

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

HUAWEI TECHNOLOGIES CO. LTD.,

Plaintiff,

v.

CIVIL ACTION NO. 2:20-CV-00030-JRG

VERIZON COMMUNICATIONS, INC.,
VERIZON BUSINESS NETWORK
SERVICES, INC., VERIZON ENTERPRISE
SOLUTIONS, LLC, CELLCO
PARTNERSHIP D/B/A VERIZON
WIRELESS, INC., VERIZON DATA
SERVICES LLC, VERIZON BUSINESS
GLOBAL LLC, VERIZON SERVICES
CORP.

Defendants.

VERIZON BUSINESS NETWORK
SERVICES, INC., CELLCO PARTNERSHIP
D/B/A VERIZON WIRELESS, VERIZON
DATA SERVICES LLC, VERIZON
BUSINESS GLOBAL LLC, VERIZON
SERVICES CORP., AND VERIZON
PATENT AND LICENSING INC.

Counterclaim-Plaintiffs,

v.

HUAWEI TECHNOLOGIES CO. LTD.,
HUAWEI TECHNOLOGIES USA, INC.,
AND FUTUREWEI TECHNOLOGIES INC.

*Counterclaim-
Defendants.*

ORDER

The Court held Pretrial Conferences in the above-captioned matter on Wednesday, June 16, 2021, Monday, June 21, 2021, and Tuesday, June 29, 2021, regarding pending pretrial motions and motions in limine (“MILs”) filed by Plaintiffs and Counterclaim-Defendants Huawei Technology Co., Ltd., Huawei Technology USA, Inc., and Futurewei Technologies, Inc.’s (collectively, “Huawei”) and Defendants and Counterclaim-Plaintiffs Verizon Communications Inc., Verizon Business Network Services, Inc., Verizon Enterprise Solutions, LLC, Cellco Partnership D/B/A Verizon Wireless, Inc., Verizon Data Services LLC, Verizon Business Global LLC, Verizon Services Corp., and Verizon Patent and Licensing, Inc. (collectively, “Verizon”) (together with Huawei, the “parties”) (Dkt. No. 250, 252, 253, 254, 255, 256, 258, 260, 261, 262, 263, 285, 366, 367, and 395). This Order memorializes the Court’s rulings on the aforementioned pretrial motions and MILs as announced from the bench into the record, including additional instructions that were given to the Parties. While this Order summarizes the Court’s rulings as announced into the record during the pretrial hearing, this Order in no way limits or constrains such rulings from the bench. Accordingly, it is hereby **ORDERED** as follows:

PRETRIAL MOTIONS

1. Verizon’s Motion for Summary Judgment To Limit Pre-Suit Damages For Huawei’s Failure To Comply With 35 U.S.C. § 287 (Dkt. No. 250)

The parties stipulated, as reflected on the record, that the motion was **WITHDRAWN** based on the parties’ agreement that Verizon now agrees it received actual notice of Huawei’s three asserted patents on March 29, 2021.

2. Huawei’s Motion to Strike and Exclude Certain Portions of the Expert Testimony of Dr. Paul Prucnal (Dkt. No. 252)

The motion was **DENIED**.

The Court was persuaded that, even if the allegedly late-disclosed infringement theory was not properly disclosed in Verizon's infringement contentions, the prejudice to Huawei was minimal. Moreover, Huawei was well aware of any prejudice that did occur and waited several months, until the eve of trial, to attempt to procure any relief.

3. Verizon's Motion to Strike and Exclude the Testimony of Bruce Schofield (Dkt. No. 253)

The motion was **DENIED**.

The Court was persuaded that Verizon adequately disclosed its induced infringement theory through its responses to Huawei's interrogatories. Moreover, none of the alleged infirmities in Mr. Schofield's report rise the level requiring striking or excluding portions of his report. These issues can be handled adequately through vigorous cross-examination at trial.

4. Huawei's Sealed Motion to Strike and Exclude in Part Opinions of Mr. Mark Lanning (Dkt. No. 254)

The motion was **DENIED**. However, the parties agreed on the record that paragraphs 156 and 157 of Mr. Lanning's "Expert Report [] Regarding Non-Infringement of U.S. Patent Numbers: 8,406,236; 8,824,505; AND 9,312,982" are **EXCLUDED** and he will not testify as to those paragraphs.

