent with this memorandum follows.

**IN THE UNITED STATES DISTRICT COURT  
FOR THE MIDDLE DISTRICT OF FLORIDA  
ORLANDO DIVISION**

<b>NXP B.V.,</b>	:	
<b>Plaintiff</b>	:	<b>No. 6:12-cv-00498-YK</b>
	:	
<b>v.</b>	:	<b>(Judge Kane)</b>
	:	
<b>BLACKBERRY, LTD., et al.,</b>	:	
<b>Defendants</b>	:	

**ORDER**

**AND NOW**, on this 25th day of March 2014, **IT IS HEREBY ORDERED THAT** Plaintiff's sealed omnibus motion in limine (Doc. No. 300) is **GRANTED AND DENIED IN PART AS FOLLOWS:**

1. Section A is **DENIED;**
2. Section B is **DENIED;**
3. Section C is **GRANTED;**
4. Section D is **DENIED;**
5. Section E is **DENIED;**
6. Section F is **DENIED;**
7. Section G is **GRANTED;** and,
8. Section J is **DENIED.**

**IT IS FURTHER ORDERED THAT** the Court reserves ruling on Plaintiff's motion in limine Sections H and I.

s/ Yvette Kane \_\_\_\_\_

Yvette Kane, District Judge  
United States District Court  
Middle District of Florida  
*Sitting by designation*