

UNITED STATES INTERNATIONAL TRADE COMMISSION  
WASHINGTON, DC

In The Matter Of

CERTAIN SILICON MICROPHONE  
PACKAGES AND PRODUCTS  
CONTAINING SAME

337-TA-825

**ORDER NO. 15: REGARDING COMPLAINANT'S MOTION IN LIMINE NO. 1 TO  
EXCLUDE IMPROPERLY DISCLOSED TESTIMONY, EXHIBITS,  
AND ARGUMENT**

(September 26, 2012)

On September 7, 2012, Complainant Knowles Electronics, LLC (Knowles) filed a Motion in Limine to Exclude Improperly Disclosed Testimony, Exhibits, and Argument (Motion Docket No. 825-020). Knowles first seeks to exclude the testimony (including exhibits when relevant) of Complainants' expert, Dr. Michael G. Pecht because:

It contains new opinions not presented in either of his expert reports or in his deposition, as well as related exhibits;

It contains irrelevant opinions relating to contentions Respondents have now abandoned, as well as a related exhibit;

It represents an attempt to rely on invalidity theories not timely disclosed in accordance with the Procedural Schedule, which required Respondents to disclose their invalidity contentions by April 24, 2012; and

It contains testimonial support for claim constructions asserted for the first time long after the April 13, 2012 deadline.

Knowles also seeks to exclude pre-hearing brief arguments not previously disclosed in discovery addressing:

The new contention that the combination of the Minervini '910 reference and Knowles Three-Piece Microphone Packages allegedly render the asserted claims of U.S. Patent No. 7,439,616 (“the '616 patent”) obvious;

The new contention that the Une prior art reference that Respondents contend anticipates claims of U.S. Patent No. 8,018,049 (“the '049 patent”) was somehow enabled;

The new contention that Figures 1-3 in the '049 patent support an argument that some of the asserted claims are somehow invalid for lack of written description; and

The new contention that the principle of issue preclusion should preclude Knowles from arguing (a) that various references or combinations do not disclose various limitations of the asserted claims, (b) that there would not have been a motivation to combine various references, or (c) that various objective indicia of non-obviousness support the validity of the patents asserted in this Investigation.

Respondents Analog Devices, Inc. (“ADI”), Amkor Technology, Inc. (“Amkor”), and Avnet, Inc. (“Avnet”) (collectively, “Respondents”), replied to Complainants’ MiL No. 1 on September 13, 2012. Respondents’ first reply is to allege that collateral estoppel precludes Knowles from re-trying issues on which it lost in Investigation No. 695 and avers this position was timely disclosed.

### **Analysis by Issue**

#### **I. Collateral Estoppel Issue (Generally)**

Just as I refused to rule on Respondents’ allegations directed to collateral estoppel in deciding Respondents’ MiL No. 5 on substantive grounds, I must also refuse to do so to rule on

the instant motion. To exclude any evidence on that basis can only be done in response to a Motion for Summary Determination establishing the affirmative defense is not available. Otherwise, to the extent the matters are properly noticed for this investigation, collateral estoppel will only be decided after a hearing.

In this investigation, Respondents properly plead the affirmative defense of collateral estoppel as their Fifth Affirmative Defense. Hence, Knowles was on notice of the defense and could have conducted discovery designed to explore the matter. Knowles claims it did conduct discovery through application of Interrogatory No. 30. While it is possible someone could construe Interrogatory No. 30 to include asking about collateral estoppel, I cannot agree that Respondents were unresponsive to Interrogatory No. 30 if they failed to discuss collateral estoppel in response, because invalidity, which is undoubtedly the point of Interrogatory No. 30, is not usually associated with collateral estoppel. On the other hand, it could also be argued that Respondents were “two cute by a half” in not discussing collateral estoppel on a claim by claim basis in response to Interrogatory No. 30.<sup>1</sup> Still, there were specific questions Knowles could have asked that would have prevented any evasion concerning the collateral estoppel and these were, apparently, unasked. Under these circumstances, I decline to exclude any reference to collateral estoppel as it may pertain to any failure by Respondents to reply to Interrogatory No. 30. In so doing, I note that Respondents still have to prove collateral estoppel and if they do not, all of the answers related thereto will be a nullity.