The Court was persuaded that Mr. Lanning should be allowed to testify at trial as to what the plain and ordinary meaning of the term "reversing" was to a person of ordinary skill in the art at the time the patent was filed, and he may cite to evidence to support those opinions from his reports. The Court is further convinced that there is no form of estoppel or any other reason to preclude a party from presenting evidence of the plain meaning of a term simply because, earlier in the case, they considered and sought construction of the claim term with a specific meaning.

5. Huawei's Motion for Partial Summary Judgment of No Invalidity Because Verizon Cannot Prove that Certain References are Prior Art (Dkt. No. 255)

The motion was **DENIED**.

The Court was persuaded that there are still active factual disputes relating to whether certain prior art references at issue were publicly available prior to the priority date of the relevant patents.

6. Huawei's Motion for Summary Judgment of Non-Infringement of U.S. Patent Nos. 8,121,111 and 8,983,288 (Dkt. No. 256)

The motion **GRANTED-IN-PART** as to the asserted method claims and **DENIED-IN-PART** as to the asserted system claims.

With regard to the method claims, the Court was persuaded that Verizon has produced no evidence that any user in the United States performed all of the methods steps of the asserted method claims and mere evidence that the method could have been performed or that Huawei touted the features in question is not sufficient to avoid summary judgment.

With regard to the system claims, the Court was persuaded that there are at least some disputed issues of material fact as to whether the complete systems (capable of performing all the claim elements) were ever sold or used in the United States.

7. Huawei's Motion for Summary Judgment on Verizon's Unfair Competition Counterclaim (Dkt. No. 258)

The parties at the pretrial conference agreed to waive oral argument on Huawei's Motion for Summary Judgment on Verizon's Unfair Competition Counterclaim (Dkt. No. 258) (the "Motion"). Having considered the Motion, for the reasons stated below, the Court finds that it should be and hereby is **DENIED**.

Under Texas law, a claim of unfair competition requires showing that (1) a defendant committed a recognized tort or illegal act, and (2) the defendant's wrongful conduct interfered

with the plaintiff's ability to conduct its business. *Mondis Tech. Ltd. v. LG Elecs. Inc.*, No. 2:07-CV-565, 2009 WL 901480, at *2 (E.D. Tex. Mar. 31, 2009). Summary judgment is warranted if "no reasonable juror could find for the non-movant," even after the non-movant was "given the opportunity to raise a genuine factual issue." *Byers v. Dall. Morning News, Inc.*, 209 F.3d 419, 424 (5th Cir. 2000).

Huawei puts forward two grounds on which it argues summary judgment of no unfair competition should be granted. (Dkt. No. 258, at 1.) Huawei concedes that the first ground is contingent on the outcome of Huawei's Motion for Summary Judgment of No Common-Law Fraud (Dkt. No. 261) (the "Fraud Motion"). (*Id.*, at 3.) Huawei argues that summary judgment of no unfair competition would be warranted if the Court grants the Fraud Motion because there would be no underlying tort or illegal act on which Verizon could base its claim of unfair competition. (*Id.*) The Court has denied the Fraud Motion, *infra*. It is therefore now undisputed that this ground fails to support entry of summary judgment.

The second ground on which Huawei argues for summary judgment of no unfair competition is that Verizon has allegedly failed to adduce evidence of any actual harm to the operation of its business resulting from the alleged fraud by Huawei. (*Id.*) Huawei argues that Verizon identified nothing more than generalized economic harm in the form of higher royalties or litigation costs. (*Id.*) In contrast, Huawei asserts that an unfair competition plaintiff must prove harm to the operation of the business via evidence such as lost sales, lost profits, or lost customers. (*Id.*)

In response, Verizon argues that there are genuine factual issues related to whether Huawei's alleged fraud interfered with Verizon's ability to conduct its business. (Dkt. No. 306, at 4.) Verizon alleges factual disputes related to whether and how it would have behaved differently

had it known that the standards at issue were entangled with undisclosed Huawei intellectual property. (*Id.*) For example, Verizon identified the testimony of its ITU-T representative, Martin Carroll, that “if he had known that Huawei had patents that it considered essential to G.709, [he] and Verizon could and would have done things differently during the G.709 standardization process.” (*Id.* at 2.) Similarly, Verizon identified the testimony of Mr. Glenn Wellbrock as stating that “if Verizon and other ITU-T participants had been aware [of Huawei’s patents], different choices might have been made.” (*Id.*) Lastly, Verizon argues that higher royalties or litigation costs are not *per se* insufficient to support a claim to damages for unfair competition. (*Id.* at 4.)

The Court agrees with Verizon. There are genuine factual issues over the extent to which Huawei’s alleged fraud interfered with the operation of Verizon’s business. Verizon identified specific testimony and evidence it intends to rely on at trial related to those issues. As a result, this ground also fails to justify entry of summary judgment.

The Motion is therefore **DENIED** because both grounds asserted by Huawei fail.

8. Verizon’s Motion to Exclude the Testimony of James E. Malackowski (Dkt. No. 260)

The motion was **DENIED**.

The Court is persuaded that none of the alleged issues with Mr. Malackowski’s report rise to the level requiring any portion of his report to be struck or excluded. Rather, Verizon can address any such issues adequately through vigorous cross-examination.

With regard to Mr. Malackowski’s alleged efforts to instruct the jury on the law, the Court further **ORDERED** that Mr. Malackowski is not to offer direct unconditioned testimony about what the law is in any area and both parties’ experts (i.e., Mr. Malackowski and Mr. Bakewell) should make it clear in their testimony and acknowledge before the jury that the Court is the only

proper source of instructions to the jury on the applicable law. Any testimony they give should be conditioned on what they understand the law to be.

9. Huawei’s Motion for Summary Judgment on Verizon’s Counterclaim for Common Law Fraud (Dkt. No. 261)

The motion was **DENIED**.

The Court is persuaded that there are still factual disputes regarding whether Huawei’s conduct during the International Telecommunication Union Telecommunication Standardization Sector (“ITU-T”) meetings constituted common-law fraud.

10. Huawei’s Motion for Summary Judgment of Verizon’s Breach of Contract Counterclaim (Dkt. No. 262)

The motion was **DENIED**.

The Court was persuaded that there are issues of material fact as to whether Huawei breached its duty to negotiate in good faith toward a RAND license. Moreover, as stated on the record, the Court concludes that Huawei waived its argument that Swiss Law—which both parties agree applies to the contract at issue—does not recognize a breach of contract cause of action for the breach of the duty to negotiate in good faith. However, resolution of this motion does not preclude Huawei from later raising such an argument at an appropriate time before the Court.

11. Huawei’s Motion to Strike and Exclude Certain Portions of the Expert Testimony of David Djavaheerian (Dkt. No. 263)

The parties at the pretrial conference agreed to waive oral argument on Huawei’s Motion to Strike and Exclude Certain Portions of the Expert Testimony of David Djavaheerian (Dkt. No. 263) (the “Motion”). Having considered the Motion, for the reasons stated below, the Court finds that it should be and hereby is **DENIED**.

Under the Federal Rules of Evidence, the Court may exclude expert testimony that is not “based on sufficient facts or data,” “the product of reliable principles and methods,” or where “the

expert has [not] reliably applied the principles and methods to the facts of the case.” Fed. R. Evid. 702. However, “the rejection of expert testimony is the exception rather than the rule.” *Id.*, Adv. Comm. Notes (2000); *Accresa Health LLC v. Hint Health Inc.*, No. 4:18-CV-00536, 2020 WL 6325731, at *7 (E.D. Tex. Feb. 26, 2020). Expert testimony should not be excluded that is “sufficiently reliable and relevant to the issue before the jury.” *Beneficial Innovations, Inc. v. Advance Publications, Inc.*, No. 2:11-CV-229-JRG-RSP, 2014 WL 12603495, at *1 (E.D. Tex. July 9, 2014). In addition, it is permissible, where appropriate, for an expert to base his or her opinions on relevant assumptions. *Robroy Indus.-Texas, LLC v. Thomas & Betts Corp.*, No. 2:15-CV-512-WCB, 2017 WL 1319553, at *5 (E.D. Tex. Apr. 10, 2017).