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<sup>1</sup> I note Dr. Pecht’s proposed testimony at Q/A 742 and 752 where he uses a very broad meaning for the term invalidity. If I were to hold Respondent responsible for the term used by their expert, then it could be fairly said they failed to properly respond to Interrogatory No. 30.

## II. Dr. Pecht's Opinions on Non-Obviousness

Knowles seeks to exclude responses to Questions 738-39, 742-43, 747-52, 754-63, 770, 773, 779, 780, 785, 787-92, and 794-97 in Dr. Pecht's Direct Witness Statement because these allegedly contain not disclosed in expert discovery. (These new opinions relate to six objective indicia of non-obviousness and are summarized in Complainant's Memorandum in Support at pp. 6-7.) Respondents have agreed to withdraw Q/As 787-792. Otherwise, Respondent's oppose and claim the opinions were disclosed and that any exhibits Knowles seeks to exclude did not exist at the time Dr. Pecht wrote his report or because they were considered in forming his expert report.

I have reviewed the parties' contentions on the Q/As relevant to this part of the MiL. Before ruling, I remind the parties that secondary considerations of non-obviousness should not be considered a primary issue in this investigation. Regardless, I find:

With regard to Q/As 738 and 739, the record cited by Respondents (including the Expert Report boilerplate answers) fails to give Complainant adequate notice of their subject area. Hence, Q/As 738 and 739 are struck and Respondents may not use Dr. Pecht to sponsor any document referenced therein.

The first two sentences of Q/A 742 are struck along with the first word of the third sentence since this is not supported by the record cited by Respondents and is irrelevant to his testimony. Adequate notice of Q/As 743, 747 was provided in Dr. Pecht's report. I note that Q/A 748 is struck because RX-0186C (paragraphs 681-682) does not give adequate notice of the subject area of the answer, but also note that even had I not struck it I would give it little weight because it is a leading question with a suggested answer.

Q/As 749, 750, 752, 751, 756, 757, 758, 759, 761, 794, 795, 796, and 797 are struck because the record cited by Respondents fails to give Complainant reasonable notice of their subject area. (In one particular instance, Q/A 758, I note Respondents' proffered support contradicts the answer.) With regard to Q/A 760, that part of the answer from "however" in the last sentence is struck, otherwise sufficient notice was provided. With regard to Q/A 762, "and RF immunity" is struck from the answer, otherwise the answer is virtually word for word from RX-0186. In passing I note that Respondents reference to testimony in a previous investigation is not helpful. Respondents did provide adequate notice for Q/As 754, 755, 763, 770, 773, 779, 780, and 785. With regard to the exclusion of exhibits, exhibits referenced in Q/As that were not struck are not excluded. Exhibits referenced in Q/As that are struck may only be used to the extent Respondents can use a witness to sponsor these exhibits other than Dr. Pecht and adequate notice was given of the question and answer applicable to the exhibit in question.

### **III. Dr. Pecht's Opinions on Obviousness Combinations**

Knowles seeks to strike Q/As 56, 310-11, 320, 364-65, and 407 of Dr. Pecht's Direct Witness Statement, and Questions 7-8 in his Rebuttal Witness Statement. Knowles alleges these Q/As should be excluded on the ground that these new opinions relating to obviousness combinations, and alleged motivations to combine, were not disclosed in expert discovery. *See* Ground Rule 12.7.6.

Respondents' introduction of RX-0112, as discussed within Q/As 364 and 365 of Dr. Pecht's Direct Witness Statement, is improper and hence these Q/As are struck. With regard to RX-0112, Respondent's logic shows a basic misunderstanding of the process. The key is whether a document or line of testimony is fairly disclosed (adequate notice is given to the other

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