Here, Huawei argues that the Court should strike and exclude paragraphs 94-97 of Mr. David Djavaheerian’s expert report related to the licensing negotiations between Verizon and Huawei over the patents now asserted by Huawei in the above-captioned case. Huawei acknowledges that Mr. Djavaheerian states that the purpose of his report is to analyze “Huawei’s behavior during negotiations with Verizon” and determine whether that behavior “was consistent with RAND licensing behavior, including whether Huawei’s conduct was typical of good faith RAND negotiations as contemplated by the ITU Patent Policy.” (Dkt. No. 263, at 3.) Huawei does not argue that Mr. Djavaheerian’s methodology for analyzing these *behaviors* is inherently flawed or unreliable or that his expertise as a patent licensing profession renders him unable to testify on those topics. Rather, Huawei argues that Mr. Djavaheerian “diverges from his task” and instead speculates about Huawei’s *motivations* and state of mind during the negotiations. (*Id.*) Huawei contends that Mr. Djavaheerian’s opinions concerning Huawei’s “ulterior motives”, “bad faith,” and lack of “good faith” during the negotiations should be excluded. (*Id.* at 4.)

Similarly, Huawei argues that even if Mr. Djavaheerian's opinions about Huawei's state of mind were proper expert testimony, they should still be excluded as they are not relevant to any claims in the case. (*Id.* at 5-6) Huawei contends that only its behaviors are relevant to the question of whether it acted in bad faith, not its state of mind at the time. (*Id.*)

In response, Verizon argues that Mr. Djavaheerian did not offer any expert opinions or any speculation about Huawei's *motivations* or state of mind. (Dkt. No. 303, at 3-4.) Rather, Mr. Djavaheerian was told to assume a certain state of mind throughout his analysis and draw his conclusions from Huawei's *behaviors* with that assumption in mind. (*Id.*) Verizon does not dispute that the question of Huawei's state of mind is one of fact for the jury to decide but contends that it is entirely proper for an expert to render an analysis assuming the jury finds certain facts to be true. (*Id.*) Likewise, Verizon does not argue that Huawei's state of mind, alone, is sufficient to prove that it breached its RAND obligations, but rather that its state of mind is a relevant consideration for the expert in analyzing whether Huawei *acted* in bad faith during the negotiations. (*Id.* at 5-7.)

Having reviewed the parties' competing arguments and read the challenged paragraphs of the expert's report, the Court agrees with Verizon. Mr. Djavaheerian explicitly states in his report that he that he "express[es] no opinion on whether Verizon's characterization of Huawei's intent or objectives is correct," but bases his opinions on the assumption that the jury finds Verizon's characterization correct. Mr. Djavaheerian's report makes clear that his opinions are based on whether Huawei's behaviors were consistent with how good faith RAND negotiations are understood in the industry, assuming retaliatory intentions. If Huawei wishes to cross-examine Mr. Djavaheerian on these assumptions, it is free to do so, but they are not a basis upon which to exclude any portion of his report. Likewise, Huawei's argument that expert opinions on its state

of mind are irrelevant to any issue in the case is moot in light of the Court's conclusion that Mr. Djavaheerian did not offer any such opinions.

The Motion is therefore **DENIED**.

12. Verizon's Motion to Exclude the Testimony of Justin R. Blok (Dkt. No. 285)

The motion was **GRANTED**.

The Court was persuaded that the entirety of Mr. Blok's report was based on an unreliable or nonexistent methodology and that the overall effect of the report was to usurp the role of the factfinder in determining whether or not Verizon could prove its claims of common-law fraud. In the Court's view, as stated on the record, Mr. Blok's report is precisely the kind of expert testimony the *Daubert* standard was created to prevent.

13. Huawei's Motion to Strike New Declaration of Dr. Mondini and the Related Portion of Verizon's Sur-Reply (Dkt. No. 395)

The motion was **DENIED**.

The Court was persuaded, and the parties did not dispute, that this Motion rose or fell with Huawei's Motion for Summary Judgment of Verizon's Breach of Contract Counterclaim (Dkt. No. 262). The Court denied Dkt. No. 262, *surpa*.

MOTIONS IN LIMINE

It is **ORDERED** that the Parties, their witnesses, and counsel shall not raise, discuss, or argue the following before the venire panel or the jury without prior leave of the Court:

I. AGREED MOTIONS IN LIMINE (Dkt. No. 361)

The following MILs were **GRANTED-AS-AGREED** and are applicable to all parties (Dkt. No. 457, 4:16-18):

- | | |
|---------------------|--|
| <u>Agreed MIL 1</u> | Disparaging or negatively insinuating on the nationality, ethnicity, place of residence, or native language of a party or witness. |
| <u>Agreed MIL 2</u> | Reference to the following: <ul style="list-style-type: none">• Uyghurs;• a party's or witness's position on Black Lives Matter;• a party's or witness's position on abortion; or• a party's or witness's religious beliefs or lack thereof. |
| <u>Agreed MIL 3</u> | Any reference to China's connection to the COVID-19 pandemic, or Wuhan's connection to the COVID-19 pandemic. |
| <u>Agreed MIL 4</u> | Any reference that a party has engaged in discovery abuse or litigation misconduct, including reference to discovery disputes and rulings, but provided that Verizon is not precluded by this agreed MIL from referencing any claims by Huawei of Fifth Amendment protections as set forth in the pending motions before the Court (Dkt. 282 and all related motions) or from raising any permitted adverse inferences. |
| <u>Agreed MIL 5</u> | Any reference to forum shopping or that the Eastern District of Texas is the wrong venue for this litigation. |
| <u>Agreed MIL 6</u> | The existence of other lawsuits or legal proceedings, but provided that this does not preclude a party from introducing prior statements from other proceedings for impeachment purposes, so long as the source of those prior statements is not referenced. |
| <u>Agreed MIL 7</u> | The existence of any government or criminal investigations concerning a party or witness, but provided that Verizon is not precluded by this agreed MIL from referencing any claims by Huawei of Fifth Amendment protections as set forth in the pending motions before the Court (Dkt. 282 and all related motions) or from raising any permitted adverse inferences. |

- Agreed MIL 8 **Any reference, argument, evidence, or testimony that a party has placed offices near universities or is otherwise attempting to siphon information from universities.**
- Agreed MIL 9 **Any reference to issues the Court determines will be decided solely by the Court, including evidence only relevant to those issues. To the extent evidence applies to both factual issues properly before the jury as well as issues reserved for the Court, such evidence may be presented to the jury but only for purposes of the factual issues properly before the jury.**
- Agreed MIL 10 **Any reference, argument, or testimony by Huawei that an accused Verizon product infringes a claimed limitation of the Huawei asserted patents under the Doctrine of Equivalents.**
- Agreed MIL 11 **Any reference to the fact that unasserted claims, patents, products, claims or defenses, infringement and invalidity contentions, or prior art were once asserted and later dropped.**
- Agreed MIL 12 **Any argument, evidence, testimony, or reference to either party’s use, if any, of jury studies, jury consultants, focus group studies, mock trial teams, or shadow juries.**
- Agreed MIL 13 **Any explanations comparing the burden of proof regarding invalidity to other areas of law (e.g., family law, adoption law, civil commitment).**
- Agreed MIL 14 **Any argument, evidence, testimony, or reference suggesting that the presumption of validity does not apply, or disparaging or praising the USPTO, its workload, or its expertise, but provided that the parties can reference statements made in the patent video.**
- Agreed MIL 15 **Any reference to any opinion by counsel or a party’s decision not to seek an opinion of counsel.**
- Agreed MIL 16 **Any reference to a petition for, or outcome of, Inter Partes Review (“IPR”) proceedings, including any decisions to institute or not institute.**
- Agreed MIL 17 **Any reference, argument, evidence, or testimony by plaintiff or counterclaim-plaintiff that the benefits and importance of an asserted patent are derived from, comparable to, or coextensive with the benefits and importance of any standard. This does not preclude a party from describing the standard as background to contextualize**

the asserted patents or describing benefits of certain accused features that are discussed in any standard.

II. PLAINTIFF'S MOTIONS IN LIMINE (Dkt. No. 367)

Plaintiff MIL 1 **Any argument, evidence, testimony, or reference commenting on the nationality, ethnicity, national origin, place of residence, political affiliation, or language of a party or witness, including references to the Chinese Communist Party, any alleged connection between Huawei and Chinese government entities, Xinjiang, Hong Kong, Taiwan, and Tibet.**

This MIL was **DENIED**. (Dkt No. 457, at 15:11-16:18.)

The Court further instructed the parties that if they had any doubt about whether the questions they planned to ask crossed the line the Court had described regarding inappropriate or excessive reference to China or national origin in general, they should approach the bench and seek guidance before asking such questions in front of the jury.

Plaintiff MIL 2 **Any argument, evidence, testimony, or reference designed to portray Huawei as a national security threat, or insinuating that Huawei brought this lawsuit in retaliation against the United States, including (i) an alleged “counterattack” by Huawei; (ii) the “14-page memo” allegedly written by Catherine Chen; (iii) the allegations in the EDNY indictment against Huawei; (iv) speeches by Ren Zhengfei employing military jargon; (v) Mr. Ren’s service in the Chinese military; (vi) legal proceedings in Canada or EDNY involving Meng Wanzhou; (vii) the BIS Entity List and similar lists.**

This MIL was **GRANTED**. (*Id.* at 26:15-28:14.)

The Court further instructed that Verizon has the burden to seek leave and demonstrate to the Court why anything related to Huawei as a national security threat should be allowed.

Plaintiff MIL 3

Any argument, evidence, testimony, or reference designed to insinuate that Huawei engages in intellectual property theft or other bad acts, including (i) the so-called “bonus memo” or “bonus program”; (ii) allegations in the EDNY indictment, Congressional, or other legal proceedings; (iii) the fact that Huawei has invoked the Fifth Amendment during discovery; or (iv) reference to problems with intellectual property protection in China.

This MIL was **GRANTED**.

The Court further instructed the parties that this ruling does not constitute an absolute exclusion. Rather, the parties were instructed that the Court intends to play a robust gatekeeping role with regard to this evidence and the parties are to request leave outside of the jury’s presence and permission of the Court to present any such evidence to the jury prior to doing so.

Plaintiff MIL 4

Any reference to dropped or unasserted/unelected claims, patents, products, invalidity contentions, or prior art.

This MIL was **GRANTED**. (*Id.* at 67:17-25.)

The Court further noted that to the extent there is a legitimate avenue to impeach a witness on credibility grounds using evidence that falls into this category, that is certainly something a party can approach and seek leave to do.

Plaintiff MIL 5

Any argument, evidence, testimony, or reference that undermines or collaterally attacks the Court’s claim constructions.

The parties at the pretrial conference agreed to waive oral argument on this MIL. Having considered the MIL, and the parties’ arguments, this MIL is **DENIED**.

The Court will enforce the Court’s Claim Construction Memorandum Order and Opinion (Dkt. No. 162) as written and will not allow the parties to re-argue claim construction at trial or

present evidence that contradicts or undermines that Order. However, there is no need for a separate duplicative Order *in limine* forbidding that practice.

Plaintiff MIL 6 **Any criticism of a party’s litigation strategy based on travel-related decisions or based on the infrequency or lack of thoroughness of access to source code.**

This MIL was **GRANTED** as to the portion of the MIL agreed upon by the parties—excluding any reference or testimony about the way a party reviewed source code in this case. The MIL was also **GRANTED** with regard to any reference or testimony about witnesses absent from trial. (*Id.*, at 47:10-21.) Empty chair arguments are excluded without prior leave.

Plaintiff MIL 7 **Any argument, evidence, testimony, or reference regarding royalty stacking, or about the alleged effect of an infringement finding on a party’s prices, products, or business.**

This MIL was **DENIED**. (*Id.*, at 57:11-12.)

Counsel for Verizon represented on the record that Verizon is not going to try to elicit royalty stacking testimony from any fact witness.

Plaintiff MIL 8 **Any evidence that a party shielded from discovery on the basis of privilege.**

This MIL was **GRANTED**. (*Id.* at 103:17-105:4.)

The Court noted that this MIL was being granted with respect to all parties.

Plaintiff MIL 9

Any suggestion, statement, or implication that the rules of standards-organizations other than the ITU apply to either party’s IP disclosure obligations.

This MIL was **DENIED**. (*Id.* at 79:22-80:3.)

The Court noted that beyond providing background information on standard-setting organizations, the parties are advised to proceed with caution when presenting this type of evidence and to be aware that the Court will not tolerate attempt to confuse or obfuscate what standard-setting body’s rules apply in this case.

III. DEFENDANT’S MOTIONS IN LIMINE (Dkt. No. 366)

Defendant MIL 1

Any questions calling for opinions on legal issues, ultimate conclusions of law, and application of law to facts.

This MIL was **DENIED**. (Dkt. No. 457, at 41:8-9.)

The Court noted that the rules of evidence do not allow fact witnesses to provide opinion testimony and the court intends to fully enforce those rules.

Defendant MIL 2

Any evidence, argument, or reference by Huawei that an accused Verizon product is “equivalent” or “functionally similar” to a claimed limitation.

The parties at the pretrial conference agreed to waive oral argument on this MIL. Having considered the MIL, and the parties’ arguments, this MIL is **DENIED**.

The Court will instruct the jury on what it is to consider when evaluating infringement. Moreover, the parties will be held to the infringement theories they have described in their infringement contentions and on which their competing experts have opined. No party will be

allowed to present a new theory (e.g., an undisclosed Doctrine of Equivalents theory) to the jury at trial and no expert will be allowed to testify as to theories not properly disclosed in the expert's report. The Court will enforce, as usual, the Federal Rules of Evidence and the Federal Rule of Civil Procedure governing these issues. There is no need for a separate and duplicative Order *in limine* forbidding the use of the terms "equivalent" or "functionally similar" at trial.

Defendant MIL 3 **Any evidence, argument, or reference to overall size and revenue.**

This MIL was **GRANTED**. (*Id.*, at 51:18-21.)

The Court noted that this grant was reciprocal and that neither party was to make mention of the other's overall size or revenue,

Defendant MIL 4 **Any argument or reference to Verizon's patents as "essential" or "required to implement" any standard.**

This MIL was **DENIED**. (*Id.*, at 98:4-15.)

The Court noted, however, that Huawei would not be allowed to exceed the scope of the direct examination during its cross-examination to explore these topics unless Verizon opens the door during direct.

Defendant MIL 5 **Any evidence, argument, or reference to non-accused products to prove infringement.**

This MIL was **WITHDRAWN** by Verizon prior to the pretrial conference.

Defendant MIL 6 **Any evidence, argument, or reference to joint defense communications and agreements and common interest privilege.**

This MIL was **GRANTED**. (*Id.*, at 114:5-20.)

The Court noted that neither party will be allowed at trial to point out to the jury where the other party has invoked privilege without first seeking and receiving leave of the Court to do so.

Defendant MIL 7 **Any expert testimony by lay/fact witnesses Wu, Ssu, Lv, Vissers, Wen, and Zhang.**

This MIL was **DENIED**. (*Id.*, at 74:17-18.)


The Court further noted that it will enforce Federal Rule of Civil Procedure 26 as written, and that before any witness who purports to offer an opinion to the jury and there's not a pre-existing written report of that witness that the other side's been served with and had an opportunity to respond to, the party offering that witness is going to have to meet its burden under the rule to show why it is permitted to do so.

Defendant MIL 8 **Any evidence, argument, or reference to financial contributions to politicians or related decisions.**

This MIL was **GRANTED**. (*Id.*, 33:22-34:18.)

The Court further instructed the parties that they may approach to seek leave to introduce such evidence, but it will be the introducing party's burden to demonstrate why the proposed evidence is more probative than prejudicial.

So ORDERED and SIGNED this 2nd day of July, 2021.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE